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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,033	11/15/2007	4908746	688013-1RX	2486

35617 7590 07/07/2009

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

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
WILLIAM J. ZYCHLEWIDCZ
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE ,SUITE 2600
ST.LOUIS, MO 63102-2740

Date:
MAILED

JUL 08 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010033
PATENT NO. : 4908746
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)).



Charles D. Huston
DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

(For Patent Owner)

MAILED

JUL 0 8 2009

CENTRAL REEXAMINATION UNIT

William J. Zychlewicz
ARMSTRONG TEASDALE, LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102

(For Third Party Requester)

In re: Mitchell Vaughn

Ex Parte Reexamination Proceeding

Control No.: 90/010,033

Filed: November 11, 2007

For: U.S. Patent No. 4,908,746

: DECISION DENYING
: PETITION FOR
: EXTENSION OF TIME
: (37 CFR § 1.136(b))

This is a decision on the June 30, 2009, petition entitled "Petition for Extension of Time under 37 C.F.R. § 1.136(b)" requesting a one-month extension of time to respond to the May 8, 2009 Final Office Action, thereby making the response deadline August 8, 2009.

The petition is before the Central Reexamination Unit for consideration.

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 4,908,746 (hereinafter, the '746 patent), issued to Mitchell Vaughn, on March 13, 1990.
2. On November 15, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '746 patent. The reexamination proceeding was assigned Control No. 90/010,033 (hereinafter, the '033 proceeding).
3. On May 8, 2009, the Patent Office mailed a Final Rejection for the reexamination proceeding. The Patent Owner was given a two-month shortened statutory period for response.

4. On June 29, 2009, the Patent Owner filed a Revocation of Power of Attorney with a new Power of Attorney.
5. On June 30, 2009, the Patent Owner filed the present petition for an extension of time of one month.

DECISION

The Patent Owner requested a one month extension of time in which to file a response to the Final Rejection mailed May 8, 2009. The request for extension is the first request for an extension of time for the present Office Action. The petition fee of \$200.00 set forth in 37 CFR § 1.17(g) for the present petition was charged to petitioner's credit card on July 1, 2009.

MPEP 2265 states, in part:

The provisions of 37 CFR 1.136 (a) and (b) are NOT applicable to ex parte reexamination proceedings under any circumstances. Public Law 97-247 amended 35 U.S.C. 41 to authorize the Director to provide for extensions of time to take action which do not require a reason for the extension in an "application." An ex parte reexamination proceeding does not involve an "application." 37 CFR 1.136 authorizes extensions of the time period only in an application in which an applicant must respond or take action. There is neither an "application," nor an "applicant" involved in a reexamination proceeding.

Therefore, the petition is **denied**.

CONCLUSION

1. Petitioner's request is **denied**.
2. The response period will end on **July 8, 2009**.



Gregory A. Morse
Director
Central Reexamination Unit

THIRD PARTY REQUESTER NOTICE:

Respondent's Resubmitted Brief filed May 12, 2009, was in response to the improper Appellant Resubmitted Brief filed April 22, 2009, and will not be considered. MPEP 2667.I.A.2.

Third Party Requester Advisory Discussion:

If the Appellant (Patent Owner) timely responds to this Notice, then under 37 CFR 1.947 the Third Party Requester (Respondent) may once file written comments (i.e., Respondent Brief) limited to issues raised by the Right of Appeal Notice or the Appellant's (Patent Owner) brief, within 30 days from the date of service of the Appellant's (Patent Owner) response to this Notice. MPEP 2667.I.A.2 Note that Respondent's brief is limited to 15 pages or 7,000 words, pursuant to 37 CFR 1.943(c). See MPEP 2667.I.B.2, which cites 2667.1.A.2.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,033	11/15/2007	4908746	5818-00601	2486

35617 7590 07/23/2009

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P.O. BOX 684908
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

WILLIAM J. ZYCHLEWIDCZ
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE ,SUITE 2600
ST.LOUIS, MO 63102-2740

Date:

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010033
PATENT NO. : 4908746
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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Charles D Huston :
DAFFER MCDANIEL LLP : (For Patent Owner)
P.O. BOX 684908 :
AUSTIN TX 78768 :

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

William J Zychlewicz :
ARMSTRONG TEASDALE LLP : (For Third Party
ONE METROPOLITAN SQUARE, : Requester)
SUITE 2600 :
ST. LOUIS, MO 63102-2740 :

In re: Mitchell D Vaughn : DECISION
Ex Parte Reexamination Proceeding : DISMISSING
Control No. 90/010,033 : PETITION FOR EXTENSION
Deposited: 06 February 2008 : OF TIME
For: US Patent No. 4,908,746 : 37 CFR § 1.550(c) & 1.181

This is a decision on the 13 July 2009, "Request for Reconsideration of Petition for Extension of Time" filed under 37 CFR § 1.550(c) requesting that the time for responding to the Final Office action mailed 08 May 2009, be extended by thirty (30) days. The petition was filed with the required certificate of service and petition fee. The petition was not 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 extended in which to file a response to the Final Office action mailed 08 May 2009, which set a two (2) months date for filing a response thereto. The petition was filed with the required certificate of service and petition fee. The patent owner's petition for extension of time filed on 13 July 2009 is not timely.

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)

ANALYSIS AND FINDINGS

The patent owner's petition to extend the period for response by thirty (30) days is before the director of the CRU. The Final Office action was mailed 08 May 2009. The time for response to the Final Office action was two (2) months for which to respond thereto.

The due date for response thereto was 08 July 2009. The instant petition was submitted on 13 July 2009. The petition was not timely filed. Pursuant to 37 CFR 1.550(c) "Any request for such extension must be filed on or before the day on which action by the patent owner is due..."

The petition request to extend the response time by thirty (30) days is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of thirty (30) days time in which to file a response to the Final Office action dated 08 May 2009 is hereby dismissed
2. The Patent Owner's response was due 08 July 2009.
3. The proceeding is hereby returned to the examiner for further handling.
4. Correspondence to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,033	11/15/2007	4908746	5818-00601	2486 -

35617 7590 07/28/2009

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/28/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

WILLIAM J. ZYCHLEWIDCZ
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE ,SUITE 2600
ST.LOUIS, MO 63102-2740

Date:

MAILED

JUL 28 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010033
PATENT NO. : 4908746
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)).



Daffer McDaniel, LLP
P.O. Box 684908
Austin, TX 78768

(For Patent Owner)

MAILED

JUL 28 2009

William J. Zychlewicz
Armstrong Teasdale LLP
One Metropolitan Square
Suite 2600
St. Louis, MO 63102-2740

(For Third Party Requester) CENTRAL REEXAMINATION UNIT

In re Mitchell D. Vaughn
Ex Parte Reexamination Proceeding
Control No. 90/010,033
Filed: November 15, 2007
For: U.S. Patent No. 4,908,746

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

This is a decision on the July 22, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination ("the July 22, 2009 patent owner petition to revive").

The appropriate petition fee of \$1,620.00 set forth in 37 CFR 1.17(m) for the July 22, 2009 patent owner petition to revive has been paid.

The July 22, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 22, 2009 patent owner petition to revive is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such

shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 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 July 22, 2009 petition satisfies only one of the three criteria required under 37 CFR 1.137(b). Specifically, a petition fee was submitted as part of the July 22, 2009 patent owner petition to revive, which satisfies item (2).

Regarding item (1), however, the criterion of submitting the requisite response required by the outstanding final Office action has not been satisfied.

In particular, the instant reexamination proceeding was terminated due to the failure to timely submit a response to the May 8, 2009 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 certificate by making all pending claims patentable or (ii) a Notice of Appeal and appeal fee.¹

Patent owner submitted a paper titled "Response To Office Action Mailed May 8, 2009" on July 22, 2009, together with accompanying Declarations. The primary examiner for the instant reexamination proceeding has confirmed that the July 22, 2009 Response and Declarations neither cancel all the rejected claims nor otherwise *prima facie* place the proceeding in condition for issuance of a reexamination certificate by making all

¹ See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

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 July 22, 2009 petition is incomplete.

Regarding item (3), the criterion of submitting a proper statement under 37 CFR 1.137(b)(3) has not been satisfied. 37 CFR 1.137(b)(3) provides, in pertinent part:

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. [Emphasis added.]

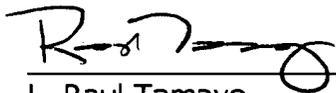
In contrast, patent owner states in the July 22, 2009 petition to revive "that the entire delay in filing the required reply from the due date for the reply until the filing of **this** petition was unintentional" (emphasis added). The July 22, 2009 patent owner petition to revive, i.e., "this petition," is not a grantable petition, for at least the reason that patent owner has not satisfied the criterion of submitting the requisite response required by the outstanding final Office action. Therefore, the July 22, 2009 patent owner petition to revive also fails to satisfy the criterion of submitting a proper statement under 37 CFR 1.137(b)(3). It is suggested that the precise language of 37 CFR 1.137(b)(3) be used as part of any future request for reconsideration of this decision.

For the foregoing reasons, the July 22, 2009 patent owner petition to revive is **dismissed**.

CONCLUSION

1. The July 22, 2009 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 (i) a proper reply to the May 8, 2009 final Office action and/or a Notice of Appeal and appeal fee and (ii) a proper statement under 37 CFR 1.137(b)(3). 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, Majid Banankhah, of CRU Art Unit 3992, at (571) 272-3770.
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



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DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

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AUG 21 2009

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Daffer McDaniel, LLP
P.O. Box 684908
Austin, TX 78768

(For Patent Owner)

MAILED

AUG 21 2009

William J. Zychlewicz
Armstrong Teasdale LLP
One Metropolitan Square
Suite 2600
St. Louis, MO 63102-2740

(For Third Party Requester) CENTRAL REEXAMINATION UNIT

In re Mitchell D. Vaughn
Ex Parte Reexamination Proceeding
Control No. 90/010,033
Filed: November 15, 2007
For: U.S. Patent No. 4,908,746

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

This is a decision on the August 7, 2009 patent owner renewed petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination ("the August 7, 2009 patent owner renewed petition to revive").

The August 7, 2009 patent owner renewed petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 7, 2009 patent owner renewed petition to revive is **granted**.

The July 24, 2009 Notice of Intent to Issue a Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer*.

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

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

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Renewed Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal and paid the corresponding fee of \$540.00 on August 7, 2009, thereby satisfying item (1).¹

A petition fee of \$1,620.00 was submitted as part of the July 22, 2009 patent owner petition to revive, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted on August 7, 2009. Therefore, item (3) is deemed to have been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.²

Accordingly, the August 7, 2009 patent owner renewed petition to revive is **granted**.

The July 24, 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 7, 2009 patent owner renewed petition to revive under 37 CFR 1.137(b) is **granted**.
2. The July 24, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

¹ See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

² See: 37 CFR 1.137(d)(3).

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for further processing in view of the August 7, 2009 Notice of Appeal, and for treatment of the July 22, 2009 response after final Office action in due course.
4. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).
5. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Majid Banankhah, of CRU Art Unit 3992, at (571) 272-3770.
6. 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



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,033	11/15/2007	4908746	5818-00601	2486

35617 7590 11/19/2009

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/19/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

WILLIAM J. ZYCHLEWIDCZ
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE ,SUITE 2600
ST.LOUIS, MO 63102-2740

Date:
MAILED

NOV 19 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010033
PATENT NO. : 4908746
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)).



PANITCH SCHWARZE BELISARIO & NADEL LLP :
ONE COMMERCE SQUARE :
2005 MARKET STREET, SUITE 2200 :
PHILADELPHIA PA 19103 :

(For Patent Owner)

MAILED

NOV 19 2009

CENTRAL REEXAMINATION UNIT

WILLIAM J. ZYCHLEWICZ :
ARMSTRONG TEASDALE LLP :
ONE METROPOLITAN SQUARE, SUITE 2600 :
ST. LOUIS, MO 63102-2740 :

(For Requester)

DAFFER MCDANIEL LLP :
P.O. BOX 684908 :
AUSTIN TX 78768 :

(Courtesy Copy)

In re Vaughn :
Ex Parte Reexamination Proceeding :
Control No. 90/010,033 :
Filed: November 15, 2007 :
For: U.S. Patent No. 4,908,746 :

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

This is a decision on the September 11, 2009 patent owner petition entitled "PETITION TO CONTINUE EX PARTE REEXAMINATION PROCEEDING UNDER 37 CFR § 1.182."

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

The petition is **dismissed** as to the continued reexamination that was requested.

The petition is **granted** to the extent that the July 22, 2009 declarations are entered, and a period of **30 days** from the mailing date of this decision is hereby set for patent owner to submit a substitute appeal brief that may rely on the now-admitted declarations, or to ratify the current brief.

BACKGROUND

1. On September 28, 2007, a request for *ex parte* reexamination of claims 1-16 of U.S. Patent Number 4,908,746 was filed by the third party requester; the resulting reexamination proceeding was given a filing date of November 15, 2007, corresponding to the date that the filing requirements of 37 CFR 1.510 were received, and assigned control number 90/010,033 ("the '10033 proceeding").
2. On January 11, 2008, an order granting reexamination of claims 1-16 of the '746 patent was mailed in the '10033 proceeding.

3. On June 6, 2008, a non-final Office action, in which claims 1-16 were rejected, was mailed in the '10033 proceeding.
4. On August 28, 2008, a first interview was held between patent owner and Office personnel, discussing a proposed declaration of prior invention under 37 CFR 1.131.
5. On September 8, 2008, patent owner submitted a timely response to the outstanding Office action, including a declaration of prior invention under 37 CFR 1.131 by the inventor, Mitchell Vaughn, and accompanying exhibits 1-4.
6. On May 8, 2009, a final Office action was mailed, setting a two month period for response, and rejecting claims 1-16 and finding the declaration and exhibits insufficient to support a finding of prior invention.
7. On July 22, 2009, patent owner submitted a response to the outstanding final Office action, including declarations by Deborah Blackstone, Ellen Bolton, and Dan Mitchell, and a new declaration by the inventor, Mitchell Vaughn, with accompanying exhibits. However, the submission was untimely, and a petition to revive the proceeding filed on the same date was dismissed on July 28, 2009.
8. The Office issued a Notice of Intent to Issue a Reexamination Certificate on July 24, 2009.
9. On August 7, 2009, patent owner filed a renewed petition under 37 CFR 1.137(b), accompanied by a Notice of appeal, to revive the reexamination proceeding and requesting entry of the July 22, 2009 declarations.
10. On August 21, 2009, the Office granted the August 7, 2009 patent owner renewed petition under 37 CFR 1.137(b), withdrawing the July 24, 2009 Notice of Intent to Issue a Reexamination Certificate. Jurisdiction over the proceeding was returned to the Central Reexamination Unit for treatment of the July 22, 2009 response after final Office action in due course. As patent owner filed a Notice of appeal on August 7, 2009, the time period for filing an appeal brief was set to expire two months from the mailing date of the August 21, 2009 decision.
11. On September 11, 2009, patent owner filed the instant petition entitled "PETITION TO CONTINUE EX PARTE REEXAMINATION PROCEEDING UNDER 37 CFR § 1.182," requesting that the evidence submission of July 22, 2009 be considered.
12. On October 15, 2009, patent owner filed a petition for extension of time under 37 CFR 1.550(c) to extend the time for filing the appeal brief for 30 days.
13. On October 21, 2009, the Office issued an advisory action denying entry of the evidence submission of July 22, 2009.

14. On October 21, 2009, patent owner filed an appeal brief.
15. On October 22, 2009, the Office dismissed the October 19, 2009, patent owner petition for extension of time under 37 CFR 1.550(c) to extend the time for filing the appeal brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.116(e) provides, in pertinent part:

An affidavit or other evidence submitted after a final rejection or other final action . . . in an ex parte reexamination filed under § 1.510, . . . but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.182 provides:

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

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

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

37 CFR 1.525(a) provides, in pertinent part:

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

DECISION

The Requested Relief of Continued Reexamination is Unavailable

The September 11, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of an evidence submission not yet considered by the Office. Patent owner based the instant petition upon an Office Notice issued in March of 2005, titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

At the time of the September 11, 2009 filing of the instant petition, the July 22, 2009 submission was currently under review by Office personnel, and had not been denied entry after a final rejection in the proceeding. Where an evidence submission has not been denied entry after a final rejection in a proceeding, a petition based upon the procedure set forth in the March, 2005 Notice is inappropriate.² Therefore the instant petition for continuation of the reexamination proceeding could not have been granted upon the facts present at the time of the filing of the petition.

Even if the instant petition had been submitted following the examiner's October 21, 2009 refusal to enter the July 22, 2009 evidence, the petition did not allege facts sufficient to permit the petition to be granted. There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 CFR 1.182 can provide continued-reexamination relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the statutory requirement for special dispatch in reexamination. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the

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

² Patent owner's request for extension of time of October 15, 2009, acknowledged that the 1.182 petition could not be decided until a decision was rendered by the Examiner. See page 2 of the request.

§ 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition, since these are key factors in reducing pendency of a reexamination proceeding. In the instant petition, patent owner alleged that the evidence submission of July 22, 2009 provided “evidence related to the events concerning FactoryLink development and commercialization in the 1985-1986 time frame.” However, patent owner did not state how the evidence submission addressed the examiner’s rejection such that the prosecution of the reexamination would be furthered, rather than delayed, in accordance with the mandate of special dispatch. Therefore, for this reason also, the petition may not be granted upon the facts present in the petition as filed.

Finally, the continued-reexamination relief requested would retard the progress of reexamination contrary to the statutory requirement for special dispatch in reexamination, as opposed to the relief as immediately-below-granted, which will further the requirement for special dispatch.

2. Patent Owner’s Declarations Are Entered

Although patent owner’s submission is inadequate to satisfy the requirements for continued reexamination, an equitable manner of relief may be provided in this instance.

Patent owner’s evidentiary submissions were submitted after final rejection but before appeal, and therefore 37 CFR 1.116(e) sets forth the requirements for their entry. As patent owner has not requested waiver of this regulation, the evidentiary submissions must satisfy 37 CFR 1.116(e), which requires that there be good and sufficient reasons why the evidence is necessary and was not earlier presented.

Applicant’s petition addresses both requirements. With regard to why the submission was not earlier presented, applicant states that the patent owner believed, as a result of the interview conducted on August 28, 2009 between patent owner and the Office, that the September 8, 2008, declaration of prior invention under 37 CFR 1.131 by the inventor, Mitchell Vaughn, and accompanying evidence “would be sufficient to swear behind the cited reference.” The declaration and evidence were held to be deficient in meeting the required burden of proof in the final Office action of May 8, 2009. The July 22, 2009 after-final submission was submitted in response to the deficiencies in the declaration of prior invention that were first noted in the final Office action of May 8, 2009. In view of the particular fact situation in this proceeding, patent owner’s statements, as presented in the petition, are considered to be a showing of good and sufficient reasons why the evidence was not earlier presented.

With regard to why the evidence is necessary, patent owner’s petition alleges that the July 22, 2009 evidence submission provides “evidence related to the events concerning FactoryLink development and commercialization in the 1985-1986 time frame.” Patent owner’s petition further alleges that the submission places the case in condition for the issuance of a reexamination certificate. While neither of these allegations, by themselves, satisfactorily address the question of whether the submission is “necessary”, the Office may look to the entirety of the record to make such a determination. The reference that patent owner seeks to remove from prior art through the evidence submissions is relied upon in every rejection applied by the Office to the claims. If a successful showing of prior invention is made, it would thus

result in the withdrawal of all of the rejections of record. The submissions are directed to addressing the deficiencies raised by the examiner in the final Office action. Such submissions are neither patents nor printed publications, and could not be the source of a future reexamination proceeding of the same patent. Thus, the submissions are deemed to be of sufficient need, based upon the aforementioned fact situation particular to this proceeding, to complete the appeal to the Board of Patent Appeals and Interferences.

Since there are good and sufficient reasons why the July 22, 2009 declarations are necessary and were not earlier presented, patent owner's petition is **granted** to the extent that the July 22, 2009 declarations are entered. It is also observed that entry of the affidavits as a consequence of this decision has been authorized by SPE Eric Keasel of the Central Reexamination Unit. In order to satisfy the statutory requirement of special dispatch, a period of **30 days** from the mailing date of this decision is hereby set for patent owner to submit a new (substitute) appeal brief that may rely on the now-admitted declarations, or to ratify the current brief.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. The patent owner addresses is not the same as that in the reexamination proceeding. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 CFR 1.33(c), and it is that of Panitch Schwarze Belisario & Nadel LLP, One Commerce Square, 2005 Market Street, Suite 2200. Accordingly, all future correspondence will be directed to Panitch Schwarze Belisario & Nadel LLP, One Commerce Square, 2005 Market Street, Suite 2200, unless, within **ONE (1) MONTH** of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123. As a courtesy, a copy of this decision is being mailed to the address of record in the reexamination file, Daffer McDaniel LLP, P.O. Box 684908, Austin TX 78768.

CONCLUSION

- The petition is **dismissed**.
- Patent owner's petition is **granted** to the extent that the July 22, 2009 declarations are entered.
- A period of **30 days** from the mailing date of this decision is hereby set for patent owner to submit a substitute appeal brief that may rely on the now-admitted declarations, or to ratify the current brief.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further proceedings.

- 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

November 17, 2009
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C:\Kiva\KenAffidavit\



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,035	10/11/2007	6712387	ATI-207 REEX II	5266
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22846 7590 06/05/2008

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

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 06/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/008,352

11/27/2006

6712387

ATI-207 RE

5109

22846

7590

06/05/2008

EXAMINER

BRIAN ROFFE, ESQ

11 SUNRISE PLAZA, SUITE 303

VALLEY STREAM, NY 11580-6111

ART UNIT

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Brian Roffe, Esq.
11 Sunrise Plaza, Suite 303
Valley Stream, NY 11580-6111

(For Patent Owner)

Richard K. DeMille
Brinks Hofer Gilson & Lione
3600 NBC Tower
455 N. Cityfront Plaza Drive
Chicago, IL 60611-5599

(For 3rd Party Requester)

MAILED
JUN 05 2008

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/008,352
Filed : November 27, 2006
For U.S. Patent No. : 6,712,387

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,035
Filed : October 11, 2007
For U.S. Patent No. : 6,712,387

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,352 was ordered in a decision mailed January 4, 2007 indicating that claims 1-38, all of the claims would be reexamined. Prosecution has progressed to the point where an Appeal Brief was filed on March 11, 2008. Some of the claims in this proceeding stand amended per an amendment filed August 22, 2007. No further action has taken place since the filing of the Appeal Brief.

Reexamination in application control No. 90/010,035 was ordered in a decision mailed January 7, 2008 indicating that claims 1-38, all of the claims would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Thus, there have been no changes made to the specification, claims, or drawings.

As evidenced by the above facts, reexamination control No. 90/008,352 and reexamination control No. 90/010,035 are currently pending. Since the order to reexamine has been mailed in

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

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

As noted above, claims have been amended in the '352 reexamination proceeding by virtue of the amendment filed August 22, 2007. No amendments have been filed in the '035 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

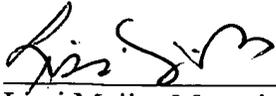
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-38, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,352 and 90/010,035 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,035	10/11/2007	6712387	AT1-207 REEX II	5266

22846 7590 09/24/2008

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/24/2008

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



Brian Roffe, Esq.
11 Sunrise Plaza
Suite 303
Valley Stream, NY 11580-6111

(For Patent Owner)

Richard K. Demille
BRINKS HOFER GILSON & LIONE
3600 NBC Tower
455 N. CityFront Plaza Drive
Chicago, IL 60611-5599

(For Requester)

MAILED

SFP 24 2008

CENTRAL REEXAMINATION UNIT

In re Breed et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,352
Filed: November 27, 2006
For: U.S. Patent No. 6,712,387

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

In re Breed et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,035
Filed: October 11, 2007
For: U.S. Patent No. 6,712,387

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This is a decision on the September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding (“the September 5, 2008 patent owner petition to revive”).

The September 5, 2008 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of \$770, for a small entity, set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to the patent owner’s deposit account no. 50-0266, as authorized on page 1 of the September 5, 2008 patent owner petition.

SUMMARY

The September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*
*

(d) *Terminal Disclaimer*.

*
*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*
*

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

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

Abandonment for Failure To Reply to a Non-Final Action

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

- (A) an argument or an amendment under 37 CFR 1.111 . . .

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period . . . for correction of the error or omission.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response¹ to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted a response on August 21, 2008 in reply to the July 19, 2008 nonfinal Office action, which satisfies item (1).² A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the September 5, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding³ is **granted**.

¹ In *ex parte* reexamination proceedings, the word “reply” is replaced by “response” to avoid confusion with the “reply” that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

² See MPEP 2268 IV and MPEP 711.03(c) II A 2 (a). Note that the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.

³ Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was “terminated” within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response to the July 19, 2008 nonfinal Office action.

CONCLUSION

- The September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.
- The merger of *ex parte* reexamination control nos. 90/008,352 and 90/010,035 **has been reinstated**.
- Jurisdiction over this merged reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the August 21, 2008 patent owner response to the July 19, 2008 nonfinal Office action.
- Any inquiry concerning the **examination** of this merged reexamination proceeding should be directed to the primary examiner, Joseph Kaufman, of CRU Art Unit 3993, at (571) 272-4928.
- Any inquiry concerning this **decision** should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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

cn



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,038	10/17/2007	5700676	Q103466	1921

67374 7590 09/30/2008

MORGAN, LEWIS & BOCKIUS, LLP
ONE MARKET SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/30/2008

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

JOHN T. CALLAHAN/WILLIAM J. SIMMONS, Ph. D.
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE
WASHINGTON, D.C. 20037

MAILED

SEP 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,038.

PATENT NO. 5700676.

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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Richard Trecartin
Morgan, Lewis & Brockius LLP
One Market, Spear Street Tower
San Francisco, California 94105

for Patent Owner

John T. Callahan
Sughrue Mion PLLC
2100 Pennsylvania Ave., N.W. Suite 800
Washington, DC 20037

for Requester

MAILED

SEP 30 2008

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/010,038
Filed: October 17, 2007
For: US Patent No. 5,700,676

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

This is a decision on the petition filed March 11, 2008 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated January 14, 2008.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated January 14, 2008, which set a two-month date for filing a response thereto. The Office action is an Order Granting Request for Reexamination. 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

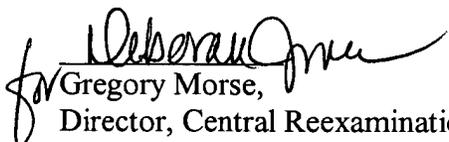
The petition for extension of time indicates that Patentee has been reviewing the Office action and gathering the necessary information in order to prepare a response. An extension of one month is needed to provide Patent Owner with a fair opportunity to complete the investigation of facts and prepare a complete response to the rejections.

Analysis and Findings

In a telephone conversation with counsel for Patent Owner, it was determined that the Order Granting the Request for Reexamination had been mistakenly interpreted as an Office action based on the request. Patent Owner will not be submitting a Patent Owner statement. Inasmuch as there has been no Office action based on the Request, the petition for additional time is unnecessary and is therefore dismissed.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated January 14, 2008 is **dismissed**.
2. The reexamination proceeding is returned to the Examiner for action in due course.
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.


for Gregory Morse,
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,038	10/17/2007	5700676	Q103466	1921

67374 7590 02/13/2009
MORGAN, LEWIS & BOCKIUS, LLP
ONE MARKET SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/13/2009

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Richard Trecartin
Morgan, Lewis & Brockius LLP
One Market, Spear Street Tower
San Francisco, California 94105

for Patent Owner

John T. Callahan
Sughrue Mion PLLC
2100 Pennsylvania Ave., N.W. Suite 800
Washington, DC 20037

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/010,038
Filed: October 17, 2007
For: US Patent No. 5,700,676

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

MAILED
FEB 13 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the petitions filed December 3, 2008 and December 30, 2008 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated July 3, 2008.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated July 3, 2008, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the \$200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

These petitions for extensions of time state that the attorney in charge of responding to the outstanding Office action continues to undergo treatment for complications of the surgery of July 9, 2008. Additional time is needed to complete the review and prepare an adequate response.

Analysis and Findings

The petition filed on December 3, 2008 was accompanied by a timely filed response to the outstanding Office action. As such, no additional time is deemed necessary for filing a response.

Conclusion

The Patent Owner's petition for extension of time in which to file a response to the Office action dated July 3, 2008 is **dismissed** .

Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

for 
Gregory Morse,
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,039	10/17/2007	5955340	Q103467	1960

67374 7590 09/30/2008

MORGAN, LEWIS & BOCKIUS, LLP
ONE MARKET SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

EXAMINER

ART UNIT PAPER NUMBER

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Richard Trecartin
Morgan, Lewis & Brockius LLP
One Market, Spear Street Tower
San Francisco, California 94105

for Patent Owner

John T. Callahan
Sughrue Mion PLLC
2100 Pennsylvania Ave., N.W. Suite 800
Washington, DC 20037

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/010,039
Filed: October 17, 2007
For: US Patent No. 5,955,340

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

MAILED

SEP 30 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the petition filed August 27, 2008 to request a two-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated July 8, 2008.

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

The petition is granted for two months for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated July 8, 2008, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the \$200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that the attorney in charge of responding to the outstanding Office action underwent surgery on July 9, 2008. Due to serious complications which required subsequent surgeries, additional time is needed to complete the review and prepare an adequate response. An extension of two months is requested provide Patent Owner with a fair opportunity to reply to the outstanding rejections.

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-month extension of time in which to file a response to the outstanding Office action. Accordingly, the period of time for filing a reply to the Office action dated July 8, 2008 is extended to run four (4) months from the date of the Office action and is due on November 8, 2008. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated July 8, 2008 is **granted** for two (2) months.
2. The Patent Owner's response is due November 8, 2008.
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.

for 
Gregory Morse,
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,039	10/17/2007	5955340	Q103467	1960

67374 7590 02/23/2009

MORGAN, LEWIS & BOCKIUS, LLP
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/23/2009

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Richard Trecartin
Morgan, Lewis & Brockius LLP
One Market, Spear Street Tower
San Francisco, California 94105

for Patent Owner

John T. Callahan
Sughrue Mion PLLC
2100 Pennsylvania Ave., N.W. Suite 800
Washington, DC 20037

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/010,039
Filed: October 17, 2007
For: US Patent No. 5,955,340

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

FILED
FEB 23 2009
CENTRAL REEXAMINATION UNIT

This is a decision on the petition filed October 30, 2008 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated July 8, 2008.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated July 8, 2008, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the \$200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

This second petition for extension of time states that the attorney in charge of responding to the outstanding Office action continues to undergo treatment for complications of the surgery of July 9, 2008. Additional time is needed to complete the review and prepare an adequate response. An extension of one month is requested provide Patent Owner with a fair opportunity to reply to the outstanding rejections.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is adequate to justify the grant of a one-month extension of time in which to file a response to the outstanding Office action. Accordingly, the period of time for filing a reply to the Office action dated July 8, 2008 is extended to run five (5) months from the date of the Office action and is due on December 8, 2008. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated July 8, 2008 is **granted** for one (1) month.
2. The Patent Owner's response is due December 8, 2008.
3. Response may be submitted as follows:

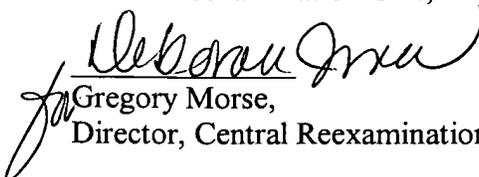
By EFS: See 37 CFR 1.8(a)(C)(ii)

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.


Gregory Morse,
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,039	10/17/2007	5955340	Q103467	1960

67374 7590 02/23/2009

MORGAN, LEWIS & BOCKIUS, LLP
ONE MARKET SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/23/2009

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Richard Trecartin
Morgan, Lewis & Brockius LLP
One Market, Spear Street Tower
San Francisco, California 94105

for Patent Owner

MAILED

FEB 23 2009

CENTRAL REEXAMINATION UNIT

John T. Callahan
Sughrue Mion PLLC
2100 Pennsylvania Ave., N.W. Suite 800
Washington, DC 20037

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/010,039
Filed: October 17, 2007
For: US Patent No. 5,955,340

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

This is a decision on the petition filed December 30, 2008 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated July 8, 2008.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated July 8, 2008, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the \$200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

These petitions for extensions of time state that the attorney in charge of responding to the outstanding Office action continues to undergo treatment for complications of the surgery of July 9, 2008. Additional time is needed to complete the review and prepare an adequate response.

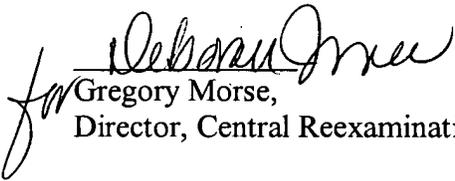
Analysis and Findings

The petition filed on December 30, 2008 was accompanied by a timely filed response to the outstanding Office action. As such, no additional time is deemed necessary for filing a response.

Conclusion

The Patent Owner's petition for extension of time in which to file a response to the Office action dated July 8, 2008 is **dismissed**.

Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.


for Gregory Morse,
Director, Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,042	11/08/2007	6,112,264	2540-1085	8514

42624 7590 10/31/2008

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/31/2008

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

OCT 31 2008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010042
PATENT NO. : 6112264
ART UNIT : 3992

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Michael R Casey
DAVIDSON BERQUIST JACKSON
& GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON VA 22203

(For Patent Owner)

OCT 31 2008

Tracy Druce
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA
WELLS FARGO PLAZA
53RD FLOOR
HOUSTON, TX 77002

(For Third Party

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

In re: Beasley et alia
Ex Parte Reexamination Proceeding
Control No. 90/010,042
Deposited on: 8 November 2007
For: US Patent No. 6,112,264

This is a decision on the 24 October 2008, patent owner's petition for "Renewed Petition Under 37 CFR § 1.1550 (c) for Extension of Time in an Ex Parte Reexamination" requesting that the time for responding to the Office action mailed 23 September 2008, be extended by one-month.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 23 September 2008, which set a one-month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 24 October 2008, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g). This is a renewed petition for extension of time.

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, there is always a question when considering the balance between the need for “special dispatch” and the need for a fair opportunity to respond to an outstanding Office action. The showing of “sufficient cause” is the criteria for this evaluation.

The patent owner’s renewed petition for a one-month extension of time from the original due date of 23 October 2008 is before the Director of the Central Reexamination Unit for consideration. Given the fact base noted in the renewed request of the extensive length of the outstanding Office action as well as evaluation of secondary considerations the patent owner has provided “sufficient cause” for granting a one-month extension for time.

The petition request is hereby **granted** for a period of one-month.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 23 September 2008 is hereby **granted**.
2. The period for response is extended by one-month.
3. The Patent Owner's response is due **23 November 2008**.
4. Response may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/

Gregory Morse
Director,
Central Reexamination Unit 3999



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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.
90/010,043	11/08/2007	7113978	2540-1081	8796

42624 7590 10/09/2008
DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/09/2008

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Tracy Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Ave., WELLS FARGO PLAZA 53rd Floor
Houston, TX 77002

Date:

MAILED

OCT 09 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010043
PATENT NO. : 7113978
ART UNIT : 3992

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

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



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United States Patent and Trademark Office
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MAILED

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

(For Patent Owner)

OCT 09 2008

CENTRAL REEXAMINATION UNIT

Tracy Druce
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA
WELLS FARGO PLAZA
53RD FLOOR
HOUSTON, TX 77002

(For Third Party

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

In re: Beasley et alia
Ex Parte Reexamination Proceeding
Control No. 90/010,043
Deposited on: 8 November 2007
For: US Patent No. 7,113,978

This is a decision on the 3 October 2008, petition for "Petition Under 37 CFR § 1.1550 (c) for Extension of Time in an Ex Parte Reexamination" requesting that the time for responding to the Office action mailed 23 September 2008, be extended by one-month.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 23 September 2008, which set a one-month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 3 October 2008, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, there is always a question when considering the balance between the need for “special dispatch” and the need for a fair opportunity to respond to the outstanding Office action. The showing of sufficient cause is the criteria for this evaluation. In this petition the patent owner has not provided an explanation for sufficient cause as to why the time is needed and should be granted. Interviews with examiners are not considered to be sufficient cause to extend the period for response. While interviews with examiners are not normally considered sufficient cause for extension of time, since the examiner is out of the Office for a weeks period of time the time for response is granted-in-part. For any additional time there should be outlined in the petition exactly why the time is needed and how it is beyond the control of the patent owner to work within the time period set for response to said Office action.

The petition request is hereby **granted in part** for a period of one-week

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 23 September 2008 is hereby **granted-in-part**
2. The period for response is extended by one-week.
3. The Patent Owner's response is due **30 October 2008**.
4. Response may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/

Gregory Morse
Director,
Central Reexamination Unit 3999



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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,044 11/05/2007 5974120 8236.002.0120 7796

35554 7590 04/17/2008

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/17/2008

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG, LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET

FIFTY-THIRD FLOOR

HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,044.

PATENT NO. 5974120.

ART UNIT 3992.

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

Reena Kuyper, Esq.
Byard Nilsson, Esq.
9255 Sunset Boulevard
Suite 810
Los Angeles, CA 90069

(For Patent Owner)

Welsh & Flaxman
2000 Duke Street, Suite 100
Alexandria, VA 22314

(For Third Party Requester)

Novak, Druce, & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

In re Katz et alia
Reexamination Proceeding
Control No. 90/008,229
Request Deposited: September 20, 2006
For: U.S. Patent No. 5,974,120

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Katz et alia
Reexamination Proceeding
Control No. 90/010,044
Request Deposited: November 5, 2007
For: U.S. Patent No. 5,974,120

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:
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:
:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,974,120 (hereinafter, the '120 patent), issued to *Katz et alia*, on October 26, 1999.

Art Unit: 3992

2. On September 20, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '120 patent. The reexamination proceeding was assigned Control No. 90/008,229 (hereinafter, the '8229 proceeding).
3. The Reexamination Order was granted in the '8229 proceeding on December 14, 2006.
4. There are currently no amendments in the '8229 proceeding.
5. On November 5, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '120 patent. The reexamination proceeding was assigned Control No. 90/010,044 (hereinafter, the '10044 proceeding).
6. The Reexamination Order was granted in the '10044 proceeding on February 1, 2008.
7. There are currently no amendments in the '10044 proceeding.
8. The '8229 and '10044 proceedings await the first action on the merits from the assigned examiner.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8229 and the '10044 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

Art Unit: 3992

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,229 and 90/010,044 are MERGED.
2. The reexamination files are being forwarded to the examiner for issuing a first Office action.
3. All correspondence regarding these proceedings should be submitted as follows:

By Mail: Mail Stop *Ex Parte* Reexam”
 Attn: Central Reexamination Unit
 Commissioner for Patents
 P. O. Box 1450
 Alexandria VA 22313-1450

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

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


Lissi Mojica Marquis
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,044	11/05/2007	5974120	8236.002.0120	7796
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35554 7590 04/17/2008

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 04/17/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG, LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET

FIFTY-THIRD FLOOR

HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,044.

PATENT NO. 5974120.

ART UNIT 3992.

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

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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REENA KUYPER, ESQ. : (For Patent Owner)
BYARD NILSSON, ESQ. :
9255 SUNSET BOULEVARD :
SUITE 810 :
LOS ANGELES CA 90069 :

WELSH & FLAXMAN LLC : (For Third Party Requester)
2000 Duke Street :
Suite 100 :
Alexandria VA 22314 :

NOVAK DRUCE & QUIGG, LLP : (For Third Party Requester)
(NDQ Reexamination Group) :
1000 Louisiana Street :
Fifty-Third Floor :
Houston, TX 77002 :

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Katz :
Ex Parte Reexamination Proceeding :
Control No. 90/008,229 :
Deposited : 20 September 2006 :
For: US Patent No. 5,974,120 :

In re: Katz :
Ex Parte Reexamination Proceeding :
Control No. 90/010,044 :
Deposited : 5 November 2007 :
For: US Patent No. 5,974,120 :

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

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

Since the two proceedings have not been terminated, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,229 and 90/010,044 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,229 and 90/010,044 are hereby MERGED.
2. The reexamination files are being forwarded to the examiner for issuing a first Office action.
3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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



MARK J. REINHART
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,044	11/05/2007	5974120	6646-250,-250A,-250B	7796

35554 7590 05/14/2009

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/14/2009

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www.uspto.gov

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG, LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET

FIFTY-THIRD FLOOR

HOUSTON, TX 77002

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,044.

PATENT NO. 5974120.

ART UNIT 3992.

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES CA 90069

(For Patent Owner)

MAILED

MAY 14 2009

CENTRAL REEXAMINATION UNIT

John L. Welsh
WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA, VA 22314

(For Third Party
Requester)

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

(For Third Party
Requester)

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

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/008,229
Deposited : 20 September 2006
For: US Patent No. 5,974,120

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/010,044
Deposited : 5 November 2007
For: US Patent No. 5,974,120

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/010,130
Deposited : 28 March 2008
For: US Patent No. 5,974,120

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

BACKGROUND

1. On 26 October 1999 US Patent No. 5,974,120 was granted to Ronald A. Katz.
2. On 20 September 2006 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,229.
3. On 14 December 2006 the Order was granted for *ex parte* reexamination in control number 90/008,229.
4. On 05 November 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,044.
5. On 01 February 2008 the Order was granted for *ex parte* reexamination in control number 90/010,044.
6. On 28 March 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,130.
7. On 28 May 2009 the Order was granted for *ex parte* reexamination in control number 90/010,130.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,229 and 90/010,044 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,229; 90/010,044; and 90/010,130 are hereby MERGED.
2. The reexamination files are being forwarded to the examiner for further action.
3. All correspondence regarding these proceedings should be submitted as follows:

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

By Fax to: (571) 273-9900

Central Reexamination Unit

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

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

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

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/010,049	11/07/2007	7060241	0601-017	9632

7590 07/15/2009

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/15/2009

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Law Office of Peter G. Korytnyk, PLLC
650A South 15th Street
Arlington, VA 22202

MAILED

JUL 15 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,049.

PATENT NO. 7060241.

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)).



James Remenick
NOVAK, DRUCE & QUIGG LLP
1300 I STREET, N.W.
1000 WEST TOWER
WASHINGTON, D.C. 20005

(Patent Owner)

Peter G. Korytnyk
LAW OFFICES OF PETER G. KORYTNYK, PLLC
650A SOUTH 15TH STREET
ARLINGTON, VA 22202

(Third Party Requester)

MAILED

JUL 15 2009

In re Paul J. Glatkowski
Reexamination Proceeding
Control No.: 90/010,049
Filed: November 7, 2007
For: U.S. Patent No.: 7,060,241

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

CENTRAL REEXAMINATION UNIT

This is a decision on the June 19, 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 June 19, 2009, has not been entered for consideration by the examiner.

FEE

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to petitioner's credit card on June 23, 2009.

BACKGROUND

1. On June 13, 2006, the Office issued U.S. Patent No. 7,060,241, to Glatkowski (the '241 patent).
2. On November 7, 2007, a third party requester filed a request for *ex parte* reexamination of the '241 patent. The request was assigned reexamination control number 90/010,049 (the '10049 proceeding).
3. On January 4, 2008, the Office issued an order granting reexamination for the '10049 reexamination request.

4. Prosecution progressed to the point where, on May 28, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '10049 proceeding.
5. On May 29, 2009, the '10049 proceeding was designated 452 status as entering the printing cycle.
6. On June 19, 2009, patent owner filed the instant petition accompanied by an IDS, which patent owner requests the Office to consider.
7. The '10049 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

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

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

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.

MPEP 2256

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

DECISION

The June 19, 2009 submission is an improper submission as it runs contrary to the provision of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters. By petitioning for multiple and distinct forms of relief that fall under different rules within a

single paper, petitioner has created confusion and ambiguity on the record in regard to the relief requested. Furthermore, disposal of the petition would create delay, as the decision making authority for each for of relief request under different relevant rules may differ. Petitioner requests, in a single paper, entry of an IDS after NIRC, vacatur of a NIRC, and waiver of the rules. Therefore, the June 19, 2009 submission from patent owner is an improper paper under 37 CFR 1.4(c). This decision will address the issue of submission of an IDS after NIRC. If petitioner continues to desire the other forms of relief requested, petitioner may submit the petition requests in separate papers under the appropriate rule(s) with payment of the appropriate fee(s).

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

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256 as follows:

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

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the reexamination proceeding, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. Nor has patent owner filed an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. Moreover, the patent owner does not provide a discussion of the substance of any of the proffered items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding. Patent owner states that the submission is solely to comply with the duty of disclosure rules and that patent owner in fact is making no assertion of any kind as to the patentability of the claims in light of the claimed invention. Such a statement and showing is completely contrary to the basis for entry of an IDS after NIRC.

Furthermore, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The petition indicates that the items of information were cited during the prosecution of an unidentified divisional application

related to the '241 patent and were "inadvertently" omitted from submission during the present reexamination proceeding. Presumably, patent owner was aware of the existence of the items of information now being submitted, but does not explain the specifics of the "inadvertence" that caused patent owner not to make the submission until after issuance of the NIRC in the present proceeding. A factual accounting as to why the information was not submitted earlier should have been provided. Accordingly, the present petition does not satisfy the requirements for the granting of a petition submitted for consideration of an IDS after a NIRC has been mailed and the proceeding has entered the printing cycle.

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

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on May 28, 2009, and the proceeding has now entered the final stages of the publication process, *i.e.* the print cycle, as evidenced by the proceeding's assigned 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 provide an amendment directed to claim patentability, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

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

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on June 19, 2009.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding.
3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.
4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



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



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.
90/010,053	11/09/2007	7,223,236	ALER-007REX	3387

60683 7590 01/16/2009
HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/16/2009

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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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,386	08/01/2008	7223236	1110 7000	7471

60683 7590 01/16/2009

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/16/2009

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

Nanda Alapati

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

8065 Leesburg Pike

Tysons Corner, VA 22182

Date:

MAILED

JAN 16 2009

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000386

PATENT NO. : 7223236

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BOZICEVIC, FIELD & FRANCIS LLP

1900 UNIVERSITY AVENUE

SUITE 200

EAST PALO ALTO, CA 94303

Date:

MAILED

JAN 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010053

PATENT NO. : 7223236

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
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ALEXANDRIA, VA 22313-1450
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HEALTH HERO NETWORK, INC.
2400 GENG ROAD
SUITE 200
PALO ALTO, CA 94303

(For Patent Owner)

MAILED

JAN 16 2009

CENTRAL REEXAMINATION UNIT

BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

(For *Ex Parte* Requester)

NANDA ALAPATI
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING, 32ND FLOOR
P.O. BOX 7037
ATLANTA, GA 30357-0037

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/010,053
Filed: November 9, 2007
For: U.S. Patent No. 7,223,236

:
:
:
:
: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

Inter Partes Reexamination Proceeding
Control No. 95/000,386
Filed: August 1, 2008
For: U.S. Patent No. 7,223,236

:
:
:

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. 7,223,236 (the '236 patent) issued to Brown on May 29, 2007.
2. A request for *ex parte* reexamination of claims 1-26 of the '236 patent was filed on November 9, 2007, by third party requester Karl Bozicevic, in which Alere Medical, Inc. was

identified as the real party in interest, and the request was assigned control number 90/010,053 (the '10053 *ex parte* proceeding).

3. On January 18, 2008, *ex parte* reexamination was ordered for claims 1-26 of the '236 patent based on the examiner's determination that the November 9, 2007 request raised a substantial new question of patentability affecting these claims.
4. A request for *inter partes* reexamination of claims 1-26 of the '236 patent was filed on August 1, 2008, by third party requester Inverness Medical Innovations, Inc., which is the real party in interest, and the request was assigned control number 95/000,386 (the '0386 *inter partes* proceeding).
5. On September 29, 2008, a non-final Office action was mailed in the '10053 *ex parte* proceeding, rejecting claims 1-26 of the '236 patent.
6. On October 30, 2008, *inter partes* reexamination was ordered for claims 1-26 of the '236 patent based on the examiner's determination that the August 1, 2008 request raised a substantial new question of patentability affecting these claims.
7. On November 26, 2008, patent owner filed a response to the September 29, 2008 Office action, amending claims 1, 21, 22 and 25.
8. There has been no further Office action in the '0386 *inter partes* proceeding, and, since an Office action has been issued, clearly the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10053 *ex parte* proceeding expired after March 18, 2008.¹

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '0386 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.

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.

(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 90/010,053 and 95/000,386 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since claims 1, 21, 22 and 25 have been amended in the '10053 *ex parte* proceeding, the claims are not currently the same in both files and an amendment is needed to place the same amendments in both proceedings.
2. Claims 1, 21, 22 and 25 are **rejected under 35 U.S.C. 112, paragraph 2**, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention. Since the same claims read differently in the two proceedings, the intended scope of the claims in each proceeding is not clear.
3. Patent owner is required to submit an appropriate amendment within one month of this decision placing the same amendment in both files.
4. This merger decision provides **an Office action on the merits** pursuant to 35 U.S.C. 314(b)(2), and patent owner's amendment response goes to the merits of the proceeding, to address the above rejection under 35 U.S.C. 112. In order that the response be considered to be a complete response pursuant to 35 U.S.C. 314(b)(2), patent owner must include the remarks that set forth the basis for having proposed the amendment to claims 1, 21, 22 and 25 in the '10053 *ex parte* reexamination proceeding. Failure to include the basis for having made the amendment to claims 1, 21, 22 and 25 in the '10053 *ex parte* reexamination will result in a holding that the amendment is nonresponsive and nonenterable, leading to cancellation of claims 1, 21, 22 and 25 in each of the pending reexamination proceedings.
5. After patent owner files a response to this decision, the third party requester may once file written comments within a period of 30 days from the date of service of patent owner's response. Any such comments must be limited to patentability issues directed to patent owner's amendment of the claims made in the *inter partes* reexamination or claims newly presented in the *inter partes* reexamination. Such issues may include the issue of claim patentability based on prior patents and printed publications applicable to any amended claims and any newly presented claims in patent owner's response. The time for submitting comments by the third party requester may not be extended.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(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 patent owner and the third party requester(s) should be directed as follows:

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

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

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

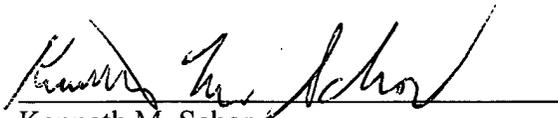
E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,386 and *ex parte* Reexamination Control No. 90/010,053 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Pursuant to Part II of this decision, the required amendment must be filed within ONE MONTH of the mail date of this decision, placing the same claims in both files of the present merged proceeding, together with an explanation of the basis for any amendment or new claims included in the response.
3. After patent owner files a response to this decision, the third party requester may once file written comments within a period of 30 DAYS from the date of service of patent owner's response. Any such comments must be limited to patentability issues directed to patent owner's amendment of the claims or newly presented claims. Such issues may include the issue of claim patentability based on prior patents/printed publications applicable to any amended claims and any newly presented claims in patent owner's response. The time for submitting comments by the third party requester is statutory and may not be extended.

4. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.
5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to place the same amendment in both proceedings and requester's comments on that response, or (b) the expiration of the time for filing the required response and any comments.
6. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.



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

January 12, 2009

C:\KIVA\KENPET3\95_0386 + 10053 amdt in EP reex, merits housekeeping amdt_req.doc

Kashnikow, Andres

June 16, 2009

From: Newsome, Lamonte
Sent: Saturday, June 13, 2009 12:08 PM
To: Graham, Matthew
Cc: Kashnikow, Andres
Subject: 90010054

Paper No.: _____

DATE : 6/13/09

TO SPE OF : ART UNIT 3993

SUBJECT : Request for Certificate of Correction for Appl. No.: 90010054 Patent No.: 6340074 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580**

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

LAMONTE NEWSOME

Certificates of Correction Branch
703-308-9390 ext. 112

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- Approved**
- Approved in Part**
- Denied**

- All changes apply.**
- Specify below which changes do not apply.**
- State the reasons for denial below.**

Comments: _____

Anders Keshanow

SPE

3993

Art Unit

Newsome, Lamonte

From: Kashnikow, Andres
Sent: Tuesday, June 16, 2009 8:06 AM
To: Newsome, Lamonte
Subject: RE: 90010054

CofC approved. COCX document sent to scanning.

Andy

From: Newsome, Lamonte
Sent: Saturday, June 13, 2009 12:08 PM
To: Graham, Matthew
Cc: Kashnikow, Andres
Subject: 90010054

Paper No.: _____

DATE : 6/13/09

TO SPE OF : ART UNIT 3993

SUBJECT : Request for Certificate of Correction for Appl. No.: 90010054 Patent No.: 6340074
C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)

South Tower - 9A22

Palm Location 7580

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

LAMONTE

NEWSOME

Certificates of

Correction Branch

703-308-9390 ext. 112

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

Approved

All changes apply.

**Approved in Part
not apply.**

Specify below which changes do

**Denied
below.**

State the reasons for denial

Comments:

**SPE
Art 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.
90/010,056	11/16/2007	5566913	668628001US	1433

25096 7590 06/02/2008

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/02/2008

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



Perkins Coie LLP
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

(For Patent Owner)

Brian M. Berliner
O'Melveny & Meyers LLP
400 S. Hope Street
Los Angeles, CA 90071

(For 3rd Party Requester)

Reexam Control No.: 90/010,056
Filed : November 16, 2007
For U.S. Patent No. : 5,566,913

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,078
Filed : December 26, 2007
For U.S. Patent No. : 5,566,913

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. 90/010,056 (a patent owner's request for reexamination), was ordered in a decision mailed January 17, 2008 indicating that claims 1-6 and 9-13 would be reexamined. A patent owner's statement was filed March 17, 2008 in this proceeding. An Information Disclosure Statement was filed on March 17, 2008. 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. 90/010,078 was ordered in a decision mailed March 11, 2008 indicating that claims 1-19 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. 90/010,056 and reexamination control No. 90/010,078 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 1-19, 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. 90/010,056 and 90/010,078 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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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.
90/010,057	01/15/2008	5,966,456	89310-0006	1411

41230 7590 11/20/2008
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2008

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



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,212	06/27/2008	5,966,456		9114

41230 7590 11/20/2008
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2008

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

Stephen Rudisill, Esq.
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED

NOV 20 2008

CENTRAL REEXAMINATION UNIT

Darius G Adli
HOGAN & HARTSON, L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third Party
Requester)

SPONTE
MERGING

DECISION, *SUA*

REEXAMINATION
PROCEEDINGS

In re: Jones *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,057
Deposited: 15 January 2008
For: US Patent No. 5,966,456

In re: Jones *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,212
Deposited: 27 June 2008
For: US Patent No 5,966,456

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

BACKGROUND

1. Patent No. 5,966,456 issued on 12 October 1999.
2. *Ex Parte* Reexamination Proceeding, control no. 90/010,057 was requested by a third party requester deposited on 15 January 2008.
3. The Reexamination Order was granted in proceeding, control no. 90/010,057 on 15 February 2008.
4. There are currently no amendments proceeding control number 90/010,057.
5. *Ex Parte* Reexamination Proceeding, control no. 90/010,212 was requested by a third party requester deposited on 27 June 2008.
6. The Reexamination Order was granted in proceeding, control no. 90/010,212 on 15 September 2008
7. There are currently no amendments proceeding control number 90/010,212.
8. On 12 November 2008 Stephen Rudisill, Esq. stated that the patent owner would not be submitting a patent owner's statement and that they were awaiting a first Office action on the merits.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/010,057 and 90/010,212 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Since there are no amendments in either proceeding, there is no requirement for a “housekeeping” amendment.

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/010,057 and 90/010,212 are hereby merged.
2. The reexamination files are hereby forwarded to the examiner for issuing a first Office action on the merits.
3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

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

/Mark Reinhart/

Gregory A. Morse,
Director,
Central Reexamination Unit



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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,057	01/15/2008	5,966,456	89310-0006	1411

41230 7590 05/07/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/07/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,057	01/15/2008	5,966,456	89310-0006	1411

41230 7590 05/07/2009

CONLEY ROSE, P.C.
P. O. Box 3267
Houston, TX 77253-3267

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/07/2009

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

Stephen Rudisill, Esq. :
CUMMINS-ALLISON CORP. : (For Patent Owner)
C/O NIXON PEABODY LLP :
161 N. CLARK ST., 48TH FLOOR :
CHICAGO IL 60601 :

MAILED

MAY 07 2009

CENTRAL REEXAMINATION UNIT

Mahbub A Siddiqui :
CONLEY ROSE, P.C. : (For Third Party
DAVID A. ROSE : Requester)
P. O. BOX 3267 :
HOUSTON, TX 77253-3267 :

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

In re: Jones *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,057 :
Deposited: 15 January 2008 :
For: US Patent No. 5,966,456 :

In re: Jones *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,212 :
Deposited: 27 June 2008 :
For: US Patent No 5,966,456 :

This is a decision on the 15 April 2009, "Request for Six-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 19 March 2009, be extended by six (6) weeks. The petition was timely filed with the petition fee. 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-in-part for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 12 October 1999 US Patent No. 5,966,456 was granted to Jones *et alia*.
2. On 15 January 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,057.
3. On 15 February 2008 the Order was granted for *ex parte* reexamination in control number 90/010,057.
4. On 27 June 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,212.
5. On 15 September 2008 the Order was granted for *ex parte* reexamination in control number 90/010,212.
6. On 20 November 2008 a decision sua sponte merging proceedings 90/010,057 and 90/010,212 was mailed.
7. On 19 March 2009 a non-Final Office action was mailed.
8. On 15 April 2009 the instant petition was submitted

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 15 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 15 April 2009, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an

argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

ANALYSIS AND FINDINGS

The patent owner's representative petition 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 non-final rejection mailed 19 March 2009. The patent owner submitted a timely filed petition with the appropriate fee.

The petition dated 15 April 2009 articulates the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally not considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The petition request to extend the response time by six (6) weeks is hereby granted-in-part.

The time granted is one (1) month

CONCLUSION

1. The patent owner's petition for extension of six (6) weeks time in which to file a response to the Office action dated 19 March 2009 is hereby **granted-in-part**
2. The period for response is extended by one (1) month.
3. The Patent Owner's response is due **19 June 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,059	01/16/2008	5909503	89310.0007	1448

41230 7590 05/06/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/06/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CONLEY ROSE, P.C.

DAVID A. ROSE

P.O. BOX 3267

HOUSTON, TX 77253-3267

Date:

MAILED
MAY 06 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010059

PATENT NO. : 5909503

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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Stephen Rudisill, Esq. :
CUMMINS-ALLISON CORP. : (For Patent Owner)
C/O NIXON PEABODY LLP :
161 N. CLARK ST., 48TH FLOOR :
CHICAGO IL 60601 :

Mahbub A Siddiqui :
CONLEY ROSE, P.C. : (For Third Party
DAVID A. ROSE : Requester)
P. O. BOX 3267 :
HOUSTON, TX 77253-3267 :

MAILED
MAY 06 2009
CENTRAL REEXAMINATION UNIT

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

In re: Graves *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,059 :
Deposited: 16 January 2008 :
For: US Patent No. 5,909,503 :

This is a decision on the 15 April 2009, "Request for Six-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 23 March 2009, be extended by six (6) weeks. The petition was timely filed with the petition fee. 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-in-part for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 1 June 1999 US Patent No. 5,909,503 was granted to Graves *et alia*.

2. On 16 January 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,059.
3. On 07 March 2008 the Order was granted for *ex parte* reexamination in control number 90/010,059.
4. On 23 March 2009 a non-Final Office action was mailed.
5. On 15 April 2009 the instant petition was submitted

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 23 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 15 April 2009, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

ANALYSIS AND FINDINGS

The patent owner’s representative petition 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 non-final rejection mailed 23 March 2009. The patent owner submitted a timely filed petition with the appropriate fee.

The petition dated 15 April 2009 articulates the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally not considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The petition request to extend the response time by six (6) weeks is hereby granted-in-part.

The time granted is one (1) month

CONCLUSION

1. The patent owner's petition for extension of six (6) weeks time in which to file a response to the Office action dated 23 March 2009 is hereby granted-in-part
2. The period for response is extended by one (1) month.
3. The Patent Owner's response is due 23 June 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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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,060	01/16/2008	6381354	89310.0005	1503

41230 7590 11/20/2008

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2008

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



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Stephen Rudisill, Esq.
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED
NOV 20 2008
CENTRAL REEXAMINATION UNIT

Darius G Adli
HOGAN & HARTSON, L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third Party
Requester)

SPONTE
MERGING

DECISION, *SUA*

REEXAMINATION
PROCEEDINGS

In re: Mennie *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,060
Deposited: 16 January 2008
For: US Patent No. 6,381,354

In re: Mennie *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,217
Deposited: 8 July 2008
For: US Patent No 6,381,354

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

BACKGROUND

1. Patent No. 6,381,35419 issued on 30 April 2002.
2. *Ex Parte* Reexamination Proceeding, control no. 90/010,060 was requested by a third party requester deposited on 16 January 2008.
3. The Reexamination Order was granted in proceeding, control no. 90/010,060 on 7 March 2008
4. There are currently no amendments proceeding control number 90/010,060.
5. *Ex Parte* Reexamination Proceeding, control no. 90/010,217 was requested by a third party requester deposited on 8 July 2008.
6. The Reexamination Order was granted in proceeding, control no. 90/010,217 on 23 September 2008
7. There are currently no amendments proceeding control number 90/010,217.
8. On 12 November 2008 Stephen Rudisill, Esq. stated that the patent owner would not be submitting a patent owner's statement and that they were awaiting a first Office action on the merits.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/010,060 and 90/010,217 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Since there are no amendments in either proceeding, there is no requirement for a “housekeeping” amendment.

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/010,060 and 90/010,217 are hereby merged.
2. The reexamination files are hereby forwarded to the examiner for issuing a first Office action on the merits.
3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

By Hand: Customer Service Window
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3. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611 or Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Gregory A. Morse,
Director,
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,060	01/16/2008	6381354	89310.0005	1503

41230 7590 05/06/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/06/2009

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.
90/010,217	07/08/2008	6381354	89310.0005	9569

41230 7590 05/06/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/06/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CONLEY ROSE, P.C.
DAVID A. ROSE
P.O. BOX 3267
HOUSTON, TX 77253-3267

Date: **MAILED**
MAY 06 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010060
PATENT NO. : 6381354
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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Date:

MAY 06 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DARIUSH G. ADLI

HOGAN & HARTSON LLP

1999 AVE. OF THE STARS, SUITE 1400

LOS ANGELES, CA 90067

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010217

PATENT NO. : 6381354

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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Stephen Rudisill, Esq. :
CUMMINS-ALLISON CORP. : (For Patent Owner)
C/O NIXON PEABODY LLP :
161 N. CLARK ST., 48TH FLOOR :
CHICAGO IL 60601 :

MAILED
MAY 06 2009

CENTRAL REEXAMINATION UNIT

Mahbub A Siddiqui :
CONLEY ROSE, P.C. : (For Third Party
DAVID A. ROSE : Requester)
P. O. BOX 3267 :
HOUSTON, TX 77253-3267 :

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

In re: Mennie *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,060 :
Deposited: 16 January 2008 :
For: US Patent No. 6,381,354 :

In re: Mennie *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,217 :
Deposited: 08 July 2008 :
For: US Patent No 6,381,354 :

This is a decision on the 15 April 2009, "Request for Six-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 19 March 2009, be extended by six (6) weeks. The petition was timely filed with the petition fee. The petition lacks 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 30 April 2002 US Patent No. 6,381,354 was granted to Mennie *et alia*.
2. On 16 January 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,060.
3. On 07 March 2008 the Order was granted for *ex parte* reexamination in control number 90/010,060.
4. On 08 July 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,217.
5. On 23 September 2008 the Order was granted for *ex parte* reexamination in control number 90/010,217.
6. On 20 November 2008 a decision sua sponte merging proceedings 90/010,060 and 90/010,217 was mailed.
7. On 19 March 2009 a non-Final Office action was mailed.
8. On 15 April 2009 the instant petition was submitted without certificate of service.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 15 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 15 April 2009, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.17 (g). The petition lacks the required certificate of service pursuant to 37 CFR 1.550(f).

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). 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's representative petition 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 non-final rejection mailed 19 March 2009. The patent owner submitted a timely filed petition with the appropriate fee but lacking the required certificate of service.

The petition dated 15 April 2009 articulates the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally not considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The patent owner is reminded of the required service of all papers in *ex parte* reexamination proceedings pursuant to 37 CFR 1.550(f). The patent owner is further reminded that lacking service the document may be refused consideration by the Office.

The petition request to extend the response time by six (6) weeks is hereby granted-in-part. The time granted is one (1) month

CONCLUSION

1. The patent owner's petition for extension of six (6) weeks time in which to file a response to the Office action dated 19 March 2009 is hereby granted-in-part

2. The period for response is extended by one (1) month.
3. The Patent Owner's response is due **19 June 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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CENTRAL REEXAMINATION UNIT

GEORGE R. SCHULTZ
SCHULTZ ASSOCIATES, P.C.
5400 LBJ FREEWAY
SUITE 1200
DALLAS, TX 75240

In re Application of

PERRY et al.

Control No. 90/010,061 (U.S. Patent 6,926,151 B1)

Filed: October 18, 2002

Attorney Docket No. 17333.1

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 April 14, 2008.

The request is **NOT APPROVED**.

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, “[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]” More specifically, 37 CFR 10.40 states, “[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is” for one of the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client. The reasons set forth in the request; “Patent was sold” does not meet any conditions set forth in 37 CFR 1040.

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

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

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **MARK E. TURK**
LYNN, TILLOTSON & PINKER, LLP
750 N. ST. PAUL STREET, SUITE 1400
DALLAS, TX 75201

cc: **JOHN M. GUYNN**
WORKMAN NYDEGGER
60 EAST SOUTH TEMPLE, SUITE 1000
SALT LAKE CITY, UT 84111

(Third Party Requester)

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on April 14, 2008. There is no indication it was served on the 3rd Party Requester.



UNITED STATES PATENT AND TRADEMARK OFFICE

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

GEORGE R. SCHULTZ
SCHULTZ ASSOCIATES, P.C.
5400 LBJ FREEWAY
SUITE 1200
DALLAS, TX 75240

MAILED

MAY 27 2008

CENTRAL REEXAMINATION UNIT

In re Application of	:	
PERRY et al.	:	
Control No. 90/010,061 (U.S. Patent 6,926,151)	:	DECISION ON PETITION
Filed: October 18, 2002	:	TO WITHDRAW
Attorney Docket No. 17333.1	:	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 20, 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 George R. Schultz. All attorneys/agents of record have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R. 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

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

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3991

cc: **MICHAEL STUART PERRY**
MARTHA STARR PERRY
10 SKI HAVEN
JUSTIN, TX 76247

cc: **MICHAEL KRAWZSENEK**
FULBRIGHT & JAWORSKI, L.L.P.
600 Congress Ave., Suite 2400
Austin, TX 78701-2978

cc: **JOHN M. GUYNN**
WORKMAN NYDEGGER
60 EAST SOUTH TEMPLE, SUITE 1000
SALT LAKE CITY, UT 84111

(Third Party Requester)

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on May 20, 2008. There is no indication it was served on 3rd Party Requester.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,063	01/08/2008	6702020	304-28548-USRE (D5407-394)	6754
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25397 7590 06/18/2009

EXAMINER

DUANE MORRIS LLP - Houston
3200 SOUTHWEST FREEWAY
SUITE 3150
HOUSTON, TX 77027

ART UNIT	PAPER NUMBER
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DATE MAILED: 06/18/2009

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



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GARY R. MAZE
DUANE MORRIS LLP
3200 SOUTHWEST FREEWAY SUITE 3150
HOUSTON, TX 77027

(For Patent Owner)

MAILED
JUN 18 2009
CENTRAL REEXAMINATION UNIT

In re Zachman et al. :
Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/010,063 : UNDER 37 CFR 1.181
Filed: January 8, 2008 :
For: U.S. Patent No.: 6,702,020 :

This is a decision on a petition filed by the patent owner on April 27, 2009. The petition is entitled "PETITION TO ACCEPT AN AMENDMENT AFTER FINAL REJECTION AND TO EXTEND THE TIME FOR FILING THE NOTICE APPEAL UNTIL A DECISION IS MADE ON THE PETITION UNDER 37 CFR § 1.182" (hereinafter "the petition").¹

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

The petition under 37 CFR 1.181 dated April 27, 2009 is denied.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,702,020 (hereinafter, "the '020 patent") issued on March 9, 2004.
2. A request for *ex parte* reexamination, assigned control No. 90/010,063 (hereinafter, "the '063 proceeding"), was filed by patent owner on January 8, 2008.
3. *Ex parte* reexamination was ordered for the '063 proceeding on February 27, 2008.

¹ As this a petition seeks to invoke the authority of the supervisor involving the examiner's refusal to enter an amendment after a final rejection, it is being treated as a petition filed under 37 CFR 1.181(a)(3)

4. On July 24, 2008, a non-final Office action, which rejected claims 1, 3, 12 and 16, was mailed in the '063 reexamination proceeding².
5. On September 22, 2008, the patent owner filed an amendment.
6. On March 26, 2009, the Office issued a Final rejection Office action. The Office action again rejected claims 1, 3, 12 and 16 and stated that the phrase "without circulation" that had been added to the claims by amendment was new matter.
7. On April 8, 2009, an interview was held. No agreement was reached at the interview. The meaning of "circulation" and "without circulation" was discussed during the interview.
8. On April 13, 2009, an amendment after Final rejection was filed.
9. On April 21, 2009, the Office issued an Advisory action refusing entry of the amendment after Final rejection.
10. On April 27, 2009, the patent owner filed the instant petition requesting entry of the amendment after Final rejection and extension of the time to file a Notice of Appeal.

DECISION ON PETITION TO ACCEPT AMENDMENT AFTER FINAL REJECTION

The patent owner (petitioner) states that as a result of the April 8, 2009, interview, patent owner's counsel realized that an error in understanding of the Bissonnette reference had been made. Patent owner states that the Bissonnette reference could function to accomplish the "without circulation" function, but required two distinct pressure levels to be applied to nested sleeves as well as movement of the crossover tool. Patent owner supplied this argument in the amendment after Final rejection filed on April 13, 2009. The examiner refused entry of this amendment, stating that a showing of good cause was required to consider the amendment.

Patent owner states that the April 13, 2009 amendment itself contained the best showing of good cause that there could be, as it admits that the interview caused another consideration of the claim language and the functioning of the Bissonnette tool and resulted in the realization that the previous arguments that were made were incorrect. Patent owner also states that the amendment constitutes the removal of an incorrect argument and a proposed accurate amendment without the

² Reexamination was requested for claims 1, 3, 12 and 16 only. Reexamination was NOT requested for claims 2, 4-11, 13-15 and 17-22.

new matter issue. Thus, patent owner contends that the good cause is inherent in the offered amendment after Final rejection that was refused entry.

In response to patent owner's arguments that the amendment after Final filed April 13, 2009 should be entered, the Director finds that there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final. See MPEP 2272. Second, the fact that patent owner has changed his line of argument following a reevaluation of the primary reference and its application to the claims, regardless of the veracity or suitability of the new line of argument, is not a proper grounds to enter an amendment after Final rejection. Third, although the amendment after Final of April 13, 2009 was not entered, the arguments contained therein pertaining to the application of the Bissonnette reference were considered by the examiner.

Turning to the facts in this proceeding, the Final rejection of March 26, 2009 sets forth the same grounds of rejection based upon Bissonnette as was set forth in the first Office action. Patent owner had an opportunity, in responding to the first Office action, to amend the claims and address the examiner's application of the Bissonnette reference. It was not until after the Final rejection was issued that the patent owner decided to change his line of argument regarding the Bissonnette reference and further amend the claims. MPEP 2272 specifically states that a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented, as set forth by 37 CFR 1.116(b), is required. This is a strict standard and is doubly important in view of the requirement that all *ex parte* reexamination proceedings are to be acted upon with "special dispatch." Here, patent owner has not provided the necessary showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. A change in the line of argument regarding a reference, regardless of how the change came about, does not constitute a showing of good and sufficient reasons why the amendment is necessary. The examiner did not change his grounds of rejection in the Final rejection: the Bissonnette reference was applied in exactly the same manner as in the first Office action. It is also noted that the amendment proposed by the patent owner in the April 13, 2009 after Final amendment seeks to do more than address/eliminate the "without circulation" limitation. The amendment proposes to add claim limitations that were not previously presented, and that have nothing to do with the "without circulation" limitation³. This was correctly noted by the examiner in the Advisory action of April 21, 2009. Thus, patent owner's decision to change course with the arguments appears to go beyond merely addressing the "without circulation" limitation. As patent owner is well aware, substantial changes to the claims cannot be made after the issuance of a Final rejection. Thus, not only has the requisite showing of good cause not been made, the

³ For example, in claim 1, in the April 13, 2009 after Final amendment, patent owner seeks to add the limitations of "after gravel is deposited outside the body" and "pressurizing said first passage system to a single predetermined pressure to initiate movement of said valve member."

proposed amendment after Final rejection is beyond the scope of that permitted by 37 CFR 1.116.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the amendment of April 13, 2009 should not be entered. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion and deciding not to enter the amendment of April 13, 2009.

Accordingly, good and sufficient reasons to enter the amendment of April 13, 2009 in the reexamination proceeding have not been provided and the patent owner's petition is denied.

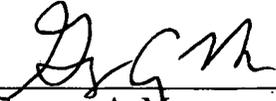
DECISION ON REQUEST FOR EXTENSION OF TIME

The petition also requests an extension of time to file a Notice of Appeal. The request indicates that additional time is desired to make a determination as to the need for filing a Notice of Appeal as the determination would be based on the decision rendered on the petition. 37 CFR 1.181(f) states that "(t)he mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings". Thus, when balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, and mindful of the warning set forth in 37 CFR 1.181, Patent Owner's showing is not adequate to justify the grant of an additional one-month extension of time in which to file a proper response to the Final Office action mailed March 26, 2009. Accordingly, request for an additional one month to respond to the Final Office action mailed March 26, 2009 is denied. A response (e.g., a Notice of Appeal) is still due to be filed on or before June 26, 2009.

CONCLUSION

1. The petition under 37 CFR 1.181 to have the amendment after final rejection filed April 13, 2009, and therefore, reopen prosecution, is denied.
2. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution. See *1292OG20*, March 1, 2005.
3. The request for an extension of time of one additional time within which to file an appropriate response to the final Office action is denied.

4. 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



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Alexandria, VA 22313-1450
www.uspto.gov

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

(For Patent Owner)

MAILED

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

OCT 02 2008

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,066
Filed : December 5, 2007
For U.S. Patent No. : 6,174,325

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,135
Filed : April 4, 2008
For U.S. Patent No. : 6,174,325

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. 90/010,066 was ordered in a decision mailed January 24, 2008 indicating that claims 9 and 25-27 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed cancelling claims 1-38 (all of the claims in the patent) and adding claims 39-56. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,135 was ordered in a decision mailed June 27, 2008 indicating that claims 1-8, 10-24, and 28-38 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 8, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and Concurrent

Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,066, and reexamination control No. 90/010,135 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1-38 have been cancelled and claims 39-56 been added in reexamination proceeding control No. 90/010,066 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,135 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,066 and 90/010,135 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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Alexandria, VA 22313-1450
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Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

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CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

Reexam Control No.: 90/010,068
Filed : December 5, 2007
For U.S. Patent No. : 5,403,368

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,136
Filed : April 7, 2008
For U.S. Patent No. : 5,403,368

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. 90/010,068 was ordered in a decision mailed January 22, 2008 indicating that claims 1, 2, 12, and 14 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed amending claims 1, 8, 10, 11, 14, and 15; cancelling claims 2-7, 9, and 12; and adding claims 19-32. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,136 was ordered in a decision mailed June 27, 2008 indicating that claims 1, 3-5, and 7-11 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 25, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and Concurrent

Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,068, and reexamination control No. 90/010,136 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1, 8, 10, 11, 14, and 15 have been amended; claims 2-7, 9, and 12 cancelled; and claims 19-32 added in reexamination proceeding control No. 90/010,068 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,136 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

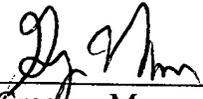
The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two reexaminations. All papers issued by the Office will contain the identifying data for each 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 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. 90/010,068 and 90/010,136 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

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

(For Patent Owner)

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Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,069
Filed : December 5, 2007
For U.S. Patent No. : 5,626,631

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,134
Filed : April 4, 2008
For U.S. Patent No. : 5,626,631

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. 90/010,069 was ordered in a decision mailed January 24, 2008 indicating that claims 1-5, 8, and 9 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed cancelling claims 1-6, and 8-10 and adding claims 11-41. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,134 was ordered in a decision mailed June 27, 2008 indicating that claims 1-10 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 25, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and Concurrent

Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,069, and reexamination control No. 90/010,134 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1-6, and 8-10 have been cancelled and claims 11-41 added in reexamination proceeding control No. 90/010,069 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,134 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,069 and 90/010,134 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

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
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CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

Reexam Control No.: 90/010,070
Filed : December 5, 2007
For U.S. Patent No. : 5,964,749

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,154
Filed : April 29, 2008
For U.S. Patent No. : 5,964,749

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. 90/010,070 was ordered in a decision mailed January 29, 2008 indicating that claims 8, 9, 12, and 16 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed cancelling claims 1-2, and 5-18 and adding claims 19-46. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,154 was ordered in a decision mailed June 27, 2008 indicating that claims 1, 2, 5-7, 10, 11, 13-15, 17, and 18 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 25, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and

Concurrent Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,070, and reexamination control No. 90/010,154 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1-2, and 5-18 have been cancelled and claims 19-46 added in reexamination proceeding control No. 90/010,070 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,154 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

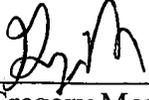
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,070 and 90/010,154 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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



Gregory Morse, Director
Central Reexamination Unit



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,074	12/07/2007	5,329,369	230.2-US-RX	1754

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

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CENTRAL REEXAMINATION UNIT

Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105-2482

(For Patent Owner)

Hovey Williams LLP
10801 Mastin Blvd., Suite 1000
Overland Park, KS 66210

(For Third Party Requester)

Gates & Cooper LLP
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045

(For Third Party Requester)

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).

Art Unit: 3992

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

Art Unit: 3992

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.



Gregory Morse
Director, Central Reexamination Unit



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ALEXANDRIA, VA 22313-1450
www.uspto.gov

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

(Patent Owner)

Jennifer C. Bailey
Hovey Williams, LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108

(First *Ex Parte* Requester)

Jason S. Feldmar
Gates & Cooper, LLP
6701 Center Drive West, Suite 1500
Los Angeles, CA 90045

(Second *Ex Parte* Requester)

MAILED

MAY 04 2009

CENTRAL REEXAMINATION UNIT

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.

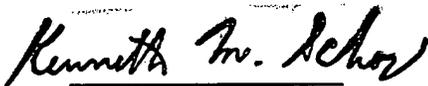
MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public under 37 CFR 1.11(d)." If the February 23, 2009 information is not expunged from the record at the point that the reexamination proceeding is considered for action on the merits, 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 expungement 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,075	12/27/2007	6115074	230.1-US-RX	1819

20872 7590 09/12/2008
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/12/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/008,828

08/31/2007

6115074

4671-4672-001

2830

20872

7590

09/12/2008

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/12/2008

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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

HOVEY WILLIAMS LLP
10801 MASTIN BLVD., SUITE 1000
OVERLAND PARK, KS 66210

Date:
MAILED

SEP 15 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008828
PATENT NO. : 6115074
ART UNIT : 3900

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

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



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CENTRAL REEXAMINATION UNIT

Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105-2482

(For Patent Owner)

Hovey Williams LLP
10801 Mastin Blvd., Suite 1000
Overland Park, KS 66210

(For Third Party Requester)

Gates & Cooper LLP
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045

(For Third Party Requester)

In re Willis et alia
Reexamination Proceeding
Control No. 90/008,828
Request Deposited: August 31, 2007
For: U.S. Patent No. 6,115,074

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Willis et alia
Reexamination Proceeding
Control No. 90/010,075
Request Deposited: December 7, 2007
For: U.S. Patent No. 6,115,074

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,115,074 (hereinafter, the '074 patent), issued to Ozkan *et alia*, on September 5, 2000.
2. On August 31, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '074 patent. The reexamination proceeding was assigned Control No. 90/008,828 (hereinafter, the '8828 proceeding).

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3. The Reexamination Order was granted in the '8828 proceeding on November 1, 2007.
4. There are currently no amendments in the '8828 proceeding.
5. On December 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '074 patent. The reexamination proceeding was assigned Control No. 90/010,075 (hereinafter, the '10075 proceeding).
6. The Reexamination Order was granted in the '10075 proceeding on March 14, 2008.
7. There are currently no amendments in the '10075 proceeding.
8. The '8828 and '10075 proceedings await the first action on the merits from the assigned examiner.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8828 and the '10075 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all

Art Unit: 3992

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

CONCLUSION

1. Reexamination Control Nos. 90/008,828 and 90/010,075 are merged.
2. The reexamination files are being forwarded to the examiner for issuing a first Office action.
3. All correspondence regarding these proceedings should be submitted as follows:

By Mail: Mail Stop *Ex Parte* Reexam”
 Attn: Central Reexamination Unit
 Commissioner for Patents
 P. O. Box 1450
 Alexandria VA 22313-1450

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

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



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.
90/010,075	12/27/2007	6115074	230.1-US-RX	1819

20872 7590 08/12/2009
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/12/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Gates & Cooper LLP
6701 Center Drive West
Suite 1050
Los Angeles CA 90045

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AUG 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,075 + 90/008,828

PATENT NO. 6115074

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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Robert A Saltzberg :
MORRISON & FOERSTER LLP : (For Patent Owner
425 MARKET STREET :
SAN FRANCISCO CA 94105-2482 :

MAILED

AUG 12 2009

CENTRAL REEXAMINATION UNIT

HOVEY WILLIAMS LLP : (For Third Party
10801 MASTIN BLVD., SUITE 1000 : Requester)
OVERLAND PARK, KS 66210 :

Jason Feldmar :
GATES & COOPER LLP : (For Third Party
HOWARD HUGHES CENTER : Requester)
6701 CENTER DRIVE WEST, :
SUITE 1050 :
LOS ANGELES, CA 90045 :

In re: Ozkan *et alia* : DECISION
Ex Parte Reexamination Proceeding : DISMISSING
Control No. 90/008,828 : PETITION FOR EXTENSION
Deposited: 31 August 2007 : OF TIME
For: US Patent No. 6,115,074 : 37 CFR § 1.550(c) & 1.181

In re: Ozkan *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,075 :
Deposited: 27 December 2007 :
For: US Patent No. 6,115,074 :

This is a decision on the 04 August 2009, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Final Office action mailed 11 March 2009, be extended by one month. The petition was timely filed with the petition fee.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 11 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a Final Office action. The patent owner submitted an after Final amendment on 11 May 2009. The advisory action mailed 20 and 22 July 2009 extended the response period to five (5) months. The patent owner's petition for extension of time was timely filed on 04 August 2009, together with the proper fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. ...

Ex parte prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. (emphasis added)...

MPEP § 2265 Extensions of time (in-part)

I. FINAL ACTION — TIME FOR RESPONSE

...

The filing of a timely first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted, but in no case may the period for response exceed 6 months from the date of the final action. Even if previous extensions have been granted, the primary examiner is authorized to grant the request for extension of time which is implicit in the filing of a timely first response to a final rejection. It should be noted that the filing of any timely first response to a final rejection will be construed as including a request to extend the shortened statutory period for an additional month, even an informal response and even a response that is not signed. (emphasis added) ...

ANALYSIS AND FINDINGS

The patent owner's petition to extend the period for response by one (1) month thereby further extending the period for response to six (6) months is before the Director of the CRU. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Final Office action was mailed 11 March 2009. The patent owner submitted a timely filed after Final amendment on 11 May 2009. The examiner's advisory action extended the period for response to five (5) months. The patent owner submitted a timely filed a petition for extension of time on 04 August 2009 with the appropriate fee.

The examiner once extended the period for response. MPEP § 2265 states that second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. The petitioner stated that "The attorneys have diligently attempted to prosecute this application." MPEP § 2265 requires:

"The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period."

The petition seeks extension of time awaiting a petition decision for a concurrently filed petition seeking entry of a declaration filed under 37 CFR § 1.132. The instant petition argues the merits of the petition filed under 37 CFR 1.181 as support for why the period for response should be extended by one (1) month thereby further extending the period for response to six (6) months.

“Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.” There is no indication as to how this situation is extraordinary.

The petition request to extend the response time further by one (1) month extending the time to six (6) months is hereby dismissed.

CONCLUSION

1. The patent owner’s petition for further extending the time in which to file a response to the Final Office action dated 11 March 2009 is hereby **dismissed**
2. The Patent Owner’s response was due **11 August 2009**.
3. The proceeding is hereby returned to the examiner for further handling.
4. Correspondence to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,075	12/27/2007	6115074	230.1-US-RX	1819
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20872 7590 08/13/2009

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 08/13/2009

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Gates & Cooper LLP
6701 Center Drive West
Suite 1050
Los Angeles CA 90045

MAILED

AUG 13 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,075, 90/008,828

PATENT NO. 6115074.

ART UNIT 3992.

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

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



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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Robert A Saltzberg :
MORRISON & FOERSTER LLP : (For Patent Owner
425 MARKET STREET :
SAN FRANCISCO CA 94105-2482 :

MAILED

HOVEY WILLIAMS LLP : (For Third Party
10801 MASTIN BLVD., SUITE 1000 : Requester)
OVERLAND PARK, KS 66210 :

AUG 13 2009

CENTRAL REEXAMINATION UNIT

Jason Feldmar :
GATES & COOPER LLP : (For Third Party
HOWARD HUGHES CENTER : Requester)
6701 CENTER DRIVE WEST, :
SUITE 1050 :
LOS ANGELES, CA 90045 :

In re: Ozkan *et alia* : DECISION
Ex Parte Reexamination Proceeding : GRANTING
Control No. 90/008,828 : PETITION FOR ENTRY
Deposited: 31 August 2007 : OF DECLARATION
For: US Patent No. 6,115,074 : 37 CFR § 1.181

In re: Ozkan *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/010,075 :
Deposited: 27 December 2007 :
For: US Patent No. 6,115,074 :

This is a decision on the 04 August 2009, "Petition Under 37 § 1.181 Requesting Entry of Declaration After Final Office Action."

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner requests entry of the Bove declaration submitted 11 May 2009 under 37 CFR § 1.132. The petition was filed under 37 CFR § 1.181 for which no fee is required and was properly served on the third party requesters.

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

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

ANALYSIS AND FINDINGS

It should be noted that the petitioner is factually incorrect in the statement that the Bove declaration submitted 11 May 2009 under 37 CFR § 1.132 is necessary to address the examiner's new grounds for rejection. Review of the non-final Office action mailed on 19 September 2008 and the final Office action mailed on 11 March indicates that the rejections to claims remain consistent; hence the finality of the Office action was correct and appropriate. Review of the proceeding indicates that the petitioner seeks to further address arguments with respect to the rejections.

However, to clarify the record and enable the patent owner to use the Bove declaration for support in the Appeal, the declaration is entered into the record. The proceeding will be returned to the examiner in charge of the proceeding for possible further consideration. The time for submission of the appeal brief continues to run from the date of the notice of appeal filed on 11 August 2009.

The patent owner's petition for entry of declaration is hereby granted.

CONCLUSION

1. The patent owner's petition for entry of declaration is hereby **granted**.
2. The Bove declaration submitted 11 May 2009 under 37 CFR § 1.132 is hereby entered.

3. The Patent Owner's appeal brief is due according to the requirements of MPEP § 2273
4. Correspondence to the Office should be addressed as follows:

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,078	12/26/2007	5566913	062180-053	5493

7590 06/02/2008
Gregory W. J. Hauth
1091 18th Court
Mukilteo, WA 98275

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/02/2008

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



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

Brian M. Berliner, Esq.

O'MELVENY & MYERS LLP

400 S. Hope Street

Los Angeles, CA 90071

MAILED

JUN 02 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,078.

PATENT NO. 5566913.

ART UNIT 3993.

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

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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,078	12/26/2007	5566913	062180-053	5493

7590 06/02/2008
Gregory W. J. Hauth
1091 18th Court
Mukilteo, WA 98275

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/02/2008

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



Perkins Coie LLP
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

(For Patent Owner)

Brian M. Berliner
O'Melveny & Meyers LLP
400 S. Hope Street
Los Angeles, CA 90071

(For 3rd Party Requester)

Reexam Control No.: 90/010,056
Filed : November 16, 2007
For U.S. Patent No. : 5,566,913

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,078
Filed : December 26, 2007
For U.S. Patent No. : 5,566,913

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. 90/010,056 (a patent owner's request for reexamination), was ordered in a decision mailed January 17, 2008 indicating that claims 1-6 and 9-13 would be reexamined. A patent owner's statement was filed March 17, 2008 in this proceeding. An Information Disclosure Statement was filed on March 17, 2008. 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. 90/010,078 was ordered in a decision mailed March 11, 2008 indicating that claims 1-19 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. 90/010,056 and reexamination control No. 90/010,078 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 1-19, 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. 90/010,056 and 90/010,078 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:

DATE *02/01/2010*

TO SPE OF : ART UNIT *3991*

SUBJECT : Request for Certificate of Correction on Patent No.: *90/010,079*

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

Please complete this form and return with file, within 7 days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location 7590 - Tel. No. (703) 305-8309

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

Thank You For Your Assistance

Certificates of Correction Branch

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

Approved

All changes apply.

Approved in Part

Specify below which changes **do not** apply.

Denied

State the reasons for denial below.

Comments:

DEBORAH D. JONES
CRU SPE UNIT 3991
Deborah Jones

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

UNITED STATES PATENT AND TRADEMARK OFFICE REEXAMINATION CERTIFICATE OF CORRECTION

Page 1 of 1

REEXAM CERT. NO. 7,276,146 C1

CONTROL NO.: 90/010,079

ISSUE DATE : April 7, 2009

INVENTOR(S) : Wilsey, Christopher D.

It is certified that an error appears or errors appear in the above-identified Ex Parte Reexamination certificate and that said Certificate is hereby corrected as shown below:

On the cover page, Item (73) Assignee, replace --Corange International Limited, Hamilton (BM)-- with "Roche Diagnostics Operations, Inc., Indianapolis, IN (US); Roche Operations Ltd., Hamilton (BM)"

Col. 2, line 20, replace --Vaccrel@-- with "Vacrel@"

Col. 2, line 23, replace --145 µl-- with "1.45 µl"

Col. 2, line 27, replace --X100 200-- with "X100@"

Col. 2, line 50, replace --Actual-- with "actual"

Col. 4, line 34, replace --appling-- with "applying"

Col. 4, line 38, replace --claime-- with "claim"

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Woodard, Emhardt, Moriarty, McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,080	12/14/2007	7276147	007404-000838 21452 US6	9236
41577	7590	05/04/2009	EXAMINER	
WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP 111 MONUMENT CIRCLE, SUITE 3700 INDIANAPOLIS, IN 46204-5137				
			ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

JOHN T. CALLAHAN
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W., SUITE 800
WASHINGTON, D.C. 20037

MAILED

MAY 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,080.

PATENT NO. 7276147.

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)).



Thomas Q. Henry
Woodard, Emhart, Moriarty,
McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137

(For Patent Owner)

MAILED

MAY 04 2009

CENTRAL REEXAMINATION UNIT

In re : Christopher D. Wilsey
Reexamination Proceeding
Control No.: 90/010,080
Filed: December 14, 2007
For: U.S. Patent No.: 7,276,147
Certificate Issued: February 24, 2009

:
: DECISION ON PETITION
: UNDER 37 CFR 1.182
:

This is a decision on the April 28, 2009 patent owner petition titled "PETITION FOR QUESTIONS NOT SPECIFICALLY PROVIDED FOR UNDER 37 CFR 1.182" which seeks correction of the reexamination certificate issued February 24, 2009, from the above captioned proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182, has been paid by credit card.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 7,276,147 (the '147 patent) issued on October 2, 2007.
2. An assignment of an undivided half interest in United States Patent No. 7,276,147 ('147 patent) from Roche Diagnostics Operations, Inc. to Corange International Limited was recorded in the Office on March 26, 2007.
3. A request for reexamination of the '147 patent was filed on December 14, 2007. The request was assigned control No. 90/010,080 (the '10,080 proceeding).
4. On December 18, 2008, a change of name for Corange International Limited to Roche Operations LTD. was recorded in the Office's assignment records for United States Patent No. 7,276,147 ('147 patent).
5. An *Ex Parte* Reexamination Certificate issued for the '10,080 proceeding on February 24, 2009.

6. On April 28, 2009, patent owner filed the present petition seeking correction of the reexamination certificate issued February 24, 2009

DECISION

The present petition under 37 CFR 1.182 requests the Office to issue a Certificate of Correction to correct information printed on the issued Reexamination Certificate (6677th) in U.S. Patent No. 7,276,147 on February 24, 2009. The Office error alleged by petitioner involves listing “Corange International Limited” as the assignee of record on the reexamination certificate although a corrected assignment of one-half interest in United States Patent No. 7,276,147 (‘147 patent) from Roche Diagnostics Operations, Inc. to Corange International Limited was recorded on March 26, 2007 (prior to the filing date of the reexamination request) and a Change of Name of Corange International Limited to Roche Operations Limited was recorded on December 18, 2008, a date after the ‘147 patent had issued and before the issue and publication of the reexamination certificate.¹ Petitioner requests issuance of a certificate of correction for the reexamination certificate changing the assignee name on the reexamination certificate from “Corange International Limited, Hamilton (BM)” to “Roche Diagnostics Operations, Inc., Indianapolis, IN (US); Roche Operations Ltd., Hamilton(BM).”

The Correction Requested is not directed to an Error in Reexamination Certificate

Petitioner’s attention is directed to 35 U.S.C. § 152, which states:

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

Thus, the Office may issue a patent to the assignee of record of a pending application, or an assignee whose assignment was submitted for recordation against an application pending at the Office. The statute, however, makes no provision for issuance of a patent to the assignee by way of an assignment recorded, or submitted for recordation, **after** issuance of the patent, as the application is then no longer pending but is an issued patent. Likewise, § 152 makes no provision for the Office to issue a reexamination certificate reflecting that the previously issued patent, which issued to the assignee of record, is subject to an assignment submitted for recordation after the patent issued, including any assignment recorded after a request for reexamination has been filed. In other words, the Office is not required to identify any change in the recorded assignee on the reexamination certificate. The Office will, however, identify a change in the assignee of record on the reexamination certificate if (a) a title report generated at the time the request for reexamination is filed identifies an assignee of record that is different from that listed on the face of the patent, or (b) the patent owner submits, during the reexamination proceeding, a proper statement under 37 CFR 3.73(b) stating that title is in an assignee different from that listed in the patent (see MPEP § 320). In this instance, the change of

¹ The Office mailed the Notice of Recordation on December 19, 2008.

name to Roche Operations LTD.² was submitted for recordation and recorded after the '147 patent had issued; thus, the title report that was generated at the time the request for reexamination was filed **properly identified** "Corange International Limited" as an assignee of record. In addition, there is no record of patent owner having filed a proper statement under 37 CFR 3.73(b) stating that a portion of the title was in Roche Operations LTD. by way of a name change subsequent to the filing of the reexamination proceeding. Accordingly, the reexamination certificate properly listed "Corange International Limited" as an assignee of record. The Office committed no error in not reflecting the post-issuance change of name from Corange International Limited to Roche Operations LTD. on the reexamination certificate, and accordingly, the requested Certificate of Correction will not be issued.³

Petitioner is reminded that **an application** may issue in the name of an assignee consistent with the application's filed or recorded assignment where the assignee is identified by applicant on Part B-Fee Transmittal of the PTOL-85 form that is returned by applicant with the issue fee. Unlike an application, however, **reexamination proceedings do not have such a procedure** that provides for assignment information that was recorded after the filing of a request for reexamination (not appearing on the title report). Instead, a proper statement under 37 CFR 3.73(b) must be submitted during the reexamination proceeding in order to have a new assignee listed on the reexamination certificate.

CONCLUSION

- 1) The petition is dismissed.
- 2) A copy of this decision is being placed in the file for the present reexamination, and is also being placed in the file of U.S. Patent No. 7,276,147, which is the patent subjected to Reexamination Proceeding 90/010,080.
- 3) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.



Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

May 1, 2009

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² One of the corrections sought to be included on the reexamination certificate.

³ The certificate does not list Roche Diagnostics Corporation, Inc., the owner of the remaining half-interest in the title of the patent. This error may be corrected, if patent owner files a new petition providing a certificate of correction designating the proper assignment as of the December 14, 2007 filing date of the reexamination request.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,082	12/19/2007	6038195	38512.11	3316

22852 7590 07/31/2008

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/31/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

David M. O'Dell
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, TX 75202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010082
PATENT NO. : 6038195
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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Finnegan, Henderson et al., LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Patent Owner)

David L. McCombs, Esq.
Hayes and Boone, LLP
901 Main Street, Suite 3100
Dallas, TX 75202-3789

(For Requester)

MAILED

JUL 31 2008

CENTRAL REEXAMINATION UNIT

In re Farmweld et al.
Reexamination Proceeding
Control No.: 90/010,082
Filed: December 19, 2007
For: U.S. Patent No. 6,038,195

:
: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183
:

This is a decision on the May 13, 2008 patent owner petition entitled "PETITION TO WAIVE 37 CFR § 1.98(a) (2) AND ENTER INTO THE FILE DOCUMENTS FROM CO-PENDING REEXAMINATION PROCEEDING," being treated under 37 CFR 1.183. The petition requests waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a), for entry into the record of reexamination proceeding control No. 95/010,082 - the foreign and non-patent literature documents that were previously submitted in a copending reexamination proceeding.

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. 6,038,195 (the '195 patent) issued on March 14, 2000.
2. U.S. Patent Nos. 6,715,020 (the '020 patent) issued on March 30, 2004.
3. The '195 patent and the '020 patent are related patent application filings, which both ultimately claim benefit to US application 07/510,898, filed April 18, 1990, now abandoned.
4. A request for *inter partes* reexamination of the '020 patent was filed on October 1, 2007. The request was assigned control No. 95/001,008 (the '1008 reexamination proceeding).

5. A request for *ex parte* reexamination of the '195 patent was filed on December 19, 2007. The request was assigned control No. 90/010,082 (the '082 reexamination proceeding).
6. Reexamination was ordered for the '1008 proceeding on December 19, 2007.
7. Reexamination was ordered for the '082 proceeding on February 15, 2008.
8. On February 19, 2008, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '1008 proceeding.
9. On May 13, 2008, patent owner filed in the '082 proceeding - a document entitled "Information Disclosure Statement" that is identical to the document of the same title filed on February 19, 2008 in the '1008 proceeding. Office records fail to reveal, however, that copies of the references listed in the May 13, 2008 document entitled "Information Disclosure Statement" were received by the Office in the '082 proceeding.
10. Concurrent with the May 13, 2008 submission in the '082 proceeding, the patent owner filed the instant petition under 1.183 requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a), and requesting entry into the record of reexamination proceeding control no. 90/010,082 - the foreign and non-patent literature documents that were previously submitted in the copending reexamination proceeding.

DECISION

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

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

37 CFR 1.98 states (in part):

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a) (1), (a) (2) and (a) (3) of this section.

-
- (2) A legible copy of:
- (i) Each foreign patent;
 - (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
 - (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
 - (iv) All other information or that portion which caused it to be listed.

.

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each application for which applicant files an information disclosure statement. Copies of the Information Disclosure Statement references were not appropriately provided in this proceeding; accordingly, patent owner has requested waiver of the rules to permit transfer of scanned-in references of a related reexamination proceeding (such references submitted for an identical document entitled "information disclosure statement" from the related reexamination proceeding to the present proceeding. The scanning of a single submission of references and subsequent electronic transfer of the same scanned references in an identical document entitled "information disclosure statement" from a related reexamination proceeding eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requesters. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, the grant of this petition is not an acknowledgement that patent owner's May 13, 2008 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of the waiver of the formal submission requirements of 37 CFR 1.555 and 1.98 granted by this decision.

A petition fee of \$400.00 under 37 CFR 1.17(f) has been received and processed by the Office.

ADDITIONAL DISCUSSION

Petitioner asserts that a granting of a waiver of the "copy requirement" is supported by the granting of a similar petition in another reexamination proceeding.¹ However, that decision expressly states that EFS-Web is now available for reexamination filings thus minimizing the need for such a request for relief. The Office (via the Electronic Business Center) released a notice in the summer of 2007 stating that EFS-Web version 1.1.4 is designed to receive papers for reexamination proceedings.² Also, in December 2007 the Office issued a legal notice stating that EFS-Web was available for both initial and *follow-on* papers in reexamination proceedings.³ Accordingly, petitioner now has multiple instances of both constructive and actual notice that e-filing of initial and follow on papers is available in reexamination proceedings. Any subsequent submission of a document entitled "information disclosure statement" filed with a petition requesting a waiver of the "copy requirement," absent a showing of extraordinary circumstances significantly above and beyond the mere convenience rationale set forth in the present instance, will not receive favorable consideration. The Office has provided a readily usable alternative for the

¹ Petitioner discusses a petition decision issued on April 17, 2008 in reexamination proceeding 95/001,013.

² See http://www.uspto.gov/ebc/portal/efs/efs_web_114_v13.pdf

³ Memorandum signed by John J. Love, Deputy Commissioner for Patent Examination Policy, Legal Framework for EFS-Web page 10, § XXII (Signed November 29, 2007) at <http://www.uspto.gov/ebc/portal/efs/legalframework.pdf>

submission of documents that minimizes the burden of document handling for all parties, EFS-Web, but only if utilized. Therefore, petitioner, having been placed on notice is cautioned to utilize EFS-Web in filing large duplicative submissions in multiple Office proceedings, in order to minimize those burdens and not cause unnecessary expenditure of the Office's limited resources.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is granted.
2. Patent owner and counsel have been placed on notice to utilize EFS-Web in future filings of large duplicative submissions in multiple Office proceedings.
3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit for transfer of the references from the copending reexamination proceeding to the '082 proceeding.
4. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.



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



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Naveen Modi :
FINNEGAN, HENDERSON, FARABOW, : (For Patent Owner)
GARRETT & DUNNER LLP :
901 NEW YORK AVENUE, NW :
WASHINGTON DC 20001-4413 :

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

David M. O'Dell :
HAYNES AND BOONE, LLP : (For Third Party
IP SECTION : Requester)
2323 VICTORY AVENUE :
SUITE 700 :
DALLAS, TX 75219 :

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

In re: Farmwald et alia :
Ex parte Reexamination Proceeding :
Control No. 90/010,082 :
Deposited on: 19 December 2007 :
For: US Patent No. 6,038,195 :

This is a decision on the 06 November 2009, "Patent Owner's Request for Extension of Time Pursuant to 37 C.F.R. § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 01 October 2009, be extended by one (1) month. The petition was timely filed.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 01 October 2009, which set a two (2) months date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 06 November 2009, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

The petition is dismissed for the reasons set forth below.

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

ANALYSIS AND FINDINGS

The patent owner’s representative petitions under 37 CFR § 1.550(c) to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of “sufficient cause.” There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final rejection was mailed 01 October 2009. The petition was timely filed on 06 November 2009 with the appropriate fee.

The petition dated 06 November 2009 cites the length of the Office action as well as

interpretation issues among multiple prior art rejections, the petitioner further notes a large number of copending proceedings. The possible need for declarations was also noted. The previously granted petition for extension of time recited essentially the same reasoning. On balance, the petitioner has not demonstrated "sufficient cause" to grant an extension of time.

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

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the Office action dated 01 October 2009 is hereby dismissed.
2. The Patent Owner's response is due 01 December 2009.
3. Response may be submitted as follows:

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

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

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

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,082	12/19/2007	6038195	38512.11	3316

22852 7590 12/01/2009

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/01/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
Dallas, TX 75219

Date:

MAILED

DEC 01 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010082
PATENT NO. : 6038195
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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Naveen Modi
Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
901 New York Avenue, NW
Washington, D.C. 20001-4413

(For Patent Owner)

MAILED

DEC 01 2009

CENTRAL REEXAMINATION UNIT

David O'Dell
Haynes and Boone, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219

(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,082
Filing Date: December 19, 2007
For: U.S. Patent No. 6,038,195

: **DECISION**
: **ON PETITION**
: **FOR EXTENSION**
: **OF TIME**

This is a decision on the November 19, 2009 patent owner petition entitled "Petition under 37 CFR §1.181 for review of decision dismissing petition for extension of time", which has been treated as a renewed petition under 37 CFR §1.550(c).

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

For the reasons set forth below, the petition is granted in part.

DECISION

On October 1, 2009, a non-final rejection was mailed in this proceeding. On November 6, 2009, patent owner petitioned for an extension of time of one month. On November 12, that petition was dismissed. The present petition, in addition to making some arguments about the decision of November 12, presents additional facts for consideration. In order to consider these additional facts, the petition has been considered as a renewed petition for extension of time under 37 CFR 1.550(c).

Patent Owner lists several factors in favor of an extension of time. However, some of them are unpersuasive. Patent owner stresses the timing of the examiner interview of December 17, 2009. On consultation with the examiner, it is not apparent that an earlier interview date was requested by patent owner. That is, the examiner was not unavailable for an interview for the period October 1 to November 30. It is noted that the petition of November 6 states that "[patent owner]

is in the process of scheduling a personal interview with [the examiner] during the middle of December”, not that the examiner was seasonably contacted and indicated that he was unavailable for an extended period of time. To the extent that patent owner elects to have an interview after the expiration of the period for response, that is not “good cause” for an extension.

Patent owner also indicates that the same factors that were cited in the petition for extension of time of March 25, 2009 (in response to the non-final action of February 13, 2009) should be equally persuasive. However, patent owner has already submitted a series of declarations/affidavits on May 13, 2009. The petitions of November 6, 2009 and November 19, 2009 do not specify what additional affidavits are necessary given that a first set has already been submitted, or that patent owner is in the process of obtaining these affidavits.

Patent owner also discusses the volume of proceedings. This is a factor that is more significant in a first response in a proceeding. In a first response it is more likely that parties will misestimate the time required; by the time a second response is due presumably adequate resources have been dedicated to the proceedings. As patent owner has already responded to one set of office actions in the related proceedings, presumably patent owner and counsel for patent owner understand the resources required to respond to this set of proceedings.

Patent owner also discusses the timing of office responses. While the USPTO regrets that the response to the previous action took some time, this is not a factor that is identified in 37 CFR 1.550(c) or MPEP 2265 as “good cause”. MPEP 2265 identifies the reasons for a grant of an extension of time as

(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.

It is not apparent how the time the USPTO took to act on the response of May 13, 2009 and follow-on paper of May 29, 2009 increased the time required to respond to the office action of October 1, 2009.

It is noted that the present petition presents additional facts about availability of counsel.

In the petition of November 6, 2009, patent owner also lists related proceedings that are concurrently being responded to: (a) in related proceeding 95/001013 a response was filed November 9, 2009; (b) in related proceeding 95/001,154 and 95/001,108 a response was filed October 5, 2009; (c) in related proceeding 95/001,109 and 95/001,155 a response was filed November 9, 2009; (e) in related proceeding 95/000,178 a response was filed October 7, 2009; (f) in 95/001,026 a response was filed October 23, 2009. As no response from patent owner is outstanding in those proceedings, the difficulty of responding to these multiple proceedings is less significant. However, in related proceeding 95/001,106 and 95/001,131, an extension of time was also denied on November 12, 2009 and that petition has not been renewed; in 95/001,107 and 95/001,132 an extension of time was denied on November 12, 2009 and that petition has not been renewed; and in 90/010487 a response is due 12/29/09.

Taking all the facts and circumstances into consideration, the petition is granted-in-part and the time to respond to the office action of October 1, 2009 is extended by one week (7 days).

CONCLUSION

1. Patent owner's petition of November 19, 2009, treated as a renewed request for extension of time is **GRANTED-IN-PART**.
2. Telephone inquiries related to the present decision should be directed to Eric Keasel, SPE, GAU 3992 at 571-272-4929 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.
90/010.082	12/19/2007	6038195	38512.11	3316

22852 7590 04/20/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/20/2010

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

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APR 20 2010

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

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

(For 3rd Party Requester)

In re Farmwald et al.
Reexamination Proceeding
Control No.: 90/010,082
Filed: December 19, 2007
For: U.S. Patent No.: 6,038,195

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

This is a decision on the February 25, 2010 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed February 25, 2010, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,038,195 (the '195 patent) issued on March 14, 2000.

2. On February 15, 2008, the Office issued an order granting a December 19, 2007 request for reexamination of claims 1-24, 27, and 32-37 by a third party requester, which was accorded control number 90/010,082 (the '10082 proceeding).
3. The proceeding progressed until, on February 5, 2010, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '10082 proceeding.
4. On February 19, 2010, the present proceeding entered the publication cycle.
5. The instant petition was filed on February 25, 2010, 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 February 25, 2010. Patent owner states that the process of gathering materials "from the multiple proceedings involving the '195 patent and/or other patents in the same family" for submission with the IDS "took an enormous amount of time and resources." Petition at 2. The petition does not, however, detail the specifics of, nor explain the specific reasons for submission of the materials at this date, rather than an earlier date. Therefore, the petition does not present a sufficient explanation of why the information submitted could not have been submitted earlier.

Furthermore, 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 documents from corresponding foreign applications, from litigation proceedings, and from a pending related application. There are no statements by the patent owner that unequivocally state why the documents submitted make 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.

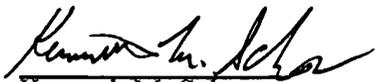
For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since it has been required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory 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 February 5, 2010, 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 February 25, 2010.
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

April 20, 2010



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.
90/010,083	01/29/2008	6375865	082913.00008	9161

616 7590 11/12/2009

THE MAXHAM FIRM
9330 SCRANTON ROAD, SUITE 350
SAN DIEGO, CA 92121

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/12/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HOLLAND & KNIGHT LLP

10 ST JAMES AVENUE

11 FLOOR

BOSTON, MA 02116-3889

Date:

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010083

PATENT NO. : 6375865

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)).



The Maxham Firm
9330 Scranton Road, Suite 350
San Diego, CA 92121

(For Patent Owner)

Holland & Knight LLP
10 St. James Ave.
Boston, MA 02116-3889

(For Requester)

MAILED
NOV 12 2009
CENTRAL REEXAMINATION UNIT

In re Paulson et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,083
Filed: January 29, 2008
For: U.S. Patent No. 6,375,865

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

This is a decision on the October 28, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding (“the October 28, 2009 patent owner petition to revive”).

The October 28, 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 \$810 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to the patent owner’s deposit account no. 02-0460, as authorized on page 2 of the October 28, 2009 patent owner petition to revive.

SUMMARY

The October 28, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon . . . for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*

*

(d) *Terminal Disclaimer*.

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

Abandonment for Failure To Reply to a Final Action

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

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

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response¹ to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted a notice of appeal and appeal fee on November 6, 2009, which satisfies item (1).² A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the October 28, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

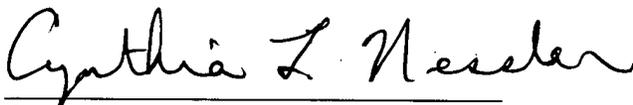
Accordingly, the October 28, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

¹ In 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 (b).

CONCLUSION

- The October 28, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.
- The time period for filing an appeal brief and the appeal brief fee is set to run **two (2) months** from the date of this decision.
- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3991 for processing of the October 28, 2009 patent owner amendment/response to the April 28, 2009 final Office action, and of the declarations of Alan Keith Miller and of Oleg Ponomarev, all of which accompanied the October 28, 2009 patent owner petition to revive.
- 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.
- Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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Craig J Cox
FULBRIGHT & JAWORSKI L.L.P. CENTRAL REEXAMINATION UNIT : (For Patent Owner)
2200 ROSS AVENUE :
SUITE 2800 :
DALLAS TX 75201-2784 :

David J Cushing :
SUGHRUE MION, PLLC : (For Third Party
2100 PENNSYLVANIA AVENUE, N.W. : Requester)
SUITE 800 :
WASHINGTON, DC 20037 :

In re: Reiter *et alia* : DECISION
Ex Parte Reexamination Proceeding : GRANTING-IN-PART
Control No. 90/010,085 : PETITION FOR EXTENSION
Deposited: 02 May 2008 : OF TIME
For: US Patent No. 5,606,621 : 37 CFR §§ 1.550(C) & 1.181

This is a decision on the 23 July 2009, "Petition For Extension of Time Under 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 09 July 2009, be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

The petition 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 the period of time be extended in which to file a response to the Office action mailed 09 July 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 23 July 2009.

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. ...

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 petitioner has noted that the examiner in charge of the proceeding is unavailable for interviews on three proposed dates. While interviews are not typically considered sufficient cause for granting an extension of time, in order to provide the patent owner with a fair opportunity to respond to the outstanding non-final Office action the petition is granted for a two (2) week extension of time.

The petition request to extend the response time is hereby granted-in-part.

The time for which to respond to the patent owner's notice of appeal is hereby extended by two (2) weeks.

CONCLUSION

1. The patent owner's petition for extension of time is hereby granted-in-part.
2. The time for submission of the response by the patent owner is extended by two (2) weeks.
3. The Patent Owner's Appeal is due 24 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.
90/010,093	01/31/2008	6264560	0504-002	6839
22442	7590	07/30/2008	EXAMINER	
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			ART UNIT	PAPER NUMBER

DATE MAILED: 07/30/2008

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Day Casebeer Madrid & Batchelder LLP
20300 Stevens Creek Blvd., Suite 400
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,093.

PATENT NO. 6264560.

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)).



Dennis J. Dupray
Sheridan Ross P.C.
1560 Broadway
Suite 1200
Denver, CO 80202

(For Patent Owner)

MAILED
JUL 30 2008

CENTRAL REEXAMINATION UNIT

Bradley A. Waugh
Day Casebeer Madrid & Batchelder LLP
20300 Stevens Creek Blvd., Suite 400
Cupertino, CA 95014

(For Requester)

In re Reissue Application of: Goldberg et al.
Application No. 12/138,357
Filed: June 12, 2008
For: U.S. Patent No. 6,264,560

**DECISION ON PETITION
UNDER 37 CFR 1.182
TO MERGE REISSUE
AND REEXAMINATION
PROCEEDINGS**

In re Goldberg
Reexamination Proceeding
Control No. 90/010,093
Filed: January 31, 2008
For: U.S. Patent No. 6,264,560

This is a decision on the June 12, 2008 patent owner petition under 1.182 to merge above-captioned reissue application and reexamination proceeding.

The petition, reissue application 12/138,357, and reexamination control number 90/010,093 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,264,560 (the '560 patent) issued on July 24, 2001, with 105 claims.
2. A request for reexamination of the '560 patent was filed by a third party requester on January 31, 2008, and was assigned control No. 90/010,093 (the '0093 proceeding).
3. Reexamination was ordered for the '0093 proceeding on February 29, 2008.

4. An application for reissue of the '560 patent, assigned application No. 12/138,357 (the '357 application), was filed by the patent owner on June 12, 2008.
5. On June 12, 2008, the present petition under 37 CFR 1.182 was filed by the patent owner in the '0093 proceeding requesting merger of the reissue application and reexamination proceeding.
6. A notice of concurrent proceedings was filed by the patent owner on June 12, 2008 in the '264 reissue application informing the Office of the '0093 proceeding.
7. The notice of reissue of the '357 reissue application is scheduled to be published in the *Official Gazette* on August 19, 2008.

DISCUSSION

Under MPEP 1441, the present petition for a merger decision is premature and not yet ripe for decision because the '357 reissue application is not to be acted on sooner than 2 months after August 19, 2008, the date when the notice of reissue will be published in the *Official Gazette*.

MPEP 1441 ("Two-Month Delay Period") provides as follows:

"Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

Thus, even after the '357 reissue application is announced in the *Official Gazette*, action is still not to be taken by the Office for the '357 reissue application until two months from the announcement date. Accordingly, the petition for merger is dismissed, since it is premature to consider such a petition.

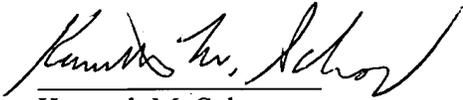
While petitioner may file a petition for a waiver of the 2-month delay provision of MPEP 1441 under 37 CFR 1.182, a sufficient showing must be provided, before the Office will act on the '357 reissue application without delaying for 2 months. MPEP 1441 provides as follows:

"Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(f)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP

§ 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration.”

CONCLUSION

1. The petition requesting merger of the '357 reissue application and '0093 reexamination proceeding is dismissed.
2. Jurisdiction over the '357 reissue application is being transferred to Technology Center 3700, in which the reissue proceeding is assigned. Jurisdiction over the '0093 reexamination proceeding is being returned to the Central Reexamination Unit.
3. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



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

7/29/08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,093	01/31/2008	6264560	3367-4-REX	6839

22442 7590 06/02/2009

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/02/2009

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



Dennis J. Dupray
Sheridan Ross P.C.
1560 Broadway
Suite 1200
Denver, Colorado 80202

(For Patent Owner)

MAILED
JUN 02 2009
CENTRAL REEXAMINATION UNIT

Bradley A. Waugh
Day Casebeer Madrid & Batchelder LLP
20300 Stevens Creek Blvd., Suite 400
Cupertino, California 95014

(For Requester)

In re Reissue Application of: Goldberg et al. :
Application No. 12/138,357 :
Filed: June 12, 2008 :
For: U.S. Patent No. 6,264,560 :

In re Goldberg :
Reexamination Proceeding :
Control No. 90/010,093 :
Filed: January 31, 2008 :
For: U.S. Patent No. 6,264,560 :

DECISION
SUA SPONTE
MERGING REISSUE
AND REEXAMINATION
PROCEEDINGS

Reissue application 12/138,357, and reexamination control number 90/010,093 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. 6,264,560 (the '560 patent) issued on July 24, 2001, with 105 claims.
2. A request for reexamination of the '560 patent was filed by a third party requester on January 31, 2008, and was assigned control No. 90/010,093 (the '0093 proceeding).
3. Reexamination was ordered for the '0093 proceeding on February 29, 2008.
4. An application for reissue of the '560 patent, assigned application No. 12/138,357 (the '357 application), was filed by the patent owner on June 12, 2008. The application included a preliminary amendment that amended the text of claims 1, 2, 4-6, 9, 12, 20, 42, 50, 66, 91, 92, and 97; cancelled claims 8, 11, 15-19, 24, 26-41, 33, 34, 36, 40, 41, 43-49, 56-58, 68-70, 73, 77, and 101; and added new claims 106-109.

5. On June 12, 2008, a petition under 37 CFR 1.182 was filed by the patent owner in the '0093 proceeding requesting merger of the reissue application and reexamination proceeding.
6. A notice of concurrent proceedings was filed by the patent owner on June 12, 2008 in the '357 reissue application informing the Office of the '0093 proceeding.
7. On July 30, 2008, a decision was issued dismissing the June 12, 2008 petition for merger as premature.
8. The notice of the filing of the '357 application for reissue of the '560 patent published in the *Official Gazette* on August 19, 2008.

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. 12/138,357 and reexamination control No. 90/010,093 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant reissue and reexamination

proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an ex parte reexamination proceeding under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, merger would be ordered. 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. 90/010,093 shows the presence of the following live claims: original patent claims 1-105;
3. A review of reissue application No. 12/138,357 shows that the application included a preliminary amendment that amended the text of claims 1, 2, 4-6, 9, 12, 20, 42, 50, 66, 91, 92, and 97; cancelled claims 8, 11, 15-19, 24, 26-41, 33, 34, 36, 40, 41, 43-49, 56-58, 68-70, 73, 77, and 101; and added new claims 106-109.

Accordingly, the claims are not identical in both proceedings.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both proceedings, specifically, Application No.

12/138,357 and Control Number 90/010,093. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reissue/reexamination proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.
2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings (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.
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. 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

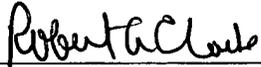
remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

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. 12/138,357 and reexamination control No. 90/010,093 **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 all cases 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 3700. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '560 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 Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.



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

5/19/09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,094	02/01/2008	6397189	8246.002.000000	9430

7590 01/09/2009

MCANDREWS HELD & MALLOY
NORTHWESTERN ATRIUM CENTER
500 WEST MADISON STREET
31ST FLOOR
CHICAGO, IL 60606

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/09/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SAN FRANCISCO OFFICE OF NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JAN 09 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010094
PATENT NO. : 6397189
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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McANDREWS, HELD & MALLOY, LTD
500 WEST MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

(For Patent Owner)

JAN 09 2009

CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For *Ex Parte* Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,094
Filed: February 1, 2008
For: U.S. Patent No. 6,397,189

:
: DECISION
: GRANTING
: PETITION
:

This is a decision on patent owner's petition filed on December 4, 2008 entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)." Patent owner requests waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of references that are subject to a protective order with respect to reexamination proceeding control nos. 90/010,094, 90/010,095, 90/010,097 and 90/010,147.

The petition is before the Office of Patent Legal Administration. Although captioned as a petition under 37 CFR 1.182, the petition will be treated as a petition under 37 CFR 1.183 for suspension of the rules.

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. 13-0017, as authorized on page three of the petition.

REVIEW OF FACTS

1. U.S. Patent No. 5,848,398 (the '398 patent) issued on December 8, 1998, U.S. Patent No. 6,381,575 (the '575 patent) issued on April 30, 2002, U.S. Patent No. 6,397,189 (the '189 patent) issued on May 28, 2002, and U.S. Patent No. 6,970,834 (the '834 patent) issued on November 29, 2005.

2. A request for *ex parte* reexamination of the '834 patent was filed on February 1, 2008. The request was assigned control no. 90/010,095 (the '10095 reexamination proceeding).
3. Also, a request for *ex parte* reexamination of the '189 patent was filed on February 1, 2008. The request was assigned control no. 90/010,094 (the '10094 reexamination proceeding).
4. Further, a request for *ex parte* reexamination of the '575 patent was filed on February 1, 2008. The request was assigned control no. 90/010,097 (the '10097 reexamination proceeding).
5. Reexamination was ordered for the '10095 proceeding on April 9, 2008.
6. Reexamination was ordered for the '10094 proceeding and for the '10097 proceeding on April 11, 2008.
7. A request for *ex parte* reexamination of the '398 patent was filed on April 22, 2008. The request was assigned control no. 90/010,147 (the '10147 reexamination proceeding).
8. Reexamination was ordered for the '10147 proceeding on June 23, 2008.
9. On August 28, 2008, patent owner filed a paper in the '10097 proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO CONSOLIDATE REEXAMINATION PROCEEDINGS," requesting that the '10094, '10095, '10097 and '10147 proceedings (the four proceedings) be consolidated in order to, among other reasons, minimize the volume of disclosure of information and documents from two concurrent lawsuits involving the underlying patents.
10. On October 1, 2008, the Office mailed a "DECISION DISMISSING PETITION TO CONSOLIDATE REEXAMINATION PROCEEDINGS" in the '10097 proceeding. The decision indicated that, for information subject to protective order, the Office would be willing to consider a petition under 37 CFR 1.183, requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of the protected materials to serve as the required copy for the four proceedings.
11. On December 4, 2008, patent owner filed, in each of the four proceedings, a "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)."
12. Patent owner filed a paper entitled "SUBMISSION OF INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. § 1.555" in the '10095 proceeding on December 12, 2008, in the '10094 proceeding on December 16,

2008, in the '10097 proceeding on December 17, 2008, and in the '10147 proceeding on December 18, 2008 (IDS submissions). Patent owner electronically submitted in each of the four proceedings copies of references cited in the IDS submissions that are not subject to a protective order. Patent owner submitted by mail, pursuant to MPEP 724, only in the '10095 proceeding, copies of references cited in the IDS submissions that are subject to a protective order.

13. Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" in the '10095 proceeding.

DECISION

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

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

37 CFR 1.98 states (in part):

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(2) A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each reexamination proceeding for which a patent owner files an IDS, to constitute a proper IDS. Accordingly, if patent owner intends to file an identical IDS in multiple reexamination proceedings, the rules require patent owner to file the IDS and copies of the references cited therein in each of the proceedings. EFS-Web, the Office's electronic filing system, facilitates such multiple filings by enabling

patent owner to scan each reference to be submitted only once and then to electronically file the scanned references into each of the proceedings.

In the present situation, patent owner has already electronically filed in each of the four proceedings the references identified in the IDS submissions that are not stated to be subject to a protective order. The Office recognizes, however, that the references identified in the IDS submissions that are subject to the protective order cannot be filed electronically. See MPEP 724. Thus, in this instance, the acceptance of a single submission of the references that are subject to the protective order for the '10095 proceeding will ease the burden of handling these references for the Office, as well as the patent owner, without prejudice to the third party requesters. Accordingly, the instant petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 to permit a single submission of the protected materials to serve as the required copy for the four proceedings is **granted**.

The grant of the petition is not based upon the individual facts and circumstances of the four proceedings. Furthermore, grant of the petition is not an acknowledgement that patent owner's IDS submissions comply with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of the waiver of the reference copy submission requirement pursuant to this decision.

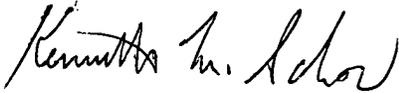
MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the proceeding is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed protected 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 examiner may issue a determination on the issue of importance of the 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 the Office issues a determination that any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable," then the information determined to be "important..." will be scanned into the record of the '10095 proceeding, with a subsequent electronic transfer of the same scanned references into the '10094, '10097 and '10147 proceedings.

ADDITIONAL DISCUSSION

Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" (petition to expunge) in the '10095 proceeding. In light of this decision granting patent owner's instant petition, patent owner must also file the petition to expunge and requisite petition fee in the '10094 proceeding such that any of the references that are subject to the protective order found by the examiner not to be material to patentability are subsequently expunged from the '10094 proceeding.

CONCLUSION

1. Patent owner's December 4, 2008 petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is granted.
2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit.
3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.



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

1-7-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,094	02/01/2008	6397189	8246.002.000000	9430

7590 02/05/2009
MCANDREWS HELD & MALLOY
NORTHWESTERN ATRIUM CENTER
500 WEST MADISON STREET
31ST FLOOR
CHICAGO, IL 60606

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/05/2009

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SAN FRANCISCO OFFICE OF NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010094
PATENT NO. : 6397189
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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Alexandria, VA 22313-1450
www.uspto.gov

Joseph M. Butscher
MCANDREWS HELD & MALLOY
NORTHWESTERN ATRIUM CENTER
500 WEST MADISON STREET
31ST FLOOR
CHICAGO IL 60606

(For Patent Owner

MAILED

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CENTRAL REEXAMINATION UNIT

Stephen C. Durant
SAN FRANCISCO OFFICE OF
NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party
Requester)

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

In re: Martin et alia
Ex Parte Reexamination Proceeding
Control No. 90/010,094
Deposited on: 1 February 2008
For: US Patent No. 6,397,189

This is a decision on the 2 February 2009, petition for "Request for a Two-Month Extension of Time Pursuant to 37 CFR 1.550(c)," requesting that the time for responding to the non-final Office action, mailed 18 December 2008 be extended by two (2) months.

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

The petition is Granted-in-Part for the reasons set forth below.

Summary of Relevant Facts

1. On 1 February 2008 a third party requester, requested reexamination of US Patent No. 6,397,189.
2. On 11 April 2008 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.
3. On 18 December 2008 a non-final Office action was mailed to the address of record.
4. On 2 February 2009 a petition was filed requesting two (2) months extension of time for which to respond to the outstanding Office action.

Decision

The Patent Owner requests an extension of time in which to file a response to the non-final Office action mailed 18 December 2008, which set a two-months date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the non-final Office action be extended by two (2) additional months. The petitioner has provided "sufficient cause" for granting an extension of time in-part. The petition is timely filed.

The petitioner has provided the petition fee set forth in 37 CFR § 1.17(g).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

The patent owner petitions the director if the Central Reexamination Unit for an extension of time for an additional two (2) months for which to submit a response to the non-final Office action mailed on 18 December 2008.

The patent owner has the need to contact an expert witness to determine whether declarations pursuant to 37 CFR § 1.132 will be necessary, a nearly one week delay in receipt of the Office action and the difficulty in responding to four different actions in related proceedings whose responses due at the same time.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

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

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

Conclusion

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Office action dated 18 December 2008 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 will end on **18 March 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.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,095	02/01/2008	6970834	8246.002.000000	9579

7590 01/09/2009

McANDREWS, HELD & MALLOY, LTD
500 WEST MADISON STREET 34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/09/2009

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
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

McANDREWS, HELD & MALLOY, LTD
500 WEST MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

(For Patent Owner)

NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For *Ex Parte* Requester)

MAILED

JAN 09 2009

Ex Parte Reexamination Proceeding
Control No.: 90/010,095
Filed: February 1, 2008
For: U.S. Patent No. 6,970,834

:
: DECISION
: DISMISSING
: PETITION
:

CENTRAL REEXAMINATION UNIT

This is a decision on patent owner's petition filed on December 4, 2008 entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)." Patent owner requests waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of references that are subject to a protective order with respect to reexamination proceeding control nos. 90/010,094, 90/010,095, 90/010,097 and 90/010,147.

The petition is before the Office of Patent Legal Administration.

The petition is dismissed as moot.

REVIEW OF FACTS

1. U.S. Patent No. 5,848,398 (the '398 patent) issued on December 8, 1998, U.S. Patent No. 6,381,575 (the '575 patent) issued on April 30, 2002, U.S. Patent No. 6,397,189 (the '189 patent) issued on May 28, 2002, and U.S. Patent No. 6,970,834 (the '834 patent) issued on November 29, 2005.
2. A request for *ex parte* reexamination of the '834 patent was filed on February 1, 2008. The request was assigned control no. 90/010,095 (the '10095 reexamination proceeding).

3. Also, a request for *ex parte* reexamination of the '189 patent was filed on February 1, 2008. The request was assigned control no. 90/010,094 (the '10094 reexamination proceeding).
4. Further, a request for *ex parte* reexamination of the '575 patent was filed on February 1, 2008. The request was assigned control no. 90/010,097 (the '10097 reexamination proceeding).
5. Reexamination was ordered for the '10095 proceeding on April 9, 2008.
6. Reexamination was ordered for the '10094 proceeding and for the '10097 proceeding on April 11, 2008.
7. A request for *ex parte* reexamination of the '398 patent was filed on April 22, 2008. The request was assigned control no. 90/010,147 (the '10147 reexamination proceeding).
8. Reexamination was ordered for the '10147 proceeding on June 23, 2008.
9. On August 28, 2008, patent owner filed a paper in the '10097 proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO CONSOLIDATE REEXAMINATION PROCEEDINGS," requesting that the '10094, '10095, '10097 and '10147 proceedings (the four proceedings) be consolidated in order to, among other reasons, minimize the volume of disclosure of information and documents from two concurrent lawsuits involving the underlying patents.
10. On October 1, 2008, the Office mailed a "DECISION DISMISSING PETITION TO CONSOLIDATE REEXAMINATION PROCEEDINGS" in the '10097 proceeding. The decision indicated that, for information subject to protective order, the Office would be willing to consider a petition under 37 CFR 1.183, requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of the protected materials to serve as the required copy for the four proceedings.
11. On December 4, 2008, patent owner filed, in each of the four proceedings, a "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)."
12. Patent owner filed a paper entitled "SUBMISSION OF INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. § 1.555" in the '10095 proceeding on December 12, 2008, in the '10094 proceeding on December 16, 2008, in the '10097 proceeding on December 17, 2008, and in the '10147 proceeding on December 18, 2008 (IDS submissions). Patent owner electronically submitted in each of the four proceedings copies of references cited in the IDS submissions that are not subject to a protective order. Patent owner

submitted by mail, pursuant to MPEP 724, only in the '10095 proceeding, copies of references cited in the IDS submissions that are subject to a protective order.

13. Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" in the '10095 proceeding.

DECISION

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

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

37 CFR 1.98 states (in part):

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(2) A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

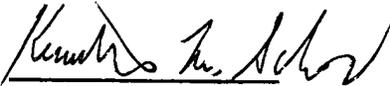
37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). In the present proceeding, patent owner has fulfilled the reference copy submission requirements of 37 CFR 1.98(a) for which a waiver is sought. Accordingly, the petition is dismissed as moot.

No fee is due. Patent owner's Deposit Account No. 13-0017 will be credited in the amount of \$400.00.

This decision does not constitute an acknowledgement that patent owner's IDS submission on December 12, 2008 complies with all other requirements of the relevant rules. The examiner of record will make such a determination once jurisdiction is returned.

CONCLUSION

1. Patent owner's December 4, 2008 petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 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
Office of the Deputy Commissioner
for Patent Examining Policy



UNITED STATES PATENT AND TRADEMARK OFFICE

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

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FEB 04 2009

Joseph M. Butscher
McANDREWS, HELD & MALLOY, LTD : (For Patent Owner)
500 WEST MADISON STREET :
34TH FLOOR :
CHICAGO IL 60661 :

CENTRAL REEXAMINATION UNIT

Stephen C. Durant :
SAN FRANCISCO OFFICE OF : (For Third Party
NOVAK, DRUCE & QUIGG LLP : Requester)
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

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

In re: Martin et alia :
Ex Parte Reexamination Proceeding :
Control No. 90/010,095 :
Deposited on: 1 February 2008 :
For: US Patent No. 6,970,834 :

This is a decision on the 2 February 2009, petition for "Request for a Two-Month Extension of Time Pursuant to 37 CFR 1.550(c)," requesting that the time for responding to the non-final Office action, mailed 18 December 2008 be extended by two (2) months.

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

The petition is Granted-in-Part for the reasons set forth below.

Summary of Relevant Facts

1. On 1 February 2008 a third party requester, requested reexamination of US Patent No. 6,970,834.
2. On 9 April 2009 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.
3. On 18 December 2008 a non-final Office action was mailed to the address of record.
4. On 2 February 2009 a petition was filed requesting two (2) months extension of time for which to respond to the outstanding Office action.

Decision

The Patent Owner requests an extension of time in which to file a response to the non-final Office action mailed 18 December 2008, which set a two-months date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the non-final Office action be extended by two (2) additional months. Since the petitioner has provided "sufficient cause" for granting an extension of time in-part. The petition is timely filed.

The petitioner has provided the petition fee set forth in 37 CFR § 1.17(g).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time for an additional two (2) months for which to submit a response to the non-final Office action mailed on 18 December 2008.

The patent owner has the need to contact an expert witness to determine whether declarations pursuant to 37 CFR § 1.132 will be necessary, a nearly one week delay in receipt of the Office action and the difficulty in responding to four different actions in related proceedings whose responses due at the same time.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

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

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

Conclusion

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Office action dated 18 December 2008 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 will end on **18 March 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.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit



MAILED

FEB 18 2009

McAndrews, Held & Malloy, LTD CENTRAL REEXAMINATION UNIT
500 West Madison Street, 34th Floor
Chicago, IL 60661

(Patent Owner)

Novak, Druce & Quigg, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(*Ex Parte* Requester)

<i>Ex Parte</i> Reexamination Proceeding	:	
Control No. 90/010,095	:	DECISION
Filed: February 1, 2008	:	ON
For: U.S. Patent No. 6,970,834 B1	:	PETITIONS
	:	

This is a decision addresses the patent owner "PETITION UNDER 37 C.F.R. § 1.183 REQUESTING WAIVER OF THE SERVICE REQUIREMENT OF 37 C.F.R. §§ 1.550(f)," submitted on December 12, 2008 and the patent owner "PETITION TO EXPUNGE UNDER 37 C.F.R. §§ 1.59(b)," submitted on December 15, 2008.

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. U.S. Patent No. 6,970,834 to Martin et al. (the '834 patent) issued on November 29, 2005.
2. On February 1, 2008, a third party requester filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/010,095 (the '10095 proceeding).
3. On April 9, 2008 the Office granted the '10095 reexamination request, and ordered reexamination.
4. On December 12, 2008, the patent owner filed an Information Disclosure Statement (IDS) in the '10095 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).

5. On December 15, 2008, patent owner filed 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 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 1.59 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 requester. 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

¹ See 37 CFR 1.11(d).

² For reexamination proceeding, see MPEP 724.04(c), part (C).

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 found to be the case, at this point.

In this instance, the information being submitted may 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. The protective order is 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 December 12, 2008 information covered by the protective order to the Office, and (b) that disclosure to the public of the protected information may occur if the information covered by the protective order is found to be "important to a reasonable examiner in deciding whether or not a claim is patentable."⁴ It is to be noted that if claims are under rejection, information supporting patentability may be deemed to be "important to a reasonable examiner," even if the evidence is not ultimately persuasive on the 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.

Petitioner Instructions

Petitioner must notify the court which issued the protective order, and all other parties covered by the protective order that the December 12, 2008 information has been submitted to the Office, and that under the procedures of the Office for handling documents submitted under seal, if the material is deemed to be "important to a reasonable examiner" in deciding patentability of at least one claim, then the material will 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 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.

³ Again, see MPEP 724.04(c), part (C).

⁴ *Id.*

If petitioner timely informs the Office that the court and the parties authorize and consent to the submission, then a further decision granting the waiver of the service requirement will be issued and jurisdiction will be transferred to the Central Reexamination Unit (CRU). The information will 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 if either the court or any one of the parties protected by the court's protective order do not authorize or consent to the submission of protected information to the Office, then this decision will be revisited, the petition will be dismissed, and the December 12, 2008 information will 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

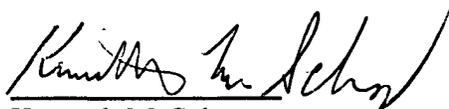
The information submitted with the petition under 37 CFR 1.59, appears to be appropriately submitted. Accordingly, the materials are **provisionally sealed**.

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 December 12, 2008 information has not been expunged from the record at the point 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." A review of the file history reveals that the requisite determination has not been made. Therefore, a decision on the petition to expunge at this time is premature, because it is not certain that the December 12, 2008 information will remain in the record, and if it does, then any information submitted in confidence but found to be "important to a reasonable examiner in deciding whether or not a claim is patentable" must not be expunged. Accordingly, it is not appropriate at this time to make a determination to expunge. In due course, the proceeding will be forwarded to the examiner for examination, and contingent upon petitioner's submission in response to this decision, if the protected information remains in the file history, 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 made of record (as discussed above), the issue of expungement would 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 provisionally sealed material 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 has one month or (30) days (whichever is later) from the issue date of this decision to submit a response indicating that either the court that issued the protective order and/or the other parties covered by the protective order approve and consent to the submission of the protective order information in the present Office proceeding which may result in the information becoming available to the public.
3. Jurisdiction over the present proceeding will be retained by the Office of Patent Legal Administration until petitioner submits either: (1) a timely and appropriate response, as outlined above, to the instant decision; or (2) the one month (30 day) time period has elapsed, and a decision is rendered as to whether December 12, 2008 information will remain in the record. Thereafter, jurisdiction will be transferred to the Central Reexamination Unit (CRU).
4. **The provisional grant of this decision will be revisited and 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 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

02-18-09

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 10/01/2008

McANDREWS HELD & MALLOY LTD
500 WEST MADISON STREET 34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/01/2008

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MAILED

OCT 01 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,097.

PATENT NO. 6381575.

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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McANDREWS HELD & MALLOY LTD
500 West Madison Street 34th Floor
Chicago, IL 60661

(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Street 53rd Floor
Houston, TX 77002

(For Requester)

MAILED

OCT 0 1 2008

CENTRAL REEXAMINATION UNIT

In re Martin *et alia*
Reexamination Proceeding
Control No. 90/010,097
For: U.S. Patent No. 6,381,575

: DECISION DISMISSING
: PETITION TO CONSOLIDATE
: REEXAMINATION
: PROCEEDINGS

The above *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of a petition filed August 28, 2008 to consolidate reexamination proceedings. Although the petition is styled as a petition under 37 CFR 1.182, the petition is considered pursuant to 37 CFR 1.181. No fee is required and the petition fee under 37 CFR 1.17(f) submitted on August 28, 2008 will be replenished to Deposit Account Number DA 130017.

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,381,575 (hereinafter, the '575 patent), issued to Martin *et alia*, on April 30, 2002.
2. On February 1, 2008, a third party deposited a request for *ex parte* reexamination of the '575 patent. The reexamination proceeding was assigned Control No. 90/010,097 (hereinafter, the '10097 proceeding).
3. On April 11, 2008, the order granting the request for reexamination was mailed.
4. On August 28, 2008, the present petition was filed.

Art Unit: 3992

RELEVANT REGULATIONS AND GUIDELINES

1.550 Conduct of ex parte reexamination proceedings.

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

(f) The reexamination requester will be sent copies of Office actions issued during the ex parte reexamination proceeding. After filing of a request for ex parte reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

DECISION

Initially, it is noted that the present petition does not reflect service. Patent Owner is respectfully directed to 37 CFR 1.550(f) regarding the requirement to serve any document filed by the patent owner on the third party requester.

“The Patentee respectfully petitions to consolidate the reexamination proceedings of Reexamination Control No: 90/010,094, Reexamination Control No. 90/010,095, Reexamination Control No. 90/010,097 and Reexamination Control No. 90/010,147 into a single Reexamination proceeding...” It is noted that the four reexamination proceedings are directed to four different patents. The four patents are commonly assigned and have overlapping inventive entities. However, the inventive entity of the ‘575 patent is different from the inventive entities of the underlying patents of the other three reexamination proceedings.

Patent Owner argues that “it is believed that the process of examination will be more efficient for the Examiner.” It is unclear why Patent Owner believes it would be more efficient for the Examiner to examine more than 60 claims covering 4 patents in a single proceeding. The claims cover different scope in the different patents and different prior art references were submitted by requester. Of the dozens of references submitted by requester between the four proceedings, only two references are common to all four proceedings.

Furthermore, consolidating the proceedings has a greater potential for delay. For example, if three of the non-consolidated proceedings have completed actions and are ready for mailing, any unresolved issues in the fourth proceeding would delay prosecution if the proceedings were consolidated. This runs counter to the requirement for “special dispatch”.

Art Unit: 3992

Patent Owner argues that the volume of material that they plan to submit would impose a burden on the office and would not be environmentally friendly if submitted in each of the four proceedings.

Patent Owner has filed the present petition via electronic filing system EFS-Web. So, Patent Owner is aware that such papers can be filed electronically. Patent Owner is **strongly encouraged** to file their voluminous IDS via EFS for all material that is not trade secret, proprietary and/or subject to protective order. This greatly reduces the burden on the office and is the most environmentally friendly manner for Patent Owner to submit such papers.

For material (information) that is subject to protective order, the concern is noted. The office would be willing to consider a petition to suspend the rules under 37 CFR 1.183 to permit a single submission of the **protected materials only** to serve as the required copy for the four proceedings if the petition with the requisite fee were filed in each of the proceedings. The petition would be a petition requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a), for entry into the record of the reexamination proceeding and would be filed in the three proceedings in which the copy of the material is not submitted.

CONCLUSION

1. The petition to consolidate the '10097 proceeding with control numbers 90/010,094, 90/010,095, and 90/010,147 is **dismissed**.
2. Patent owner may file a request for reconsideration, without additional fee, to address the decision. Any such request for reconsideration would be directed to the Central Reexamination Unit.
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

Art Unit: 3992

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 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.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 01/09/2009

EXAMINER

STEPHEN C. DURANT
NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

ART UNIT PAPER NUMBER

DATE MAILED: 01/09/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 01/09/2009

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CHICAGO, IL 60661

EXAMINER

ART UNIT PAPER NUMBER

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500 WEST MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

(For Patent Owner)

NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For *Ex Parte* Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,097
Filed: February 1, 2008
For: U.S. Patent No. 6,381,575

:
: DECISION
: GRANTING
: PETITION
:

MAILED
JAN 09 2009
CENTRAL REEXAMINATION UNIT

This is a decision on patent owner's petition filed on December 4, 2008 entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)." Patent owner requests waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of references that are subject to a protective order with respect to reexamination proceeding control nos. 90/010,094, 90/010,095, 90/010,097 and 90/010,147.

The petition is before the Office of Patent Legal Administration. Although captioned as a petition under 37 CFR 1.182, the petition will be treated as a petition under 37 CFR 1.183 for suspension of the rules.

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. 13-0017, as authorized on page three of the petition.

REVIEW OF FACTS

1. U.S. Patent No. 5,848,398 (the '398 patent) issued on December 8, 1998, U.S. Patent No. 6,381,575 (the '575 patent) issued on April 30, 2002, U.S. Patent No. 6,397,189 (the '189 patent) issued on May 28, 2002, and U.S. Patent No. 6,970,834 (the '834 patent) issued on November 29, 2005.

2. A request for *ex parte* reexamination of the '834 patent was filed on February 1, 2008. The request was assigned control no. 90/010,095 (the '10095 reexamination proceeding).
3. Also, a request for *ex parte* reexamination of the '189 patent was filed on February 1, 2008. The request was assigned control no. 90/010,094 (the '10094 reexamination proceeding).
4. Further, a request for *ex parte* reexamination of the '575 patent was filed on February 1, 2008. The request was assigned control no. 90/010,097 (the '10097 reexamination proceeding).
5. Reexamination was ordered for the '10095 proceeding on April 9, 2008.
6. Reexamination was ordered for the '10094 proceeding and for the '10097 proceeding on April 11, 2008.
7. A request for *ex parte* reexamination of the '398 patent was filed on April 22, 2008. The request was assigned control no. 90/010,147 (the '10147 reexamination proceeding).
8. Reexamination was ordered for the '10147 proceeding on June 23, 2008.
9. On August 28, 2008, patent owner filed a paper in the '10097 proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO CONSOLIDATE REEXAMINATION PROCEEDINGS," requesting that the '10094, '10095, '10097 and '10147 proceedings (the four proceedings) be consolidated in order to, among other reasons, minimize the volume of disclosure of information and documents from two concurrent lawsuits involving the underlying patents.
10. On October 1, 2008, the Office mailed a "DECISION DISMISSING PETITION TO CONSOLIDATE REEXAMINATION PROCEEDINGS" in the '10097 proceeding. The decision indicated that, for information subject to protective order, the Office would be willing to consider a petition under 37 CFR 1.183, requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of the protected materials to serve as the required copy for the four proceedings.
11. On December 4, 2008, patent owner filed, in each of the four proceedings, a "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)."
12. Patent owner filed a paper entitled "SUBMISSION OF INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. § 1.555" in the '10095 proceeding on December 12, 2008, in the '10094 proceeding on December 16,

2008, in the '10097 proceeding on December 17, 2008, and in the '10147 proceeding on December 18, 2008 (IDS submissions). Patent owner electronically submitted in each of the four proceedings copies of references cited in the IDS submissions that are not subject to a protective order. Patent owner submitted by mail, pursuant to MPEP 724, only in the '10095 proceeding, copies of references cited in the IDS submissions that are subject to a protective order.

13. Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" in the '10095 proceeding.

DECISION

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

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

37 CFR 1.98 states (in part):

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(2) A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each reexamination proceeding for which a patent owner files an IDS, to constitute a proper IDS. Accordingly, if patent owner intends to file an identical IDS in multiple reexamination proceedings, the rules require patent owner to file the IDS and copies of the references cited therein in each of the proceedings. EFS-Web, the Office's electronic filing system, facilitates such multiple filings by enabling

patent owner to scan each reference to be submitted only once and then to electronically file the scanned references into each of the proceedings.

In the present situation, patent owner has already electronically filed in each of the four proceedings the references identified in the IDS submissions that are not stated to be subject to a protective order. The Office recognizes, however, that the references identified in the IDS submissions that are subject to the protective order cannot be filed electronically. See MPEP 724. Thus, in this instance, the acceptance of a single submission of the references that are subject to the protective order for the '10095 proceeding will ease the burden of handling these references for the Office, as well as the patent owner, without prejudice to the third party requesters. Accordingly, the instant petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 to permit a single submission of the protected materials to serve as the required copy for the four proceedings is **granted**.

The grant of the petition is not based upon the individual facts and circumstances of the four proceedings. Furthermore, grant of the petition is not an acknowledgement that patent owner's IDS submissions comply with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of the waiver of the reference copy submission requirement pursuant to this decision.

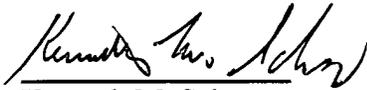
MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the proceeding is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed protected 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 examiner may issue a determination on the issue of importance of the 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 the Office issues a determination that any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable," then the information determined to be "important..." will be scanned into the record of the '10095 proceeding, with a subsequent electronic transfer of the same scanned references into the '10094, '10097 and '10147 proceedings.

ADDITIONAL DISCUSSION

Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" (petition to expunge) in the '10095 proceeding. In light of this decision granting patent owner's instant petition, patent owner must also file the petition to expunge and requisite petition fee in the '10097 proceeding such that any of the references that are subject to the protective order found by the examiner not to be material to patentability are subsequently expunged from the '10097 proceeding.

CONCLUSION

1. Patent owner's December 4, 2008 petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is granted.
2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit.
3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.



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

1-7-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 02/04/2009

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EXAMINER

ART UNIT PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 01/09/2009

EXAMINER

STEPHEN C. DURANT
NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

ART UNIT PAPER NUMBER

DATE MAILED: MAILED

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CENTRAL REEXAMINATION UNIT

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Joseph M. Butscher :
McANDREWS, HELD & MALLOY, LTD : (For Patent Owner)
500 WEST MADISON STREET :
34TH FLOOR :
CHICAGO IL 60661 :

Stephen C. Durant :
SAN FRANCISCO OFFICE OF : (For Third Party
NOVAK, DRUCE & QUIGG LLP : Requester)
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

MAILED
FEB 04 2009
CENTRAL REEXAMINATION UNIT

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

In re: Martin et alia :
Ex Parte Reexamination Proceeding :
Control No. 90/010,097 :
Deposited on: 1 February 2008 :
For: US Patent No. 6,381,575 :

This is a decision on the 2 February 2009, petition for "Request for a Two-Month Extension of Time Pursuant to 37 CFR § 1.550(c)," requesting that the time for responding to the non-final Office action, mailed 18 December 2008 be extended by two (2) months.

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

The petition is Granted-in-Part for the reasons set forth below.

Summary of Relevant Facts

1. On 1 February 2008 a third party requester, requested reexamination of US Patent No. 6,381,575.
2. On 11 April 2009 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.
3. On 18 December 2008 a non-final Office action was mailed to the address of record.
4. On 2 February 2009 a petition was filed requesting two (2) months extension of time for which to respond to the outstanding Office action.

Decision

The Patent Owner requests an extension of time in which to file a response to the non-final Office action mailed 18 December 2008, which set a two-months date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the non-final Office action be extended by two (2) additional months. Since the petitioner has provided "sufficient cause" for granting an extension of time in-part. The petition is timely filed.

The petitioner has provided the petition fee set forth in 37 CFR § 1.17(g).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time for an additional two (2) months for which to submit a response to the non-final Office action mailed on 18 December 2008.

The patent owner has the need to contact an expert witness to determine whether declarations pursuant to 37 CFR § 1.132 will be necessary, a nearly one week delay in receipt of the Office action and the difficulty in responding to four different actions in related proceedings whose responses due at the same time.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

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

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

Conclusion

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Office action dated 18 December 2008 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 will end on **18 March 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
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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.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit



MAILED

FEB 28 2008

Proskauer Rose LLP
One International Place
Boston, MA 02110

CENTRAL REEXAMINATION UNIT

(Patent Owner)

Donna M. Meuth
Wilmer Hale LLP
60 State Street
Boston, MA 02109

(For Third Party Requester)

In re Anthony J. Durkin *et al*
Ex Parte Reexamination Proceeding
Control No.: 90/010,098
Filed: February 1, 2008
For: U.S. Patent No.: 6,743,222: DECISION GRANTING
: THIRD PARTY REQUESTER
: PETITION TO VACATE
: FILING DATE AND TERMINATE
: EX PARTE REEXAMINATION

This is a decision on the February 22, 2008 third party requester petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND/OR 1.183."

The petition and the 90/010,098 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the above petition.

The petition is granted for the reasons set forth below.

FEES

A single petition fee of \$ 400.00 (37 CFR 1.17(f)) has been charged to Deposit Account No. 08-0219 as authorized in the patent owner petition.

REVIEW OF SALIENT FACTS

1. Patent number 6,743,222 (the '222 patent) issued on June 1, 2004.
2. A request for *ex parte* reexamination of the '222 patent was filed on February 1, 2008, and was assigned control No. 90/010,098 (the '10098 *ex parte* reexamination proceeding).
3. A Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements (37 CFR 1.510(c)) was mailed on February 7, 2008.
4. A request to withdraw the February 7, 2008 Notice was filed by third party requester on February 11, 2008.

5. On February 12, 2008, the Office mailed a Decision in which the February 7, 2007 Notice was vacated and the '10098 *ex parte* reexamination proceeding was accorded a filing date of February 1, 2008.
6. Third party requester has now filed the present petition to vacate the February 1, 2008 filing date of the '10098 *ex parte* reexamination proceeding and to terminate the '10098 *ex parte* reexamination proceeding in favor of a new request for *ex parte* reexamination of the '222 patent filed concurrently with the present petition on February 22, 2008.¹

DECISION

I. Relevant Authority

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.510(b) and (d) provide, in pertinent 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.

(d) The filing date of the request for *ex parte* reexamination is the date on which the request satisfies all the requirements of this section.

37 CFR 1.540, second sentence, provides:

No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

MPEP § 2225 provides:

After filing of a request for *ex parte* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 or 37 CFR 1.555, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2282, should be filed with the Office prior to the date of the decision on the

¹ The new request for *ex parte* reexamination of the '222 patent that was deposited on February 22, 2008 is being reviewed for compliance with the requirements of 37 CFR 1.510 and has not yet been accorded a filing date.

request for reexamination. Any papers directed to the merits of the reexamination other than those under 37 CFR 1.501, 1.555 or 1.915, or MPEP § 2282, filed prior to the decision on the request will be returned to the sender by the Central Reexamination Unit or Technology Center Director without consideration. A copy of the letter accompanying the returned papers will be made of record in the patent file. However, no copy of the returned papers will be retained by the Office. If the submission of the returned papers is appropriate later in the proceedings, they will be accepted by the Office at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985, 989 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982) and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981).

II. Background and Relief Requested

A review of the record shows that on February 1, 2008, the third party requester filed a request for *ex parte* reexamination of the '222 patent. The request was initially deemed by the Office have failed to comply with the requirements of 37 CFR 1.510(b) in that the request was deemed to lack a statement pointing out each substantial new question of patentability based on the cited patents and printed publications relied upon in the request and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination was requested. Therefore, the Office did not accord a filing date to the '10098 request for *ex parte* reexamination. However, third party requester traversed the refusal to accord a filing date. The Director of the Central Reexamination Unit held that the traverse was persuasive, reversed the refusal to accord a filing date, and accorded the '10098 *ex parte* reexamination proceeding a filing date of February 1, 2008, (the date upon which the request was originally deposited).

Third party requester has now filed a petition requesting the waiver of such rules that would preclude consideration of the petition prior. Third party requester further requests relief in the form of vacatur of the filing date of the February 1, 2008 filing date for the '10098 *ex parte* reexamination proceeding, and termination of the '10098 *ex parte* reexamination proceeding. The underlying basis of the third party requester's request for relief is that the request for *ex parte* reexamination in the '10098 *ex parte* reexamination proceeding contains, at least at pages 5-8 thereof, inadvertent inaccuracies in the "Statement of New Questions of Patentability." Further, Appendix G, the claim chart in which a substantial new question of patentability (SNQ) is shown, is stated by third party requester to be inaccurate.

III. Analysis and Findings

When a request for *ex parte* reexamination is deposited, and the request does not comply with the all of the requirements of 37 CFR 1.510, the Office will refuse to accord a filing date.² Where a request for *ex parte* reexamination is accorded a filing date, but is thereafter determined to have failed to comply with the requirements of 37 CFR 1.510, the filing date is vacated.³ However, there is no provision in the rules that permits the filing of an "amended request" (or an "amendment" to a request) for *ex parte* reexamination in a proceeding that has been granted a filing date. Further, acceptance of such of such a paper in an *ex parte* reexamination proceeding that has been accorded a filing date would present additional work for the patent owner, the public, and the Office, to determine the extent to which the amendment version of the request differed from the original version. Filing by third party requester of a second request for *ex parte* reexamination of the '222 might well be precluded if the second request

² See: MPEP § 2227

³ *Id.*

relies upon establishment by the same cited prior art of the same SNQs as are relied upon in the present '10098 *ex parte* reexamination proceeding.⁴

Accordingly, although the present petition was filed prior the time in which the rules permit substantive filings in an *ex parte* reexamination proceeding, it is considered that the third party requester has established the existence of an extraordinary situation which justifies consideration of the present petition via a 37 CFR 1.183 waiver of the provisions of 37 CFR 1.540 (and any other rule that might be deemed to preclude the filing of the present petition prior to the mailing of an Order granting or denying *ex parte* reexamination).

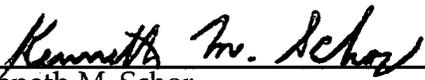
It is also considered that although the rules do not provide for the relief requested by petitioner third party requester of vacating the filing date of the '10098 *ex parte* reexamination proceeding, and then terminating that proceeding, it is appropriate under 37 CFR 1.182 to grant the relief requested by petitioner third party requester. As no decision has been rendered on the request for *ex parte* reexamination in the '10098 *ex parte* reexamination proceeding, it does not appear that the requested vacatur of the filing date for the '10090 *ex parte* reexamination and resulting termination of that proceeding would be prejudicial to the patent owner or to the public. Office resources required to determine whether third party requester has demonstrated (in the concurrently filed new request for *ex parte* reexamination of the '222 patent) the existence of one or more SNQs will be conserved. Further, it is to be noted that by reason of the inaccuracies that are mentioned in Section II., *supra*, the '10098 *ex parte* reexamination proceeding is based on a request for reexamination that arguably fails, to comply with the provisions of 37 CFR 1.510(b), at least in part. Such a request is, technically, not entitled to a filing date.⁵ Therefore, vacatur of the filing date resulting in termination of the proceedings is warranted.

⁴ See: "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending," 1292 OG 20

⁵ See: 37 CFR 1.510(d).

CONCLUSION

1. The third party requester petition that the filing date of the '10098 *ex parte* reexamination be vacated is granted.
2. In light of the statement by third party requester that the request for *ex parte* reexamination contains errors regarding the establishment of one or more substantial new questions of patentability and the manner of applying the cited prior art the '222 patent claims, the '10098 *ex parte* reexamination proceeding is hereby terminated as a result of the vacatur of the filing date.
3. Jurisdiction of the '10098 *ex parte* reexamination proceeding will be returned to the Central Reexamination Unit for appropriate action as required by this decision.
4. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.


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

sm
February 27, 2008

February 27, 2007
C:\kiva\kimpropa\EP\ 90_10098227_1.182/1.183 (3PR Vacate Filing Date-Error in Request) grant.doc



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,101	02/06/2008	5,325,522	5818-00600	4258

35617 7590 07/23/2009

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/23/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010101
PATENT NO. : 5325522
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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Charles D Huston :
DAFFER MCDANIEL LLP : (For Patent Owner)
P.O. BOX 684908 :
AUSTIN TX 78768 :

William J Zychlewicz :
ARMSTRONG TEASDALE LLP (14983) : (For Third Party
PATRICK W. RASCHE : Requester)
ONE METROPOLITAN SQUARE, :
SUITE 2600 :
ST. LOUIS, MO 63102-2740 :

In re: Mitchell D Vaughn : DECISION
Ex Parte Reexamination Proceeding : DISMISSING
Control No. 90/010,101 : PETITION FOR EXTENSION
Deposited: 06 February 2008 : OF TIME
For: US Patent No. 5,325,522 : 37 CFR § 1.550(c) & 1.181

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 13 July 2009, "Request for Reconsideration of Petition for Extension of Time" filed under 37 CFR § 1.550(c) requesting that the time for responding to the Final Office action mailed 08 May 2009, be extended by thirty (30) days. The petition was filed with the required certificate of service and petition fee. The petition was not 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 extended in which to file a response to the Final Office action mailed 08 May 2009, which set a two (2) months date for filing a response thereto. The petition was filed with the required certificate of service and petition fee. The patent owner's petition for extension of time filed on 13 July 2009 is not timely.

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)

ANALYSIS AND FINDINGS

The patent owner's petition to extend the period for response by thirty (30) days is before the director of the CRU. The Final Office action was mailed 08 May 2009. The time for response to the Final Office action was two (2) months for which to respond thereto.

The due date for response thereto was 08 July 2009. The instant petition was submitted on 13 July 2009. The petition was not timely filed. Pursuant to 37 CFR 1.550(c) "Any request for such extension must be filed on or before the day on which action by the patent owner is due..."

The petition request to extend the response time by thirty (30) days is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of thirty (30) days time in which to file a response to the Final Office action dated 08 May 2009 is hereby dismissed
2. The Patent Owner's response was due 08 July 2009.
3. The proceeding is hereby returned to the examiner for further handling.
4. Correspondence to the Office should be addressed as follows:

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

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

By Hand: Customer Service Window
Randolph Building
401 Dulany Street

Alexandria, VA 22314

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



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P.O. Box 1450
Alexandria, VA 22313-1450
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Daffer McDaniel, LLP
P.O. Box 684908
Austin, TX 78768

(For Patent Owner)

William J. Zychlewicz
Armstrong Teasdale LLP
One Metropolitan Square
Suite 2600
St. Louis, MO 63102-2740

(For Third Party Requester)

In re Mitchell D. Vaughn
Ex Parte Reexamination Proceeding
Control No. 90/010,101
Filed: February 6, 2008
For: U.S. Patent No. 5,325,522
Practitioner Docket No.: 5818-00600

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

MAILED
AUG 25 2009
CENTRAL REEXAMINATION UNIT

This is a decision on the July 22, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination, as supplemented on August 20, 2009 ("the supplemented July 22, 2009 patent owner petition to revive").

The appropriate petition fee of \$1,620.00 set forth in 37 CFR 1.17(m) for the supplemented July 22, 2009 patent owner petition to revive has been paid.

The supplemented July 22, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The supplemented July 22, 2009 patent owner petition to revive is **granted**.

The July 24, 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 1.113 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 Supplemented Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal as part of the August 20, 2009 supplement to the July 22, 2009 petition to revive and paid the corresponding fee of \$540.00 on August 20, 2009, thereby satisfying item (1).¹ A petition fee of \$1,620.00 was submitted on July 22, 2009, thereby satisfying item (2). A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the August 20, 2009 supplement to the July 22, 2009 petition to revive, thereby satisfying item (3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.²

Accordingly, the supplemented July 22, 2009 petition to revive is **granted**.

The July 24, 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 supplemented petition to revive under 37 CFR 1.137(b) is **granted**.

¹ See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

² See: 37 CFR 1.137(d)(3).

2. The July 24, 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 further processing in view of the August 20, 2009 Notice of Appeal, and for treatment in due course of the July 22, 2009 response after final Office action and August 20, 2009 Request to Enter Declarations Filed Under 37 C.F.R. § 1.116.
4. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).
5. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Majid 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.



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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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,101	02/06/2008	5,325,522	5818-00600	4258

35617 7590 10/22/2009

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/22/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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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

WILLIAM J. ZYCHLEWICZ
ARMSTRONG TEASDALE, LLP
ONE METROPOLITAN SQUARE, SUITE 2600
ST. LOUIS, MO 63102-2740

Date:

MAILED

OCT 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010101
PATENT NO. : 5325522
ART UNIT : 3992

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

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



Commissioner for Patents
United States Patent and Trademark Office
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Charles D Huston :
DAFFER MCDANIEL LLP : (For Patent Owner)
P.O. BOX 684908 :
AUSTIN TX 78768 :

William J Zychlewicz :
ARMSTRONG TEASDALE LLP (14983) : (For Third Party
PATRICK W. RASCHE : Requester)
ONE METROPOLITAN SQUARE, :
SUITE 2600 :
ST. LOUIS, MO 63102-2740 :

In re: Mitchell D Vaughn : DECISION
Ex Parte Reexamination Proceeding : DISMISSING
Control No. 90/010,101 : PETITION FOR EXTENSION
Deposited: 06 February 2008 : OF TIME
For: US Patent No. 5,325,522 : 37 CFR § 1.550(c) & 1.181

MAILED
OCT 22 2009
CENTRAL REEXAMINATION UNIT

This is a decision on the 19 October 2009, "Petition for Extension of Time" filed under 37 CFR § 1.550(c) requesting that the time for responding to the decision reviving the proceeding dated 25 August 2009, be extended by thirty (30) days. 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 extended in which to file a response to the decision dated 25 August 2009 which set a two (2) month period for response thereto. The petition was filed with the required certificate of service and petition fee.

37 CFR § 1.550 (c) states:

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a

request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action. (emphasis added)

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 petition for extension of time on 19 October 2009. The patent owner sought an extension of time awaiting response to petitions previously filed. The mere filing of a petition will not stay any period for reply that may be running nor act as a stay of proceedings.

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

CONCLUSION

1. The patent owner's petition for extension of time is hereby dismissed.
2. The time to respond continues to run.
3. Response is due on 25 October 2009.
4. Response and/or submissions to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



PANITCH SCHWARZE BELISARIO & NADEL LLP :
ONE COMMERCE SQUARE :
2005 MARKET STREET, SUITE 2200 :
PHILADELPHIA PA 19103 :

(For Patent Owner)

MAILED

NOV 19 2009

CENTRAL REEXAMINATION UNIT

WILLIAM J. ZYCHLEWICZ :
ARMSTRONG TEASDALE LLP :
ONE METROPOLITAN SQUARE, SUITE 2600 :
ST. LOUIS, MO 63102-2740 :

(For Requester)

DAFFER MCDANIEL LLP :
P.O. BOX 684908 :
AUSTIN TX 78768 :

(Courtesy Copy)

In re Vaughn :
Ex Parte Reexamination Proceeding :
Control No. 90/010,101 :
Filed: February 6, 2008 :
For: U.S. Patent No.5,325,522 :

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

This is a decision on the September 11, 2009 patent owner petition entitled "PETITION TO CONTINUE EX PARTE REEXAMINATION PROCEEDING UNDER 37 CFR § 1.182."

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

The petition is **dismissed** as to the continued reexamination that was requested.

The petition is **granted** to the extent that the July 22, 2009 declarations are entered, and a period of **30 days** from the mailing date of this decision is hereby set for patent owner to submit a substitute appeal brief that may rely on the now-admitted declarations, or to ratify the current brief.

BACKGROUND

1. On February 6, 2008, a request for *ex parte* reexamination of claims 1-8, 11-15, 17, and 19-20 of U.S. Patent Number 5,325,522 was filed by the third party requester; the resulting reexamination proceeding was given a filing date of February 26, 2008, corresponding to the date that the filing requirements of 37 CFR 1.510 were met, and assigned control number 90/010,101 ("the '10101 proceeding").
2. On March 28, 2008, an order granting reexamination of claims 1-8, 11-15, 17, and 19-20 of the '522 patent was mailed in the '10101 proceeding.

3. On July 11, 2008, a non-final Office action, in which claims 1-8, 11-15, 17, and 19-20 were rejected, was mailed in the '10101 proceeding.
4. On August 28, 2008, a first interview was held between patent owner and Office personnel, discussing a proposed declaration of prior invention under 37 CFR 1.131.
5. On September 11, 2008, patent owner submitted a timely response to the outstanding Office action, including a declaration of prior invention under 37 CFR 1.131 by the inventor, Mitchell Vaughn, and accompanying exhibits 1-4.
6. On May 8, 2009, a final Office action was mailed, setting a two month period for response, and rejecting claims 1-8, 11-15, 17, and 19-20 and finding the declaration and exhibits insufficient to support a finding of prior invention.
7. On July 22, 2009, patent owner submitted a response to the outstanding final Office action, including declarations by Deborah Blackstone, Ellen Bolton, and Dan Mitchell, and a new declaration by the inventor, Mitchell Vaughn, with accompanying exhibits. However, the submission was untimely, and a petition to revive the proceeding was filed on the same date..
8. The Office issued a Notice of Intent to Issue a Reexamination Certificate on July 24, 2009.
9. On August 20, 2009, patent owner filed a supplemental petition under 37 CFR 1.137(b) with a Notice of appeal.
10. On August 25, 2009, the Office granted the July 22, 2009 patent owner petition under 37 CFR 1.137(b), withdrawing the July 24, 2009 Notice of Intent to Issue a Reexamination Certificate. Jurisdiction over the proceeding was returned to the Central Reexamination Unit for treatment of the July 22, 2009 response after final Office action in due course. As patent owner filed a Notice of appeal on August 20, 2009, the time period for filing an appeal brief was set to expire two months from the mailing date of the August 25, 2009 decision.
11. On September 11, 2009, patent owner filed the instant petition entitled "PETITION TO CONTINUE EX PARTE REEXAMINATION PROCEEDING UNDER 37 CFR § 1.182," requesting that the evidence submission of July 22, 2009 be considered.
12. On October 19, 2009, patent owner filed a petition for extension of time under 37 CFR 1.550(c) to extend the time for filing the appeal brief for 30 days.
13. On October 20, 2009, the Office issued an advisory action denying entry of the evidence submission of July 22, 2009.

14. On October 22, 2009, the Office dismissed the October 19, 2009, patent owner petition for extension of time under 37 CFR 1.550(c) to extend the time for filing the appeal brief.
15. On October 26, 2009, patent owner filed an appeal brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.116(e) provides, in pertinent part:

An affidavit or other evidence submitted after a final rejection or other final action . . . in an ex parte reexamination filed under § 1.510, . . . but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.182 provides:

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

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

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

37 CFR 1.525(a) provides, in pertinent part:

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

DECISION

The Requested Relief of Continued Reexamination is Unavailable

The September 11, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of an evidence submission not yet considered by the Office. Patent owner based the instant petition upon an Office Notice issued in March of 2005, titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

At the time of the September 11, 2009 filing of the instant petition, the July 22, 2009 submission was currently under review by Office personnel, and had not been denied entry after a final rejection in the proceeding. Where an evidence submission has not been denied entry after a final rejection in a proceeding, a petition based upon the procedure set forth in the March, 2005 Notice is inappropriate.² Therefore the instant petition for continuation of the reexamination proceeding could not have been granted upon the facts present at the time of the filing of the petition.

Even if the instant petition had been submitted following the examiner's October 20, 2009 refusal to enter the July 22, 2009 evidence, the petition did not allege facts sufficient to permit the petition to be granted. There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 CFR 1.182 can provide continued-reexamination relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the statutory requirement for special dispatch in reexamination. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the

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

² Patent owner's request for extension of time of October 19, 2009, acknowledged that the 1.182 petition could not be decided until a decision was rendered by the Examiner. See page 2 of the request.

§ 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition, since these are key factors in reducing pendency of a reexamination proceeding. In the instant petition, patent owner alleged that the evidence submission of July 22, 2009 provided “evidence related to the events concerning FactoryLink development and commercialization in the 1985-1986 time frame.” However, patent owner did not state how the evidence submission addressed the examiner’s rejection such that the prosecution of the reexamination would be furthered, rather than delayed, in accordance with the mandate of special dispatch. Therefore, for this reason also, the petition may not be granted upon the facts present in the petition as filed.

Finally, the continued-reexamination relief requested would retard the progress of reexamination contrary to the statutory requirement for special dispatch in reexamination, as opposed to the relief as immediately-below-granted, which will further the requirement for special dispatch.

2. Patent Owner’s Declarations Are Entered

Although patent owner’s submission is inadequate to satisfy the requirements for continued reexamination, an equitable manner of relief may be provided in this instance.

Patent owner’s evidentiary submissions were submitted after final rejection but before appeal, and therefore 37 CFR 1.116(e) sets forth the requirements for their entry. As patent owner has not requested waiver of this regulation, the evidentiary submissions must satisfy 37 CFR 1.116(e), which requires that there be good and sufficient reasons why the evidence is necessary and was not earlier presented.

Applicant’s petition addresses both requirements. With regard to why the submission was not earlier presented, applicant states that the patent owner believed, as a result of the interview conducted on August 28, 2009 between patent owner and the Office, that the September 11, 2008, declaration of prior invention under 37 CFR 1.131 by the inventor, Mitchell Vaughn, and accompanying evidence “would be sufficient to swear behind the cited reference.” The declaration and evidence were held to be deficient in meeting the required burden of proof in the final Office action of May 8, 2009. The July 22, 2009 after-final submission was submitted in response to the deficiencies in the declaration of prior invention that were first noted in the final Office action of May 8, 2009. In view of the particular fact situation in this proceeding, patent owner’s statements, as presented in the petition, are considered to be a showing of good and sufficient reasons why the evidence was not earlier presented.

With regard to why the evidence is necessary, patent owner’s petition alleges that the July 22, 2009 evidence submission provides “evidence related to the events concerning FactoryLink development and commercialization in the 1985-1986 time frame.” Patent owner’s petition further alleges that the submission places the case in condition for the issuance of a reexamination certificate. While neither of these allegations, by themselves, satisfactorily address the question of whether the submission is “necessary”, the Office may look to the entirety of the record to make such a determination. The reference that patent owner seeks to remove from prior art through the evidence submissions is relied upon in every rejection applied by the Office to the claims. If a successful showing of prior invention is made, it would thus

result in the withdrawal of all of the rejections of record. The submissions are directed to addressing the deficiencies raised by the examiner in the final Office action. Such submissions are neither patents nor printed publications, and could not be the source of a future reexamination proceeding of the same patent. Thus, the submissions are deemed to be of sufficient need, based upon the aforementioned fact situation particular to this proceeding, to complete the appeal to the Board of Patent Appeals and Interferences.

Since there are good and sufficient reasons why the July 22, 2009 declarations are necessary and were not earlier presented, patent owner's petition is **granted** to the extent that the July 22, 2009 declarations are entered. It is also observed that entry of the affidavits as a consequence of this decision has been authorized by SPE Eric Keasel of the Central Reexamination Unit. In order to satisfy the statutory requirement of special dispatch, a period of **30 days** from the mailing date of this decision is hereby set for patent owner to submit a new (substitute) appeal brief that may rely on the now-admitted declarations, or to ratify the current brief.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. The patent owner addresses is not the same as that in the reexamination proceeding. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 CFR 1.33(c), and it is that of Panitch Schwarze Belisario & Nadel LLP, One Commerce Square, 2005 Market Street, Suite 2200. Accordingly, all future correspondence will be directed to Panitch Schwarze Belisario & Nadel LLP, One Commerce Square, 2005 Market Street, Suite 2200, unless, within **ONE (1) MONTH** of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123. As a courtesy, a copy of this decision is being mailed to the address of record in the reexamination file, Daffer McDaniel LLP, P.O. Box 684908, Austin TX 78768.

CONCLUSION

- The petition is **dismissed**.
- Patent owner's petition is **granted** to the extent that the July 22, 2009 declarations are entered.
- A period of **30 days** from the mailing date of this decision is hereby set for patent owner to submit a substitute appeal brief that may rely on the now-admitted declarations, or to ratify the current brief.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further proceedings.

- 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

November 17, 2009
C:\Kiva\Kenpet7\RCR\
C:\Kiva\KenAffidavit\



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.
90/010,105	02/27/2008	5976645	119168-5001	1922

50787 7590 08/14/2008

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/14/2008

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



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)

Chris P. Perque

Gardere Wynne Sewell LLP

1000 Louisiana St., Suite 3400

Houston, TX 77002-5011

MAILED
AUG 14 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,105.

PATENT NO. 5976645.

ART UNIT 3991.

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

DDJ

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

(for Patent Owner)

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

(for Third Party Requester)

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

MAILED

AUG 14 2008

CENTRAL REEXAMINATION UNIT

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

(for Third Party Requester)

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 5,976,645, issued November 2, 1999, is the subject of Reexamination Control Nos. 90/008,339 and 90/010,105.
2. A first request for reexamination, assigned Reexamination Control No. 90/008,339, was filed January 8, 2007 by Jody L. Factor of Factor & Lake in Chicago, IL. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed synthetic turf and process of forming a synthetic turf on a sub-surface base or are so close as to establish a case of obviousness.
3. Reexamination was ordered for 90/008,339 on February 16, 2007.

4. A first non-final Office action was issued on April 18, 2007.
6. Patent Owner filed a response on June 21, 2007.
7. A subsequent request for re-examination, assigned Reexamination Control No. 90/010,105, was filed February 27, 2008 by Chris P. Perque of Gardere, Wynne, Sewell LLP in Houston TX. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed synthetic turf and process of forming a synthetic turf on a sub-surface base or are so close as to establish a case of obviousness.
8. Reexamination was ordered for 90/010,105 on April 23, 2008.
9. No Patent Owner statement has been submitted and no Office action has been issued in the later reexamination.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,339 and 90/010,105 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,339 and 90/010,105 as:

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

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

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

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

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

CONCLUSION

Reexamination Control Nos. 90/008,339 and 90/010,105 are merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to submit a "housekeeping amendment" placing the same claims in both files and to name but a single representative.** Upon receipt of the response, as Office action will issue in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

for 
Gregory Morse, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,110	02/15/2008	6101687	21257/0208447-USO	4503

7590 03/24/2008

GERALD LEVY ESQ
KANE DALSIMER SULLIVAN KURUCZ LEVY EISELE AND RICH
711 THIRD AVENUE
NEW YORK, NY 10017-4059

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/24/2008

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



Gerald Levy, Esq.
Kane Dalsimer Sullivan Kurucz
Levy Eisele & Rich
711 Third Avenue
New York, NY 10017-4059

(For Patent Owner)

Darby & Darby P.C.
P.O. Box 770
Church Street Station
New York, NY 10008-0770

(Third Party Requester)

In re Safe-Strap Company, Inc.
Ex Parte Reexamination Proceeding
Control No.: 90/010,110
Filed: February 15, 2008
For: U.S. Patent No.: 6,101,687

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

This is a decision on the February 15, 2008 third party requester petition entitled "PETITION UNDER 37 CFR 1.182." The petition has been submitted pursuant to 37 CFR 1.181, 1.182, 1.183, 35 U.S.C. § 305 and MPEP § 2261.

The petition and the 90/010,110 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the petition.

The petition is dismissed for the reasons set forth below.

FEES

Although relief is requested under both 37 CFR 1.182 and 1.183, only a single \$400.00 petition fee (37 CFR 1.17(f)) is required. However, Office financial records show that the required petition fee of \$ 400.00 (37 CFR 1.17(f)) was both submitted by credit card and also charged to Deposit Account No. 04-0100 on the same date. Accordingly, a refund of \$400.00 will be made to Deposit Account No. 04-0100.

REVIEW OF SALIENT FACTS

1. Patent number 6,101,687 ("the '687 patent") issued on August 15, 2000.
2. The present request for *ex parte* reexamination of the '687 patent was filed on February 15, 2008, and was assigned control No. 90/010,110 ("the '0110 *ex parte* reexamination proceeding").

3. The present third party requester petition was filed concurrently with the request for *ex parte* reexamination of the '687 patent.
4. The '687 patent is currently the subject of litigation, in which the third party requester is a named defendant.

DECISION

I. Relevant Authority

35 U.S.C. § 303(a) provides, in part:

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

35 U.S.C. § 305 provides, in part:

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

35 U.S.C. § 312(a) provides, in part:

REEXAMINATION - Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C. § 314(c) provides:

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.

37 CFR 1.182 provides:

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

37 CFR 1.182 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 1.540 provides, in part:

No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte*

reexamination requester pursuant to § 1.535 will be considered prior to examination.

MPEP § 2241 provides:

The determination of whether or not to reexamine must be made within 3 months following the filing date of a request. See 35 U.S.C. 303(a) and 37 CFR 1.515(a). If the 3-month period ends on a Saturday, Sunday, or Federal holiday within the District of Columbia, then the determination must be mailed by the preceding business day. The examiner should take up a request for decision about 6 weeks after the request was filed. The decision should be mailed within 10 weeks of the filing date of the request.

When reexamination for the same patent has already been ordered based on an earlier request and that reexamination is pending, the examiner should immediately take up the new request for decision, i.e., there should be no delay of 6 weeks. See the last portion of MPEP § 2240 and also see MPEP § 2283 for multiple copending reexamination proceedings. A determination to reexamine may be made at any time during the period of enforceability of a patent.

MPEP § 2261 provides:

In view of the requirement for "special dispatch," reexamination proceedings will be "special" throughout their pendency in the Office. The examiner's first action on the merits should be completed *within 1 month* of the filing date of the requester's reply (37 CFR 1.535), or *within 1 month* of the filing date of the patent owner's statement (37 CFR 1.530) if there is no requester other than the patent owner. If no submissions are made under either 37 CFR 1.530 or 37 CFR 1.535, the first action on the merits should be completed *within 1 month* of any due date for such submission. Mailing of the first action should occur within 6 WEEKS after the appropriate filing or due date of any statement and any reply thereto.

Any cases involved in litigation, whether they are reexamination proceedings or reissue applications, will have priority over all other cases. Reexamination proceedings not involved in litigation will have priority over all other cases except reexaminations or reissues involved in litigation.

MPEP § 2286(I) provides, in part:

Any request *for ex parte* reexamination which indicates (A) that it is filed as a result of an agreement by parties to litigation which agreement is sanctioned by a court, or (B) that litigation is stayed for the filing of a reexamination request will be taken up by the examiner for decision 6 weeks after the request was filed. See MPEP § 2241. If reexamination is ordered, the examination following the statement by the patent owner under 37 CFR 1.530 and the reply by the requester under 37 CFR 1.535 will be expedited to the extent possible. Office actions in these reexamination proceedings will normally set a 1-month shortened statutory period for response rather than the 2 months usually set in reexamination proceedings. See MPEP § 2263. This 1-month period may be extended only upon a showing of sufficient cause. [Citations omitted.]

In addition, if (A) there is litigation concurrent with an *ex parte* reexamination proceeding and (B) the reexamination proceeding has been pending for more than one year, the Director or Deputy Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. A statement at the end of the Office action - "One month or thirty days, whichever is longer, shortened statutory period approved," followed by the signature of one of these officials, will designate such approval. It is to be noted that the statutory requirement for "special dispatch" in reexamination often becomes important, and sometimes critical, in coordinating the concurrent litigation and reexamination proceedings.

II. Background and Relief Requested

A review of the record reveals that the '687 patent is the subject of the present *ex parte* reexamination proceeding. An order granting or denying *ex parte* reexamination has not been promulgated. In accordance with 35 U.S.C. § 303(a), such order must be mailed prior to May 15, 2008. The record also provides that the '687 patent is the subject of litigation in the District Court, Eastern District of Texas and that the litigation is in a preliminary stage.

Third party requester asserts that the litigation involving the '687 patent is unlikely to be stayed because the litigation is before a judge who has a record of denying motions to stay patent litigation in which there are copending reexamination proceedings before the Office for a patent that is the subject of such litigation, thereby creating a risk of conflicting outcomes. Third party requester notes that one purpose of reexamination is to reduce litigation in the district courts, and that third party requester is in a position of financial risk, because, if the court were to uphold the validity of the '687 patent claims, third party requester would be subject to a damage award even if the Office later determines in the present '0110 *ex parte* reexamination proceeding that the claims are unpatentable.

Based on the above, petitioner requests relief in the form of putting the present request at "the top of the short list for handling before all requests."

III. Analysis and Findings

Initially, it is to be noted that the filing of the present petition is precluded by the provisions of 37 CFR 1.540. However, the Office will consider the present petition pursuant to 37 CFR 1.183 to decide whether a suspension or waiver of a regulation of Part 1 of Title 37 of the Code of Federal Regulations in extraordinary circumstances where justice requires is warranted here, and whether the requested relief under 37 CFR 1.182, not specifically provided by the regulations, should be granted.

The Office is required by the reexamination statute to mail an Order either granting or denying a request for reexamination within three months of the filing of the request for reexamination. This is true for both *inter partes* and *ex parte* reexamination requests. The Office considers such requests in the order in which they have been filed. Current statistics (through December 31, 2007) show that 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests filed involved patents that were also subject to litigation. Therefore, it does not appear that the existence of concurrent litigation involving a patent for which reexamination has been requested presents an extraordinary situation. It is also apparent that where a patent is the subject of concurrent litigation and *ex parte* reexamination, there is always a risk of different outcome. It is speculative that a successful outcome in the Office will necessarily result in a similar outcome in court. * Further, the question of staying litigation where the involved patent is also in reexamination may well be viewed differently by the parties involved.

In view of such considerations, it cannot be said that the facts and arguments presented by the third party in the present petition demonstrate that it is necessarily in the interests of justice to take the present reexamination request out of turn, merely because the involved patent is also in

* The Office determines patentability only upon the basis of prior patents and printed publications, while validity litigation is based upon many additional considerations. Even as to prior patents and printed publications, a patent owner can amend in reexamination, while there is no amendment in a court proceeding.

the litigation. This is especially true on the present facts, which involve nothing more than speculation based on prior holdings by a particular district court judge as to whether that judge will suspend litigation involving the '687 patent.

Accordingly, it is not seen that petitioner third party requester has demonstrated that waiver of 37 CFR 1.540 to permit consideration of the merits of the present petition is appropriate on the present record.

ADDITIONAL DISCUSSION

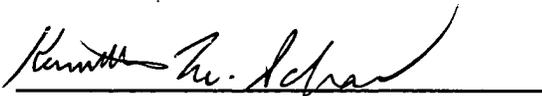
It is to be noted that Office is required by the reexamination statute to promulgate a decision on a request for reexamination (whether *ex parte* or *inter partes* reexamination) within three months from the filing of the request. Thus, even assuming a special circumstance would arise that would justify waiving the rules to take up a given request out of turn, nevertheless, the statute requires equally that all decisions on requests for reexamination be issued within three months from the filing of the request. Note that, if litigation were the sole criteria for taking reexamination proceedings out of turn, the Office would need to take 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests out of turn to accommodate reexamination requester based solely upon the existence of copending litigation, and the Office could not meet its 3-month statutory mandate as to the "non-litigation" reexamination requests. Instead, the Office must allocate all of its reexamination resources to insure that every request for *ex parte* reexamination that is filed will be addressed by the Office within the deadline set by Congress. Thus, the Office provides only the very limited exceptions provided by MPEP §§ 2241, second paragraph and 2286(I), first paragraph.

It is also to be noted that the Office is required by the reexamination statute to conduct all reexamination proceedings with special dispatch. If the Office took all 26% of the *ex parte* reexamination proceeding having concurrent litigation, and all 52% of the *inter partes* reexamination requests having concurrent litigation out of turn, and before the "non-litigation" reexamination proceedings, it would be impossible to comply with the statutory mandate to conduct the "non-litigation" reexamination proceedings with special dispatch. The Office will accordingly not take a reexamination proceeding out of turn based solely on concurrent litigation. Rather, the Office provides post-Order procedures whereby specific types of *ex parte* reexamination proceedings having concurrent litigation are treated as "special" reexamination proceedings in accordance with MPEP §§ 2261 and 2286(I), second paragraph, because such procedures are designed to further the treatment of such reexamination proceedings with "special dispatch," and are rare occurrences. Note that such procedures are not based upon speculation, since the conditions precedent are fixed and certain in those MPEP sections. Further, pursuant to the Congressional mandate of "special dispatch" in reexamination proceedings, once a request for reexamination involving a patent that is also in litigation is granted, the Office provides mechanisms that are intended to conclude a "concurrent-litigation" reexamination within a time period that is typically far shorter than patent litigation, while still treating non-concurrent-litigation reexaminations with special dispatch. If a requester seasonably files a reexamination request at the beginning of litigation proceedings, it is generally expected that the reexamination proceeding will be resolved prior to litigation proceedings, even though not taken out of turn. Current statistics (through December 31, 2007) show an average pendency of 24.0 months, and a median pendency of 18.6 months for *ex parte* reexamination proceedings, which is shorter than a typical litigation proceeding. To the extent that the present third party petition expresses concerns about future potential conflicting outcomes in the '0110 *ex parte* reexamination proceeding and the concurrent litigation, such

concerns may be addressed during the patentability determination portion of an *ex parte* reexamination proceeding if they arise, and certainly are not to be addressed during the portion of the proceeding in which the Office must determine whether the request presents a substantial new question of patentability such that the Office may assume jurisdiction to review the patentability of the claims of a patent for which reexamination is requested.

CONCLUSION

1. The third party requester petition requesting that the Office consider the request for reexamination in the '0110 *ex parte* reexamination proceeding ahead of all other pending requests does not present a basis for waiving the provisions of 37 CFR 1.540 and is, therefore, dismissed.
2. Jurisdiction of the '0110 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit for action as may be, or become, appropriate.
3. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.



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

sm
March 17, 2008



UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUN 09 2010

CENTRAL REEXAMINATION UNIT

JERRY M. PRESSON : (For Patent Owner)
HUBBELL INCORPORATED :
584 DERBY MILFORD RD. :
P.O. BOX 549 :
ORANGE CT 06477-4024 :

MICHAEL BLAINE BROOKS, P.C. : (For Third Party Requester)
P.O. BOX 1630 :
SIMI VALLEY, CA 93062-1630 :

In re: Krzysztof W Korcz : DECISION
Ex Parte Reexamination Proceeding : DISMISSING-AS-MOOT
Control No. 90/010,111 : PETITION FOR EXTENSION
Deposited on: 25 February 2008 : OF TIME
For: US Patent No. 7,301,099 B1 : [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 04 June 2010 patent owner submitted petition entitled, "Petition for Extension of Time Under 37 CFR § 1.550(c)," requesting the response period for response be extended. The petition submitted 04 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 dismissed-as-moot for the reasons set forth below.

DECISION

The Patent Owner's representative requests the period for response be extended for response to the Final Office action dated 05 March 2010. The petition for extension of time was timely filed on 04 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 provided with the petition.

The patent owner submitted a timely reply to the Office action in the form of the Notice of Appeal on 07 June 2010. The submission of a timely response renders the petition for an extension of time as moot.

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

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. 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 an unspecified amount of time 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 submitted a timely reply to the Office action in the form of the Notice of Appeal on 07 June 2010. The submission of a timely response renders the petition for an extension of time as moot.

The petition 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 Office action dated 05 March 2009 is hereby dismissed-as-moot.
2. The patent owner responded to the office action with a Notice of Appeal on 07 June 2010.
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



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Proskauer Rose LLP
One International Place
Boston, MA 02110

Patent Owner

MAILED

NOV 13 2009

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109

For 3rd Party Requester
(both Requests)

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/010,112
Filed: February 22, 2008
For: U.S. Patent No. 6,743,222

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,567
Filed: July 10, 2009
For: U.S. Patent No. 6,743,222

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. 90/010,112 was ordered in a decision mailed March 17, 2008. The decision granted reexamination for original patent claims 1-30, all of the claims in US Patent No. 6,743,222. On May 16, 2008, patent owner filed a letter waiving his rights to file a Patent Owner Statement under 37 CFR 1.530. On September 4, 2008, a non-final Office action was mailed rejecting claims 1-30, all of the claims. On November 4, 2008, patent owner filed a response to the Office action. The response amended claims 1 and 18, cancelled claim 26, and added new claims 31-45. In addition, on March 20, 2009, patent owner also filed a supplemental amendment, which

amendment includes amended claims 1 and 18, maintains the cancellation of claim 26, and includes new claims 31-45. No Office action has been rendered since the receipt of patent owner's supplemental amendment.

Reexamination in application Control No. 90/010,567 was ordered in a decision mailed August 14, 2009. The decision indicating that claims 1-30, all of the claims in US Patent No. 6,743,222 would be reexamined. On October 14, 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. 90/010,112 and reexamination control No. 90/010,567 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, original claims 1 and 18 have been amended, original claim 26 cancelled, and claims 31-45 added to reexamination control No. 90/010,112 by virtue of the November 4, 2008 and March 20, 2009 amendments. No amendment has been filed in reexamination control No. 90/010,567. 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. Currently all of the pending claims, namely claims 1-25 and 27-45 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 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 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 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. 90/010,112 and 90/010,567 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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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Docket Clerk
P.O. Drawer 800889
Dallas, TX 75380

(For Patent Owner)

MAILED

MAY 13 2009

Paul Morico
Baker Botts L.L.P.
910 Louisiana
Houston, TX 77002

(For 3rd Party Requester) **CENTRAL REEXAMINATION UNIT**
(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



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
AUG 22 2008

CENTRAL REEXAMINATION UNIT

MARK A LAUER : (For Patent Owner)
6601 KOLL CENTER PARKWAY :
SUITE 245 :
PLEASANTON CA 94566 :

ORRICK, HERRINGTON & SUTCLIFFE, LLP : (For Third Party
IP PROSECUTION DEPARTMENT : Requester)
4 PARK PLAZA :
SUITE 1600 :
IRVINE, CA 92614-2558 :

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

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

In re: Freeman :
Ex Parte Reexamination Proceeding :
Control No. 90/008,163 :
Deposited: 14 August 2006 :
For: US Patent No. 4,670,749 :

In re: Freeman :
Ex Parte Reexamination Proceeding :
Control No. 90/010,118 :
Deposited: 7 March 2008 :
For: US Patent No. 4,670,749 :

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

BACKGROUND

1. Patent No. 4,670,749 issued on 2 June 1987.
2. *Ex Parte* Reexamination Proceeding, control no. 90/008,163 was requested by a third party requester on 14 August 2006.
3. The Reexamination Order was granted in proceeding, control no. 90/008,163 on 10 October 2006.
4. There are currently no amendments proceeding control number 90/008,131.
5. *Ex Parte* Reexamination Proceeding, control no. 90/010,118 was requested by a third party requester filed on 7 March 2008.
6. The Reexamination Order was granted in proceeding, control no. 90/010,118 on 14 April 2008.
7. There are currently no amendments proceeding control number 90/010,118.
8. Proceedings control numbers 90/008,163 and 90/010,118 await action from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,163 and 90/010,118 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,163 and 90/010,118 are hereby MERGED.
2. The reexamination files are being forwarded to the examiner for further action.
3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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


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

Gregory Morse,
Director,
Central Reexamination Unit



Wood, Phillips, Katz, Clark & Mortimer
500 W. Madison Street
Suite 3800
Chicago, IL 60661

(For Patent Owner)

MAILED

JAN 22 2009

Walter J. Steinkrauss
Vidas, Arrett & Steinkraus
6640 Shady Oak Road
Suite 400
Eden Prairie, MN 55344

(For 3rd Party Requester)

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,119
Filed : March 10, 2008
For U.S. Patent No. : 4,739,672

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,287
Filed : September 19, 2008
For U.S. Patent No. : 4,739,672

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. 90/010,119 was ordered in a decision mailed May 27, 2008 indicating that claims 44-59 would be reexamined. A non-final Office action rejecting claims 44-59 was mailed October 15, 2008. A response was filed November 14, 2008. An interview was held November 14, 2008 and patent owner filed statements regarding the interview on December 4, 2008 and December 29, 2008. An Information Disclosure Statement was filed December 4, 2008 as well. There are no amendments to the claims, specification or drawings in this reexamination proceeding. No further Office action has taken place in this reexamination proceeding since the issuance of the non-final action mailed October 15, 2008.

Reexamination in application control No. 90/010,287 was ordered in a decision mailed November 17, 2008 indicating that claims 1-12, 14-23, and 25-29, all of the remaining live

claims in the patent would be reexamined¹. Patent owner filed a Waiver to Right to File Patent Owner Statement on November 25, 2008. No Office action has been issued and there are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,119 and reexamination control No. 90/010,287 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 the patent has expired, no amendments to the claims, drawings, or specifications can be made. See 37 CFR 1.530(j).

Conduct of Proceedings

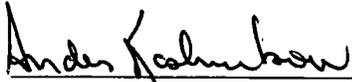
The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-12, 14-23, and 25-59, all of the remaining live claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both 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. 90/010,119 and 90/010,287 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.

¹ Claims 13 and 24 have been cancelled per Reexamination Certificate No. 3,650 issued October 27, 1998.



Gregory Morse, Director
Central Reexamination Unit





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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,123	03/13/2008	4916635	326058US	4222
22850	7590	07/02/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2008

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

CHRISTOPHER L. MCKEE

BANNER & WITCOFF, LTD

1100 13TH STREET, NW SUITE 1200

WASHINGTON, DC 20005-4051

MAILED

MAR 02 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,123.

PATENT NO. 4916635.

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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Charles L. Gholz
Oblon Spivak McClelland Maier & Neustadt
1940 Duke St.
Alexandria, VA 22314

(For Patent Owner) CENTRAL REEXAMINATION UNIT

Christopher McKee
Banner & Witcoff, LTD.
1100 13th Street N.W., Suite 1200
Washington, D.C. 20005-4051

(For Third Party Requester)

In re Singer
Reexamination Proceeding
Control No. 90/010,123
Filed: March 13, 2008
For: U.S. Patent No. 4,916,635

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**DECISION
ON PETITION
UNDER 37 CFR 1.182**

This is a decision on the May 21, 2008, patent owner petition entitled "PETITION UNDER 37 CFR 1.182 TO VACATE THE ORDER GRANTING THE THIRD REEXAMINATION."
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. United States Patent No. 4,916,635 to Singer et al. (the '635 patent) was filed for on September 12, 1988, and issued on April 10, 1990 ("Singer et al. '635").
2. On March 7, 2007, a first request for reexamination of Singer et al. '635 patent was filed, and it was assigned control No. 90/008,525 (the '8525 proceeding).
3. On April 13, 2007, the Office issued a first decision granting reexamination of the '635 patent, in the '8525 proceeding.
4. On March 28, 2007, a second request for Reexamination of Singer et al. '635 patent, was filed, and it was assigned control No. 90/008,561 (the '8561 proceeding).
5. On May 24, 2007, the Office issued a second decision granting reexamination of the '635 patent, in the '8561 proceeding.
6. The '8525 and '8561 reexamination proceedings were merged into a single proceeding on October 30, 2007.
7. The merged reexamination proceeding is currently pending.
8. On March 13, 2008, a request for reexamination, assigned control No. 90/010,123 (the '10,123 proceeding), was filed.
9. On April 9, 2008, the Office issued a third decision granting reexamination of the '635 patent, in the '10,123 proceeding.
10. On May 21, 2008, the patent owner filed the present petition to vacate the order granting the third reexamination.
11. On May 29, 2008, third party requester filed the present paper opposing the May 21, 2008 patent owner petition.
12. On June 18, 2008, patent owner filed a paper opposing the June 11, 2008 third party requester paper, which is being addressed by a separate decision.

DECISION

As to *ex parte* reexamination, MPEP 2240, II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION states in-part:

“The second or subsequent request for reexamination may raise a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the first (or prior) pending reexamination proceeding. The substantial new question may be directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package.”

“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... If the second or subsequent requester does not include the prior art which raised a substantial new question of patentability in the pending reexamination, reexamination may or may not be ordered depending on whether the different prior art raises a substantial new question of patentability. The second or subsequent request should be determined on its own merits without reference to the pending reexamination.”

The Federal Circuit in *Paltex Corp. v. Mossinghoff*, 771 F. 2d 483 (Fed. Cir. 1985), 226 USPQ 985, explained that a patent owner is protected from harassment through the filing of multiple requests for *ex parte* reexamination of the same patent by the statutory requirement and that a substantial new question of patentability must be established in any request for *ex parte* reexamination proceedings, before *ex parte* reexamination will be ordered. *See Paltex*, 771 F.2d at 486, 226 USPQ at 987.

Where a legitimate substantial new question as to the patent claims is presented, this cannot be characterized as harassment, other than in the highly unusual instance where it can be shown that the requester willfully delayed in presenting the substantial new question for purposes of delaying the ongoing reexamination prosecution.

In the instant case, reexamination was granted, meaning that the present request cannot be viewed as frivolous and for the purpose of harassment, but rather, as raising legitimate concerns as to a patent, to be resolved via a reexamination of the patent. While the petition does discuss the lengthy prior activity in the prior reexamination proceedings for the patent, etc., the petition does not provide evidence to make it “clear that the second or subsequent request was filed for purposes of harassment of the patent owner.” (Quote from MPEP 2240, *supra*) There is no evidence provided to establish that the requester purposefully delayed

presentation of materials/arguments, rather than an inadvertent omission of claim 7 from the previous reexamination requests.

MPEP 2240 requires that it must appear “clear” that the second or subsequent request was filed “for purposes of” harassment of the patent owner. Such has not been shown to be the case in the instant situation.

The purpose of reexamination is to permit the Office to reexamine the patent on the basis of prior art which was not considered during the initial examination of the patent. There is a strong public interest that all of the prior art be considered. In this regard, *In re Etter*, 225 USPQ 1 (Fed. Cir. 1985), when discussing whether the § 282 presumption of validity has application in reexamination proceedings, stated “[r]eexamination is thus neutral, the patentee and the public having an equal interest in the issuance and maintenance of valid patents.” Since the additional prior art in the fourth reexamination request has been found to raise a substantial new question of patentability and reexamination is ordered, the public should have the benefit of having the additional prior art considered by the examiner.”

Section 302 of Title 35 provides “(a)ny 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 the statute.” The Office has adopted the position that this language is permissive and multiple reexamination requests by the same party are not precluded by the statute, as long as each adds a substantial new question of patentability to be resolved.

The statute further provides that reexamination should be ordered if the prior art raises a “substantial new question of patentability.” The meaning and scope “a substantial new question of patentability” is not defined in the statute and must be developed on a case-by-case basis. Under normal circumstances prior patents and printed publications would raise a substantial new question of patentability where there is substantial likelihood that a reasonable examiner would consider the prior art important in deciding whether or not the claim is patentable. It is not necessary that a *prima facie* case of unpatentability exist as to the claims for a substantial new question of patentability to be present.

Seagate has filed three requests for reexamination of the ‘635 patent. Patent owner alleges that the filing of the third reexamination request constitutes harassment and delay based on the fact that Seagate has been on notice since May 02, 2002 that the Patent Owner is asserting claim 7 in the related district court infringement action, and on notice since May 24, 2007 that claim 7 was not being re-examined by the office, and only now requests that claim 7 be reexamined.

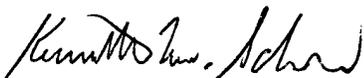
In the instant case, the central reexamination unit found that a substantial new question of patentability affecting claim 7 is raised by the present request for *ex parte* reexamination. The examiner considers a substantial new question of patentability has been raised by at least the Tallman reference and the Vali references, both of which were not before the Examiner at the time of allowance. In accordance with Section 302 of Title 35, “(a)ny 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 the statute.” And, as pointed out, the Office position is that this language is permissive and multiple reexamination requests by the same

party are not precluded by the statute, as long as each adds a substantial new question of patentability to be resolved.

In view of the above, the present petition to vacate is dismissed.

CONCLUSION

1. The petition is dismissed as to the request to vacate the order granting the present reexamination.
2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).
3. Telephone inquiries related to this decision should be directed to Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.



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

July 1, 2008

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CENTRAL REEXAMINATION UNIT

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110

(For Patent Owner)

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

(For Third Party Requester)

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

(Courtesy Copy)

In re Singer et alia
Reexamination Proceeding
Control No. 90/008,525
Request Deposited: March 7, 2007
For: U.S. Patent No. 4,916,635

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Singer et alia
Reexamination Proceeding
Control No. 90/008,561
Request Deposited: March 28, 2007
For: U.S. Patent No. 4,916,635

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In re Singer et alia
Reexamination Proceeding
Control No. 90/010,123
Request Deposited: March 13, 2008
For: U.S. Patent No. 4,916,635

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 4,916,635 (hereinafter, the '635 patent), issued to Singer *et alia*, on April 10, 1990.
2. On March 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,525 (hereinafter, the '8525 proceeding).
3. The Reexamination Order was granted in the '8525 proceeding on April 13, 2007.
4. On March 28, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,561 (hereinafter, the '8561 proceeding).
5. The Reexamination Order was granted in the '8561 proceeding on May 24, 2007.
6. The '8525 and the '8561 proceedings were merged on October 30, 2007.
7. An amendment adding new dependent claims 28 and 29 was filed on January 22, 2008.
8. On March 13, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/010,123 (hereinafter, the '10123 proceeding).
9. The Reexamination Order was granted in the '10123 proceeding on April 9, 2008.
10. The '635 patent expired on September 12, 2008.

DECISION

37 CFR 1.530(j) states:

No enlargement of claim scope. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

Art Unit: 3992

MPEP 2250 (III) states, in part:

Pursuant to 37 CFR 1.530(j), “[n]o amendment may be proposed for entry in an expired patent.” Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.

37 CFR 1.530(j) further states that “[m]oreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.”

The cancellation of the original patent claims is the only “amendatory” change permitted in an expired patent.

The ‘635 patent expired on September 12, 2008 before the reexamination certificate issued. Since no amendments will be incorporated into the patent by a certificate after the expiration of the patent (other than cancellation of original patent claims), the amendment filed January 22, 2008 is withdrawn. All subsequent reexamination will be on the basis of the unamended patent claims.

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the ‘8525, ‘8561, and ‘10123 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Art Unit: 3992

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. All subsequent reexamination will be on the basis of the unamended patent claims.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,525, 90/008,561, and 90/010,123 are merged.
2. All correspondence regarding these proceedings should be submitted as follows:

By Mail: Mail Stop *Ex Parte* Reexam"
 Attn: Central Reexamination Unit
 Commissioner for Patents
 P. O. Box 1450
 Alexandria VA 22313-1450

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

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



Gregory Morse
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,125	03/14/2008	5857201	325723US91RX	6320

22850 7590 10/16/2009

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/16/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Ave., 53rd Floor
Houston, TX 77002

Date:

MAILED

OCT 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010125
PATENT NO. : 5857201
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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Scott McKeown :
OBLON, SPIVAK, MCCLELLAND : (For Patent Owner)
MAIER & NEUSTADT, L.L.P. :
1940 DUKE STREET :
ALEXANDRIA VA 22314 :

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OCT 16 2009

CENTRAL REEXAMINATION UNIT

Tracy W Druce :
NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

In re: Wright, Jr. *et alia* : DECISION
Ex Parte Reexamination Proceeding : GRANTING
Control No. 90/010,125 : PETITION FOR EXTENSION
Deposited: 14 March 2008 : OF TIME
For: US Patent No. 5,857,201 : 37 CFR §§ 1.550(c) & 1.181

This is a decision on the 08 October 2009, "Petition Under 37 CFR § 1.550(c)" requesting that the time for responding to the final Office action mailed 31 August 2009, be extended by one (1) month extension of time. The petition was timely filed on 08 October 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 in which to file a response to the final Office action mailed 31 August 2009. The petition for extension of time was timely filed on 08 October 2009 with appropriate fee according to 37 CFR § 1.17(g).

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.

The petitioner has demonstrated “sufficient cause” given the efforts to prepare a declaration and the scheduling to meet with the technical expert are considered to support the “sufficient cause” requirement for granting the 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 to the Order granting Reexamination is extended by one (1) month
3. The Patent Owner’s response is due 31 November 2009.
4. Response and/or submissions to the Office should be addressed as follows:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://portal.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.
90/010,128	03/31/2008	6615065	5180-0048	7046

277 7590 07/30/2008

PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/30/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Richard D. Getz
O'Shea, Getz & Kosakowski, P.C.
1500 Main Street, Suite 912
Springfield, MA 01115

MAILED

JUL 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,128.

PATENT NO. 6615065.

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)).

REVIEW OF FACTS

1. U.S. Patent No. 6,615,065 (the '065 patent) was issued on September 2, 2003, with 49 claims.
2. An application for reissue of the '065 patent, assigned application No. 11/219,298 (the '298 application), was filed by the patent owner on September 2, 2005.
3. The filing of the '298 reissue application was announced in the *Official Gazette* on October 18, 2005.
4. A non-final Office Action in the '298 application was mailed on October 10, 2007.
5. Patent Owner submitted a response to the non-final Office Action on February 15, 2008.
6. A request for reexamination of the '065 patent was filed by a third party requester on March 25, 2008, and was assigned control No. 90/010,128 (the '128 proceeding).
7. Reexamination was ordered for the '128 proceeding on April 23, 2008.
8. Notice of the filing of the request for reexamination was announced in the *Official Gazette* on May 20, 2008.
9. A patent owner's statement under 37 CFR 1.530 has not been received in the '128 proceeding, and the time for filing same has expired.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

"If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

For the case where a reissue application is the first filed proceeding and the reexamination request is the later filed proceeding, MPEP 2285 II.B. states in part:

if examination of the reissue application has not begun, or if a rejection by the primary examiner has not been appealed to the Board of Patent Appeals and Interferences (Board) pursuant to 37 CFR 41.31, it is likely that the OPLA will order a merger of the reissue application examination and the reexamination proceeding.

As evidenced by the above review of facts, reissue application No. 11/219,298 and reexamination control No. 90/010,128 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and a notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue and reexamination proceedings remain merged. See 37 CFR 1.565(d).
2. A review of the file for reissue application 11/219,298 reveals the presence of: original claims 2-10, 12-25 and 36-49; amended claims 1, 11, 26 and 35; and new claims 50-125. A review of the file for reexamination control No. 90/010,128 reveals the presence of original claims 1-49. **Accordingly, the claims are not identical in both proceedings.**

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in both proceedings, specifically; Application No. 11/219,298 and Control Number 90/010,128. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.
2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged

proceeding. **However, periods for response should be set at TWO (2) months, to comply with the statutory requirement for special dispatch in ex parte reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e., the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).
5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry of a copy into each of the two files, with each of the two copies 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 is 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 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 that are not applicable under reexamination would be withdrawn (e.g., based on public use or on sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).
11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

PATENT OWNER'S ADDRESS

The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the reissue application and (3) the reexamination

proceeding. The current proper correspondence address for the patent file pursuant to 37 CFR 1.33(c) is that of Price Heneveld Cooper Dewitt & Litton, LLP of Grand Rapids, MI. Thus, for the '128 reexamination proceeding Price Heneveld Cooper Dewitt & Litton, LLP of Grand Rapids, MI is the current proper patent owner address. This is the address to which the order granting reexamination was mailed. On the other hand, the current patent owner correspondence address for the '298 reissue application pursuant to 37 CFR 1.33(a) is that of Hogan & Hartson LLP of Washington, DC.

Clarification is **required**, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within **ONE (1) MONTH** of this decision:

- (a) Designate one of the two correspondence addresses and parties prosecuting these proceedings as the correspondence address and party of record in both proceedings (to provide one address and party for the merged proceeding) and the patent file, and
- (b) If there is a designated attorney, supply the designated attorney with the requisite power of attorney in the appropriate proceedings.

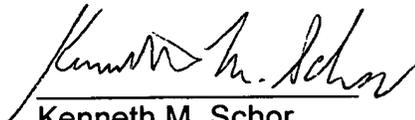
As a courtesy, this decision is being mailed to both addresses. Pending clarification, the address of Hogan & Hartson LLP of Washington, DC, will be used in future correspondence.

CONCLUSION

1. Reissue application No. 11/219,298 and reexamination control No. 90/010,128 **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 all (both) cases of the present merged proceeding.
3. The patent owner is further to, within **ONE MONTH** of this decision, unify the correspondence addresses and parties prosecuting these proceedings as set forth in the last section of this decision.
4. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3700, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who

was involved in any part of the examination of the '065 patent (e.g., by preparing/signing an action). See MPEP 2236.

5. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of:
 - (a) the expiration of the ONE MONTH period (from the mailing of this decision) for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings, or
 - (b) the receipt of both the required housekeeping amendment (i) and correspondence address and attorney papers (ii).
6. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.
7. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7710.



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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/219,298	09/02/2005	Bruce J. Barrett	65243-0006	9871
24633	7590	10/30/2008		
HOGAN & HARTSON LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON, DC 20004			EXAMINER BERHANU, ETSUB D	
			ART UNIT 3768	PAPER NUMBER
			NOTIFICATION DATE 10/30/2008	DELIVERY MODE ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dcptopatent@hhlaw.com
rogruwell@hhlaw.com



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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HOGAN & HARTSON LLP
IP GROUP, COLUMBIA SQUARE
555 THIRTEENTH STREET, N.W.
WASHINGTON DC 20004

In re Application of: Bruce Barrett et al.)
Reissue Application No. 11/219,298) **DECISION EXPUNGING THIRD**
Filed: September 2, 2005) **PARTY SUBMISSION**
For: U.S. Patent 6,615,065)
For: MULTI-CHANNEL NON-INVASIVE)
TISSUE OXIMETER)

This communication is in response to the third party submission filed in the present reissue application on August 9, 2007. The submission is stated to have been filed under 37 CFR §1.99, and has recently come to the attention of the Office. The submission was not of record at the time the examiner mailed the Office action on September 27, 2008.

RELEVANT AUTHORITY

35 U.S.C. § 252 provides, in part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. ...

37 CFR 1.99(e) provides, in part:

A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of the public to a pending published application that does not comply with the requirements of this section will not be entered. [Emphasis added.]

37 CFR 1.211 provides, in part:

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless: ...

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section. [Emphasis added.]

37 CFR 1.291(c)(2) provides:

In addition to compliance with paragraphs protest must include a concise explanation of the relevance of each item listed pursuant to paragraph (c)(1) of this section.

DECISION

The submission filed on August 9, 2007 is not a proper submission under 37 CFR 1.99, a regulation directed to the filing by a third party of an information disclosure statement directed to a patent application that is eligible for publication. See, for example 37 CFR 1.99(e). A reissue application is not a patent application that is eligible for publication, because 37 CFR 1.211(a) limits publication of pending patent applications to applications filed under either 35 U.S.C. § 111(a) or 35 U.S.C. § 371. A reissue application is an application filed under 35 U.S.C. § 251. Further, 37 CFR 1.211 clearly states that a reissue application is not eligible for publication.

Consideration has been given to treatment of the August 9, 2007 submission as a protest filed in the reissue application pursuant to 37 CFR 1.291. However, the submission does not include the concise explanation of the relevance of each item pursuant to 37 CFR 1.291(c)(2). Therefore the August 9, 2007 submission cannot be treated as a protest.

Accordingly, the August 9, 2007 submission lacks an entry right in the present reissue application as a paper filed by a party who is not the applicant in the reissue application. As such, the paper will be expunged from the record, without consideration by the examiner.

Any inquiry regarding this decision should be directed to Josie A. Ballato, Special Program Examiner at 571-272-3567.



Donald T. Hajec

Director, Technology Center 3700

Mechanical Engineering, Manufacturing, Products and Designs



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,130	03/28/2008	5974120	6646-250,-250A,-250B	2106
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35554 7590 05/14/2009

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 05/14/2009

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



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Commissioner for Patents
United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

MAILED

MAY 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,130.

PATENT NO. 5974120.

ART UNIT 3992.

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

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



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REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES CA 90069

(For Patent Owner)

MAILED

MAY 14 2009

CENTRAL REEXAMINATION UNIT

John L. Welsh
WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA, VA 22314

(For Third Party
Requester)

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

(For Third Party
Requester)

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

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/008,229
Deposited : 20 September 2006
For: US Patent No. 5,974,120

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/010,044
Deposited : 5 November 2007
For: US Patent No. 5,974,120

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/010,130
Deposited : 28 March 2008
For: US Patent No. 5,974,120

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

BACKGROUND

1. On 26 October 1999 US Patent No. 5,974,120 was granted to Ronald A. Katz.
2. On 20 September 2006 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,229.
3. On 14 December 2006 the Order was granted for *ex parte* reexamination in control number 90/008,229.
4. On 05 November 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,044.
5. On 01 February 2008 the Order was granted for *ex parte* reexamination in control number 90/010,044.
6. On 28 March 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,130.
7. On 28 May 2009 the Order was granted for *ex parte* reexamination in control number 90/010,130.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,229 and 90/010,044 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,229; 90/010,044; and 90/010,130 are hereby MERGED.
2. The reexamination files are being forwarded to the examiner for further action.
3. All correspondence regarding these proceedings should be submitted as follows:

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

By Fax to: (571) 273-9900

Central Reexamination Unit

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

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

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

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit



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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Ann M. Caviani Pease
Dechert LLP
P.O. Box 390460
Mountain View, CA 94039-0460

For Patent Owner

MAILED

SFP 29 2009

CENTRAL REEXAMINATION UNIT

Jeffrey B. Oster
8339 SE 57th Street
Mercer Island, Washington 98040

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/010,131
Filed: March 31, 2008
For: US Patent No. 6,814,934

DECISION DISMISSING
PETITION UNDER
27 CFR 1.181

The petition filed July 1, 2009 under 37 CFR 1.181 is before the Director of the Central Reexamination Unit.

The petition requests that the papers filed by third party requestor on June 22, 2009 be expunged from the record.

The papers referenced in this petition are not part of the record of this proceeding; therefore the petition is dismissed as moot. Patent owner is referred to the Decision Returning an Improper Paper mailed September 23, 2009.

Further, since this petition includes documentation regarding the returned papers, this petition will be (and will remain) marked "closed" and "not public".

This decision will be made of record in the reexamination file.

Deborah Jones,
SPE, Central Reexamination Unit

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

(For Patent Owner)

MAILED

OCT 02 2008

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,069
Filed : December 5, 2007
For U.S. Patent No. : 5,626,631

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,134
Filed : April 4, 2008
For U.S. Patent No. : 5,626,631

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. 90/010,069 was ordered in a decision mailed January 24, 2008 indicating that claims 1-5, 8, and 9 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed cancelling claims 1-6, and 8-10 and adding claims 11-41. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,134 was ordered in a decision mailed June 27, 2008 indicating that claims 1-10 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 25, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and Concurrent

Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,069, and reexamination control No. 90/010,134 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1-6, and 8-10 have been cancelled and claims 11-41 added in reexamination proceeding control No. 90/010,069 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,134 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,069 and 90/010,134 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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



Gregory Morse, Director
Central Reexamination Unit



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

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

(For Patent Owner)

MAILED

OCT 02 2008

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,066
Filed : December 5, 2007
For U.S. Patent No. : 6,174,325

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,135
Filed : April 4, 2008
For U.S. Patent No. : 6,174,325

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. 90/010,066 was ordered in a decision mailed January 24, 2008 indicating that claims 9 and 25-27 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed cancelling claims 1-38 (all of the claims in the patent) and adding claims 39-56. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,135 was ordered in a decision mailed June 27, 2008 indicating that claims 1-8, 10-24, and 28-38 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 8, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and Concurrent

Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,066, and reexamination control No. 90/010,135 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1-38 have been cancelled and claims 39-56 been added in reexamination proceeding control No. 90/010,066 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,135 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

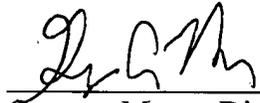
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,066 and 90/010,135 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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Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

Reexam Control No.: 90/010,068
Filed : December 5, 2007
For U.S. Patent No. : 5,403,368

**DECISION MERGING
REEXAMINATION
PROCEEDINGS**

Reexam Control No.: 90/010,136
Filed : April 7, 2008
For U.S. Patent No. : 5,403,368

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. 90/010,068 was ordered in a decision mailed January 22, 2008 indicating that claims 1, 2, 12, and 14 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed amending claims 1, 8, 10, 11, 14, and 15; cancelling claims 2-7, 9, and 12; and adding claims 19-32. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,136 was ordered in a decision mailed June 27, 2008 indicating that claims 1, 3-5, and 7-11 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 25, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and Concurrent

Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,068, and reexamination control No. 90/010,136 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1, 8, 10, 11, 14, and 15 have been amended; claims 2-7, 9, and 12 cancelled; and claims 19-32 added in reexamination proceeding control No. 90/010,068 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,136 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,068 and 90/010,136 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this**

decision within which to submit a “housekeeping” amendment placing the same claims in each of the files. Upon receipt of the response, an Office action will issue in due course.

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



Gregory Morse, Director
Central Reexamination Unit



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United States 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.
90/010,138	04/08/2008	6838618	17242US02	4522

7590 11/03/2008
JEFFREY J. HOWELL
ROYLANCE, ABRAMS, BERDO & GOODMAN, LLP
1300 19TH STREET N.W.
SUITE 600
WASHINGTON, DC 20036

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/03/2008

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

McAndrews, Held & Malloy, Ltd.

500 West Madison Street

34th Floor

Chicago, Illinois 60661

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NOV 03 2008

CENTRAL REEXAMINATION

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,138.

PATENT NO. 6838618.

ART UNIT 3992.

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

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



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

Jeffery J. Howell
Roylance, Abrams, Berdo & Goodman, LLP
1300 19th Street NW
Suite 600
Washington, DC 20036

(For Patent Owner)

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
Suite 3400
Chicago, IL 60661

(For Requester)

MAILED

NOV 03 2008

CENTRAL REEXAMINATION UNIT

In re *Newbold et al.*
Reexamination Proceeding
Control No. 90/010,138
Filed: April 8, 2008
For: U.S. Patent No. 6,838,618

:
: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

The paper filed by requester on July 7, 2008, styled as "Petition for Review of Order Denying *Ex Parte* Reexamination," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated June 5, 2008. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

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REVIEW OF FACTS

1. U.S. Patent No. 6,838,618 (hereinafter, the '618 patent) issued on January 4, 2005.
2. On January 23, 2006, a third party requester deposited a request for *inter partes* reexamination for claims 1-4, 6-7, 10-17, and 20-21 of the '618 patent, and the resulting reexamination proceeding was assigned Control No. 95/000,124 (hereinafter, the '124 reexamination proceeding).
3. On April 13, 2006, an order granting reexamination of claims 1-34 based upon U.S. Patent No. 6,105,334 to Monson, GB 2,326,467 to Ward, and 4 other references was mailed in the '124 reexamination proceeding. The order agreed with the requester that references raise a substantial new question of patentability based upon a teaching of a "housing and light fixture forming a preassembled integral unit." See the pages 3-5 of the Order. Currently, claims 1-8 stand rejected and new proposed claims 9-20 are indicated allowable.
4. On August 11, 2006, an Office action was mailed in the '124 reexamination proceeding. The Office action rejected claims 1, 2, 10, 11, 13, 15-17, 20, and 21 based on Ward. The Office action considered but did not adopt the proposed rejection of claims 1-4, 6, 7, 10-17, 20, and 21 based on Monson in view of Ward or four other references as alternative secondary teachings of the preassembled integral unit and of claims 3-6, 7, 12, and 14 based on Ward.
5. On April 8, 2008, the third party requester deposited a new request for *ex parte* reexamination for claims 1-4, 6-7, 10-14, 16-17, and 20-21 currently pending in the '124 reexamination proceeding, and the resulting reexamination proceeding was assigned Control No. 90/010,138 (hereinafter, the '138 proceeding).
6. On April 17, 2008, in the '124 reexamination proceeding, the Office mailed an action, which maintained the rejection based on Ward and did not set forth any new rejections. No further action has been taken to date in the '124 reexamination proceeding. The request stated that references raise a substantial new question of patentability based upon a teaching of a "housing and light fixture forming a preassembled integral unit." The references included Monson, Ward, and 4 new references that were not presented in the '124 reexamination proceeding.
7. On June 5, 2008, an order denying the request for reexamination for claims 1-4, 6-7, 10-14, 16-17, and 20-21 was issued.
6. On July 7, 2008, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

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Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner denied the request for reexamination based upon claim interpretation that excludes the embodiments described in the specification of the '618 patent, is contrary to the disclosure of the '618 patent and the understanding of those skilled in the art.

In support, the petitioner advances the following points:

1. The '618 patent was allowed because the prior art did not disclose a fire resistant housing and light fixture that were a preassembled integral unit. See pages 2-3 of the petition.
2. The request in the '138 reexamination proceeding brought "to the PTO's attention several prior art references that disclosed the 'preassembled integral unit' limitation. See page 3 of the petition.
3. The examiner incorrectly determined that the Capri, Juno, and Prescolite prior art references do not teach the "preassembled integral unit." See pages 4-10 of the petition.
4. An additional substantial new question of patentability (SNQ) based on the combination of Juno with Ward that was not raised in the request for reexamination. See pages 11-14 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 1-4, 6-7, 10-14, 16-17, and 20-21 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-4, 6-7, 10-14, 16-17, and 20-21 of the '618 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 1-4, 6-7, 10-14, 16-17, and 20-21. 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) nor any additional SNQs made 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

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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. 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

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

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material new argument or interpretation presented in the request.”^{2,3} This new light must be in terms of how to interpret the state of the “pre-existing technology,” as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a “new light” if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

Similarly, MPEP 2640 states that in the situation where an ordered *inter partes* reexamination is pending, and an *ex parte* reexamination request is subsequently filed:

“...reexamination should be ordered only if the art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the art cited in the subsequent request raises the same substantial new question of patentability as that raised in the earlier pending reexamination, the subsequent request should be denied... If the subsequent request does **not** include the art which raised the substantial new question of patentability in the earlier pending reexamination, reexamination may or may not be ordered, depending on whether the different art cited raises a substantial new question of patentability... in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determination**. The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.923). If a “different” substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability “affecting any claim of the patent.” See 35 U.S.C. 312(a). Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.”

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 provides guidelines for such an order, and requires that the examiner’s decision in the order state, for each patent and printed publication cited in the request, why the citation is:

² See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

³ For additional discussion regarding technical teachings viewed “in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

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- (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.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A. Prior to addressing the issue of claim interpretation, it must first be determined if the request raises a substantial new question of patentability not considered in a prior examination or reexamination. In other words, do the Monson, Ward, Lightolier, Capri, Juno, and Prescolite references, singly or together, raise an SNQ that is different from the technical teachings that were considered with respect to claim patentability in the prosecution of application number 10/702,725, which issued as the 6,838,618 patent, and in the pending reexamination proceeding '124. For this analysis, it is assumed that Capri, Juno, and Prescolite teach the "integral preassembled light fixture and housing" as argued by the Petitioner. This assumption, however, does not mean that this decision necessarily agrees with the Petitioner on this issue.

The request for reexamination, dated April 8, 2008, stated that claims 1-4, 6, 7, 10-14, 16, 17, 20, and 21 of the '618 patent are obvious under 35 U.S.C. § 103 in view of Capri, Juno, Prescolite, Lightolier, and Ward. See page 2 of the request. The request also states on page 36 that Monson can be "combined with any of these new references (Capri R150IC, Juno Air-LocIC and Prescolite H4IC)" to render claims 1-2, 10-14, 16, 17, 20, and 21 obvious. The explanation provided in the request seemingly presents the teachings of Ward, Capri, Juno, and Prescolite as equivalent teachings of the "integral preassembled light fixture and housing."

As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated April 8, 2008. As will be discussed in further detail in section B. below, consideration is limited as to whether the cited references raise a substantial new question of patentability (SNQ) to patent claims 1-4, 6, 7, 10-14, 16, 17, 20, and 21.

Monson and Ward were the basis for an order granting reexamination of the 6,838,618 patent in the '124 proceeding. Moreover, Monson was used in the rejection in the application that issued as the '618 patent, and Ward was twice applied in a rejection of claims 1, 2, 10, 11, 13, 15-17, 20, and 21 and was considered in a proposed rejection of claims 3, 4, 6-7, 12, and 14 of the '618

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patent in the '124 proceeding. Therefore, Capri, Juno, Prescolite, and Lightolier are the only references not previously considered in the previous examination of the '618 patent.

Accordingly, Capri, Juno, Prescolite, and Lightolier must present an SNQ in the form of a new technical teaching (e.g., new information) not previously discussed or considered on the record in the previous proceedings, (i.e., the examination of the application that matured into the '618 patent and the previously ordered '124 reexamination proceeding) in order for a second request for reexamination to be granted. Capri, Juno, Prescolite, and Lightolier may also present the teachings of Monson and Ward "in a new light" in order to raise a substantial new question of patentability in regards to these references that were already considered in previous examinations; presenting a previously considered teaching "in a new light" is considered to be the presentation of a new technical teaching.

As previously stated, the request explains that Capri, Juno, and Prescolite provide substantially the same teaching regarding the "integral preassembled light fixture and housing" as that of Ward. See the explanation provided on pages 36-38 of the request. In particular, see the table on page 37 of the request, which shows how Ward (the '467 Patent), Capri, Juno, and Prescolite present similar teachings. In other words, the request fails to set forth any new technical teachings by Capri, Juno, and Prescolite that is different than that of Ward. Therefore, Capri, Juno, and Prescolite present cumulative teachings to the teachings of Ward, which has been fully considered and applied in a prior examination. Accordingly, Capri, Juno, and Prescolite, fail to provide any new teachings as presented in the request for reexamination dated April 8, 2008.

The evidence and explanation, as set forth in the request dated April 8, 2008, simply does not support ordering a second request for reexamination. The request does not present sufficient evidence that Capri, Juno, Lightolier, and Prescolite present the teachings of either Monson or Ward in a new light, or themselves otherwise provide any new technical teaching that was not previously discussed and considered on the record in a previous examination. The teachings of Capri, Juno, Lightolier⁴, and Prescolite are deemed cumulative to the teachings already considered in the prior Office proceedings for the '618 patent, and as such, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination.

Accordingly, the references cited in the request for the '138 reexamination proceeding fail to raise an SNQ as to claims 1-4, 6-7, 10-14, 16-17, and 20-21 of the '618 patent, even if Capri, Juno, and Prescolite do teach the integral preassembled light fixture and housing as argued by the Petitioner.⁵

⁴ The Petitioner does not argue that Lightolier itself presents a substantial new question of patentability (SNQ). Furthermore, the request is unclear if Lightolier presents a SNQ and what proposed rejections are based on Lightolier that supports the SNQ. Accordingly, it could not be fully determined if Lightolier presents an SNQ that is different from that of Ward, Capri, Juno, and Prescolite.

⁵ This decision does not address this issue as it is not necessary.

Art Unit: 3992

Petitioner can still avail itself of an *ex parte* reexamination proceeding, provided that petitioner formulates and files a request for *ex parte* reexamination that brings forth some new technological information that was not considered in a previous examination. If a new request is filed, the new request should clearly set forth each SNQ, each proposed rejection that supports the SNQs, what claims each proposed rejection is applied to, and a clear, detailed explanation for how the references teach *every* claim limitation for *each* proposed rejection. The new request must not lump together the explanations of multiple, distinct proposed rejections. See MPEP 2214, 2216 and 2217.

As explained above, in accordance with MPEP 2640 and 2242, "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

The Petitioner correctly notes that the order did not analyze the claims as proposed to be amended in the '124 reexamination proceeding, which is currently pending. Since a reexamination certificate has not yet published, proposed amendments are not part of the patent. See 37 CFR 1.530(d) and (k). As noted above, 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 1-4, 6-7, 10-14, 16-17, and 20-21 of the '618 patent in order to grant reexamination. Any amendments to the claims or new claims added during the prosecution of Reexam Control No. 95/000,124 cannot be considered in the determination to grant the reexamination proceeding.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '618 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 position that Capri, Juno, Lightolier, and Prescolite provide a new teaching or presents a new light to the teachings of Monson and Ward. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed.

Art Unit: 3992

Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. The PETITION is DENIED.
2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in their absence to the undersigned at (571) 272-3838.



Gregory A. Morse, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,147	04/22/2008	5848398	8246.002.000004	1162

7590 01/09/2009

JOHN J. HELD
MCANDREWS HELD & MALLOY
500 W MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/09/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

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JAN 09 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,147.

PATENT NO. 5848398.

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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McANDREWS, HELD & MALLOY, LTD
500 WEST MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

(For Patent Owner)

NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For *Ex Parte* Requester)

MAILED

Ex Parte Reexamination Proceeding
Control No.: 90/010,147
Filed: April 22, 2008
For: U.S. Patent No. 5,848,398

:
: DECISION
: GRANTING
: PETITION
:

JAN 09 2009
CENTRAL REEXAMINATION UNIT

This is a decision on patent owner's petition filed on December 4, 2008 entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)." Patent owner requests waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of references that are subject to a protective order with respect to reexamination proceeding control nos. 90/010,094, 90/010,095, 90/010,097 and 90/010,147.

The petition is before the Office of Patent Legal Administration. Although captioned as a petition under 37 CFR 1.182, the petition will be treated as a petition under 37 CFR 1.183 for suspension of the rules.

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. 13-0017, as authorized on page three of the petition.

REVIEW OF FACTS

1. U.S. Patent No. 5,848,398 (the '398 patent) issued on December 8, 1998, U.S. Patent No. 6,381,575 (the '575 patent) issued on April 30, 2002, U.S. Patent No. 6,397,189 (the '189 patent) issued on May 28, 2002, and U.S. Patent No. 6,970,834 (the '834 patent) issued on November 29, 2005.

2. A request for *ex parte* reexamination of the '834 patent was filed on February 1, 2008. The request was assigned control no. 90/010,095 (the '10095 reexamination proceeding).
3. Also, a request for *ex parte* reexamination of the '189 patent was filed on February 1, 2008. The request was assigned control no. 90/010,094 (the '10094 reexamination proceeding).
4. Further, a request for *ex parte* reexamination of the '575 patent was filed on February 1, 2008. The request was assigned control no. 90/010,097 (the '10097 reexamination proceeding).
5. Reexamination was ordered for the '10095 proceeding on April 9, 2008.
6. Reexamination was ordered for the '10094 proceeding and for the '10097 proceeding on April 11, 2008.
7. A request for *ex parte* reexamination of the '398 patent was filed on April 22, 2008. The request was assigned control no. 90/010,147 (the '10147 reexamination proceeding).
8. Reexamination was ordered for the '10147 proceeding on June 23, 2008.
9. On August 28, 2008, patent owner filed a paper in the '10097 proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO CONSOLIDATE REEXAMINATION PROCEEDINGS," requesting that the '10094, '10095, '10097 and '10147 proceedings (the four proceedings) be consolidated in order to, among other reasons, minimize the volume of disclosure of information and documents from two concurrent lawsuits involving the underlying patents.
10. On October 1, 2008, the Office mailed a "DECISION DISMISSING PETITION TO CONSOLIDATE REEXAMINATION PROCEEDINGS" in the '10097 proceeding. The decision indicated that, for information subject to protective order, the Office would be willing to consider a petition under 37 CFR 1.183, requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a) to permit a single submission of the protected materials to serve as the required copy for the four proceedings.
11. On December 4, 2008, patent owner filed, in each of the four proceedings, a "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WAIVER OF THE FORMAL SUBMISSION REQUIREMENTS OF 37 C.F.R. §§ 1.555 AND 1.98(a)."
12. Patent owner filed a paper entitled "SUBMISSION OF INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. § 1.555" in the '10095 proceeding on December 12, 2008, in the '10094 proceeding on December 16,

2008, in the '10097 proceeding on December 17, 2008, and in the '10147 proceeding on December 18, 2008 (IDS submissions). Patent owner electronically submitted in each of the four proceedings copies of references cited in the IDS submissions that are not subject to a protective order. Patent owner submitted by mail, pursuant to MPEP 724, only in the '10095 proceeding, copies of references cited in the IDS submissions that are subject to a protective order.

13. Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" in the '10095 proceeding.

DECISION

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

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

37 CFR 1.98 states (in part):

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(2) A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each reexamination proceeding for which a patent owner files an IDS, to constitute a proper IDS. Accordingly, if patent owner intends to file an identical IDS in multiple reexamination proceedings, the rules require patent owner to file the IDS and copies of the references cited therein in each of the proceedings. EFS-Web, the Office's electronic filing system, facilitates such multiple filings by enabling

patent owner to scan each reference to be submitted only once and then to electronically file the scanned references into each of the proceedings.

In the present situation, patent owner has already electronically filed in each of the four proceedings the references identified in the IDS submissions that are not stated to be subject to a protective order. The Office recognizes, however, that the references identified in the IDS submissions that are subject to the protective order cannot be filed electronically. See MPEP 724. Thus, in this instance, the acceptance of a single submission of the references that are subject to the protective order for the '10095 proceeding will ease the burden of handling these references for the Office, as well as the patent owner, without prejudice to the third party requesters. Accordingly, the instant petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 to permit a single submission of the protected materials to serve as the required copy for the four proceedings is **granted**.

The grant of the petition is not based upon the individual facts and circumstances of the four proceedings. Furthermore, grant of the petition is not an acknowledgement that patent owner's IDS submissions comply with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of the waiver of the reference copy submission requirement pursuant to this decision.

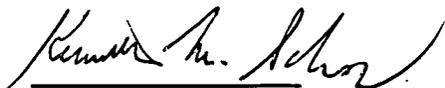
MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the proceeding is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed protected 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 examiner may issue a determination on the issue of importance of the 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 the Office issues a determination that any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable," then the information determined to be "important..." will be scanned into the record of the '10095 proceeding, with a subsequent electronic transfer of the same scanned references into the '10094, '10097 and '10147 proceedings.

ADDITIONAL DISCUSSION

Concurrent with the IDS submission on December 12, 2008, patent owner filed a "PETITION TO EXPUNGE UNDER 37 CFR § 1.59" (petition to expunge) in the '10095 proceeding. In light of this decision granting patent owner's instant petition, patent owner must also file the petition to expunge and requisite petition fee in the '10147 proceeding such that any of the references that are subject to the protective order found by the examiner not to be material to patentability are subsequently expunged from the '10147 proceeding.

CONCLUSION

1. Patent owner's December 4, 2008 petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is granted.
2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit.
3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.



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

1-7-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,147	04/22/2008	5848398	8246.002.000004	1162

7590 02/05/2009

JOHN J. HELD
MCANDREWS HELD & MALLOY
500 W MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/05/2009

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Houston, TX 77002

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FEB 05 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,147.

PATENT NO. 5848398.

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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JOHN J. HELD :
MCANDREWS HELD & MALLOY : (For Patent Owner)
500 W MADISON STREET :
34TH FLOOR :
CHICAGO IL 60661 :

Stephen C. Durant :
SAN FRANCISCO OFFICE OF : (For Third Party
NOVAK, DRUCE & QUIGG LLP : Requester)
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

MAILED
FEB 05 2009
CENTRAL REEXAMINATION UNIT

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

In re: Martin et alia :
Ex Parte Reexamination Proceeding :
Control No. 90/010,147 :
Deposited on: 22 April 2008 :
For: US Patent No. 5,848,398 :

This is a decision on the 2 February 2009, petition for "Request for a Two-Month Extension of Time Pursuant to 37 CFR 1.550(c)," requesting that the time for responding to the non-final Office action, mailed 18 December 2008 be extended by two (2) months.

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

The petition is Granted-in-Part for the reasons set forth below.

Summary of Relevant Facts

1. On 22 April 2008 a third party requester, requested reexamination of US Patent No. 5,848,398.
2. On 23 June 2008 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.
3. On 18 December 2008 a non-final Office action was mailed to the address of record.
4. On 2 February 2009 a petition was filed requesting two (2) months extension of time for which to respond to the outstanding Office action.

Decision

The Patent Owner requests an extension of time in which to file a response to the non-final Office action mailed 18 December 2008, which set a two-months date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the non-final Office action be extended by two (2) additional months. Since the petitioner has provided "sufficient cause" for granting an extension of time in-part. The petition is timely filed.

The petitioner has provided the petition fee set forth in 37 CFR § 1.17(g).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time for an additional two (2) months for which to submit a response to the non-final Office action mailed on 18 December 2008.

The patent owner has the need to contact an expert witness to determine whether declarations pursuant to 37 CFR § 1.132 will be necessary, a nearly one week delay in receipt of the Office action and the difficulty in responding to four different actions in related proceedings whose responses due at the same time.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

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

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

Conclusion

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Office action dated 18 December 2008 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 will end on **18 March 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.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit



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Grimes & Battersby, LLP
488 Main Avenue
Suite 300
Norwalk, CT 06851

(For Patent Owner)

John C. McNett, Esq.
Quentin G. Cantrell, Esq.
Woodard Emhardt Moriarty
McNett & Henry LLP
111 Monument Circle
Suite 3700
Indianapolis, IN 46204-5137

(For Requester)

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CENTRAL REEXAMINATION UNIT

In re Gregory J. Battersby et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,151
Filed: May 13, 2008
For: U.S. Patent No. 6,546,924

: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b) AND**
: **DISMISSING PETITION**
: **FOR EXTENSION OF TIME**

This is a decision on: (i) the July 2, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed *Ex Parte* Reexamination Interview Summary and revive the present terminated reexamination prosecution ("the July 2, 2009 petition to revive")¹; and (ii) the July 2, 2009 patent owner petition for retroactive extension of time ("the July 2, 2009 petition for extension of time").

The July 2, 2009 petition to revive and the July 2, 2009 petition for extension of time are before the Office of Patent Legal Administration (OPLA) for consideration.

The July 2, 2009 petition to revive is **granted**.

The July 2, 2009 petition for extension of time is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

¹ Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of May 18, 2009.

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution,

and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

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

*

*

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

37 CFR 1.560(b) provides:

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

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 May 18, 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 June 29, 2009, which was untimely. For the purpose of evaluating whether the July 2, 2009 petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on June 29, 2009, satisfies item (1).

The appropriate petition fee of \$810.00 set forth in 37 CFR 1.17(m) for the July 2, 2009 petition to revive has been paid, which satisfies item (2).

Regarding item (3), the statement provided in the July 2, 2009 petition to revive (“[t]he entire delay was unintentional”) does not specify 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, as is required by 37 CFR 1.137(b)(3). However, the statement contained in the July 2, 2009 petition to revive is being so construed, thereby satisfying item (3). Patent owner **must** notify the Office if the Office has misconstrued the statement provided in the July 2, 2009 petition to revive.

Accordingly, the July 2, 2009 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

The Petition for Extension of Time is Dismissed

In the July 2, 2009 petition for extension of time, patent owner requests that the time for submitting the written statement of interview required under 37 CFR 1.560(b) be extended retroactively until June 29, 2009. However, 37 CFR 1.550(c) specifically provides that any request for an extension of time in an *ex parte* reexamination proceeding “must be filed on or before the day on which action by the patent owner is due.”³ The time for submitting the written statement of interview required under

² See: 37 CFR 1.137(d)(3).

³ 37 CFR 1.550(c) also provides that any request for extension in an *ex parte* reexamination proceeding must be accompanied by the petition fee set forth in § 1.17(g), which is currently \$200.00. Patent owner paid the \$200.00 fee for the July 2, 2009 petition for extension of time.

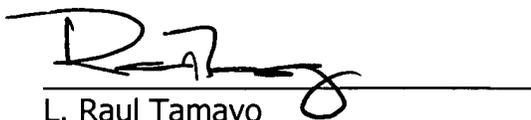
37 CFR 1.560(b) expired on June 18, 2009; therefore, the July 2, 2009 petition for extension of time is untimely.

It is also pointed out that the Office is not authorized to grant relief in a petition under 37 CFR 1.550(c) in a terminated reexamination prosecution.

Accordingly, the July 2, 2009 petition for extension of time is **dismissed**.

CONCLUSION

1. The July 2, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.
2. The July 2, 2009 patent owner petition for a retroactive extension of time is **dismissed**.
3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for processing of the July 2, 2009 *Ex Parte* Reexamination Interview Summary.
4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Glenn Dawson, of CRU Art Unit 3993, at (571) 272-4694.
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

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Attn: Patent Intake Customer No. 30623
One Financial Center
Boston, MA 02111

(For Patent Owner)

MAILED

OCT 02 2008

CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
Patent Administrator
Exchange Place
Boston, MA 02109-2881

(For 3rd Party Requester)

Reexam Control No.: 90/010,070
Filed : December 5, 2007
For U.S. Patent No. : 5,964,749

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,154
Filed : April 29, 2008
For U.S. Patent No. : 5,964,749

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. 90/010,070 was ordered in a decision mailed January 29, 2008 indicating that claims 8, 9, 12, and 16 would be reexamined. A non-final Office action was mailed May 2, 2008. On July 2, 2008 an amendment was filed cancelling claims 1-2, and 5-18 and adding claims 19-46. On August 1, 2008, patent owner filed a paper titled “First Supplemental Notification of Prior and Concurrent Proceedings Under 37 C.F.R. § 1.565”. No Office action has been prepared by Office in response to the amendment filed July 2, 2008.

Reexamination in application control No. 90/010,154 was ordered in a decision mailed June 27, 2008 indicating that claims 1, 2, 5-7, 10, 11, 13-15, 17, and 18 would be reexamined. Patent Owner filed on July 8, 2008 a letter waiving his rights under 37 C.F.R. § 1.530 to file a Patent Owner Statement. In addition, on July 25, 2008 patent Owner filed an Information Disclosure Statement, and on August 1, 2008 a letter titled “First Supplemental Notification of Prior and

Concurrent Proceedings Under 37 C.F.R. § 1.565". No Office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,070, and reexamination control No. 90/010,154 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims 1-2, and 5-18 have been cancelled and claims 19-46 added in reexamination proceeding control No. 90/010,070 by virtue of the amendment filed July 2, 2008. No amendments have been filed in the 90/010,154 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

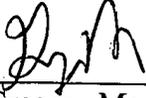
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the two 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 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. 90/010,070 and 90/010,154 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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Dickinson Wright PLLC
38525 Woodward Avenue
Suite 2000
Bloomfield Hills, MI 48304-2970

For Patent Owner

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JUL 23 2009

CENTRAL REEXAMINATION UNIT

Richard D. McLeod
Klarquist Sparkman LLP
121 SW Salmon Street, #1600
Portland, OR 97204

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,155
Filed: April 30, 2008
For: U.S. Patent No. 5,292,125

DECISION ON PETITION
TO MERGE REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,472
Filed: March 26, 2009
For: U.S. Patent No. 5,292,125

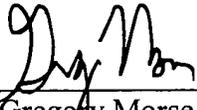
The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of the petition filed by third party requester on June 3, 2009 (copy in each proceeding) requesting that the above-mentioned proceedings be merged.

The petition is hereby **dismissed as being moot**.

Prosecution on the merits in reexamination proceeding 90/010,155 were indicated as being closed in the Notice of Intent to Issue *Ex Parte* Reexamination Certificate mailed April 23, 2009. *Ex Parte* Reexamination Certificate No. 6,927, based on the 90/010,155 reexamination proceeding, issued July 14, 2009. In view of the issuance of the reexamination certificate, the need to consider the merger the above-identified reexamination proceedings is rendered moot.

Upon the mailing of this decision, reexamination proceeding control No. 90/010,472 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.



Gregory Morse, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,158	05/06/2008	6835723	1256-01464	6368

81391 7590 03/19/2009

Andrus, Scales, Starke & Sawall, LLP
100 East Wisconsin Avenue
Suite 1100
Milwaukee, WI 53202-4178

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/19/2009

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



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Thomas M. Wozny
Andrus, Sceales, Starke & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, WI 53202

For Patent Owner

Ex Parte Reexamination Proceeding
Control No. 90/010158
Filed: May 6, 2008
For: US Patent No. 6,835,723

MAILED

MAR 18 2009

CENTRAL REEXAMINATION UNIT

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

This is a decision on the petition filed March 13, 2009 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated January 14, 2009.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated January 14, 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

The petition for extension of time states that the substantial new question of patentability to be considered in this proceeding is obviousness type double patenting in view of USPN 6,627,622. A reissue application has been filed on the ‘622 patent concurrently with the present Request for Reexamination. Reissue applications have also been filed on two related patents. The patents have been licensed to a party represented by French attorneys who have requested input into the responses. An extension of time for one month is requested to provide Patent Owner to confer with the French attorneys.

Analysis and Findings

A full response to the outstanding Office action was filed on March 15, 2009. Therefore the request for an extension of time is unnecessary and the petition is dismissed.

•

The Patent Owner's petition for extension of time in which to file a response to the Office action dated February 8, 2008 is **dismissed**.

Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

for 
Gregory Morse,
Director,
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,167	05/15/2008	6213979	4195.002	7324

20995 7590 08/26/2009

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/26/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HOVEY WILLIAMS LLP
10801 MASTIN BLVD.
SUITE 1000
OVERLAND PARK, KS 66210

Date:

MAILED

AUG 26 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010167

PATENT NO. : 6213979

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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Knobbe, Martens, Olson & Bear, LLP (For Patent Owner)
2040 Main Street
14th Floor
Irvine, CA 92614

Scott R. Brown (For Third Party Requester)
Hovey Williams, LLP
10801 Mastin Blvd.
Suite 1000
Overland Park, KS 66210-1697

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AUG 26 2009

CENTRAL REEXAMINATION UNIT

In re Steven F. Bierman :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/010,167 : **DISMISSING**
Filed: May 15, 2008 : **PETITION UNDER**
For: U.S. Patent No. 6,213,979 : **37 CFR 1.137(b)**

This is a decision on the August 10, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination¹ ("the August 10, 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 10, 2009 patent owner petition to revive has been paid.

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

The August 10, 2009 patent owner petition to revive is **dismissed**.

¹ Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of May 8, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

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*

(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 August 10, 2009 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 August 10, 2009 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 May 8, 2009 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 certificate by making all pending claims patentable or (ii) a Notice of Appeal and appeal fee.²

Patent owner submitted a paper titled "Patent Owner's Response to Final Office Action" on August 10, 2009. The primary examiner for the instant reexamination proceeding has confirmed that the August 10, 2009 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 August 10, 2009 petition is incomplete.

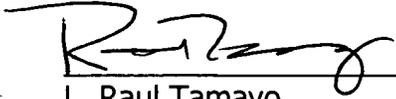
For the foregoing reasons, the August 10, 2009 patent owner petition to revive is **dismissed**.

CONCLUSION

1. The August 10, 2009 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 May 8, 2009 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, Beverly Flanagan, of CRU Art Unit 3993, at (571) 272-4766.

² 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.



L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,167	05/15/2008	6213979	4195.002	7324

20995 7590 09/30/2009

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
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EXAMINER

ART UNIT PAPER NUMBER

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SEP 3 0 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,167.

PATENT NO. 6213979.

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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2040 Main Street
14th Floor
Irvine, CA 92614

(For Patent Owner)

Scott R. Brown
Hovey Williams, LLP
10801 Mastin Blvd.
Suite 1000
Overland Park, KS 66210-1697

(For Third Party Requester)

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SEP 30 2009

CENTRAL REEXAMINATION UNIT

In re Steven F. Bierman
Ex Parte Reexamination Proceeding
Control No. 90/010,167
Filed: May 15, 2008
For: U.S. Patent No. 6,213,979

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

This is a decision on the September 24, 2009 patent owner renewed petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination ("the September 24, 2009 patent owner renewed petition to revive").

The September 24, 2009 patent owner renewed petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 24, 2009 patent owner renewed petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer*.

*

*

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

37 CFR 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the

prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

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

*

*

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

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 Renewed Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal and paid the corresponding fee of \$540.00 on September 24, 2009, thereby satisfying item (1).¹

A petition fee of \$1,620.00 was submitted as part of the August 10, 2009 patent owner petition to revive, thereby satisfying item (2).

Proper statements under 37 CFR 1.137(b)(3) were submitted on August 10, 2009, and September 24, 2009. Therefore, item (3) is deemed to have been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.²

Accordingly, the September 24, 2009 patent owner renewed petition to revive is **granted**.

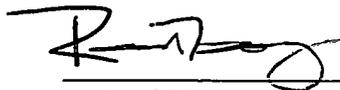
CONCLUSION

1. The September 24, 2009 patent owner renewed petition to revive under 37 CFR 1.137(b) is **granted**.
2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3993, for further processing in view of the September 24, 2009 Notice of Appeal, and for treatment of the August 10, 2009 Patent Owner's Response To Final Office Action in due course.
3. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).

¹ See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

² See: 37 CFR 1.137(d)(3).

4. 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.
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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,167	05/15/2008	6213979	4195.002	7324

20995 7590 12/08/2009

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FOURTEENTH FLOOR
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/08/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HOVEY WILLIAMS LLP
10801 MASTIN BLVD.
SUITE 1000
OVERLAND PARK, KS 66210

Date:

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010167
PATENT NO. : 6213979
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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14th Floor
Irvine, CA 92614

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Scott R. Brown
Hovey Williams, LLP
10801 Mastin Blvd.
Suite 1000
Overland Park, KS 66210-1697

(For Requester)

In re Bierman :
Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/010,167 : UNDER 37 CFR 1.181
Filed: May 15, 2008 :
For: U.S. Patent No.: 6,213,979 :

This is a decision on a petition filed by the patent owner on November 30, 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 enter the amendment filed on September 24, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated November 30, 2009 is denied with respect to entry of the amendment filed on September 24, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,213,979 (hereinafter, the '979 patent) issued on April 10, 2001.
2. A request for *ex parte* reexamination for claims 49, 50, 53, and 54 of the '979 patent, assigned control No. 90/010,167 (hereinafter, the '167 proceeding), was filed by a third party requester on May 15, 2008.
3. *Ex parte* reexamination was ordered for claims 49, 50, 53, and 54 of the '979 patent in the '167 proceeding on July 29, 2008.
4. The patent owner did not file a statement under 37 CFR 1.530.
5. On November 7, 2008, a non-final Office action, which rejected claims 49, 50, 53, and 54 based upon anticipation by Gordon '647, claims 49 and 50 based upon anticipation by Bierman '435, claims 49, 50, and 53 based upon anticipation by Sorbonne, and also claims 49, 50, and 53 based upon anticipation by Boyd, was mailed in the '167 reexamination proceeding.
6. On December 10, 2008, a personal interview was held. In the interview, claim interpretation was discussed. E.g., the meaning and scope of the phrase "means for limiting longitudinal movement of the medical line" in claim 49 was discussed. See the interview summary dated December 19, 2008.
7. On January 7, 2009, the patent owner filed a response, which included arguments and a declaration under 37 CFR 1.132 by Paul Frankhouse. No amendments were made to the claims.
8. On May 8, 2009, the Office issued a Final rejection Office action, which addressed the patent owner's response of January 7, 2009. The Office action which maintained the rejections of claims 49, 50, 53, and 54 based upon anticipation by Gordon '647, claims 49 and 50 based upon anticipation by Bierman '435, claims 49, 50, and 53 based upon anticipation by Sorbonne, and also claims 49, 50, and 53 based upon anticipation by Boyd.
9. On August 10, 2009, Patent Owner filed a response, a proposed amendment to claim 49, and a petition to revive under 37 CFR 1.137(b).
10. On August 26, 2009, the Office issued decision dismissing the petition to revive.

11. On September 24, 2009, the patent owner filed a response, a proposed amendment to claim 49, a notice of appeal and a renewed petition to revive under 37 CFR 1.137(b).
12. On September 30, 2009, a decision granting the petition to revive was mailed. Patent owner was given two months from the mailing date of the decision to file the appeal brief.
13. On November 4, 2009, the Office mailed an advisory action which stated that the proposed amendment of September 24, 2009 will not be entered. The advisory states that entry of the amendment raised new issues that would require further consideration and is not deemed to place the proceeding in better form for appeal.
14. On November 30, 2009, the patent owner filed an appeal brief and the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the amendment of September 24, 2009 be entered.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed amendment of September 24, 2009 because the proposed amendments "... do not raise new issues that would require further consideration and search, do not expand the scope of Claim 49, and do place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal." See page 2 of the petition.

The petitioner explains how the amendment of September 24, 2009 is commensurate with arguments presented for claim 49 in their response to the first Office action and were made in response to the examiner's claim interpretation in the Final Office action. See pages 3-6 of the petition. Specifically, the petitioner states that the addition of the phrases "and without substantially moving the received portion of the fitting," "in both longitudinal directions," and "in a non-occlusive manner" to describe operation of the "means for releaseably latching" and "means for limiting longitudinal movement" in claim 49 does not introduce any new issues because the phrases either clarify or more closely align the claim language with the arguments presented by the patent owner. See pages 3-6 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed amendment of September 24, 2009, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts

involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final Office action of May 8, 2009 sets forth the same grounds of rejection based on prior art as set forth in the first Office action. The patent owner chose not to make amendments to the claims in response to the first Office action, which would have been entered as a matter of right. The record shows the patent owner was aware of how the examiner was interpreting the means plus function language in claim 49 prior to their January 7, 2009 response. See the interview summary dated December 19, 2008, which summarizes the discussion of the interpretation of the phrase “means for limiting longitudinal movement.” In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed amendment of September 24, 2009 because the proposed amendment clarifies the claim language in response to the examiner’s claim interpretation explained in the Final Office action dated May 8, 2009, and therefore, could not have been presented earlier. The record, however, does not support this allegation.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the amendment of September 24, 2009 should not be entered because the addition of the phrases to claim 49 introduces new issues. First, it is noted that the patent owner did not show any support in the disclosure for the proposed amendments to claim 49.¹ Therefore, the amendment would require further consideration by the examiner because the examiner would have to make the determination as to whether the proposed amendments are supported by the original disclosure and to do introduce new matter. In addition, the issue regarding claim interpretation as to the means plus functional claim language was discussed during the interview of December 10, 2008. As discussed above, the patent owner, however, chose not to make any claim amendments to claim 49 in their January 7, 2009 response to the first Office action. It was only after the examiner maintained the rejection in the Final Office action and was not convinced by the January 7, 2009 response that the patent owner proposed claim amendments. Therefore, the record indicates that the patent owner was aware of how the examiner was interpreting the means plus functional language of claim 49 prior to the Final Office action, and chose not to make claim amendments in response to the first Office action.

In regard to patent owner’s arguments that the proposed amendment of September 24, 2009 should be entered because it aligns the claim language to previously presented arguments, the record does not support the patent owner’s contention that this does not raise new issues and simplifies issues for appeal. The Final Office action of May 8, 2009 makes it clear that the examiner did not consider the limitations argued by the patent owner in their January 7, 2009 response to be part of the claimed invention. See, e.g., the last paragraph on page 14, and pages

¹ The examiner did not explicitly state that the September 24, 2009 amendment failed to comply with 37 CFR 1.530(e) in the November 4, 2009 advisory action. The examiner, however, did state that the proposed amendment would raise new issues as discussed above, and the issue of support for the proposed amendment is an example of a new issue created by the proposed amendment.

9-10 of the Final Office action, dated May 8, 2009. Therefore, the record indicates that the examiner did not fully consider whether the prior art of record taught such limitations, as proposed to be added to claim 49, because such limitations were not part of the claimed invention. Therefore, it cannot be said that adding such limitations to claim 49 does not raise new issues.

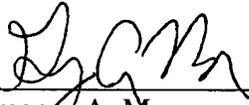
Finally, it is noted that the patent owner has filed an appeal brief on November 30, 2009. The appeal brief is based on the original claims of the '979 patent, and as required by Office rules, does not address the proposed amendments of September 24, 2009. It is also noted that patent owner has included similar arguments as presented in the September 24, 2009 response.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the amendment of September 24, 2009. The petition will not address the other issues (e.g., expanding the scope) as such is not required to decide this petition.

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 entry of the amendment dated September 24, 2009 is denied.
2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,168	05/16/2008	5889839	25587-030	9258

27683 7590 02/04/2010

HAYNES AND BOONE, LLP

IP Section

2323 Victory Avenue

Suite 700

Dallas, TX 75219

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Shawn G. Hansen

MANATT, PHELPS & PHILLIPS, LLP

1001 Page Mill Road, Building 2

Palo Alto, CA 94304

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CENTRAL REEXAMINATION UNIT

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REEXAMINATION CONTROL NO. 90/010,168.

PATENT NO. 5889839.

ART UNIT 3992.

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Wei Wei Jeang :
HAYNES AND BOONE, LLP : (For Patent Owner)
IP Section :
2323 Victory Avenue :
Suite 700 :
Dallas TX 75219 :

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CENTRAL REEXAMINATION UNIT

Shawn G Hansen :
MANATT PHELPS AND PHILLIPS : (For Third Party
ROBERT D. BECKER : Requester)
1001 PAGE MILL ROAD, BUILDING 2 :
PALO ALTO, CA 94304 :

In re: Beyda et alia : DECISION
Ex parte Reexamination Proceeding : DISMISSING
Control No. 90/010,168 : PETITION FOR EXTENSION
Deposited on: 16 May 2008 : OF TIME
For: US Patent No. 5,889,839 : 37 CFR §§ 1.550(c) & 1.181

This is a decision on the 27 January 2010, "Petition Under 37 C.F.R. § 1.550(c) and (e)" requesting that the time for responding to the Final Office action mailed 26 August 2009, be further extended by one (1) day. The petition was not timely filed.

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

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

DISCUSSION

The Patent Owner requests the period of time to be extended in which to file a response to the Final Office action mailed 26 August 2009. The petition for extension of time was not timely filed on 27 January 2010, together with fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

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

37 CFR § 1.550 (c) states:

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

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(e) states:

(e) If a response by the patent owner is not timely filed in the Office,
(1) The delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a); or

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

MPEP § 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. Any advisory Office action using form PTOL-467, Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief, which is issued in reply to patent owner's response after final rejection (and prior to the filing of the notice of appeal) will inform the patent owner of the automatic 1 month extension of time. It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. Note further that the patent owner is entitled to know the examiner's ruling on a timely response 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.

ANALYSIS AND FINDINGS

The patent owner's representative petitions under 37 CFR § 1.550(c) to extend the period for response by adding one (1) day to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Final rejection was mailed 26 August 2009. The petition was not timely filed.

37 CFR § 1.550(e) does provide for Director acceptance if shown to the Director's satisfaction that the delay was unavoidable. The petition notes a docketing error but does not provide all the details surrounding the when and why and what circumstances accounting for the delay.

37 CFR 1.550(e) does provide for acceptance of late papers pursuant to 37 CFR § 1.137

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

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the Office action dated 27 August 2009 is hereby dismissed as untimely.
2. Response may be submitted as follows:

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

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

By Hand: Customer Service Window
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Alexandria, VA 22314

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reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the “soft scanning” process is complete.

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

/Mark Reinhart/

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.
90/010,168	05/16/2008	5889839	25587-030	9258

27683 7590 03/25/2010

HAYNES AND BOONE, LLP

IP Section

2323 Victory Avenue

Suite 700

Dallas, TX 75219

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/25/2010

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



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REEEXAM CONTROL NUMBER	FILING OR 371 (c) DATE	PATENT NUMBER
90/010,168	05/16/2008	5889839

MANATT PHELPS AND PHILLIPS
ROBERT D. BECKER
1001 PAGE MILL ROAD BUILDING 2
PALO ALTO, CA 94304

CONFIRMATION NO. 9258
REEEXAMINATION REQUEST
NOTICE



Date Mailed: 06/10/2008

NOTICE OF REEXAMINATION REQUEST FILING DATE

(Third Party Requester)

Requester is hereby notified that the filing date of the request for reexamination is 05/16/2008, the date that the filing requirements of 37 CFR § 1.510 were received.

A decision on the request for reexamination will be mailed within three months from the filing date of the request for reexamination. (See 37 CFR 1.515(a)).

A copy of the Notice is being sent to the person identified by the requester as the patent owner. Further patent owner correspondence will be the latest attorney or agent of record in the patent file. (See 37 CFR 1.33). Any paper filed should include a reference to the present request for reexamination (by Reexamination Control Number).

cc: Patent Owner
SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

/rbell/

Legal Instruments Examiner
Central Reexamination Unit 571-272-7705; FAX No. 571-273-9900



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,168	05/16/2008	5889839	25587-030	9258

27683 7590 03/25/2010

RESEARCH IN MOTION
ATTN: GLENDA WOLFE
BUILDING 6, BRAZOS EAST, SUITE 100
5000 RIVERSIDE DRIVE
IRVING, TX 75039

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/25/2010

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Research in Motion
Attn: Glenda Wolfe
Building 6, Brazos East, Suite 100
5000 Riverside Drive
Irving, TX 75039

(For Patent Owner)

MAILED

MAR 25 2010

Shawn G. Hansen, Esq.
Manatt, Phelps & Phillips, LLP
1001 Page Mill Road, Building 2
Palo Alto, CA 94304

(For Requester)

CENTRAL REEXAMINATION UNIT

Haynes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(Courtesy Copy)

In re William J. Beyda et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,168
Filed: May 16, 2008
For: U.S. Patent No. 5,889,839

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

This is a decision on the February 17, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination¹ ("the February 17, 2010 patent owner petition to revive").

The February 17, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The February 17, 2010 patent owner petition to revive is **granted**.

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 August 26, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*
*

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

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

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

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

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

*
*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000.

Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*
*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal and paid the corresponding fee of \$540.00 on January 27, 2010, thereby satisfying item (1).²

The petition fee of \$1,620.00 was charged to patent owner on January 28, 2010, thereby satisfying item (2).

Patent owner's statements at the paragraph bridging pages 1 and 2 of the February 17, 2010 patent owner petition to revive are deemed to satisfy the requirement of 37 CFR 1.137(b)(3) to provide 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 was unintentional. Therefore, item (3) has been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.³

Accordingly, the February 17, 2010 patent owner petition to revive is **granted**.

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

³ See: 37 CFR 1.137(d)(3).

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 5,889,839 patent file is that of Research in Motion, Attn: Glenda Wolfe, Building 6, Brazos East, Suite 100, 5000 Riverside Drive, Irving, TX 75039.

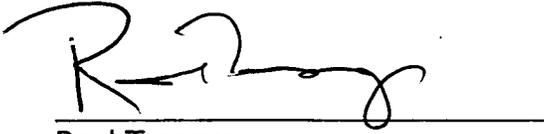
As a courtesy, this decision is being mailed to the address of Haynes and Boone, LLP, IP Section, 2323 Victory Avenue, Suite 700, Dallas, TX 75219, in view of the July 17, 2008 and April 24, 2009 Powers of Attorney in the file of the '10168 reexamination proceeding.

The address of Research in Motion, Attn: Glenda Wolfe, Building 6, Brazos East, Suite 100, 5000 Riverside Drive, Irving, TX 75039, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '839 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The February 17, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.
2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for further processing in view of the January 27, 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. The address of Research in Motion, Attn: Glenda Wolfe, Building 6, Brazos East, Suite 100, 5000 Riverside Drive, Irving, TX 75039, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '839 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, Fred Ferris III, of CRU Art Unit 3992, at (571) 272-3778.

6. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

A handwritten signature in black ink, appearing to read "R. Tamayo", is written over a horizontal line.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,172	05/21/2008	5,642,001	TI-18438X	3067

23494 7590 01/12/2009

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/12/2009

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



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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

(For Patent Owner)

In re Miyazaki
Reexamination Proceeding
Control No. 90/010,172
Request Deposited: May 21, 2008
For: U.S. Patent No. 5,642,001

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Miyazaki
Reexamination Proceeding
Control No. 90/010,267
Request Deposited: September 3, 2008
For: U.S. Patent No. 5,642,001

:
: MAILED
:
: JAN 12 2009
: CENTRAL REEXAMINATION UNIT

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,642,001 (hereinafter, the '001 patent), issued to Miyazaki, on June 24, 1997.
2. On May 21, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '001 patent. The reexamination proceeding was assigned Control No. 90/010,172 (hereinafter, the '10172 proceeding).
3. The Reexamination Order was granted in the '10172 proceeding on July 11, 2008 along with a Notice of Defective Paper indicating the amendment did not comply with 37 CFR 1.530.
4. On September 3, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '001 patent. The reexamination proceeding was assigned Control No. 90/010,267 (hereinafter, the '10267 proceeding).

5. The Reexamination Order was granted in the '10267 proceeding on October 22, 2008.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '10172 and the '10267 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.

An improper amendment had been filed in the '10172 proceeding and a proper amendment is of record in the '10267 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.

Art Unit: 3992

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. 90/010,172 and 90/010,267 are **merged**.
2. Patent Owner has **one month** from the date of this decision to submit a "housekeeping" amendment.
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.

Art Unit: 3992

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

Eric Keasel For

Gregory Morse

Director, Central Reexamination Unit



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David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

MAILED

NOV 19 2008

CENTRAL REEXAMINATION UNIT

Matthew A. Newboles
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

:
:
:
:
: DECISION MERGING
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

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

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.




Gregory Morse, Director
Central Reexamination Unit



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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.
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90/010,175

05/22/2008

5843073

CRD-001RX

5404

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

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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

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

EXAMINER

ART UNIT PAPER NUMBER

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90/09,188; 90/010,175; 90/010,194; 90/010,578;

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,196	06/16/2008	5843073	70422-25-01	2938
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76808	7590	11/17/2009		
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Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 11/17/2009

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

1-3

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

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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

48

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

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

For Patent Owner

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

For 3rd Party Requester
90/009,188

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 &
90/010,578

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

MAILED

NOV 17 2009

CENTRAL REEXAMINATION UNIT

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 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 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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Alexandria, VA 22313-1450
www.uspto.gov

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

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NOV 19 2008

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester) CENTRAL REEXAMINATION UNIT
90/009,186

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

(For 3rd Party Requester)
90/010,176

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

(For 3rd Party Requester)
90/010,197

Reexam Control No.: 90/009,186
Filed : June 13, 2008
For U.S. Patent No. : 6,159,203

Reexam Control No.: 90/010,176
Filed : May 22, 2008
For U.S. Patent No. : 6,159,203

Reexam Control No.: 90/010,197
Filed : June 16, 2008
For U.S. Patent No. : 6,159,203

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: DECISION MERGING
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the September 25, 2008 patent owner petition filed in each of the above-identified reexamination proceedings. The petition is entitled "Request for Consolidation of Multiple Co-Pending *Ex Parte* Reexamination Proceedings Under 37 C.F.R. § 1.565."

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

Relevant Authority

37 CFR 1.565(c) provides:

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

MPEP § 2283, Subsection VII, provides:

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2267.

While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine (37 CFR 1.525) on the second request, the better practice is to include any such petition with the patent owner's statement under 37 CFR 1.530, in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to 37 CFR 1.535 in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under 37 CFR 1.550(g).

All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or the CRU Special Program Examiner, if the CRU Director delegates it to him or her).

Consideration of Merger

A petition to merge *ex parte* reexamination proceeding 90/009,186 (the '186 proceeding), *ex parte* reexamination proceeding 90/010,176 (the '176 proceeding), and *ex parte* reexamination proceeding 90/010,197 (the '197 proceeding) was filed September 25, 2008 in each of the above-identified files. No fee was submitted, and none is required inasmuch as the Office will generally treat the issue of merger *sua sponte*, if no petition to merge is filed. Thus in this instance, the present petition is taken as being equivalent to a notice to the Office that merger should be considered.

Reexamination of the '186 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-3, 9-15, and 20-25 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '186 proceeding. Accordingly, the '186 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '176 proceeding was ordered in a decision mailed August 21, 2008. Reexamination was ordered for claims 1-26 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent

owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '176 proceeding. Accordingly, the '176 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '197 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-3, 8-15, and 20-25 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '197 proceeding. Accordingly, the '197 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

As evidenced by the above facts, the '186, '176, and '197 reexamination proceedings are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, and a patent owner's statement has not and now cannot be filed in any of those proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-26, which are all of the claims of the '203 patent and for which reexamination has been ordered, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each proceeding, and each action will be entered into each of the files (which will be maintained as separate electronic Image File Wrapper files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,186, 90/010,176 and 90/010,197 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Gregory Morse, Director
Central Reexamination Unit





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United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester)
90/009,185

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

(For 3rd Party Requester)
90/010,177

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

(For 3rd Party Requester)
90/010,198

Reexam Control No.: 90/009,185
Filed : June 13, 2008
For U.S. Patent No. : 6,547,780

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: DECISION MERGING
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

Reexam Control No.: 90/010,177
Filed : May 22, 2008
For U.S. Patent No. : 6,547,780

Reexam Control No.: 90/010,198
Filed : June 16, 2008
For U.S. Patent No. : 6,547,780

This is a decision on the September 25, 2008 patent owner petition filed in reexamination control number 90/010,177. The petition is entitled "Request for Consolidation of Multiple Co-Pending *Ex Parte* Reexamination Proceedings Under 37 C.F.R § 1.565."

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

Relevant Authority

37 CFR 1.565(c) provides:

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

MPEP § 2283, Subsection VII, provides:

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2267.

While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine (37 CFR 1.525) on the second request, the better practice is to include any such petition with the patent owner's statement under 37 CFR 1.530, in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to 37 CFR 1.535 in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under 37 CFR 1.550(g).

All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or to the CRU SPE if the CRU Director delegates it to him or her).

Consideration of Merger

The petition to merge *ex parte* reexamination proceeding 90/009,185 (the '185 proceeding), *ex parte* reexamination proceeding 90/010,177 (the '177 proceeding), and *ex parte* reexamination proceeding 90/010,198 (the '198 proceeding) was filed on September 25, 2008 in the file of '177 proceeding. No fee was submitted, and none is required inasmuch MPEP § as the Office will generally treat the issue of merger *sua sponte*, if no petition to merge is filed. Thus, in this instance, the present petition is taken as being equivalent to notice to the Office that merger should be considered.

Reexamination of the '185 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, and 7-12 of U.S. Patent No. 6,547,780 (the '780 patent). Concurrently with the filing of the present petition, patent owner filed a notice waiving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '185 reexamination proceeding. Accordingly, the '185 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination in the '177 proceeding was ordered in a decision mailed July 19, 2008. Reexamination was ordered for claims 1-14, i.e., all of the claims, of the '780 patent. The time for filing a patent owner's statement under 37 CFR 1.530 expired on September 19, 2008, without a patent owner's statement having been filed. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '711 reexamination proceeding. Accordingly, the '177 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination in the '198 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, and 7-12 of the '780 patent. Concurrently with the filing of the present petition, patent owner filed a notice waiving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '198 reexamination proceeding. Accordingly, the '198 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

As evidenced by the above facts, the '185, '177 and '198 reexamination proceedings are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, and a patent owner's statement has not been and now cannot be filed in any of those proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

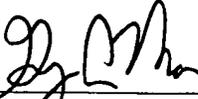
Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-14, which are all of the claims of the '780 patent and for which reexamination has been ordered, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each proceeding, and each action will be entered into each of the files (which will be maintained as separate electronic Image File Wrapper files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, appeal brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,185, 90/010,177 and 90/010,198 are hereby merged into a single proceeding. It being noted that the claims of record are identical in each of the merged *ex parte* reexamination proceedings, upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Gregory Morse, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,177	05/22/2008	6547780	CRD-003RX	5408

76808 7590 10/09/2008

Leason Ellis LLP
81 Main Street
Suite 100
White Plains, NY 10601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/09/2008

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www.uspto.gov

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

SCOTT WITONSKY
PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

MAILED

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,177.

PATENT NO. 6547780.

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)).



David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

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

(For 3rd Party Requester)

MAILED

OCT 09 2008

In re CardioFocus, Inc.
Ex Parte Reexamination Proceeding
Control No.: 90/010,177
Filed: May 22, 2008
For: U.S. Patent No. 6,547,780

:
: DECISION
: DISMISSING
: PETITION
:

CENTRAL REEXAMINATION UNIT

On September 25, 2008, patent owner filed a petition styled as "Petition to Suspend Action." No fee is required for the petition, which in this instance, is taken as a petition under 37 CFR 1.181 for the exercise of supervisory authority.

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

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

RELEVANT BACKGROUND

1. U.S. Patent No. 6,547,780 (hereinafter the '780 patent) issued on April 15 2003.
2. A request for *ex parte* reexamination of the '780 patent was deposited in the Office on May 22, 2008 by a third party requester, assigned control number 90/010,177 (the '0177 reexamination proceeding), and assigned a filing date of May 22, 2008.
3. Two other requests for *ex parte* reexamination of the '780 patent have been filed, 90/009,185 and 90/010,198, with all three reexamination requests having been filed by a different third party requester.
4. Reexamination was ordered in each of the three reexamination proceedings for the '780 patent.

5. Each of the three reexamination proceedings has reached the procedural stage in which it is ready for examination as to the patentability of the claims for which reexamination has been ordered.
4. On September 25, 2008 patent owner filed a petition to merge the '0177 reexamination proceeding with the two other requests for *ex parte* reexamination of the '780 patent.
5. Also on September 25, 2008, patent owner filed the present petition to suspend the '0177.

DECISION

The present petition has been filed to request that prosecution in the '0177 reexamination proceeding be suspended pending a merger of that proceeding with two other pending reexamination proceedings that are also directed to the '780 patent. A decision merging the three reexamination proceedings has been mailed on October 8, 2008. Accordingly, the present petition has become moot.

CONCLUSION

1. The petition for suspension of the '0177 reexamination proceeding is dismissed.
2. Jurisdiction over the '0177 reexamination proceeding is returned to the Central Reexamination Unit for action not inconsistent with the "Decision Merging *Ex Parte* Reexamination Proceedings" mailed on October 8, 2008.
3. Telephone inquiries related to this decision should be directed to undersigned, at (571) 272-7743, or in his absence, to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Stephen Marcus
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.
90/010,183	05/30/2008	5741966	626852000230	4442

25225 7590 07/08/2009
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/08/2009

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CLIFFORD A. ULRICH
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010183
PATENT NO. : 5741966
ART UNIT : 3993

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

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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,293	09/22/2008	5741966	80000.010.966	6087

25225 7590 07/08/2009
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/08/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010293
PATENT NO. : 5741966
ART UNIT : 3992

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Richard C. Kim
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

(For Patent Owner)

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

Clifford A. Ulrich
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NEW YORK 10004

(For Third Party Requester)

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

(For Third Party Requester)

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

In re: Handfield et alia
Ex Parte Reexamination Proceeding
Control No. 90/010,183
Deposited : 30 May 2008
For: US Patent No. 5,741,966

In re: Handfield et alia
Ex Parte Reexamination Proceeding
Control No. 90/010, 293
Deposited : 22 September 2008
For: US Patent No. 5,741,966

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

BACKGROUND

1. On 21 April 1998 US Patent No. 5,741,966 was granted to Handfield *et alia*.
2. On 30 May 2008 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,183.
3. On 02 July 2008 the Order was granted for *ex parte* reexamination in control number 90/010,183.
4. On 12 March 2009 a non-final Office action was mailed in 90/010,183.
5. On 12 June and 16 June 2009 amendments and remarks were received in 90/010,183.
6. On 22 September 2008 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,293.
7. On 11 December 2008 the Order was granted for *ex parte* reexamination in control number 90/010,293.
8. There are no amendments to the claims in control number 90/010,293.

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. 90/010,183 and 90/010,293 *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. 90/010,183 and 90/010,293 *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/
for

Gregory A. Morse,
Director,
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,185	06/03/2008	5367627	R62319B	7681
40401	7590	01/29/2010	EXAMINER	
Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 01/29/2010

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Ying Chen
CHEN YOSHIMURA LLP
255 S. Grand Ave., #215
Los Angeles, CA 90012

Date:

MAILED

JAN 29 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010185
PATENT NO. : 5367627
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)).



Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

MAILED

Ying Chen
CHEN YOSHIMURA LLP
255 S. Grand Ave., # 215
Los Angeles, CA 90012

(For Requester)

JAN 29 2010

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding
Jerome D. Johnson
Control No.: 90/010,185
Filed: June 3, 2008
For: U.S. Patent No.: 5,367,627

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

This is a decision on the October 5, 2009 patent owner paper entitled "Petition under 37 CFR 1.182 and PTO Official Gazette of March 1, 2005 to Enter Declarations and After-Final Responses," which is being taken as a request for continued reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to petitioner's credit card in accordance with petitioner's October 5, 2009 authorization in the Payment Information section of their EFS-WEB Electronic Acknowledgement Receipt.

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

REVIEW OF THE FACTS

1. On November 22, 1994, U.S. Patent 5,367,627 (the '627 patent) issued to Jerome D. Johnson.
2. On June 3, 2009, a request for *ex parte* reexamination of claims 1, 6-8 of the '627 patent was filed by a third party requester. The request was assigned reexamination control number 90/010,185 (the '10185 proceeding).
3. On July 22, 2008, the Office issued an order granting the '10185 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1, 6-8 of the '627 patent, would be subject to reexamination.
4. On July 29, 2008, a notice of the filing of the '10185 *ex parte* reexamination was published in the *Official Gazette*.

5. On September 22, 2008, the time period for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10185 *ex parte* reexamination proceeding expired without the submission of a statement by the patent owner.
6. On November 26, 2008, a first Office action on the merits issued rejecting claims 1, 6-8 as unpatentable over dBASE.
7. On December 3, 2008, the November 26, 2009 first Office action on the merits rejecting claims 1, 6-8 as unpatentable over dBASE was remailed. The remailing of the Office action reset the time period for response.
8. On February 3, 2009, patent owner filed a response adding new claims 16-39 and only providing remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.
9. On March 11, 2009, patent owner conducted an interview with the examiner of record.
10. On March 13, 2009, patent owner submitted an information disclosure statement (IDS).
11. On March 19, 2009, patent owner *sua sponte* filed a supplemental response adding new claims 16-40 and providing additional remarks asserting patentability over the prior art of record. Patent owner also submitted a notice of concurrent proceedings, namely five different co-pending patent infringement litigation proceedings on the '627 patent in the Federal District Court for the Eastern District of Texas.
12. On April 7, 2009, patent owner submitted a statement of the substance of the March 11, 2009 interview in accordance with 37 CFR 1.560(b).
13. On May 4, 2009, a final Office action was issued in the '10185 proceeding rejecting claims 1, 6-8 and 16-40 as unpatentable.
14. On July 2, 2009, patent owner submitted an after-final response under 37 CFR 1.116 consisting entirely of remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.
15. On July 29, 2009, patent owner submitted a supplemental after-final response consisting of a declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne.
16. On September 4, 2009, patent owner, with Dr. V. Thomas Rhyne, conducted an interview with the examiner of record.
17. On September 10, 2009, the Office issued an advisory action responding to patent owner's after final submissions. The Rhyne declaration, which was filed after a final action, but before the filing of a notice of appeal, was not entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented in accordance with 37 CFR 1.116(e).

18. On October 5, 2009, patent owner filed a notice of appeal in the '10185 proceeding.
19. Also on October 5, 2009, patent owner filed another declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne, a statement of the substance of the September 10, 2009 interview in accordance with 37 CFR 1.560(b), a second response after final under 37 CFR 1.116 and two petitions under 37 CFR 1.181 requesting supervisory review.
20. Finally, on October 5, 2009, patent owner filed a petition under 37 CFR 1.182 requesting entry of all after final submissions, to include all after-final responses and declarations in the '10185 proceeding.
21. On November 23, 2009, patent owner submitted a status inquiry regarding the petitions submitted on October 5, 2009.
22. On December 4, 2009, patent owner submitted an appeal brief.
23. This decision is in response to the October 5, 2009 patent owner petition requesting the opening of prosecution to permit and entry of the after-final affidavit evidence and responses.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '10185 reexamination proceeding to provide consideration of the Rhyne declarations filed on July 29, 2009 and October 5, 2009 along with all other after-final communications submitted in response to the May 4, 2009 final Office action.

In March of 2005, the Office issued a notice¹ which provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances.

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 for *ex parte* reexamination which mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Further, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a

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

showing that that patent owner has made a *bona fide* effort during the proceeding to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

Based on the facts and circumstances of the present case, petitioner patent owner's response in the form of a request to enter evidence after final rejection, i.e., the Rhyne declarations of July 29, 2009 and October 5, 2009 have not been shown to be a *bona fide* effort to advance prosecution and as such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner makes three arguments to justify the granting of the extraordinary relief of reopening prosecution and entry of papers: (1) The July 29, 2009 37 CFR 1.132 declaration does not raise new issues and should be entered because it addresses the same issues argued of record by providing additional evidence in support of patent owner's position; and (2) the July 29, 2009 37 CFR 1.132 declaration is essential to understand Dr. Rhyne's September 4, 2009 interview comments; (3) The October 5, 2009 37 CFR 1.132 declaration and second after final response address the new issue of "overlap" raised by the examiner in the September 4, 2009 interview and the May 4, 2009 final Office action presented a new grounds of rejection based upon the "overlap" issue (as evidenced by the Interview Summary and Advisory Action) and therefore constitutes a newly raised issue patent owner has not had an opportunity to respond to, justifying continued reexamination.

The July 29, 2009 Rhyne Declaration. Petitioner's arguments to justify the granting of the relief of a request for continued reexamination and entry of the declaration is that (1) the declaration does not raise new issues and should be entered because it addresses the same issues argued of record by providing additional evidence in support of patent owner's position and (2) entry of the declaration is necessary to understand Dr. Rhyne's answers during the September 4, 2009 interview. The granting of a request for continued reexamination under ordinary circumstances where the petitioner was in control of the prosecution of the proceeding in the normal course of examination could have made a submission without delaying the proceeding is contrary to the mandate of special dispatch. Specifically, after the first Office action but before the final Office action, petitioner did not submit the July 29, 2009 Rhyne declaration with the response to the first Office action. Such inaction is contrary to an appropriate basis for granting of a request for continued reexamination. As to the first argument, petitioner's only statement to justify the granting of a request for continued reexamination and entering the declaration is that the declaration "simply addresses the same issues" that the examiner and patent owner already argued and counter argued. Contrary to petitioner's assertion, it is unreasonable for petitioner to justify continued reexamination and reopening of prosecution of a reexamination proceeding based upon the submission of a declaration delayed until almost three months after final

rejection, because it is cumulative of the arguments and submissions previously presented during open prosecution. Presentation of merely cumulative information is not a “*bona fide* effort to advance prosecution” such that the benefits of reopening prosecution would outweigh the delays in view of the statutory mandate of conducting the proceeding with special dispatch.

Regarding the second argument, an understanding of Dr. Rhyne’s September 4, 2009 interview comments, petitioner asserts the record requires Dr. Rhyne’s credentials from the declaration to serve as a foundation to establish his expertise. However, the comments in the interview do not require an evidentiary foundation to establish a party’s expertise. Furthermore, petitioner had previous opportunities to submit such optional, credibility enhancing information, e.g. at the time of the interview or in their 37 CFR 1.560(b) summary of the interview, but chose not to do so. Therefore, petitioner has provided no justifiable reason as to why the July 29, 2009 Rhyne declaration should be entered. Accordingly, the arguments are not persuasive. It is to be noted that while reopening for continued reexamination will not be granted, the rules are waived to the extent that a declaration limited solely to establishing Dr. Rhyne’s credentials to serve as a foundation to establish his expertise will be entered, since entry of same will not raise new issues as to the merits and will not delay the advance of prosecution. The examiner can simply proceed to consider patent owner’s appeal brief of December 4, 2009.

The October 5, 2009 Submissions. Regarding the October 5, 2009 supplemental Rhyne declaration and the second after final response, petitioner’s sole argument to justify the granting of the relief of a request for continued reexamination, and entry of the declaration and second after final response, is that based upon the alleged “new” issue of “overlap” raised by the examiner in the September 4, 2009 interview. The thrust of petitioner’s argument is that the September 4, 2009 interview apparently injected an interpretation of the prior art and/or claims regarding the potential for text and graphics to be understood as overlapping concepts instead of separate and distinct. Accordingly, as per petitioner’s argument, the examiner’s discussion of this interpretation with patent owner’s expert somehow changed the May 4, 2009 final rejection in such a manner as to constitute a new grounds of rejection that merits the granting of a request for continued reexamination, entry of the October 5, 2009 Rhyne supplemental declaration along with a second after final response.

Contrary to petitioner’s assertion, it is unreasonable for petitioner to justify continued reexamination and reopening of prosecution of a reexamination proceeding based upon an *ex post* discussion documented in the September 4, 2009 interview’s summary. The assertion is untenable, as under current policy, practice and procedure interview summary comments do not serve as grounds of rejection, nor can they alter a grounds of rejection previously made of record. Therefore, the comments regarding “overlap” are not a rejection of the claims, nor are they part of a stated rejection of record. The interview comments, at best, are simply part of an after-final interview discussion between patent owner’s expert and the examiner of record, where issues of claim interpretation were discussed. And, there is no showing that these asserted “overlap” issues could not have been addressed during open prosecution, rather than petitioner choosing to do so only after receiving a final rejection and submitting an after-final amendment and a supplemental after-final response. In the December 3, 2008 re-mailed non-final first Office action for this proceeding, claim 8 was rejected, stating that the proposal (catalogue) includes graphical information (the text in Fig. 8-15 is graphical information) corresponding to the customer’s requirements, and that based on this evidence it is clear that dBASE discloses each

and every limitation of claim 8, thus anticipating the claim. Thus, a "text = graphics" claim term interpretation was communicated to patent owner by the examiner from the beginning of prosecution. The "text = graphics" claim interpretation issue could have been fully discussed and clarified in any interview before final rejection, rather than waiting for an interview after the second (supplemental) response to final rejection. Patent owner did argue the "text = graphics" claim interpretation issue in Patent Owner's February 3, 2009 response² and discussed it during the March 11, 2009 interview.³ However, the examiner was not persuaded, and the grounds of rejection to claim 8, using the "text = graphics" claim interpretation, was maintained in the final Office action of May 4, 2009.⁴ To the extent that the examiner's actions regarding patent owner's February 3, 2009 response may be asserted to not be proper, e.g. the failure to fully respond to a patent owner's argument in regards to claim 8, the sole proper vehicle for actions taken by an examiner is under 37 CFR 1.181 and not under 37 CFR 1.182.

The effect of entry of the supplemental declaration and second response after final would be contrary to the conduct of reexamination proceedings with the statutory mandate of special dispatch. Congressional intent for 35 U.S.C. § 305 was for reexamination to provide a speedy alternative to litigation of issued patents. The statute explicitly states that reexamination proceedings are to be conducted with special dispatch. A continuation of examination for reexamination proceedings on issued patents, absent extraordinary equitable reasons for such continuation, runs contrary to § 305. Any continuation of a reexamination proceeding must be weighed against the legislative history behind the enactment of § 305, which expresses an intent for rapid and compact reexamination proceedings.⁵ It is also noted that both a Notice of appeal and an appeal brief have been filed in the proceeding. Granting petitioner's request to reopen prosecution would require pulling the proceeding back from the appeal brief stage. In the instant petition, petitioner has not persuasively shown that patent owner has made a *bona fide* effort during the proceeding to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate with special dispatch, to justify the delay resulting from continued prosecution in view of the clear statutory mandate of § 305.

To the extent that patent owner's arguments raise a petitionable issue asserting that a rejection was made in error, or that the examiner raised new grounds of rejection in the final Office action of May 4, 2009, that is directed to an action taken by the examiner. The sole proper vehicle for actions taken by an examiner is under 37 CFR 1.181 and not 37 CFR 1.182. Petitioner has filed petitions on October 5, 2009 under 37 CFR 1.181, not yet decided, to seek relief from the examiner's actions during examination.

As a final point, a petition under 37 C.F.R. § 1.182, for relief not otherwise provided under the regulations, is a highly fact-specific inquiry. Based on the facts and circumstances of the present proceeding, reopening of the examination of the '10185 reexamination proceeding and entering the Rhyne declarations filed on July 29, 2009 and October 5, 2009 along with all other after-final

² See the remarks section of the February 3, 2009, page 25, the first and second full paragraphs.

³ See the March 11, 2009 Examiner Interview Summary, page 4, last paragraph. See also Applicant's April 7, 2009 Statement of Substance of Interview under 37 CFR 1.560(b), page 8, last paragraph.

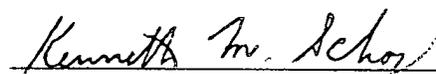
⁴ See page 6 of the Office action where the examiner maintains the grounds of the rejection to claim 8 and see page 31 where the examiner comments on patent owner's arguments regarding claim 8.

⁵ A comprehensive discussion of the statutory mandate for special dispatch can be found in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

communications submitted in response to the May 4, 2009 final Office action, is not warranted. Accordingly, the § 1.182 petition is deemed insufficient to satisfy the requirements set forth in the Notice. In view of the above and the facts and circumstances of record, the petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.
2. The rules are waived to the extent that a declaration limited solely to establishing Dr. Rhyne's credentials to serve as a foundation to establish his expertise will be entered, since entry of same will not raise new issues as to the merits and will not delay the advance of prosecution.
3. Jurisdiction for the '10185 reexamination proceeding is returned to the Central Reexamination Unit (CRU).
4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.



Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet7/
1-22-10



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Alexandria, VA 22313-1450
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JUN 29 2010

CENTRAL REEXAMINATION UNIT

HersHKovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

Ying Chen
CHEN YOSHIMURA LLP
255 S. Grand Ave., # 215
Los Angeles, CA 90012

(For Requester)

In re Reexamination Proceeding
Jerome D. Johnson
Control No.: 90/010,185
Filed: June 3, 2008
For: U.S. Patent No.: 5,367,627

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

This is a decision on the October 5, 2009, "Petition under 37 C.F.R. § 1.181 and MPEP 1002.02(c)(3)(a) to Have the Expert Declaration Entered" requesting that the "expert declaration of July 7, 2009¹" should be entered into the reexamination record. The patent owner has petitioned under 37 CFR § 1.181(a)(3).

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

The petition is dismissed for the reasons set forth below.

¹ The record does not show an expert declaration dated "July 7, 2009." It is assumed that petitioner meant the declaration by Dr. V. Thomas Rhyne, dated July 29, 2009, in the reexamination record. The advisory action addressed papers filed on July 2, 2009 and July 29, 2009. The only declaration filed amongst these papers was the declaration by Dr. V. Thomas Rhyne, dated July 29, 2009.

REVIEW OF THE FACTS

1. On November 22, 1994, U.S. Patent 5,367,627 (the '627 patent) issued to Jerome D. Johnson.
2. On June 3, 2009, a request for *ex parte* reexamination of claims 1, 6-8 of the '627 patent was filed by a third party requester. The request was assigned reexamination control number 90/010,185 (the '10185 proceeding).
3. On July 22, 2008, the Office issued an order granting the '10185 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1, 6-8 of the '627 patent, would be subject to reexamination.
4. On July 29, 2008, a notice of the filing of the '10185 *ex parte* reexamination was published in the *Official Gazette*.
5. On September 22, 2008, the time period for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10185 *ex parte* reexamination proceeding expired without the submission of a statement by the patent owner.
6. On November 26, 2008, a first Office action on the merits issued rejecting claims 1, 6-8 as unpatentable over dBASE.
7. On December 3, 2008, the November 26, 2009 first Office action on the merits rejecting claims 1, 6-8 as unpatentable over dBASE was remailed. The remailing of the Office action resent the time period for response.
8. On February 3, 2009, patent owner filed a response adding new claims 16-39 and only providing remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.
9. On March 11, 2009, patent owner conducted an interview with the examiner of record.
10. On March 13, 2009, patent owner submitted an information disclosure statement (IDS).
11. On March 19, 2009, patent owner *sua sponte* filed a supplemental response adding new claims 16-40 and providing additional remarks asserting patentability over the prior art of record. Patent owner also submitted a notice of concurrent proceedings, namely five different co-pending patent infringement litigation proceedings on the '627 patent in the Federal District Court for the Eastern District of Texas.
12. On April 7, 2009, patent owner submitted a statement of the substance of the March 11, 2009 interview in accordance with 37 CFR 1.560(b).
13. On May 4, 2009, a final Office action was issued in the '10185 proceeding rejecting claims 1, 6-8 and 16-40 as unpatentable.

14. On July 2, 2009, patent owner submitted an after-final response under 37 CFR 1.116 consisting entirely of remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.
15. On July 29, 2009, patent owner submitted a supplemental after-final response consisting of a declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne (hereinafter "the July 29, 2009 expert declaration").
16. On September 4, 2009, patent owner, with Dr. V. Thomas Rhyne, conducted a second interview with the examiner of record.
17. On September 10, 2009, the Office issued an advisory action responding to patent owner's after final submissions. The Rhyne declaration, which was filed after a final action, but before the filing of a notice of appeal, was not entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented in accordance with 37 CFR 1.116(e).
18. On October 5, 2009, patent owner filed a notice of appeal in the '10185 proceeding.
19. Also on October 5, 2009, patent owner filed another declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne, a statement of the substance of the September 10, 2009 interview in accordance with 37 CFR 1.560(b), a second response after final under 37 CFR 1.116 and two petitions under 37 CFR 1.181 requesting supervisory review.
20. Finally, on October 5, 2009, patent owner filed a petition under 37 CFR 1.182 requesting entry of all after final submissions, to include all after-final responses and declarations in the '10185 proceeding.
21. On December 4, 2009, patent owner submitted an appeal brief.
22. On January 29, 2010, the Office mailed a decision dismissing the petition under 37 CFR 1.182.
23. On March 2, 2010, the Office mailed a "Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination.
24. On March 26, 2010, patent owner filed a petition under 37 CFR 1.181 for supervisory review of the decision mailed January 29, 2010.
25. On March 31, 2010, patent owner filed a replacement appeal brief.
26. On June 7, 2010, the Office mailed an advisory action that stated the supplemental declaration, dated October 5, 2009, is not entered.
27. This decision is in response to the October 5, 2009 patent owner petition under 37 CFR 1.181 requesting the entry of the declarations dated July 29, 2009 and October 5, 2009.

DISCUSSION

In response to patent owner's arguments that the examiner erred in not entering the July 29, 2009 expert declaration, the director finds there are not good and sufficient reasons to enter the declaration. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection. See MPEP 2271.

The criteria for entry of evidence declarations in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP § 716.01 for entry of evidence declarations in an application. The policy regarding timeliness states in part:

"Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection, *
- (3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e);..."

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 with the request that the dBase reference raised a substantial new question of patentability for claims 1 and 6-8. Reexamination was not requested or granted for claims 2-5 and 9-15 of the '627 patent. The patent owner chose not to file comments under 37 CFR 1.530. The first Office action dated December 3, 2008, set forth an anticipation rejection based on the dBase reference. Patent owner filed a response of February 3, 2009. No amendments were made to original claims 1 and 6-8. Proposed new claims 16-39 were added. On March 19, 2009, patent owner filed a supplemental response which added proposed new claim 40. The final Office action maintained all of the anticipation rejection 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 it is inconsistent for the examiner to state that she agreed to consider the opinions of Dr. Rhyne in the interview summary of the September 4, 2009 interview and then refuse to enter the July 29, 2009 expert declaration by Dr. Rhyne. Patent owner also argues that the July 29, 2009 expert declaration should be entered because it "... has already become an integral part of the written record because detailed verbal statements have been attributed to him [Dr. Rhyne] through the Interview Summary." See page 3 of the petition. Patent owner states that the required showing as to why the declaration is necessary and was not presented earlier is met by the references made to the declaration by the examiner in the record, and that entry of the July 29, 2009 expert declaration is necessary to establish the expert's credentials and lay a background. Finally, the patent owner conditionally requests entry of a supplement expert declaration filed on October 5, 2009.

Patent owner's arguments pertaining to the allegation that the final was premature will not be addressed in this decision. Such arguments are untimely under 37 CFR 1.181(f), as explained in a separate decision, which addresses the second petition under 37 CFR 1.181 filed on October 5, 2009.

In reviewing the record, the examiner provided the patent owner information and references that are useful in defining the position of the Office, which has been consistently maintained. 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 July 22, 2008, clearly stated how the teachings of the dBase reference apply to claims 1 and 6-8 in the analysis of whether there is a substantial new question of patentability. See, e.g., pages 6-7 of the order. Likewise, the first Office action, dated December 3, 2009, also made it clear that the examiner's position as to how the teachings of the dBase reference applies to claims 1 and 6-8. See, e.g., pages 5-8 of the December 3, 2009 Office action. The record also shows that the final rejection maintained the anticipation rejection based upon the dBase reference, and repeated the **identical grounds**. See, pages 3-6 in the May 4, 2009 Office action. Therefore, the record shows that the patent owner was consistently and clearly notified of the basis for the anticipation rejection, e.g., how the dBase reference applies to the claimed invention.

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 dBase reference. These arguments are untimely and are

addressed in a separate decision in response to the second petition under 37 CFR 1.181 filed on October 5, 2009. To reiterate, in the interview summary and advisory action, the examiner was addressing arguments made by the patent owner, not modifying or altering the grounds of rejection made in the earlier-mailed final rejection.

In response to patent owner's arguments regarding entry of the July 29, 2009 expert declaration, such arguments are not persuasive. First, the interview summary of September 4, 2009 stated that the examiner will consider Dr. Rhyne's opinions presented in the interview. It did not give any indication that the examiner will enter the July 29, 2009 expert declaration, nor did the examiner's statement in the interview summary give *carte blanche* for entry for any and all expert declarations by Dr. Rhyne. In addition, patent owner's arguments that the July 29, 2009 expert declaration should be entered because the record contains a discussion of Dr. Rhyne's opinions are without merit. The record clearly shows that patent owner has had ample opportunity to submit evidence in the submission of the response and supplemental response to the non-final Office action, and in the interview of March 11, 2009, which was prior to the final rejection. Specifically, after the first Office action but before the final Office action, petitioner did not submit the Rhyne declarations with the response to the first Office action. Such inaction is contrary to statutory requirement for special dispatch. In the petition, patent owner attempts to justify the delay in submitting the expert declaration by stating "... it is only after the final rejection was issued that Patent Owner's representative realized that the Examiner was still insisting on making a rejection that quite simply is not supportable, in spite of the detailed explanation given in the Response to the non-final rejection." See page 5 of the petition. This statement clearly indicates that patent owner's representative made an intentional choice to only present arguments (and not evidence) in response to the non-final Office action. While petitioner patent owner states that it was reasonable for the patent owner to rely upon arguments in responding to the non-final action, it is not clear why it became unreasonable for the patent owner to rely upon arguments *only* after a final Office action was mailed. Thus, the petition does not present a persuasive reason why the need for the declarations could not have been earlier anticipated. As pointed out by the examiner in the advisory actions, the request for entry of the after-final evidence fails for want of a persuasive explanation of why the declaration is necessary and was not earlier filed, as required by 37 CFR 116(e).

In addition, petitioner asserts the record requires Dr. Rhyne's credentials from the declaration to serve as a foundation to establish his expertise. However, the comments in the interview do not require an evidentiary foundation to establish a party's expertise. Furthermore, petitioner had opportunities to submit such optional, credibility information, e.g. at the time of the interview or in their 37 CFR 1.560(b) summary of the interview, but chose not to do so. In addition, the fact that patent owner obtained entry of Dr. Rhyne's opinions in the record through the interview of September 4, 2009 mitigates the need for the late entry of the July 29, 2009 and the October 5, 2009 expert declarations. Therefore, petitioner has provided no justifiable reason as to why the July 29, 2009 expert declaration and the October 5, 2009 supplemental declaration should be entered. Therefore, the record does not support that entry of the July 29, 2009 expert declaration and the October 5, 2009 supplemental dispatch is necessary, and is not violating the statutory mandate for special dispatch.

The record shows that the examiner appropriately followed Office policies and procedures, e.g., as set forth in MPEP 2271 and 716.01, in making the determination that the July 29,

2009 expert declaration and the October 5, 2009 supplemental declaration should not be entered 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 not enter the July 29, 2009 and October 5, 2009 expert declarations. Accordingly, the petition is dismissed.

CONCLUSION

1. The patent owner's petition under 37 CFR § 1.181 to enter the declarations, dated July 29, 2009 and October 5, 2009, 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.

4. Telephone inquiries with regard to this decision should be directed to Supervisory Patent Examiner Eric Keasel at (571) 272-4929.



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
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JUN 29 2010

CENTRAL REEXAMINATION UNIT

HersHKovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

Ying Chen
CHEN YOSHIMURA LLP
255 S. Grand Ave., # 215
Los Angeles, CA 90012

(For Requester)

In re Reexamination Proceeding
Jerome D. Johnson
Control No.: 90/010,185
Filed: June 3, 2008
For: U.S. Patent No.: 5,367,627

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

This is a decision on the October 5, 2009, "Petition under 37 C.F.R. § 1.181 and MPEP 1002.02(c)(3)(a) and MPEP 706.07(e) to Withdraw Premature Final Rejection" requesting that the final rejection of May 4, 2009 should be withdrawn as premature. The patent owner has petitioned under 37 CFR § 1.181(a)(3).

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

The petition is dismissed as untimely for the reasons set forth below, without consideration of the merits.

REVIEW OF THE FACTS

1. On November 22, 1994, U.S. Patent 5,367,627 (the '627 patent) issued to Jerome D. Johnson.
2. On June 3, 2009, a request for *ex parte* reexamination of claims 1, 6-8 of the '627 patent was filed by a third party requester. The request was assigned reexamination control number 90/010,185 (the '10185 proceeding).
3. On July 22, 2008, the Office issued an order granting the '10185 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1, 6-8 of the '627 patent, would be subject to reexamination.
4. On July 29, 2008, a notice of the filing of the '10185 *ex parte* reexamination was published in the *Official Gazette*.
5. On September 22, 2008, the time period for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10185 *ex parte* reexamination proceeding expired without the submission of a statement by the patent owner.
6. On November 26, 2008, a first Office action on the merits issued rejecting claims 1, 6-8 as unpatentable over dBASE.
7. On December 3, 2008, the November 26, 2009 first Office action on the merits rejecting claims 1, 6-8 as unpatentable over dBASE was remailed. The remailing of the Office action resent the time period for response.
8. On February 3, 2009, patent owner filed a response adding new claims 16-39 and only providing remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.
9. On March 11, 2009, patent owner conducted an interview with the examiner of record.
10. On March 13, 2009, patent owner submitted an information disclosure statement (IDS).
11. On March 19, 2009, patent owner *sua sponte* filed a supplemental response adding new claims 16-40 and providing additional remarks asserting patentability over the prior art of record. Patent owner also submitted a notice of concurrent proceedings, namely five different co-pending patent infringement litigation proceedings on the '627 patent in the Federal District Court for the Eastern District of Texas.
12. On April 7, 2009, patent owner submitted a statement of the substance of the March 11, 2009 interview in accordance with 37 CFR 1.560(b).
13. On May 4, 2009, a final Office action was issued in the '10185 proceeding rejecting claims 1, 6-8 and 16-40 as unpatentable.

14. On July 2, 2009, patent owner submitted an after-final response under 37 CFR 1.116 consisting entirely of remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.
15. On July 29, 2009, patent owner submitted a supplemental after-final response consisting of a declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne.
16. On September 4, 2009, patent owner, with Dr. V. Thomas Rhyne, conducted a second interview with the examiner of record.
17. On September 10, 2009, the Office issued an advisory action responding to patent owner's after final submissions. The Rhyne declaration, which was filed after a final action, but before the filing of a notice of appeal, was not entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented in accordance with 37 CFR 1.116(e).
18. On October 5, 2009, patent owner filed a notice of appeal in the '10185 proceeding.
19. Also on October 5, 2009, patent owner filed another declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne, a statement of the substance of the September 10, 2009 interview in accordance with 37 CFR 1.560(b), a second response after final under 37 CFR 1.116 and two petitions under 37 CFR 1.181 requesting supervisory review.
20. Finally, on October 5, 2009, patent owner filed a petition under 37 CFR 1.182 requesting entry of all after final submissions, to include all after-final responses and declarations in the '10185 proceeding.
21. On December 4, 2009, patent owner submitted an appeal brief.
22. On January 29, 2010, the Office mailed a decision dismissing the petition under 37 CFR 1.182.
23. On March 2, 2010, the Office mailed a "Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination.
24. On March 26, 2010, patent owner filed a petition under 37 CFR 1.181 for supervisory review of the decision mailed January 29, 2010.
25. On March 31, 2010, patent owner filed a replacement appeal brief.
26. On June 7, 2010, the Office mailed an advisory action that stated the supplemental declaration, dated October 5, 2009, is not entered.
27. This decision is in response to the October 5, 2009 patent owner petition under 37 CFR 1.181 requesting the opening of prosecution to the final being premature.

DISCUSSION

The Patent Owner requests that the final rejection, dated May 4, 2009, be withdrawn. The petitioner considers the final Office action improper because it is allegedly contained a new ground of rejection which was not necessitated by amendments.

The request to withdraw the final Office action is dismissed, as untimely.

STATEMENT OF RELEVANT AUTHORITY

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within **two months** of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. **This two-month period is not extendable.** (Emphasis added.)

...

DECISION

The patent owner brings before the Office a petition under 37 CFR § 1.181 to withdraw Final rejection, dated May 4, 2009, as improper because it is allegedly not consistent with the policies set forth in MPEP 706.07(a). The patent owner filed the petition on October 5, 2009. The action from which relief is requested is the Final rejection, which was mailed on May 4, 2009. The assertion that petitioner was not aware that the Final rejection was premature until receipt of the September 10, 2009 advisory action is untenable. Under current Office policy, practice and procedure, interview summary comments do not serve as grounds of rejection, nor can they alter a grounds of rejection previously made of record. Therefore, the comments regarding "overlap" are not a rejection of the claims, nor are they part of a stated rejection of record. The interview comments, at best, are simply part of an after-final interview discussion between patent owner's expert and the examiner of record, where issues of claim interpretation were discussed. The advisory action, dated June 25, 2009, did not set forth the new grounds of rejection, which is the basis of the relief being requested, but only explained why the request for reconsideration, dated September 10, 2009, did not place the proceedings in condition for allowance and/or responded to arguments made in the after-final response. Therefore, the petition was filed over **two months** from the mailing date of the action (May 4, 2009) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two months** from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. The patent owner's petition under 37 CFR § 1.181 to withdraw the finality of the Office action, dated May 4, 2009, is hereby **dismissed**, as untimely, without consideration of the merits.
2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

3. Response should be addressed as follows:

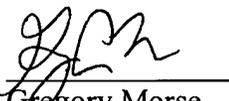
By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence.

4. Telephone inquiries with regard to this decision should be directed to Supervisory Patent Examiner Eric Keasel at (571) 272-4929.



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

Dann, Dorfman, Herrell & Skillman
1601 Market Street
Suite 2400
Philadelphia, PA 19103-2307

(For Patent Owner)

MAILED

JAN 21 2009

Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, MA 01742-9133

(For 3rd Party Requester)
90/008,692

CENTRAL REEXAMINATION UNIT

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For 3rd Party Requester)
90/010,186

Reexam Control No.: 90/008,692
Filed : June 11, 2007
For U.S. Patent No. : 5,645,081

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,186
Filed : June 3, 2008
For U.S. Patent No. : 5,645,081

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,692 was ordered in a decision mailed September 4, 2007 indicating that claims 1-6, 8, 11, 13-14, 16-17, 30, 39-44, 46, 49, 54-59, 61, and 64 would be reexamined. A non-final Office action was mailed February 28, 2008. Patent Owner filed a response on April 28, 2008. Since then, a number of Information Disclosure Statements and Notifications of Concurrent Proceedings have been filed. There are no amendments to the claims, specification or drawings in this reexamination proceeding.

Reexamination in application control No. 90/010,186 was ordered in a decision mailed August 28, 2008 indicating that claims 1-82, all of the claims in the patent, would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. A number of Information Disclosure Statements and Notifications of Concurrent Proceedings have been filed. There are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,692 and reexamination control No. 90/010,186 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

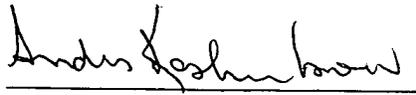
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-82, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,692 and 90/010,186 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Gregory Morse

Gregory Morse, Director
Central Reexamination Unit





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,188	06/06/2008	7315015	250112-1272	1756

24504 7590 11/18/2009

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 GALLERIA PARKWAY, S.E.
STE 1500
ATLANTA, GA 30339-5994

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/18/2009

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



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CENTRAL REEXAMINATION UNIT

THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, LLP
600 GALERIA PARKWAY, S.E. STE 1500
ATLANTA, GA 30339-5994

: (For Patent Owner)

In re HSIEH *et alia*
Reexamination Proceeding
Control No. 90/010,188
Request Deposited: June 6, 2008
For: U.S. Patent No. 7,315,015

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

This is a decision on the November 16, 2009, "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner response be extended "for additional time beyond the shortened statutory period".

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,315,015 (hereinafter, the '015 patent), issued to HSIEH *et alia*, on January 1, 2008.
2. On June 6, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '015 patent. The reexamination proceeding was assigned Control No. 90/010,188 (hereinafter, the '10188 proceeding).
3. The reexamination order was granted in the '10188 proceeding on July 2, 2008.
4. Later in prosecution, a final office action was mailed on September 15, 2009.

Art Unit: 3992

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on November 16, 2009, together with the petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons **must** include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date of the request for extension is submitted, an (B) why, in spite of the actions taken thus far, the requested additional time is needed. The statement of (A) **must** provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period...

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Analysis and Findings

In the request, it is stated "the undersigned attorney communicates with an intellectual property firm in Taiwan and that firm, in turn, corresponds with the owner/assignee of the application [patent]". Thus, the petition alleges, additional time is required for communications. The petition also states "More significantly, the assignee, not be a U.S. corporation/individual, is requiring extra time to prepare an appropriate response". No other statements are provided. No factual accounting of reasonably diligent behavior by all those responsible of the actions taken by patent owner to date has been submitted as required. Further, no explanation as to why, in

Art Unit: 3992

spite of the actions taken thus far, the requested additional time is needed. The request fails to meet the requirements as outlined in MPEP 2265 for granting of a request for extension of time under 37 CFR 1.550(c).

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains November 16, 2009. Unless a timely Notice of Appeal or other timely proper response has been filed by owner, the proceeding appears to be terminated. Owner is advised petitions for revival under 37 CFR 1.137(b) are available. Alternatively, the Office will issue a Notice of Intent to Issue Reexamination Certificate cancelling all finally rejected claims in due course.

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

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

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

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

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

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

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

/J. Harrison/

Jessica Harrison, SPE AU 3992
Central Reexamination Unit



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P.O. Box 1450
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David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

MAILED

NOV 19 2008

CENTRAL REEXAMINATION UNIT

Matthew A. Newboles
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

:
:
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:
: 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.




Gregory Morse, Director
Central Reexamination Unit



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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

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

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;

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,196	06/16/2008	5843073	70422-25-01	2938
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76808	7590	11/17/2009		
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EXAMINER

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

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

1-2

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

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

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ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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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

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

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ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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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.
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90/010,175	05/22/2008	5843073	CRD-001RX	5404
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76808	7590	11/17/2009		
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EXAMINER

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

ART UNIT	PAPER NUMBER
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DATE MAILED: 11/17/2009

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

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

For Patent Owner

Matthew A. Newboles
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 &
90/010,578

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

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CENTRAL REEXAMINATION UNIT

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.

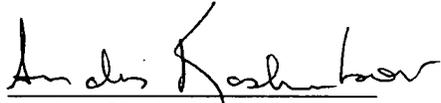
Conduct of Proceedings

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 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 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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

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

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

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: 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.




Gregory Morse, Director
Central Reexamination Unit



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90/010,188; 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

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

EXAMINER

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

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

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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

3

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/009,188	06/13/2008	5843073	CRDIO-046X	9268
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76808	7590	11/17/2009		
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EXAMINER

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

ART UNIT	PAPER NUMBER
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DATE MAILED: 11/17/2009

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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

76808 7590 11/17/2009

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2009

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

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

For Patent Owner

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

For 3rd Party Requester
90/009,188

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 &
90/010,578

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

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CENTRAL REEXAMINATION UNIT

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.

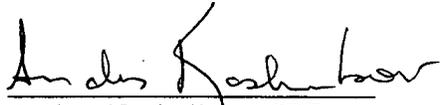
Conduct of Proceedings

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

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

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NOV 19 2008

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester) CENTRAL REEXAMINATION UNIT
90/009,186

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

(For 3rd Party Requester)
90/010,176

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

(For 3rd Party Requester)
90/010,197

Reexam Control No.: 90/009,186
Filed : June 13, 2008
For U.S. Patent No. : 6,159,203

Reexam Control No.: 90/010,176
Filed : May 22, 2008
For U.S. Patent No. : 6,159,203

Reexam Control No.: 90/010,197
Filed : June 16, 2008
For U.S. Patent No. : 6,159,203

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: DECISION MERGING
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: PROCEEDINGS
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This is a decision on the September 25, 2008 patent owner petition filed in each of the above-identified reexamination proceedings. The petition is entitled "Request for Consolidation of Multiple Co-Pending *Ex Parte* Reexamination Proceedings Under 37 C.F.R. § 1.565."

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

Relevant Authority

37 CFR 1.565(c) provides:

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

MPEP § 2283, Subsection VII, provides:

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2267.

While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine (37 CFR 1.525) on the second request, the better practice is to include any such petition with the patent owner's statement under 37 CFR 1.530, in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to 37 CFR 1.535 in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under 37 CFR 1.550(g).

All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or the CRU Special Program Examiner, if the CRU Director delegates it to him or her).

Consideration of Merger

A petition to merge *ex parte* reexamination proceeding 90/009,186 (the '186 proceeding), *ex parte* reexamination proceeding 90/010,176 (the '176 proceeding), and *ex parte* reexamination proceeding 90/010,197 (the '197 proceeding) was filed September 25, 2008 in each of the above-identified files. No fee was submitted, and none is required inasmuch as the Office will generally treat the issue of merger *sua sponte*, if no petition to merge is filed. Thus in this instance, the present petition is taken as being equivalent to a notice to the Office that merger should be considered.

Reexamination of the '186 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-3, 9-15, and 20-25 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '186 proceeding. Accordingly, the '186 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '176 proceeding was ordered in a decision mailed August 21, 2008. Reexamination was ordered for claims 1-26 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent

owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '176 proceeding. Accordingly, the '176 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '197 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-3, 8-15, and 20-25 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '197 proceeding. Accordingly, the '197 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

As evidenced by the above facts, the '186, '176, and '197 reexamination proceedings are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, and a patent owner's statement has not and now cannot be filed in any of those proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

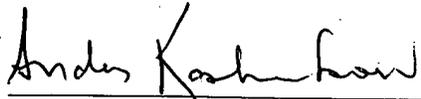
Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-26, which are all of the claims of the '203 patent and for which reexamination has been ordered, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each proceeding, and each action will be entered into each of the files (which will be maintained as separate electronic Image File Wrapper files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,186, 90/010,176 and 90/010,197 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Gregory Morse, Director
Central Reexamination Unit





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www.uspto.gov

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OCT 08 2008

CENTRAL REEXAMINATION UNIT

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester)
90/009,185

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

(For 3rd Party Requester)
90/010,177

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

(For 3rd Party Requester)
90/010,198

Reexam Control No.: 90/009,185
Filed : June 13, 2008
For U.S. Patent No. : 6,547,780

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: DECISION MERGING
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

Reexam Control No.: 90/010,177
Filed : May 22, 2008
For U.S. Patent No. : 6,547,780

Reexam Control No.: 90/010,198
Filed : June 16, 2008
For U.S. Patent No. : 6,547,780

This is a decision on the September 25, 2008 patent owner petition filed in reexamination control number 90/010,177. The petition is entitled "Request for Consolidation of Multiple Co-Pending *Ex Parte* Reexamination Proceedings Under 37 C.F.R § 1.565."

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

Relevant Authority

37 CFR 1.565(c) provides:

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

MPEP § 2283, Subsection VII, provides:

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2267.

While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine (37 CFR 1.525) on the second request, the better practice is to include any such petition with the patent owner's statement under 37 CFR 1.530, in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to 37 CFR 1.535 in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under 37 CFR 1.550(g).

All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or to the CRU SPE if the CRU Director delegates it to him or her).

Consideration of Merger

The petition to merge *ex parte* reexamination proceeding 90/009,185 (the '185 proceeding), *ex parte* reexamination proceeding 90/010,177 (the '177 proceeding), and *ex parte* reexamination proceeding 90/010,198 (the '198 proceeding) was filed on September 25, 2008 in the file of '177 proceeding. No fee was submitted, and none is required inasmuch MPEP § as the Office will generally treat the issue of merger *sua sponte*, if no petition to merge is filed. Thus, in this instance, the present petition is taken as being equivalent to notice to the Office that merger should be considered.

Reexamination of the '185 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, and 7-12 of U.S. Patent No. 6,547,780 (the '780 patent). Concurrently with the filing of the present petition, patent owner filed a notice waiving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '185 reexamination proceeding. Accordingly, the '185 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination in the '177 proceeding was ordered in a decision mailed July 19, 2008. Reexamination was ordered for claims 1-14, i.e., all of the claims, of the '780 patent. The time for filing a patent owner's statement under 37 CFR 1.530 expired on September 19, 2008, without a patent owner's statement having been filed. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '711 reexamination proceeding. Accordingly, the '177 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination in the '198 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, and 7-12 of the '780 patent. Concurrently with the filing of the present petition, patent owner filed a notice waiving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '198 reexamination proceeding. Accordingly, the '198 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

As evidenced by the above facts, the '185, '177 and '198 reexamination proceedings are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, and a patent owner's statement has not been and now cannot be filed in any of those proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-14, which are all of the claims of the '780 patent and for which reexamination has been ordered, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each proceeding, and each action will be entered into each of the files (which will be maintained as separate electronic Image File Wrapper files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, appeal brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,185, 90/010,177 and 90/010,198 are hereby merged into a single proceeding. It being noted that the claims of record are identical in each of the merged *ex parte* reexamination proceedings, upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Gregory Morse, Director
Central Reexamination Unit



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Accenture Chicago 28164
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

For Patent Owner

MAILED

FEB 26 2010

CENTRAL REEXAMINATION UNIT

Daniel M. DeVos
Blakeley, Sokoloff, Taylor & Zafman, LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,201
Filed: June 19, 2008
For: U.S. Patent No. 7,013,284

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,713
Filed: October, 9, 2009
For: U.S. Patent No. 7,013,284

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. 90/010,201 was ordered in a decision mailed October 1, 2008. The decision granted reexamination for claims 1-22, all of the claims in US Patent No. 7,013,284, would be reexamined. On July 17, 2009, a non-final Office action was mailed rejecting all of the claims (i.e., claims 1-22). On September 17, 2009, patent owner filed a response to the Office action. The response presented arguments in

favor of confirmation of claims 1-22 and added new claims 23-40. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/010,713 was ordered in a decision mailed December 17, 2009. The decision indicating that claims 1-22, all of the claims in US Patent No. 7,013,284, would be reexamined. No patent owner statement under 37 CFR 1.530 has been filed and no Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,201 and reexamination control No. 90/010,713 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, new claims 23-40 were added in reexamination proceeding 90/010,201 by the response filed September 17, 2009. No amendment has been filed in reexamination control No. 90/010,713. 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. 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 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 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. 90/010,201 and 90/010,713 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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P.O. Box 1450
Alexandria, VA 22313-1450
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Cichosz & Cichosz, PLLC
129 E. Commerce Street
Milford, MI 48381

For Patent Owner
(both requests)

MAILED

NOV 12 2009

Ex Parte Reexamination Proceeding
Control No. 90/010,202
Filed: July 30, 2008
For: U.S. Patent No. 6,659,074

DECISION MERGING
REEXAMINATION
PROCEEDINGS

~~CENTRAL REEXAMINATION UNIT~~

Ex Parte Reexamination Proceeding
Control No. 90/010,545
Filed: May 19, 2009
For: U.S. Patent No. 6,659,074

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. 90/010,202 was ordered in a decision mailed October 20, 2008 granting reexamination of claims 1-17, all of the claims in US Patent No. 6,659,074. 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. 90/010,545 was ordered in a decision mailed June 19, 2009, indicating that claims 1-17, all of the claims in US patent No. 6,659,074 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. 90/010,202 and reexamination control No. 90/010,545 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. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

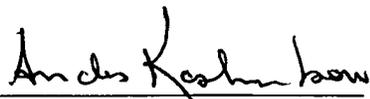
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-17, all of the pending claims 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. 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 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 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. 90/010,202 and 90/010,545 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,207	06/23/2008	7314328	LIBE 58RE	1883

61650 7590 07/10/2009

MYERS WOLIN, LLC
100 HEADQUARTERS PLAZA
North Tower, 6th Floor
MORRISTOWN, NJ 07960-6834

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/10/2009

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



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MYERS WOLIN, LLC
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NORTH TOWER, 6TH FLOOR
MORRISTOWN, NJ 07960-6834

(For Patent Owner)

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

DAVID M. MAIORANA, Esq.
JONES DAY
901 LAKESIDE AVENUE, NORTH POINT
CLEVELAND, OH 44114

(For Third Party Requester)

In re Liberatore
Inter partes Reexamination Proceeding
Control No. 95/000,387
Filed: August 6, 2008
For: U.S. Patent No. 7,314,328

:
:
:
:
: DECISION, *SUA SPONTE*,
:
: TO MERGE REEXAMINATION

Ex parte Reexamination Proceeding
Control No. 90/010,207
Filed: June 23, 2008
For: U.S. Patent No. 7,314,328

: PROCEEDINGS
:
:
:

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

REVIEW OF FACTS

1. United States Patent Number 7,314,328 (the '328 patent) issued to Liberatore, on January 1, 2008.

2. A request for *ex parte* reexamination was filed by patent owner, on June 23, 2008. The resulting reexamination proceeding was assigned Control No. 90/010,207 (the '207 proceeding). Reexamination was requested for claims 1-20 of the '328 patent.
3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,387 (the '387 proceeding), was filed by third party requester on August 6, 2008. Reexamination was requested for claims 1-20 of the '328 patent.
4. An order granting reexamination of claims 1-20 in the '328 patent was mailed for the '207 reexamination proceeding on August 18, 2008.
5. An order denying the request for *inter partes* reexamination for claims 1-20 in the '387 reexamination proceeding was mailed on October 29, 2008.
6. On November 14, 2008, the third party requester filed a petition under 37 CFR §§ 1.181 and 1.927 for the '387 reexamination proceeding.
7. On April 29, 2009 the Office granted the third party's petition and granted *inter partes* reexamination of claims 1-20 of the '328 patent.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '387 and the '207 reexamination proceedings are currently pending. An order granting reexamination of claims 1-20 of the '328 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989(a) 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, (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 95/000,387 and 90/010,207 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. The patent owner is required to continue 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 partes* 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.

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 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 the file for each proceeding.

All papers that are 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 Dulaney St.
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.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. 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 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 which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of the *inter partes* reexamination requester), even though the brief relates to merged multiple proceedings and even though 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. 95/000,387 and *ex partes* Reexamination Control No. 90/010,207 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. 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.
4. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Maria Nuzzolillo, at (571) 272-8150, or in her absence, to Pinchus M. Laufer, at (571)272-7726.



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



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Alexandria, VA 22313-1450
www.uspto.gov

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
14th Floor
Irvine, CA 92614

(For Patent Owner)

Scott R. Brown
Hovey Williams, LLP
10801 Mastin Blvd.
Suite 1000
Overland Park, KS 66210-1697

(For Third Party Requester)

MAILED
AUG 26 2009
CENTRAL REEXAMINATION UNIT

In re Steven F. Bierman
Ex Parte Reexamination Proceeding
Control No. 90/010,211.
Filed: June 27, 2008
For: U.S. Patent No. 7,247,150

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

This is a decision on the August 11, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination¹ ("the August 11; 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 11, 2009 patent owner petition to revive has been paid.

The August 11, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 11, 2009 patent owner petition to revive is **dismissed**.

¹ Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of May 11, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*
*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.550 provides, in pertinent part:

(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 August 11, 2009 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 August 11, 2009 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 May 11, 2009 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 certificate by making all pending claims patentable or (ii) a Notice of Appeal and appeal fee.²

Patent owner submitted a paper titled "Patent Owner's Response to Final Office Action" on August 11, 2009. The primary examiner for the instant reexamination proceeding has confirmed that the August 11, 2009 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 August 11, 2009 petition is incomplete.

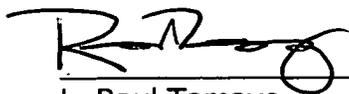
For the foregoing reasons, the August 11, 2009 patent owner petition to revive is **dismissed**.

CONCLUSION

1. The August 11, 2009 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 May 11, 2009 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, Beverly Flanagan, of CRU Art Unit 3993, at (571) 272-4766.

² 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.



L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration



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Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
14th Floor
Irvine, CA 92614

(For Patent Owner)

Scott R. Brown
Hovey Williams, LLP
10801 Mastin Blvd.
Suite 1000
Overland Park, KS 66210-1697

(For Third Party Requester)

MAILED

SFP 3-02009

CENTRAL REEXAMINATION UNIT

In re Steven F. Bierman
Ex Parte Reexamination Proceeding
Control No. 90/010,211
Filed: June 27, 2008
For: U.S. Patent No. 7,247,150

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

This is a decision on the September 24, 2009 patent owner renewed petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination ("the September 24, 2009 patent owner renewed petition to revive").

The September 24, 2009 patent owner renewed petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 24, 2009 patent owner renewed petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer*.

*

*

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

37 CFR 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the

prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

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

*

*

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

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 Renewed Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal and paid the corresponding fee of \$540.00 on September 24, 2009, thereby satisfying item (1).¹

A petition fee of \$1,620.00 was submitted as part of the August 11, 2009 patent owner petition to revive, thereby satisfying item (2).

Proper statements under 37 CFR 1.137(b)(3) were submitted on August 11, 2009, and September 24, 2009. Therefore, item (3) is deemed to have been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.²

Accordingly, the September 24, 2009 patent owner renewed petition to revive is **granted**.

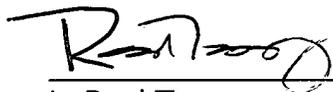
CONCLUSION

1. The September 24, 2009 patent owner renewed petition to revive under 37 CFR 1.137(b) is **granted**.
2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3993, for further processing in view of the September 24, 2009 Notice of Appeal, and for treatment of the August 11, 2009 Patent Owner's Response To Final Office Action in due course.
3. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).

¹ See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

² See: 37 CFR 1.137(d)(3).

4. 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.
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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,211	06/27/2008	7,247,150	4195.003	8316

20995 7590 12/08/2009

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/08/2009

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HOVEY WILLIAMS LLP
10801 MASTIN BLVD.
SUITE 1000
OVERLAND PARK, KS 66210

Date:

MAILED

DEC 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010211

PATENT NO. : 7247150

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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Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
14th Floor
Irvine, CA 92614

(For Patent Owner)

MAILED

DEC 08 2009

CENTRAL REEXAMINATION UNIT

Scott R. Brown
Hovey Williams, LLP
10801 Mastin Blvd.
Suite 1000
Overland Park, KS 66210-1697

(For Requester)

In re Bierman :
Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/010,211 : UNDER 37 CFR 1.181
Filed: June 27, 2008 :
For: U.S. Patent No.: 7,247,150 :

This is a decision on a petition filed by the patent owner on November 30, 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 enter the amendment filed on September 24, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated November 30, 2009 is denied with respect to entry of the amendment filed on September 24, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,247,150 (hereinafter, the '150 patent) issued on July 24, 2007.
2. A request for *ex parte* reexamination for claims 1, 31, and 35 of the '150 patent, assigned control No. 90/010,211 (hereinafter, the '211 proceeding), was filed by a third party, requester on June 27, 2008.
3. *Ex parte* reexamination was ordered for claims 1, 31, and 35 of the '150 patent in the '211 proceeding on July 29, 2008.
4. The patent owner did not file a statement under 37 CFR 1.530.
5. On November 7, 2008, a non-final Office action, which rejected claims 1 and 35 based upon anticipation by Bierman '435 and also Gordon '647 and claim 31 based upon anticipation by Gordon '880 and also Bierman '273, was mailed in the '211 reexamination proceeding.
6. On December 10, 2008, a personal interview was held. In the interview, claim interpretation was discussed in that the examiner's pointed out that claims 1 and 35 did not positively recite the "fitting" as being part of the claimed invention. See the interview summary dated December 19, 2008.
7. On January 7, 2009, the patent owner filed a response, which included arguments and a declaration under 37 CFR 1.132 by Paul Frankhouse. No amendments were made to the claims.
8. On May 6, 2009, the Office issued a Final rejection Office action, which addressed the patent owner's response of January 7, 2009. The Office action again rejected claims 1 and 35 as anticipated by Bierman '435 and also Gordon '647 and claim 31 as anticipated by Gordon '880 and also Bierman '273.
9. On August 11, 2009, Patent Owner filed a response, a proposed amendment to claims 1 and 31, and a petition to revive under 37 CFR 1.137(b).
10. On August 26, 2009, the Office issued decision dismissing the petition to revive.

11. On September 24, 2009, the patent owner filed a response, a proposed amendment to claims 1 and 31, a notice of appeal and a renewed petition to revive under 37 CFR 1.137(b).
12. On September 30, 2009, a decision granting the petition to revive was mailed. Patent owner was given two months from the mailing date of the decision to file the appeal brief.
13. On November 4, 2009, the Office mailed an advisory action which stated that the proposed amendment of September 24, 2009 will not be entered. The advisory states that entry of the amendment raised new issues that would require further consideration and is not deemed to place the proceeding in better form for appeal.
14. On November 30, 2009, the patent owner filed an appeal brief and the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the amendment of September 24, 2009 be entered.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed amendment of September 24, 2009 because the proposed amendments "... do not raise new issues that would require further consideration and search, do not expand the scope of Claims 1 and 31, and do place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal." See page 2 of the petition.

The petitioner explains how the amendment of September 24, 2009 is commensurate with arguments presented for claims 1 and 31 in their response to the first Office action and were made in response to the examiner's claim interpretation in the Final Office action. See pages 3-7 of the petition. Specifically, the petitioner also states that the addition of the phrases "and without substantially moving the received portion of the fitting" and "in a non-occlusive manner" to describe operation of the coupling to claim 1 does not introduce any new issues because the phrases either clarify or more closely align the claim language with the arguments presented by the patent owner. See pages 3-5 of the petition. Finally, petition states that the addition of the phrase "that is non-uniform in its circumference" to modify the fitting and the phrase "at least when the irregularly shaped medical article is not disposed between the wall" to modify the cover in claim 31 also does not introduce any new issues because the phrases clarify and more closely align the claim language with the arguments presented by the patent owner. See pages 5-7 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed amendment of September 24, 2009, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final Office action of May 6, 2009 sets forth the same grounds of rejection based on prior art as set forth in the first Office action. The patent owner chose not to make amendments to the claims in response to the first Office action, which would have been entered as a matter of right. The record shows the patent owner was aware of how the examiner was interpreting the functional limitations of claim 1 prior to their January 7, 2009 response. See the interview summary dated December 19, 2008. In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed amendment of September 24, 2009 because the proposed amendment clarifies the claim language in response to the examiner's claim interpretation explained in the Final Office action dated May 6, 2009, and therefore, could not have been presented earlier. The record, however, does not support this allegation.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the amendment of September 24, 2009 should not be entered because the addition of the phrases to claims 1 and 31 introduces new issues. First, it is noted that the patent owner did not show any support in the disclosure for the proposed amendments to claims 1 and 31.¹ Therefore, the amendment would require further consideration by the examiner because the examiner would have to make the determination as to whether the proposed amendments are supported by the original disclosure and to do introduce new matter. In addition, the issue regarding claim interpretation as to whether claim 1 positively recited a fitting and the functional language pertaining to the coupling element was discussed during the interview of December 10, 2008. As discussed above, the patent owner, however, chose not to make any claim amendments to claim 1 in their January 7, 2009 response to the first Office action. It was only after the examiner maintained the rejection in the Final Office action and was not convinced by the January 7, 2009 response that the patent owner proposed claim amendments. Therefore, the record indicates that the patent owner was aware of how the examiner was interpreting the functional language of claim 1 prior to the Final Office action, and chose not to make claim amendments in response to the first Office action.

¹ The examiner did not explicitly state that the September 24, 2009 amendment failed to comply with 37 CFR 1.530(e) in the November 4, 2009 advisory action. The examiner, however, did state that the proposed amendment would raise new issues as discussed above, and the issue of support for the proposed amendment is an example of a new issue created by the proposed amendment.

In regard to patent owner's arguments that the proposed amendment of September 24, 2009 should be entered because it aligns the claim language to previously presented arguments, the record does not support the patent owner's contention that this does not raise new issues and simplifies issues for appeal. The Final Office action of May 6, 2009 makes it clear that the examiner did not consider the functional limitations argued by the patent owner in their January 7, 2009 response to be part of the claimed invention. See, e.g., the last paragraph on page 10, and pages 11-13 of the Final Office action, dated May 6, 2009. Therefore, the record indicates that the examiner did not fully consider whether the prior art of record taught such functional limitations, as proposed to be added to claims 1 and 31, because such limitations were not part of the claimed invention. Therefore, it cannot be said that adding such functional limitations to claims 1 and 31 does not raise new issues.

Finally, it is noted that the patent owner has filed an appeal brief on November 30, 2009. The appeal brief is based on the original claims of the '150 patent, and as required by Office rules, does not address the proposed amendments of September 24, 2009. It is also noted that patent owner has included similar arguments as presented in the September 24, 2009 response.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the amendment of September 24, 2009. The petition will not address the other issues (e.g., expanding the scope) as such is not required to decide this petition.

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 entry of the amendment dated September 24, 2009 is denied.
2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,212	06/27/2008	5,966,456		9114
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41230 7590 11/20/2008

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 11/20/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,057

01/15/2008

5,966,456

89310-0006

1411

41230 7590 11/20/2008

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

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ART UNIT PAPER NUMBER

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Stephen Rudisill, Esq.
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED

NOV 20 2008

CENTRAL REEXAMINATION UNIT

Darius G Adli
HOGAN & HARTSON, L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third Party
Requester)

SPONTE
MERGING

DECISION, *SUA*

REEXAMINATION
PROCEEDINGS

In re: Jones *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,057
Deposited: 15 January 2008
For: US Patent No. 5,966,456

In re: Jones *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,212
Deposited: 27 June 2008
For: US Patent No 5,966,456

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

BACKGROUND

1. Patent No. 5,966,456 issued on 12 October 1999.
2. *Ex Parte* Reexamination Proceeding, control no. 90/010,057 was requested by a third party requester deposited on 15 January 2008.
3. The Reexamination Order was granted in proceeding, control no. 90/010,057 on 15 February 2008.
4. There are currently no amendments proceeding control number 90/010,057.
5. *Ex Parte* Reexamination Proceeding, control no. 90/010,212 was requested by a third party requester deposited on 27 June 2008.
6. The Reexamination Order was granted in proceeding, control no. 90/010,212 on 15 September 2008
7. There are currently no amendments proceeding control number 90/010,212.
8. On 12 November 2008 Stephen Rudisill, Esq. stated that the patent owner would not be submitting a patent owner's statement and that they were awaiting a first Office action on the merits.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/010,057 and 90/010,212 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Since there are no amendments in either proceeding, there is no requirement for a "housekeeping" amendment.

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos: 90/010,057 and 90/010,212 are hereby merged.
2. The reexamination files are hereby forwarded to the examiner for issuing a first Office action on the merits.
3. All correspondence regarding these proceedings should be submitted as follows:

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

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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

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

/Mark Reinhart/

Gregory A. Morse,
Director,
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,212	06/27/2008	5,966,456		9114

7590 05/07/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST
48th FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/07/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,212	06/27/2008	5,966,456		9114

7590 05/07/2009

CONLEY ROSE, P.C.
P. O. Box 3267
Houston, TX 77253-3267

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/07/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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Stephen Rudisill, Esq.
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED

MAY 07 2009

CENTRAL REEXAMINATION UNIT

Mahbub A Siddiqui
CONLEY ROSE, P.C.
DAVID A. ROSE
P. O. BOX 3267
HOUSTON, TX 77253-3267

(For Third Party
Requester)

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

In re: Jones *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,057
Deposited: 15 January 2008
For: US Patent No. 5,966,456

In re: Jones *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,212
Deposited: 27 June 2008
For: US Patent No 5,966,456

This is a decision on the 15 April 2009, "Request for Six-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 19 March 2009, be extended by six (6) weeks. The petition was timely filed with the petition fee. 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-in-part for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 12 October 1999 US Patent No. 5,966,456 was granted to Jones *et alia*.
2. On 15 January 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,057.
3. On 15 February 2008 the Order was granted for *ex parte* reexamination in control number 90/010,057.
4. On 27 June 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,212.
5. On 15 September 2008 the Order was granted for *ex parte* reexamination in control number 90/010,212.
6. On 20 November 2008 a decision sua sponte merging proceedings 90/010,057 and 90/010,212 was mailed.
7. On 19 March 2009 a non-Final Office action was mailed.
8. On 15 April 2009 the instant petition was submitted

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 15 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 15 April 2009, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an

argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

ANALYSIS AND FINDINGS

The patent owner's representative petition 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 non-final rejection mailed 19 March 2009. The patent owner submitted a timely filed petition with the appropriate fee.

The petition dated 15 April 2009 articulates the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally not considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The petition request to extend the response time by six (6) weeks is hereby granted-in-part.

The time granted is one (1) month

CONCLUSION

1. The patent owner's petition for extension of six (6) weeks time in which to file a response to the Office action dated 19 March 2009 is hereby granted-in-part
2. The period for response is extended by one (1) month.
3. The Patent Owner's response is due 19 June 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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,214	07/01/2008	6900462	0553-0172.99	2481

26568 7590 08/20/2009

COOK ALEX LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/20/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
AUG 29 2009
CENTRAL REEXAMINATION UNIT

Mark J Murphy :
COOK ALEX LTD : (For Patent Owner)
SUITE 2850 :
200 WEST ADAMS STREET :
CHICAGO IL 60606 :

In re: *Suzawa et alia* : DECISION
Ex Parte Reexamination Proceeding : GRANTING
Control No. 90/010,214 : PETITION FOR ENTRY
Deposited: 01 July 2008 : OF AMENDMENT
For: US Patent No. 6,900,462 : 37 CFR § 1.181

This is a decision on the 10 August 2009, "Petition Requesting Entry of Amendment After Final" requesting that the amendment dated 13 May 2009 be entered. The petition was timely filed.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner petitions for entry under 37 CFR § 1.181 of after final amendments in an *ex parte* reexamination proceeding. The amendment was submitted on 13 May 2009. The examiner mailed on 24 July 2009 an advisory action telling the patent owner that the amendment would not be entered.

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

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

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

- (a) An amendment after final action must comply with § 1.114 or this section.
- (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
 - (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
 - (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
 - (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented....

ANALYSIS AND FINDINGS

Upon *de novo* review of the proposed amendment, the amendment to the drawing 12A to correct reference number 161 to 162 to overcome an examiner's objection is appropriate and will be entered.

The petition request to enter the amendment dated 13 May 2009 will be entered.

The petition is hereby granted.

CONCLUSION

1. The patent owner's petition for entry of the amendment dated 13 May 2009 is hereby **granted**.
2. The Patent Owner's time to submit their appeal continues to run.
3. Correspondence to the Office should be addressed as follows:

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

By Fax to: (571) 273-9900

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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; 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.
90/010,217	07/08/2008	6381354	89310.0005	9569

41230 7590 11/20/2008

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2008

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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,060	01/16/2008	6381354	89310.0005	1503

41230 7590 11/20/2008

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2008

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www.uspto.gov

Stephen Rudisill, Esq.
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED

NOV 20 2008

CENTRAL REEXAMINATION UNIT

Darius G Adli
HOGAN & HARTSON, L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third Party
Requester)

SPONTE
MERGING

DECISION, *SUA*

REEXAMINATION
PROCEEDINGS

In re: Mennie *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,060
Deposited: 16 January 2008
For: US Patent No. 6,381,354

In re: Mennie *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,217
Deposited: 8 July 2008
For: US Patent No 6,381,354

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

BACKGROUND

1. Patent No. 6,381,35419 issued on 30 April 2002.
2. *Ex Parte* Reexamination Proceeding, control no. 90/010,060 was requested by a third party requester deposited on 16 January 2008.
3. The Reexamination Order was granted in proceeding, control no. 90/010,060 on 7 March 2008
4. There are currently no amendments proceeding control number 90/010,060.
5. *Ex Parte* Reexamination Proceeding, control no. 90/010,217 was requested by a third party requester deposited on 8 July 2008.
6. The Reexamination Order was granted in proceeding, control no. 90/010,217 on 23 September 2008
7. There are currently no amendments proceeding control number 90/010,217.
8. On 12 November 2008 Stephen Rudisill, Esq. stated that the patent owner would not be submitting a patent owner's statement and that they were awaiting a first Office action on the merits.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/010,060 and 90/010,217 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Since there are no amendments in either proceeding, there is no requirement for a "housekeeping" amendment.

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/010,060 and 90/010,217 are hereby merged.
2. The reexamination files are hereby forwarded to the examiner for issuing a first Office action on the merits.
3. All correspondence regarding these proceedings should be submitted as follows:

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

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United States Patent & Trademark Office
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3. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611 or Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Gregory A. Morse,
Director,
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,217	07/08/2008	6381354	89310.0005	9569

41230 7590 05/06/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/06/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,060	01/16/2008	6381354	89310.0005	1503

41230 7590 05/06/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/06/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CONLEY ROSE, P.C.

DAVID A. ROSE

P.O. BOX 3267

HOUSTON, TX 77253-3267

Date: **MAILED**
MAY 06 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010060

PATENT NO. : 6381354

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

MAILED

Date:

MAY 06 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DARIUSH G. ADLI
HOGAN & HARTSON LLP
1999 AVE. OF THE STARS, SUITE 1400
LOS ANGELES, CA 90067

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010217
PATENT NO. : 6381354
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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Stephen Rudisill, Esq.
CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO IL 60601

(For Patent Owner)

MAILED

MAY 06 2009

CENTRAL REEXAMINATION UNIT

Mahbub A Siddiqui
CONLEY ROSE, P.C.
DAVID A. ROSE
P. O. BOX 3267
HOUSTON, TX 77253-3267

(For Third Party
Requester)

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

In re: Mennie *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,060
Deposited: 16 January 2008
For: US Patent No. 6,381,354

In re: Mennie *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,217
Deposited: 08 July 2008
For: US Patent No 6,381,354

This is a decision on the 15 April 2009, "Request for Six-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 19 March 2009, be extended by six (6) weeks. The petition was timely filed with the petition fee. The petition lacks 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 30 April 2002 US Patent No. 6,381,354 was granted to Mennie *et alia*.
2. On 16 January 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,060.
3. On 07 March 2008 the Order was granted for *ex parte* reexamination in control number 90/010,060.
4. On 08 July 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,217.
5. On 23 September 2008 the Order was granted for *ex parte* reexamination in control number 90/010,217.
6. On 20 November 2008 a decision sua sponte merging proceedings 90/010,060 and 90/010,217 was mailed.
7. On 19 March 2009 a non-Final Office action was mailed.
8. On 15 April 2009 the instant petition was submitted without certificate of service.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 15 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 15 April 2009, together with electronic fee transmittal for the \$200.00 petition fee as required by 37 CFR § 1.17 (g). The petition lacks the required certificate of service pursuant to 37 CFR 1.550(f).

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). 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's representative petition 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 non-final rejection mailed 19 March 2009. The patent owner submitted a timely filed petition with the appropriate fee but lacking the required certificate of service.

The petition dated 15 April 2009 articulates the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally not considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The patent owner is reminded of the required service of all papers in *ex parte* reexamination proceedings pursuant to 37 CFR 1.550(f). The patent owner is further reminded that lacking service the document may be refused consideration by the Office.

The petition request to extend the response time by six (6) weeks is hereby granted-in-part. The time granted is one (1) month

CONCLUSION

1. The patent owner's petition for extension of six (6) weeks time in which to file a response to the Office action dated 19 March 2009 is hereby granted-in-part

2. The period for response is extended by one (1) month.
3. The Patent Owner's response is due **19 June 2009.**
4. Response and/or submissions to the Office to change the correspondence address or power of attorney in the record of the patent should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,221	07/17/2008	5,825,449	1160-01-REX-SM	9018

7590 02/13/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/13/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,737	07/12/2007	5825449	01450.0023.000000	6736

30827 7590 02/13/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/13/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

MAILED

FEB 13 2009

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

HOWREY LLP - EAST
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

(For Third Party Requester)

KLEIN, O'NEILL & SINGH, LLP
43 CORPORATE PARK, SUITE 204
IRVINE, CA 92606
ATTN: SCOTT LORAS MURRAY

In re Shin
Reexamination Proceeding
Control No. 90/008,737
Request Deposited: July 10, 2007
For: U.S. Patent No. 5,825,449

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Shin
Reexamination Proceeding
Control No. 90/010,221
Request Deposited: July 16, 2008
For: U.S. Patent No. 5,825,449

:
:
:
:
:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,825,449 (hereinafter, the '449 patent), issued to Shin, on October 20, 1998.

Art Unit: 3992

2. On July 10, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '449 patent. The reexamination proceeding was assigned Control No. 90/008,737 (hereinafter, the '8737 proceeding).
3. The Reexamination Order was granted in the '8737 proceeding on October 15, 2007.
4. On July 16, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '449 patent. The reexamination proceeding was assigned Control No. 90/010,221 (hereinafter, the '10221 proceeding).
5. The Reexamination Order was granted in the '10221 proceeding on October 10, 2008.
6. A non-final office action was mailed in the '8737 proceeding on December 22, 2008 setting a 2-month period for response.
7. There are currently no amendments in either proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8737 and the '10221 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

Art Unit: 3992

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

CONCLUSION

1. Reexamination Control Nos. 90/008,737 and 90/010,221 are MERGED.
2. The period for response to the non-final office action of the '8737 remains running. A response to the action in the merged proceeding, as outlined above, is due on or before February 23, 2009 (February 22 is a Sunday).
3. All correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

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

Art Unit: 3992

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,221	07/17/2008	5,825,449	1160-01-REX-SM	9018

7590 07/14/2009

EXAMINER

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

ART UNIT PAPER NUMBER

DATE MAILED: 07/14/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SCOTT LORAS MURRAY
KLEIN, O'NEILL & SINGH, LLP
43 CORPORATE PARK, SUITE 204
IRVINE, CA 92606

Date:

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010221
PATENT NO. : 5825449
ART UNIT : 3992

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(for patent owner) MAILED

JUL 14 2009

HOWREY LLP - EAST
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

(for requester) CENTRAL REEXAMINATION UNIT

Klein, O'Neill & Singh, LLP
43 Corporate Park, Suite 204
Irvine, CA 92606

(for requester)

In re Reexamination of USP 5825449
Cont. Nos.: 90/008,737 and 90/010,221
Filed: July 10, 2007 and July 16, 2008
For: **LIQUID CRYSTAL DISPLAY DEVICE AND
METHOD OF MANUFACTURING THE SAME**

**DECISION ON PETITIONS
UNDER 37 CFR 1.59**

This is a decision on the petition under 37 CFR 1.59(b), filed March 16, 2009 and May 14, 2009, to expunge information from the above identified merged reexamination proceedings.

The petitions are granted.

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,221	07/17/2008	5,825,449	1160-01-REX-SM	9018

7590 07/14/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/14/2009

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

SCOTT LORAS MURRAY
KLEIN, O'NEILL & SINGH, LLP
43 CORPORATE PARK, SUITE 204
IRVINE, CA 92606

Date:

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010221
PATENT NO. : 5825449
ART UNIT : 3992

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(for patent owner) **MAILED**

JUL 14 2009

HOWREY LLP - EAST
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

(for requester) **CENTRAL REEXAMINATION UNIT**

Klein, O'Neill & Singh, LLP
43 Corporate Park, Suite 204
Irvine, CA 92606

(for requester)

In re Reexamination of USP 5825449
Cont. Nos.: 90/008,737 and 90/010,221
Filed: July 10, 2007 and July 16, 2008
For: **LIQUID CRYSTAL DISPLAY DEVICE AND
METHOD OF MANUFACTURING THE SAME**

**DECISION ON PETITIONS
UNDER 37 CFR 1.59**

This is a decision on the petition under 37 CFR 1.59(b), filed March 16, 2009 and May 14, 2009, to expunge information from the above identified merged reexamination proceedings.

The petitions are granted.

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

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

Art Unit: 3992

Patent owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to petitioner (patent owner). A copy of this decision (without the expunged material) is being sent to both requesters and will be entered in the file.

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



Gregory Morse
Director, Central Reexamination Unit



Paper No.

Mark E. Courtney
17950 Preston Road
Suite 1000
Dallas, TX 75252

MAILED

MAY 27 2010

In re Application of:
Bisker
Application No. 90/010,224
Filed: July 22, 2008
For: DECORATIVE PHOTOGRAPHIC TILE
AND METHOD USING SAME

CENTRAL REEXAMINATION UNIT

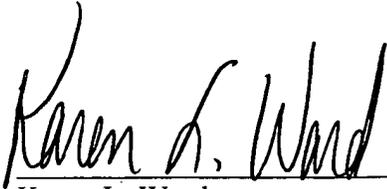
DECISION ON REQUEST TO
WITHDRAW AS ATTORNEY
OR AGENT

This is a decision on the Request To Withdraw from Representation filed May 10, 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 May 10, 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.

A handwritten signature in black ink, reading "Karen L. Ward". The signature is written in a cursive style with a horizontal line underneath it.

Karen L. Ward
Patent Reexamination Specialist
Central Reexamination Unit
(571) 272-7932

cc: Darcy Bisker
1380 Preserve Circle
Golden, CO 80401



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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/010,224	07/22/2008	5863632	CBI-001RX

CONFIRMATION NO. 4829

POWER OF ATTORNEY NOTICE

25962
SLATER & MATSIL, L.L.P.
17950 PRESTON RD, SUITE 1000
DALLAS, TX 75252-5793



Date Mailed: 05/27/2010

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/10/2010.

- 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.

/klward/

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
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/010,224	07/22/2008	5863632	CBI-001RX

DARCY BISKER
1380 PRESERVE CIRCLE
GOLDEN, CO 80401

CONFIRMATION NO. 4829
POA ACCEPTANCE LETTER



Date Mailed: 05/27/2010

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/10/2010.

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.

/klward/

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,231	07/28/2008	5,524,127	079280-0000007	1674

23446 7590 01/29/2009

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/29/2009

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
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
McLEAN ,VA 22102

Date: MAILED

JAN 29 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010231
PATENT NO. : 5524127
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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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

(For Patent Owner)

MAILED

JAN 29 2009

CENTRAL REEXAMINATION UNIT

Mark J Danielson
PILLSBURY WINTHROP SHAW
PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

(For Third Party
Requester)

DECISION DISMISSING

PETITION FROM GRANT
OF REQUEST UNDER
37 CFR § 1.515(c)

In re: Petranovich
Ex Parte Reexamination Proceeding
Control No. 90/010,231
Deposited on: 28 July 2008
For: US Patent No. 5,524,127

This is a decision on the Petition under 37 CFR 1.515 (c) regarding the, "Petition on Order Denying *Ex Parte* Reexamination, (37 CFR § 1.515(c))" of US Patent No. 5,524,127. The petition was received 19 November 2008.

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

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

REVIEW OF FACTS

1. US Patent No. 5,524,127 was issued on 4 June 1996.
2. A request for *ex parte* reexamination was deposited on 28 July 2008 under control no. 90/010,231.
3. The Order was Granted for *ex parte* reexamination in a paper mailed 20 October 2008.

4. The third party requester filed the instant petition on 19 November 2008.

DISCUSSION

The third party requester has petitioned the Director of the Central Reexamination Unit, 3999 under 37 CFR 1.515 (c) to request review of the decision Granting *ex parte* reexamination of US Patent 5,524,127 in the 90/010,231 proceeding. The petitioner seeks review for claims 1-3 of the claims 1-6 requested.

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

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

MPEP § 2248 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

ANALYSIS AND FINDINGS

A review of the Order granting *ex parte* reexamination notes some inconsistencies in the Order. The first paragraph in the Order states that claims one to six are subject to reexamination, while later in the action, claims one to three are identified as not raising a substantial new question. To clarify the record, all six claims requested, claims one to six, will be reexamined by the examiner.

Since all six claims of US patent no. 5,524,127 will be reexamined, the petitioner's request for reexamination of claims one to three is a moot point and as such is dismissed. Absent claims which are not to be reexamined there are no further issues remaining for which this petition seeks redress.

The third party petition dated 19 November 2008 is noted but since all claims will be

reexamined, the petition is dismissed as moot.

This decision is final and non-appealable. 37 CFR § 1.515(c). No further communication on this matter will be acknowledged or considered.

DECISION

1. The third party requester's petition filed under 37 CFR § 1.515 (c) of 19 November 2008 for requesting withdrawal of the Order Granting the reexamination request in proceeding control number 90/010,231 is hereby **dismissed as moot**.
2. The *ex parte* reexamination proceeding 90/010,231 is hereby forwarded to the examiner assigned this proceeding for **reexamination of all claims, one to six**.
3. Response by the Patent Owner may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit



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Barnes & Thornburg
600 One Summit Square
Fort Wayne, IN 46802

For Patent Owner

MAILED

FEB 12 2010

B. Todd Patterson
Patterson & Sheridan, LLP
3040 Post Oak Blvd, Suite 1500
Houston, TX 77056

For 3rd Party Requester
90/010,233

CENTRAL REEXAMINATION UNIT

Peter Medley
Keating and Bennett, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

For 3rd Party Requester
90/010,647

Ex Parte Reexamination Proceeding
Control No. 90/010,233
Filed: July 30, 2008
For: U.S. Patent No. 7,089,201

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,647
Filed: August 17, 2009
For: U.S. Patent No. 7,089,201

Reexamination proceedings control Nos. 90/010,233 and 90/010,647 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. 90/010,233 was ordered in a decision mailed July 30, 2008. The decision indicating that only claims 35-42 of US Patent No. 7,089,201

would be reexamined. Reexamination was not requested for claims 1-34 and 43 of the patent. A non-final Office action was mailed April 24, 2009, rejecting claims 35-42. Patent owner filed a timely response on June 23, 2009. The response included an amendment to claim 38. Further, on June 23, August 27, and November 25, 2009, patent owner filed papers updating the status of concurrent court proceedings involving the patent undergoing reexamination in these proceedings. No Office action has been rendered in response to patent owner's reply of June 23, 2009.

Reexamination in application control No. 90/010,647 was ordered in a decision mailed August 17, 2009. The decision indicating that only claims 35-42 of US Patent No. 7,089,201 would be reexamined. Reexamination was not requested for claims 1-34 and 43 of the patent. On November 24, 2009, patent owner filed a paper waiving his rights to file a patent owner statement under 37 CFR 1.530. Further, on June 23, August 27, and November 25, 2009, patent owner filed papers updating the status of concurrent court proceedings involving the patent undergoing reexamination in these proceedings. No Office action has been rendered in this reexamination proceeding.

As evidenced by the above facts, reexamination Control No. 90/010,233 and reexamination control No. 90/010,647 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, claim 38 has been amended in reexamination control no. 90/010,233 by virtue of the response filed June 23, 2009. 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 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

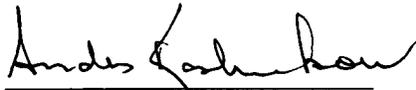
The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently only claims 35-42 are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued 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 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 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. 90/010,233 and 90/010,647 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 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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Ezra Sutton & Associates, P.A.
Plaza 9
900 Route 9
Woodbridge, NJ 07095

For Patent Owner

Foley Hoag, LLP
Patent Group, World Trade Center West
155 Seaport Blvd
Boston, MA 02210-2600

For 3rd Party Requester

MAILED

AUG 27 2009

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/010,236
Filed: August 25, 2008
For: U.S. Patent No. 6,080,147

DECISION ON PETITION
TO RE-MAIL OFFICE
ACTION

This is a decision on patent owner's paper styled "Petition To Remail Office Action Based On Non-Receipt" filed August 5, 2009, requesting that the Office action mailed March 6, 2009 be re-mailed based on patent owner's failure to receive the Office action. There is no fee associated with this petition.¹

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

Under the reasoning promulgated in *Delgar v. Schuyler*, 172 USPQ 513 and as explained in section 711.03(c)(I)(A) of the MPEP, an allegation that an Office action that was properly addressed to the correspondence of record was never received may be considered in a petition to re-mail that Office action. If adequately supported, the Office may grant such a petition and re-mail the Office action.

To establish non-receipt of an Office communication, the petition must include: (1) a statement from patent owner describing the system used for recording an Office action received at the correspondence of record, and the statement should establish that the docketing system used is sufficiently reliable; (2) a statement from patent owner stating that the Office action was not received at the correspondence address of record, and indicate that a search of patent owner's record indicates that the Office action was not received; and (3) a copy of patent owner's records to show non-receipt of the Office action.

¹ The petition included a response to the Office action of March 6, 2009 as patent owner's representative obtained a copy of the Office action when becoming aware of it as a result of a telephone call initiated by the Office on or about July 30, 2009, to verify that no response had been filed to the Office action.

The instant petition lacks of the above required items. The Petition is therefore **DISMISSED** and the Office action of March 6, 2009 will not be re-mailed or the response submitted with the petition accepted as having been timely filed.

Any action, such as a renewed petition, taken in response to this decision must be taken **within two (2) months** of the mailing date of this decision, see 37 CFR 1.181(f). If no renewed petition is filed within the period indicated above, this reexamination proceeding will be terminated pursuant to 37 CFR 1.550(d) that states, in part, "the prosecution of an ex parte reexamination proceeding is terminated if the patent owner fails to file a timely and appropriate response". The termination of the reexamination proceeding would result in the issuance of a reexamination certificate that would be consistent with the position taken in the last Office action. In this instant, as claims 1-8, all of the claims in the patent undergoing reexamination, were rejected, the claims would be cancelled.

Response to this decision 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 Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.



Gregory Morse, Director
Central Reexamination Unit

acting
for



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MAR 25 2010

CENTRAL REEXAMINATION UNIT

Ezra Sutton
Plaza 9
900 Route 9
Woodbridge, NJ 07095

(For patent owner)

Scott E. Kamholz
Foley Hoag LLP
155 Seaport Blvd.
Boston, MA 02210-2600

(For requester)

In re Edward L. Tobinick
Ex Parte Reexamination Proceeding
Control No. 90/010,236
Filed: August 5, 2008
For: U.S. Patent No. 6,080,147

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

This is a decision on the December 7, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination¹ ("the December 7, 2009 patent owner petition to revive").

The appropriate petition fee of \$810.00 set forth in 37 CFR 1.17(m) for the December 7, 2009 patent owner petition to revive has been paid.

The December 7, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 7, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

¹ Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the March 6, 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 December 7, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the March 6, 2009 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The March 6, 2009 Office action set a two-month period for response. A proper response to the March 6, 2009 Office action was not filed until August 7, 2009, which was untimely. However, for the purpose of evaluating whether the December 7, 2009 patent owner petition to revive is a grantable petition, the submission of the August 7, 2009 response to the March 6, 2009 Office action satisfies item (1).²

Accordingly, the December 7, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The December 7, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.
2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for treatment of the August 7, 2009 Amendment and Response.
3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Robert Fetsuga, of CRU Art Unit 3993, at (571) 272-4886.
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 This decision is not directed to the persuasiveness and propriety of the arguments presented in the August 7, 2009 response as to each of the rejections set forth in the March 6, 2009 Office action; such is the examiner's province.



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COMMISSIONER FOR PATENTS
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SecuGen Corporation
2356 Walsh Avenue
Santa Clara, CA 95051

MAILED
SEP 11 2008

(Patent Owner)

CENTRAL REEXAMINATION UNIT

[Enclosure: Third Party Requester's September 9, 2008 Petition]

Baker & McKenzie LLP
Patent Department
2001 Ross Avenue
Suite 2300
Dallas, TX 75201

(For Third Party Requester)

In re *SecuGen Corporation*
Ex Parte Reexamination Proceeding
Control No.: 90/010,237
Filed: August 6, 2008
For: U.S. Patent No. 6,324,020 B1

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

This is a decision on the September 9, 2008 third party requester paper entitled "SUPPLEMENTAL SUBMISSION FURTHER TO UNION COMMUNITY'S REQUEST FOR EX-PARTE EXAMINATION" (hereinafter "the petition").

The above styled paper is being treated as a petition. The petition and *ex parte* reexamination control number 90/010,237 are before the Office of Patent Legal Administration for decision.

The petition does not assert a regulatory basis for the requested relief, but has authorized the payment of any fees required by charging such fees to Deposit Account No. 13-0480. Although the petition does not state any regulatory basis for the relief being requested thereby, it appears that the basis for the relief requested is 37 CFR 1.182, since the relief requested by petitioner is that the request for reexamination (assigned control number 90/010,237) "be dismissed." As discussed, *infra*, consideration of the petition would also require waiver of the rules under 37 CFR 1.183. A petition under 37 CFR 1.182 and a petition under 37 CFR 1.183 each requires payment of the fee established by 37 CFR 1.17(f). A single petition fee under 37 CFR 1.17(f) in the amount of \$400.00 will be charged to above identified Deposit Account for the present petition.

09/11/2008 JHCDUGA 00000002 130480 90010237

01 FC:1462 400.00 DA

The petition paper is being expunged from the record as an improper paper. The petition is dismissed and a copy of the petition is being mailed to patent owner for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,324,020 B1 (the '020 patent) issued on November 27, 2001 from application number 09/368,442 (the '442 application) filed on August 4, 1999, and is assigned to SecuGen Corporation.
2. Third party requester Union Community Co. Ltd. caused a request for *ex parte* reexamination of the '020 patent to be filed on August 6, 2008. The request for reexamination was assigned control number 90/010,237 (hereinafter "the '0237 reexamination proceeding") and is the present proceeding.
3. There has been no determination on the request for reexamination in the '237 reexamination proceeding.
4. The present petition was filed on September 9, 2008, with no indication of service on the patent owner.

STATUTORY AND REGULATORY PROVISIONS

35 U.S.C. § 301 states, in pertinent part:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 states, in pertinent part:

"Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

35 U.S.C. § 303(a) provides:

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

35 U.S.C. § 304 provides:

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

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

“After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. ... In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto,” (Emphasis added.)

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.535 provides.

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

37 CFR 1.550(f) provides:

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

DECISION

As noted, *supra*, the request for reexamination of the ‘020 patent was filed on August 6, 2008. The record shows that reexamination has not been ordered, or denied. Therefore, in accordance with 37 CFR 1.535, the third party requester was not entitled to file any submission at the time the petition present petition was filed. Further, 37 CFR 1.550(f) requires the present petition be served by third party requester on patent owner. Therefore, consideration of the present petition on its merits would require a waiver the provisions of both 37 CFR 1.535 and 1.550(f) to excuse the failure to serve the petition and suspend the prohibition on the filing of this paper when reexamination has not been ordered, and patent owner has, not filed a patent owner’s statement..

Granting of such a waiver of the rules under 37 CFR 1.183 requires that petitioner demonstrate that the situation is an extraordinary one in which justice would require a waiver of the rules. Petitioner third party requester has failed to make any such showing. Therefore, the petition is a paper that lacks an entry right, since it (a) was filed at a time that the rules preclude such a filing and (b) was also not served on patent owner as required by the rules. Therefore, the present petition paper will be expunged from the record.

ADDITIONAL DISCUSSION

35 U.S.C. §§ 302-305 provide, *inter alia*, that when a request for reexamination is filed, the Director will determine whether a substantial new question of patentability exists.¹ Thereafter, if the Director has determined that a substantial new question of patentability exists, that determination will include an order for reexamination of the patent.² Thereafter, reexamination will be conducted, and patent owner will be permitted to amend his patent and a new claim or claims thereto.³

A request to withdraw an *ex parte* reexamination request, would not be permitted in view of the legislation and implementing rules which require that (1) once an *ex parte* reexamination request is filed, it will be decided, and (2) once the request is determined to raise a substantial new question of patentability of a claim of the patent, the request *will* result in an order for reexamination to resolve the substantial new question, which in turn *will* be followed by reexamination in accordance with 35 U.S.C. §§ 303-305. The statutory language is based on the public interest in resolving any reexamination proceeding that is filed.

Withdrawal of a third party requested reexamination proceeding would leave both the public and the patent owner with an unresolved request for reexamination. Both the public and the patent owner have a right to such a resolution. In the event reexamination is ordered, a substantial new question of patentability will have been raised in the proceeding, and the patent owner has a statutory right to have that question resolved, including amending the patent as deemed necessary. All of this would be abrogated by "withdrawing" or otherwise "abandoning" or "terminating" a reexamination.

It is finally to be noted that even if a reexamination request could be withdrawn, the Director is authorized under 35 U.S.C. § 303(a) to order reexamination on his own initiative, based on an existing substantial new question of patentability, and this would serve the public interest for which the provision for a Director-initiated-reexamination was enacted. As a matter of administrative convenience, the Office need not, and will not, expend the additional resources needed to terminate and conclude one reexamination proceeding only to institute another one based on the same substantial new question of patentability that presently exists in the reexamination proceeding for which withdrawal is requested.

CONCLUSION

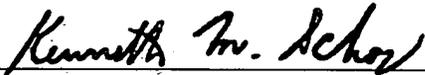
1. The third party requester petition filed February 17, 2006 is dismissed.

¹ 35 U.S.C. § 303

² 35 U.S.C. § 304

³ 35 U.S.C. § 305

2. The petition paper is being expunged from the record, by being marked "non-public" and "closed in the Image File Wrapper, and will not form part of the record in the '0237 reexamination proceeding.
3. A copy of this decision will be made of record in the reexamination file.
4. A copy of the petition paper filed September 8, 2008, is being provided to the patent owner as an attachment to this decision in order to perfect service.
5. The '0237 *ex parte* reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for appropriate action.
6. Telephone inquiries related to the present decision should be directed to the Stephen Marcus, Senior Legal Advisor, at 571-272-7743, or, in his absence, to the undersigned at 571-272-7710.



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

sm
September 10, 2008



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.
90/007,247	10/04/2004	6573099	0687/74768	6310

23432 7590 06/25/2009

COOPER & DUNHAM, LLP
30 Rockefeller Plaza
20th Floor
NEW YORK, NY 10112

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/25/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,247	10/04/2004	6573099	0687/74768	6310
23432	7590	06/25/2009	EXAMINER	

Erich E. Veitenheimer
Cooley Godward KronishLLP
777 6th Street, NW Suite 1100
Washington, DC 20001

ART UNIT	PAPER NUMBER
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DATE MAILED: 06/25/2009

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



Cooper & Dunham, LLP
30 Rockefeller Plaza
20th Floor
New York, NY 10112

(For Patent Owner)

Erich E. Veitenheimer
Cooley Godward Kronish LLP
777 6th Street, NW Suite 1100
Washington, DC 20001

(For Third Party Requester)

MAILED

In re Graham *et al.*
Merged *Ex Parte* Reexamination Proceedings
Control Nos.: 90/007,247 & 90/008,096
Filed: Oct. 4, 2004 & May 18, 2006
For: U.S. Patent No.: 6,573,099

:
: DECISION
: ON
: PETITIONS
:

JUN 25 2009
CENTRAL REEXAMINATION UNIT

This is a decision on the April 7, 2009 patent owner petition under 37 CFR 1.182 requesting continued reexamination and the May 7, 2009 patent owner petition under 37 CFR 1.182 requesting withdrawal of the April 7, 2009 petition.

The above noted petitions are before the Office of Patent Legal Administration.

For the reasons set forth below, the April 7, 2009 petition is dismissed as withdrawn and has not been considered on its merits. The May 7, 2009 petition is granted.

FEEES

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the April 7, 2009 petition under 37 CFR 1.182 has been charged to Deposit account No. 03-3125 in accordance with petitioner's authorization on page 6 of the April 7, 2009 petition.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the May 7, 2009 petition under 37 CFR 1.182 is waived, as the petition is a request to withdraw the previous petition.¹

REVIEW OF THE FACTS

1. On June 3, 2003, the Office issued U.S. Patent 6,573,099 (the '099 patent) to Michael Wayne Graham. After issuance, the inventorship was corrected to add Robert Norman Rice.
2. On October 4, 2004, a first request for *ex parte* reexamination of the '099 patent was filed by a third party requester, Nucleonics, Inc. The resulting reexamination proceeding was assigned control number 90/007,247 (the '7247 proceeding).

¹ As such, the petition for withdrawal of the prior petition is treated as a supplemental petition, as far as the fee is concerned.

3. On December 7, 2004, the Office issued an order in the '7247 proceeding granting the first request for reexamination of the '099 patent.
4. On May 18, 2006, another request for *ex parte* reexamination of the '099 patent was filed by a third party requester, Nucleonics, Inc. The resulting reexamination proceeding was assigned control number 90/008,096 (the '8096 proceeding).
5. On July 20, 2006, the Office issued an order in the '8096 proceeding granting the second request for reexamination of the '099 patent.
6. On October 26, 2006, the Office merged the '7247 and the '8096 proceedings into the present merged *ex parte* reexamination proceeding (the merged proceeding).
7. Prosecution in the merged proceeding advanced to the point that a final Office action issued on November 26, 2008.
8. On February 26, 2009, patent owner submitted an amendment after final with an evidentiary declaration by Dr. Riggs.
9. On March 25, 2009, the Office issued an advisory action informing patent owner the February 26, 209 amendment did not place the proceeding in condition for confirmation or allowance and did not reduce issues for appeal and therefore would not be entered.
10. On April 7, 2009, patent owner submitted a petition requesting entry of the February 26, 2009 after final amendment.
11. Concurrently on April 7, 2009, patent owner submitted a petition requesting continued reexamination of the merged proceeding.
12. On April 22, 2009, patent owner submitted a petition requesting an extension of time.
13. On April 24, 2009, the Office issued a supplemental advisory action informing patent owner that the February 26, 209 amendment, while not placing the proceeding in condition for confirmation or allowance, reduced issues for appeal, and, therefore, it would be entered. The supplemental advisory action also extended patent owner's time to respond to the November 26, 2009 final Office action for six months until May 26, 2009.
14. On April 25, 2009, the Office issued a decision granting patent owner's April 7, 2009 petition requesting entry of the February 26, 2009 amendment after final.
15. On April 27, 2009, the Office issued a decision dismissing patent owner's April 22, 2009 petition for an extension of time in light of the extension of time granted by the April 24, 2009 supplemental advisory action.

16. On May 7, 2009, patent owner filed a petition requesting withdrawal of the April 7, 2009 petition requesting continued reexamination of the merged proceeding, in light of the Office's entry of the February 26, 2009 after final amendment.
17. On May 27, 2007, patent owner submitted a notice of appeal with a certificate of express mailing dated May 22, 2009.

DECISION ON PETITION UNDER 37 CFR 1.182

In the April 7, 2009 petition, patent owner requested that the Office continue the prosecution of the merged reexamination proceeding to provide consideration of the Riggs declaration and the February 26, 2009 after-final amendment in response to the November 26, 2008 final Office action.

In the May 7, 2009 petition, patent owner requested that the Office withdraw from consideration the April 7, 2009 request for continued prosecution of the merged reexamination proceeding in light of the fact that the Riggs declaration and the February 26, 2009 after-final amendment were entered onto the record by the Office on April 25, 2009.

In light of the patent owner request that the Office withdraw from consideration the April 7, 2009 request for continued prosecution of the merged reexamination proceeding, the April 7, 2009 petition is hereby dismissed as withdrawn and has not been considered on its merits. The May 7, 2009 petition is granted.

CONCLUSION

1. The April 7, 2009 petition under 37 CFR 1.182 is dismissed as withdrawn.
2. The May 7, 2009 petition under 37 CFR 1.182 is granted.
3. Jurisdiction for the merged reexamination proceeding is returned to the Central Reexamination Unit (CRU).
4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,238	08/06/2008	6519466	2875.262REX0	2884

34408 7590 06/05/2009

THE ECLIPSE GROUP LLP
10605 BALBOA BLVD., SUITE 300
GRANADA HILLS, CA 91344

EXAMINER

ART UNIT PAPER NUMBER

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DATE MAILED:

NOV 2 0 2009

CENTRAL REEXAMINATION UNIT

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,238	08/06/2008	6519466	18178.1.1.1.1	2884

22913 7590 11/20/2009
Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Ave. NW
Washington, DC 20005

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2009

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,238	08/06/2008	6519466	18178.1.1.1.1	2884

22913 7590 11/20/2009

Workman Nydegger
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

EXAMINER

ART UNIT PAPER NUMBER

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COMMISSIONER FOR PATENTS
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P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

THE ECLIPSE GROUP LLP
10605 BALBOA BLVD., SUITE 300
GRANADA HILLS CA 91344

(For Patent Owner)

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVE. NW
WASHINGTON, DC 20005

(For Third Party Requester)

WORKMAN NYDEGGER
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

(Courtesy Copy)

MAILED

NOV 20 2009

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/010,238
Filed: August 6, 2008
For: U.S. Patent No. 6,519,466

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

This is a decision on patent owner's petition paper, filed on September 8, 2009, entitled "PETITION UNDER 37 CFR 1.183 REQUESTING WAIVER OF THE SIGNATURE OF AN INVENTOR FOR A DECLARATION UNDER 37 CFR 1.131" (petition under 1.183), requesting waiver of the signature of an unwilling inventor on a declaration under 37 CFR 1.131 and acceptance of the declaration under 37 CFR 1.131 without execution by all of the named inventors. The petition under 37 CFR 1.183 was accompanied by the "DECLARATION OF GREGORY BRET TURETZKY IN SUPPORT OF PETITION UNDER 37 CFR 1.183."

The proceeding and the petition under 37 CFR 1.183 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 THE RELEVANT FACTS

1. On February 11, 2003, United States Patent Number 6,519,466 (the '466 patent) issued. The '466 patent was assigned to SiRF Technology, Inc. (referred to herein as "SiRF").
2. On August 6, 2008, a request for *ex parte* reexamination of the '466 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/010,238 (the '10238 proceeding).
3. On October 17, 2008, the Office issued an order granting *ex parte* reexamination in the '10238 proceeding.
4. On June 5, 2009, a non-final Office action was issued in the '10238 proceeding.
5. On July 27, 2009, a power of attorney revoking the previous power of attorney and appointing new counsel was filed, in addition to a statement under 37 CFR 3.73(b) establishing that the present assignee has the authority to act in the '10238 proceeding. The power of attorney was filed by Mr. Adam Dolinico, lead counsel of the assignee, as representative of the assignee, and the statement under 37 CFR 3.73(b) was also filed by Mr. Dolinico, as authorized to act on behalf of the assignee.
6. On July 31, 2009, patent owner filed a request for extension of time to file patent owner's response to the June 5, 2009 Office action.
7. On August 5, 2009, patent owner's request for extension of time was granted, extending patent owner's time period for response by one month.
8. On September 8, 2009, patent owner timely filed an "AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION" in the '10238 proceeding, accompanied by a "DECLARATION UNDER 37 CFR 1.131."
9. Concurrently, on September 8, 2009, patent owner filed the instant "PETITION UNDER 37 CFR 1.183 REQUESTING WAIVER OF THE SIGNATURE OF AN INVENTOR FOR A DECLARATION UNDER 37 CFR 1.131," accompanied by the "DECLARATION OF GREGORY BRET TURETZKY IN SUPPORT OF PETITION UNDER 37 CFR 1.183."

DECISION

Relevant Statutes, Regulations and 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 provides:

(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 provides:

(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

On September 8, 2009, patent owner filed an "AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION," accompanied by a "DECLARATION UNDER 37 CFR 1.131," which was executed by three of the four named inventors of the '466 patent, Gregory Bret Turetzky, Ashutosh Pande and Kanwar Chadha. Concurrently on September 8, 2009, patent owner filed the instant petition under 37 CFR 1.183, accompanied by the declaration of Gregory Bret Turetzky in support of the petition under 37 CFR 1.183, requesting waiver of the signature of the fourth inventor of the '466 patent, Lionel Jacques Garin, on the declaration under 37 CFR 1.131.

The instant petition has been fully considered. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. *See, Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that ". . . *the owner of the patent under reexamination. . .* may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. In this case, three of the four inventors, rather than the patent owner, have attempted to submit a declaration under 37 CFR 1.131. Thus, as this avenue for relief is available to patent owner, waiver of the rule is not required.

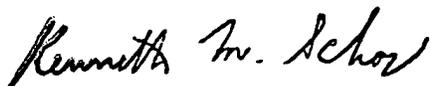
In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief and for that reason the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed. The "DECLARATION UNDER 37 CFR 1.131," which accompanied patent owner's "AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION," filed on September 8, 2009, will not be entered into the record of the '10238 proceeding.

PATENT OWNER'S ADDRESS

Patent owner is reminded to update the correspondence address in the '466 patent file based on the change in power of attorney in the '10238 proceeding. The Office will not engage in double correspondence with more than one attorney or agent. *See* 37 CFR 1.33(c). It is recommended that Form PTO/SB/123 be used for this purpose.

CONCLUSION

1. For the reasons set forth herein, patent owner's September 8, 2009 "PETITION UNDER 37 CFR 1.183 REQUESTING WAIVER OF THE SIGNATURE OF AN INVENTOR FOR A DECLARATION UNDER 37 CFR 1.131" is dismissed.
2. The "DECLARATION UNDER 37 CFR 1.131," which accompanied patent owner's "AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION," filed on September 8, 2009, will not be entered into the record of the '10238 proceeding.
3. Jurisdiction for the '10238 reexamination proceeding is being returned to the Central Reexamination Unit (CRU).
4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.



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



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,239	08/08/2008	6077443	2565/181	4896

86651 7590 08/03/2009

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/03/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

HISCOCK & BARCLAY, LLP
2000 HSBC PLAZA
100 CHESTNUT STREET
ROCHESTER, NY 14604-2404

MAILED

AUG 03 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010239
PATENT NO. : 6077443
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)).



Kenyon & Kenyon LLP
One Broadway
New York NY 10004

(Patent Owner)

MAILED

Hiscock & Barclay LLP
2000 HSBC Plaza
100 Chestnut St.
Rochester, NY 14604

(Third Party Requester)

AUG 03 2009

CENTRAL REEXAMINATION UNIT

In re Rainer Goldau
Reexamination Proceeding
Control No.: 90/010,239
Filed: August 8, 2008
For: U.S. Patent No.: 6,077,443

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

This is a decision on the May 8, 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 May 8, 2009, has not been entered for consideration by the examiner.

FEE

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. 11-0600 in accordance with petitioner's authorization in the May 8, 2009 petition.

BACKGROUND

1. On June 20, 2000, the Office issued U.S. Patent No. 6,077,443, to Rainer Goldau (the '443 patent).
2. On August 8, 2008, a third party requester deposited a request for *ex parte* reexamination of the '443 patent. The request was assigned reexamination control number 90/010,239 (the '10239 proceeding).
3. On October 23, 2008, the Office issued an order granting reexamination for the '10239 reexamination request.

4. Prosecution progressed to the point where, on May 1, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '10239 proceeding.
5. On May 8, 2009, the '10239 proceeding was designated 452 status as entering the print cycle.
6. Also on May 8, 2009, patent owner filed the instant petition accompanied by an IDS, which patent owner requests the Office to consider.
7. The '10239 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

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

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

MPEP 2256

....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. **Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. (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 or 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, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

The requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256 as follows:

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

In the present instance, the fact situation fails to satisfy the grounds for the entry of information after issuance of a NIRC, either before or after the proceeding has entered the print 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. While patent owner does provide a brief summary of the substance of the items of information, patent owner has neither explained the relevancy of the teachings nor applied the teachings to the claim limitations in the present reexamination proceeding. Furthermore, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier in the reexamination proceeding. Patent owner admits to awareness of the information submitted by dint of a first action issued on May 1, 2007 in a related Japanese application citing this same information. Patent owner makes no attempt to provide a factual accounting as to why the information was not previously submitted, despite this admission on the record to being aware of the information during the entire duration of the present proceeding. It is noted that the petition was submitted on the same day the proceeding was designated 452 status, *i.e.* entered the print cycle. However, 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 print cycle. Therefore, the present petition does not satisfy the requirements for a petition submitted 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 May 1, 2009, and the proceeding has now entered the final stages of the publication process, *i.e.* the print cycle, as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure explain why it could not have been submitted earlier, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

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

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on May 8, 2009.
2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding.
3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

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

Roberta Clarke, Director, OPLA for
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.
90/010,242	08/11/2008	5,968,131	6087.007.131	7635

7590 01/12/2009

EXAMINER

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

ART UNIT PAPER NUMBER

DATE MAILED: 01/12/2009

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.
90/010,242	08/11/2008	5,968,131	6087.007.131	7635

7590 01/12/2009

JINNTUNG SU
MANATT, PHELPS & PHILLIPS LLP
1001 PAGE MILL ROAD
BLDG .2
PALO ALTO, CA 94304

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/12/2009

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JINNTUNG SU
MANATT, PHELPS & PHILLIPS LLP
1001 PAGE MILL ROAD, BLDG. 2
PALO ALTO CA 94304

(For Patent Owner)

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

(For Third Party Requester)

MAILED

JAN 17 2009

CENTRAL REEXAMINATION UNIT

In re Mendez et alia
Reexamination Proceeding
Control No. 90/010,242
Request Deposited: August 11, 2008
For: U.S. Patent No. 5,968,131

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Mendez et alia
Reexamination Proceeding
Control No. 90/010,259
Request Deposited: August 28, 2008
For: U.S. Patent No. 5,968,131

:
:
:
:
:

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. 5,968,131 (hereinafter, the '131 patent), issued to Mendez *et alia*, on October 19, 1999.
2. On August 11, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '131 patent. The reexamination proceeding was assigned Control No. 90/010,242 (hereinafter, the '10242 proceeding).

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3. On August 28, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '131 patent. The reexamination proceeding was assigned Control No. 90/010,259 (hereinafter, the '10242 proceeding).
4. The Reexamination Order was granted in the '10242 proceeding on October 10, 2008.
5. The Reexamination Order was granted in the '10259 proceeding on October 10, 2008.
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 '10242 and the '10259 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

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CONCLUSION

1. Reexamination Control Nos. 90/010,242 and 90/010,259 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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(For Patent Owner)

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

MAILED

APR 27 2010

(For Requester) CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

In re Singer et alia
Reexamination Proceeding
Control No. 90/010,251
For: U.S. Patent No. 6,314,473

: DECISION
: DISMISSING AS MOOT
: PETITION UNDER
: 37 CFR 1.181

This is a decision on the March 4, 2010 petition to withdraw the finality of the office action mailed January 4, 2010.

The petition is before the Central Reexamination Unit for consideration.

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

DECISION

Subsequent to the filing of the instant petition, Patent Owner filed a response to the final rejection, including declarations and arguments. In view of the response to the final rejection, the office has withdrawn the standing rejections and issued a Notice of Intent to Issue Reexamination Certificate on April 23, 2010. Therefore, the petition to withdraw the finality of the previous office action is **dismissed as moot**.

CONCLUSION

1. Petitioner's request is **dismissed as moot**.
2. All correspondence relating to this *ex parte* reexamination proceeding should be directed:

Art Unit: 3992

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

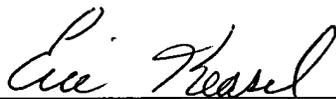
By Mail to: Mail Stop *Ex Parte* Reexam
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Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
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By FAX to: (571) 273-9900
Central Reexamination Unit

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401 Dulany Street
Alexandria, VA 22314

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

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



Eric Keasel
SPE, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,255	08/26/2008	6923352		4417

33417 7590 02/10/2009

LEWIS, BRISBOIS, BISGAARD & SMITH LLP
221 NORTH FIGUEROA STREET
SUITE 1200
LOS ANGELES, CA 90012

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/10/2009

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Date: **FEB 10 2009**

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David M. Kleiman

L.A. PATENTS, INTELLECTUAL PROPERTY LAW

21900 Burbank Blvd., 3rd Floor

Woodland, CA 91367

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010255

PATENT NO. : 6923352

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)

LEWIS, BRISBOIS, BISGAARD
& SMITH LLP
221 North Figueroa Street
Suite 1200
Los Angeles, CA 90012

MAILED

FEB 10 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

David M. Kleiman
L.A. PATENTS, INTELLECTUAL PROPERTY LAW
21900 Burbank Blvd., 3rd Floor
Woodland Hills, CA 91367

In re Oh

Reexamination Proceeding
Control No. 90/010,255
Filed: August 26, 2008
For: U.S. Patent No. 6,923,352

:
: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

The paper filed by requester on November 17, 2008, styled as "37 C.F.R. § 1.181 Petition Seeking Review of the Examiner's Determination Refusing Reexamination of U.S. Patent No. 6,923,352," 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 21, 2008. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

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REVIEW OF FACTS

1. U.S. Patent No. 6,923,352 (hereinafter, the '352 patent) issued on August 2, 2005.
2. On August 26, 2008, the third party requester deposited a request for *ex parte* reexamination for claims 1-27, and the resulting reexamination proceeding was assigned Control No. 90/010,255 (hereinafter, the '255 proceeding).
3. On October 21, 2008, an order denying the request for reexamination for claims 1-27 was issued.
6. On November 17, 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 upon several errors. In support, the petitioner advances the following points:

1. The examiner incorrectly concluded that the request did not set forth a substantial new question of patentability by the Scicluna reference alone with respect to claims 1-12, 18-23 and 27. See pages 4-5 and 9-16 of the petition.
2. The examiner incorrectly concluded that the teachings of Tsai are cumulative to the teachings considered in the prior examination and does not raise a substantial new question of patentability in combination with the Scicluna reference with respect to claims 1-12, 18-23 and 27. See page 5 and 16-21 of the petition.
3. The examiner incorrectly determined that the combination of the Scicluna, Tsai, Godshaw, and Weber references to not raise a substantial new question of patentability with respect to claims 13, 14, and 24. See pages 5 and 21-22 of the petition.
4. The examiner incorrectly determined that the combination of the Scicluna, Tsai, Lim, and Cohen references to not raise a substantial new question of patentability with respect to claims 15-17, 25, and 26. See pages 5 and 22-23 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 1-27 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial

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of the request to order reexamination for claims 1-27 of the '352 patent. Consideration is limited as to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 1-27. 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) nor any additional SNQs made for the first time in the petition.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

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

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

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

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

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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. 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."^{2,3} 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 provides guidelines for such an order, and requires that the examiner's decision in the order state, for each patent and printed publication cited in the request, why the citation is:

- (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
- (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
- (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
- (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

² See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

³ For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al.*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

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Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester, which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A. Scicluna reference: It must first be determined if the Scicluna reference raises a substantial new question of patentability (SNQ) not considered in a prior examination or reexamination. In other words, does the Scicluna reference, either singly or together, raise an SNQ that is different from the technical teachings that were considered with respect to claim patentability in the prosecution of application number 10/310,434, which issued as the 6,923,352 patent?

In the prior prosecution, the Scicluna reference was applied in a rejection under 35 U.S.C. 102(b) of claims 1-11 and in rejections under 35 U.S.C. 103(a) in combination with the teachings of Weber or Godshaw (claims 12-14), in combination with the teachings of Lim (claims 15 & 17), and in combination with the teachings of Lim and Cohen (claim 16). See the Office action dated July 2, 2004. Specifically, similar limitations pertaining to the rear compartment comprising an opening and a cover, present in all the independent claims of the '352 patent, were located in originally-filed dependent claims 12-14 in the application that issued as the '352 patent. The examiner determined that Scicluna did not teach such limitations and applied the teachings of Weber and Godshaw in combination with Scicluna. Therefore, the Scicluna, Weber, Godshaw, Lim, and Cohen references are old art that were previously considered and applied in a prior examination.

The request for reexamination, dated August 26, 2008, stated that claims 1-12, 18-23, and 27 of the '352 patent are obvious under 35 U.S.C. § 103 in view of Scicluna and/or Tsai. See page 5 of the request. The request also proposes rejections under 35 U.S.C. 103(a) of claims 13, 14, and 24 based on Scicluna and Tsai and in further view of Godshaw or Weber (see page 7 of the request) and claims 15-17, 25, 26 based on Scicluna and Tsai and in further view of Lim and Cohen (see page 8 of the request).

As stated in the section above, in order for old art to raise a SNQ, 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. In an attempt to meet this requirement, the request does point to a teaching in Scicluna pertaining to the side zippers for closing the wheel cover flap (e.g., see page 6 of the request). In the order denying the request for reexamination, the examiner explicitly found that this new teaching of Scicluna does not teach the claim limitations to which this new teaching was being applied. Specifically, the examiner determined that that this new teaching does not teach the limitations that "the rear compartment comprises an opening proximate to the container's top from which the carrying means may be deployed and a cover for covering the opening for fully concealing the carrying means from view in a closed position." See pages 5-6 of the order denying reexamination dated October 21, 2008.

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Upon *de novo* review, the examiner correctly determined that the “new” teaching of Scicluna does not teach the claim limitations to which this teaching was applied in the request for reexamination. In reviewing the reference as a whole, Scicluna clearly teaches that the cover for the compartment 160 does not cover the compartment where the carrying means are located. The petitioner states on page 10 of the petition that “[t]here is nothing in the portion of the patent that was cited to by the requester that states the rear wheel cover flap 160 had to be shorter, or that a top side zipper could not also be provided to the rear wheel cover flap 60 of the first embodiment shown in FIGS 1 and 2.” Even applying this teaching to the embodiments of Figures 1-6 would not result in the claimed invention. At best, applying this “new” teaching to the embodiment of Figures 1-6 would result in the compartment 60 having a zipper closure instead of a hook and loop fastener closure. See column 3, lines 4-24, of the Scicluna reference. The petitioner seems to be equating the rear wheel cover flap as the rear compartment that houses the carrying means, but the rear wheel cover flap 60 or 160 is clearly a different structure than that of the rear compartment located between elements 20 and 22 (in Figures 1-6) or inside element 120 (in Figure 7). Therefore, the examiner correctly concluded that a reasonable examiner would not find this “new” teaching to be important to a reasonable examiner in determining the patentability of the claims.

In evaluating the context in which the Scicluna reference was previously considered and the scope of the prior consideration, it is clear that the examiner considered and applied the Scicluna reference under the doctrines of both anticipation and obviousness. In addition, the evidence of record shows that the Scicluna reference is nine pages long (including the front page and 4 sheets of drawings) and does not involved a complex technology. More importantly, the Scicluna reference was deemed by the examiner in the prior prosecution to be missing teachings pertaining to the rear compartment comprising an opening and a cover, as cited in originally-filed claims 12-14 in the application that issued as the ‘352 patent. The examiner in the prior examination considered and applied (in a rejection of claims 12-14) the modification of the Scicluna reference by adding the closure (e.g., a zipper) that closes the top of the rear compartment to fully conceal the carrying means located therein. The rejection was withdrawn when such limitations were added to the independent claims and arguments were made that such a modification would not be obvious. As explained above, the “new” teaching pointed out by the requester does not provide any new light the proposed modification of Scicluna as to the rear compartment’s opening and cover. The fact that the examiner in the prior examination did not mention a certain portion of the Scicluna reference does not provide substantial evidence that it was not considered. According to the policy and procedures of the Office, an examiner cites to portions of the reference that illustrate the claim limitations that the reference teaches in a rejection, but that alone does not provide evidence that only those cited portions were considered and applied. See MPEP 706. It would be unreasonable to expect an examiner to mention every portion of a reference applied in a rejection and state that the teaching was considered but determined to be not important to the patentability of the claims. Accordingly, the Scicluna reference, alone, fails to raise an SNQ as to claims 1-27.

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B. Scicluna and Tsai references: As stated in the section above, Scicluna is old prior art that was applied in a rejection in a prior examination. The Tsai reference was not applied nor cited in the prior examination. The petitioner states on pages 16-21 of the petition that the Tsai reference is not cumulative to the teachings of the prior art already considered and applied in a prior examination (namely Godshaw and Weber) because the configuration of the container in Tsai is very similar to the configuration of the container in Scicluna. Therefore, the petitioner concludes that "it would have been quite obvious to a person of ordinary skill in the art" to modify Scicluna to have a zippered rear compartment to fully conceal the carrying means. See pages 17-18 of the petition.

Upon review of Godshaw, Weber, and Tsai, it is clear that the teachings of Tsai regarding the rear compartment having a similar configuration to that of Scicluna's rear compartment and an opening and a cover for covering the opening for fully concealing the carrying means from view is cumulative to the teachings of Godshaw and Weber. Godshaw teaches a backpack, which is of similar shape and size to that of Scicluna's backpack. Godshaw's backpack includes a carrying means (both an extendable handle and shoulder straps) that are enclosed in rear compartments and fully concealed by a cover when not in use. For example, see Figures 1 and 2 and column 3 lines 16-18. Weber teaches a travel pack, which is of similar configuration to Tsai, that includes shoulder straps in a rear compartment that has an opening and a cover for fully concealing the straps when not in use (e.g., see Figures 1 and 2 and column 3 lines 61-63). Tsai teaches luggage that has a rear compartment for storing an extendable handle in which the rear compartment has an opening and a cover for fully concealing the handle when not in use. Furthermore, see the Figures on pages 17 and 19 of the request, which shows how Tsai, Godshaw, and Weber present similar teachings pertaining to the rear compartment. Therefore, Tsai's teachings are cumulative to the teachings of Godshaw and Weber, which were applied in the prior examination, in combination with the Scicluna reference, for teachings pertaining to the rear compartment having an opening and a cover for fully concealing the carrying means.

As further evidence, the request for reexamination states, e.g., on page 9, that Tsai presents similar teachings to Godshaw and Weber pertaining to the compartment concealing the carrying means. Moreover, the request is seemingly arguing that the prior rejection based on Scicluna in view of Godshaw should have been retained in the prior examination (see pages 9-11 of the request). Therefore, the requester is merely citing to a reference not of record in the prior examination (Tsai) for applying the same teachings in substantially the same manner that was already made in the prior examination. As stated above in Section II, reexamination 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.

As previously mentioned, Godshaw and Weber were the basis for teachings pertaining to the rear compartment comprising an opening and a cover in dependent claims 12-14 in the prior examination. Accordingly, Tsai must present an SNQ in the form of a new technical teaching (e.g., new information) not previously discussed or considered on the record in the previous proceedings, (i.e., the examination of the application that matured into the '352 patent) in order

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for a request for reexamination to be granted. Tsai may also present the teachings of old art (e.g., Scicluna, Weber, Godshaw, Cohen, and Lim) "in a new light" in order to raise a substantial new question of patentability in regards to these references that were already considered in previous examinations; presenting a previously considered teaching "in a new light" is considered to be the presentation of a new technical teaching.

Petitioner states that Tsai is not cumulative to the teachings of Godshaw and Weber because the request is not relying on Tsai for the teaching regarding the rear compartment comprising an opening and a cover. See the explanation provided on pages 17-19 of the petition. In particular, petitioner states the request is relying on the teaching of Tsai of providing a similarly configured rear compartment to that of Scicluna, which "...provides a much clearer suggestion and motivation than either Weber or Godshaw to add a top side zipper to the rear wheel cover flap 60 of Scicluna and thereby fully conceal from view the underlying carrying means." See page 19 of the petition. The evidence of record does not support petitioner's conclusion. First, it is clear that Godshaw teaches a backpack of similar configuration (shape and size) to that of Scicluna's backpack. The invention of Tsai actually pertains to luggage, which one of ordinary skill in the art would know that luggage is typically bigger in size and shape than a backpack and usually does not comprise shoulder straps. Therefore, petitioner's position that Tsai is not cumulative because of its teaching of a similar configuration is not supported by the evidence of record. Furthermore, the fact that the configuration of the luggage of Tsai is similar to the backpack of Scicluna (even if true) is not determinative of obviousness. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures."). See MPEP 2145.

Therefore, the request fails to set forth any new technical teachings that are pertinent to the patentability of the claims of the '352 patent, and that are different than that of Godshaw and Weber. Therefore, Tsai presents cumulative teachings to the teachings of Godshaw and Weber, which has been fully considered and applied in a prior examination, in combination with the Scicluna reference. Accordingly, Scicluna in view of Tsai fail to provide any new teachings as presented in the request for reexamination dated August 26, 2008.

The evidence and explanation, as set forth in the request dated August 26, 2008, simply does not support ordering a request for reexamination. The request does not present sufficient evidence that Tsai present the teachings of Scicluna in a new light, or otherwise provide any new technical teaching that was not previously discussed and considered on the record in a previous examination. The teachings of Tsai are deemed cumulative to the teachings already considered

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in the prior Office proceedings for the '352 patent, and as such, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination.

C. Scicluna, Tsai, Godshaw, and Weber references: As stated in the section above, Scicluna, Godshaw, and Weber are old prior art that was applied in a rejection in a prior examination. This proposed rejection is not supported by a SNQ for the reasons explained above in subsections A and B because both Scicluna and Tsai fail to present an SNQ. Therefore, Godshaw and Weber are not presented in any new light that was not already considered and applied in the prior examination.

D. Scicluna, Tsai, Lim, and Cohen references: As stated in the section above, Scicluna, Lim, and Cohen are old prior art that was applied in a rejection in a prior examination. This proposed rejection is not supported by a SNQ for the reasons explained above in subsections A and B because both Scicluna and Tsai fail to present an SNQ. Therefore, Lim and Cohen are not presented in any new light that was not already considered and applied in the prior examination.

Accordingly, the references cited in the request for the '255 reexamination proceeding fail to raise an SNQ as to claims 1-27 of the '352 patent.

Petitioner can still avail itself of an *ex parte* reexamination proceeding, provided that petitioner formulates and files a request for *ex parte* reexamination that brings forth some new technological information that was not considered in a previous examination. For example, presenting a secondary reference as anticipating the claims of the '352 patent may bring forth some new technological information that was not considered in a previous examination. See *In re Melvin J. Swanson et al.*, 540 F.3d 1368, 1376, 2008 U.S. APP. Lexis 18928. If a new request is filed, the new request should clearly set forth each SNQ, each proposed rejection that supports the SNQs, what claims each proposed rejection is applied to, and a clear, detailed explanation for how the references teach *every* claim limitation for *each* proposed rejection. The new request must not lump together the explanations of multiple, distinct proposed rejections. See MPEP 2214, 2216 and 2217.

As explained above, in accordance with MPEP 2640 and 2242, "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

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REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '352 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. The PETITION is DENIED.
2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Andy 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



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.
90/010,259	08/28/2008	5968131	6082.007.1312	8244

7590 01/12/2009

JINNTUNG SU
MANATT, PHELPS & PHILLIPS LLP
1001 PAGE MILL ROAD, BLDG. 2
PALO ALTO, CA 94304

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/12/2009

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)

Novak Druce & Quigg, LLP.
(NDQ Reexamination Group)
1000 Louisiana Street Fifty-Third Floor
Houston, TX 77002

MAILED

JAN 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,259.

PATENT NO. 5968131.

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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JINNTUNG SU
MANATT, PHELPS & PHILLIPS LLP
1001 PAGE MILL ROAD, BLDG. 2
PALO ALTO CA 94304

(For Patent Owner)

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

(For Third Party Requester)

MAILED

JAN 17 2009

CENTRAL REEXAMINATION UNIT

In re Mendez et alia
Reexamination Proceeding
Control No. 90/010,242
Request Deposited: August 11, 2008
For: U.S. Patent No. 5,968,131

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Mendez et alia
Reexamination Proceeding
Control No. 90/010,259
Request Deposited: August 28, 2008
For: U.S. Patent No. 5,968,131

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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. 5,968,131 (hereinafter, the '131 patent), issued to Mendez *et alia*, on October 19, 1999.
2. On August 11, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '131 patent. The reexamination proceeding was assigned Control No. 90/010,242 (hereinafter, the '10242 proceeding).

Art Unit: 3992

3. On August 28, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '131 patent. The reexamination proceeding was assigned Control No. 90/010,259 (hereinafter, the '10242 proceeding).
4. The Reexamination Order was granted in the '10242 proceeding on October 10, 2008.
5. The Reexamination Order was granted in the '10259 proceeding on October 10, 2008.
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 '10242 and the '10259 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. 90/010,242 and 90/010,259 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.
90/010,267	09/03/2008	5642001	TI-18438X2	3663

23494 7590 01/12/2009

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/12/2009

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



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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

(For Patent Owner)

In re Miyazaki
Reexamination Proceeding
Control No. 90/010,172
Request Deposited: May 21, 2008
For: U.S. Patent No. 5,642,001

:
: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Miyazaki
Reexamination Proceeding
Control No. 90/010,267
Request Deposited: September 3, 2008
For: U.S. Patent No. 5,642,001

:
: MAILED
:
: JAN 12 2009
:
: CENTRAL REEXAMINATION UNIT

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,642,001 (hereinafter, the '001 patent), issued to Miyazaki, on June 24, 1997.
2. On May 21, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '001 patent. The reexamination proceeding was assigned Control No. 90/010,172 (hereinafter, the '10172 proceeding).
3. The Reexamination Order was granted in the '10172 proceeding on July 11, 2008 along with a Notice of Defective Paper indicating the amendment did not comply with 37 CFR 1.530.
4. On September 3, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '001 patent. The reexamination proceeding was assigned Control No. 90/010,267 (hereinafter, the '10267 proceeding).

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5. The Reexamination Order was granted in the '10267 proceeding on October 22, 2008.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '10172 and the '10267 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.

An improper amendment had been filed in the '10172 proceeding and a proper amendment is of record in the '10267 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.

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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. 90/010,172 and 90/010,267 are **merged**.
2. Patent Owner has **one month** from the date of this decision to submit a "housekeeping" amendment.
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
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For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Art Unit: 3992

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

Eric Keasel For

Gregory Morse

Director, Central Reexamination Unit



MAILED

NOV 06 2009

Goodwin Procter LLP CENTRAL REEXAMINATION UNIT (For Patent Owner)
135 Commonwealth Drive
Menlo Park, CA 94025

Chalin A. Smith (For Requester)
Smith Patent Consulting, LLC
3309 Duke Street
Alexandria, VA 22314

In re Leslie M. McEvoy et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/010,275 : **GRANTING**
Filed: September 11, 2008 : **PETITION UNDER**
For: U.S. Patent No. 7,378,509 : **37 CFR 1.137(b)**

This is a decision on the September 26, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination¹ ("the September 26, 2009 patent owner petition to revive").

The appropriate petition fee of \$810.00 set forth in 37 CFR 1.17(m) for the September 26, 2009 patent owner petition to revive has been paid.

The September 26, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 26, 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 ...

11/06/2009 JHCDOUGA 00000001 504634 90010275
01 PC:2433 810.00 DA

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 June 11, 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.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the June 11, 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 11, 2009 Office action set a two-month period for response. A proper response to the June 11, 2009 Office action was not filed until September 26, 2009, which was untimely. However, for the purpose of evaluating whether the September 26, 2009 patent owner petition to revive is a grantable petition, the submission of the September 26, 2009 response to the June 11, 2009 Office action satisfies item (1).²

The appropriate petition fee of \$810.00 set forth in 37 CFR 1.17(m) for the September 26, 2009 petition to revive has been paid, which satisfies item (2).

Regarding item (3), the statement provided in the September 26, 2009 petition to revive (“[t]he delay in submitting this Response was unintentional”) does not specify 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, as is required by 37 CFR 1.137(b)(3). However, the statement contained in the September 26, 2009 petition to revive is being so construed, thereby satisfying item (3). Patent owner **must** notify the Office if the Office has misconstrued the statement provided in the September 26, 2009 petition to revive.

Accordingly, the September 26, 2009 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The September 26, 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 September 26, 2009 Amendment and Response To Office Action in *Ex Parte* Reexamination Under 37 CFR § 1.550.
3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Shri Ponnaluri, of CRU Art Unit 3991, at (571) 272-0809.

² This decision is not directed to the persuasiveness and propriety of the arguments presented in the September 26, 2009 response as to each of the rejections set forth in the June 11, 2009 Office action; such is the examiner’s province.

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,277	10/23/2008	7239723	1255.002RE	5359

44338 7590 07/21/2009

FELDMANGALE, P.A.
1700 Market Street
Suite # 3130
Philadelphia, PA 19103

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/21/2009

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



Feldmangale, P.A.
1700 Market Street
Suite #3130
Philadelphia, PA 19103

(For Patent Owner)

RECEIVED

In re Al-Sheikh
Ex Parte Reexamination Proceeding
Control No. 90/010,277
Filed: October 23, 2008
For: U.S. Patent No. 7,239,723

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

JUL 21 2009
CENTRAL REEXAMINATION UNIT

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 \$810 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 response¹ 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 8, 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 proceeding³ is **granted**.

CONCLUSION

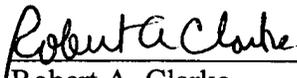
- The July 1, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

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 3992 for processing of the patent owner amendment/response to the April 8, 2009 nonfinal Office action.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Colin LaRose, of CRU Art Unit 3992 at (571) 272-7423.
- 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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689

22850 7590 03/11/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/11/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689

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

EXAMINER

ART UNIT PAPER NUMBER

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DATE MAILED:

MAR 11 2010

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

LAURA SHERIDAN
WILMER CUTLER PICKERING HALE
AND DORR, L.L.P.
399 PARK AVENUE
NEW YORK, NY 10022

(For Requester)

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

In re Wong et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,278
Filed: September 16, 2008
For: U.S. Patent No. 5,394,140

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

This is a decision on the December 24, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

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

The petition is dismissed.

BACKGROUND

- On September 16, 2008, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/010,278 ("the '10278 proceeding").
- Prosecution in the '10278 proceeding progressed until, on July 23, 2009, a final Office action was mailed. The final Office action rejected claims 1-20, which are all of the claims subject to reexamination. No claim amendments were made during the reexamination proceeding.
- On August 5, 2009, patent owner filed a notice of concurrent proceedings, in which a June 15, 2009 order granting a stay of litigation in the case of *Research in Motion v. Motorola* pending resolution of specified reexamination proceedings was granted by the U.S. District Court for the Northern District of Texas, Dallas Division.

- On September 22, 2009, the Office granted a petition for extension of time filed by patent owner on 9 September 2009, extending the period for reply to the final Office action to 23 October 2009.
- On October 23, 2009, patent owner filed a response to the final Office action, including a § 1.132 affidavit by Mr. John Friend.
- On December 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the Friend affidavit submitted on October 23, 2009 as failing to have a right of entry under 37 C.F.R. § 1.116 because there were not good and sufficient reasons why the declaration was necessary and not presented earlier. The action set a time period for response to run 6 months from the date of the final Office action.
- On December 24, 2009, patent owner filed the instant petition entitled “PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION,” requesting continued prosecution of the reexamination, including entry and consideration of the Friend affidavit filed on October 23, 2009, and refused entry on December 16, 2009.
- On January 25, 2010, a Notice of Appeal was filed by patent owner.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.181 provides, in pertinent part:

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

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

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

propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

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

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

DECISION

The December 24, 2009, patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of an affidavit under § 1.132 addressing construction of means-plus-function claims. Relief is requested under the § 1.182 petition procedure set forth as a transitional procedure in a March 1, 2005 Notice.

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

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Patent owners were advised by the Office to use the petition procedure set forth in 37 C.F.R. § 1.182 for situations not otherwise addressed, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 C.F.R. § 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of

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

special dispatch. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 mandates that reexamination proceedings must be conducted “with special dispatch within the Office.”

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

In light of this, patent owner, in his petition, alleges that entry of the October 23, 2009 Friend declaration is a *bona fide* attempt to advance prosecution as entry would “lead to a proper interpretation of the claims’ true scope” and provide an interpretation of the claims prior to the Board’s review, thereby satisfying special dispatch. Petition at 4-5. However, there is no showing as to the examiner raising the question of claim scope for the first time in the final Office action or in the advisory Office action.

It is further noted that while the affiant states that he has a technical background, the subject of claim construction is a legal, rather than a scientific or technical, matter. Claim construction is a matter of law rather than fact. *See, e.g., Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004) (“The task of determining whether the limitation in question should be regarded as a means-plus-function limitation, like all claim construction issues, is a question of law . . .”). This position as to claim construction could have been presented as argument by counsel in the response to the final Office action, and could be presented by patent owner in the appeal brief.²

Entry of the October 23, 2009 Friend affidavit would include, on the record, opinion evidence on legal questions by a nonexpert in the legal field. The likely result of entry of this affidavit is that the examiner and patent owner would continue to disagree as to the claim interpretations at issue. *See* advisory Office action of December 16, 2009. The examiner’s position has been set forth in the final Office action, and patent owner’s position will be set forth in the appeal brief, as acknowledged in the instant petition at page 4. Therefore, it is likely that even if the declaration is entered, an appeal would be required to address this disagreement. In the appeal, the claim interpretation would be addressed *de novo*. Entry of this declaration would thus not result in any

² As admitted by patent owner in the petition at 4, review of the rejections by the Board (or a reviewing court) would be *de novo*, i.e., giving no deference to the examiner’s interpretation. For this reason, the affidavit evidence directed to legal conclusions would not act to reduce any issues for appeal.

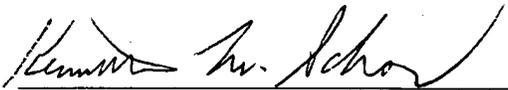
savings of time such that special dispatch would be served. The appeal process is the standard process for resolving disputes on the merits of the rejections of the claims between the positions of the examiner and the patent owner, and patent owner has presented no persuasive reason to deviate from this standard procedure. Based on the set of facts in this proceeding, reopening of prosecution would delay the resolution of the substantial new questions of patentability raised by the request for reexamination contrary to the statutory mandate that the Office proceed towards resolution with special dispatch. The need for special dispatch is further underscored by the fact that court litigation is currently stayed pending resolution of this reexamination proceeding.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is deemed not to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

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

CONCLUSION

- The December 24, 2009 patent owner petition is dismissed.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



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

March 10, 2010
Kenpet7/RCR



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689
22850	7590	03/22/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 03/22/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689

22850 7590 03/22/2010

Laura Sheridan
Wilmer Cutler Pickering Hale and Dorr LLP
399 Park Avenue
New York, NY 10022

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/22/2010

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

(For Patent Owner)

LAURA SHERIDAN
WILMER CUTLER PICKERING HALE
AND DORR, L.L.P.
399 PARK AVENUE
NEW YORK, NY 10022

(For Requester)

MAILED

MAR 2 2010

CENTRAL REEXAMINATION UNIT

In re Wong et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,278
Filed: September 16, 2008
For: U.S. Patent No. 5,394,140

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

This is a decision on the March 18, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF."

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

The petition under 37 C.F.R. § 1.183 to request a suspension of time is **granted** as to the underlying relief desired to the extent that the time for to file an Appeal Brief is extended to run 30 days from the mailing date of this decision, pursuant to 37 CFR § 41.37(e) and 37 CFR § 1.550(c).

FEES

The requisite petition fee for a petition under 37 C.F.R. § 1.183 is \$400.00 pursuant to 37 C.F.R. § 1.17(f); however, as the petition is being taken as for an extension of time pursuant to 37 C.F.R. § 1.550(c), the fee pursuant to 37 C.F.R. § 1.17(g) of \$200.00 is applicable. Petitioner paid the \$200.00 fee by credit card payment as set forth on page 3 of the petition.

BACKGROUND

- On September 16, 2008, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/010,278 ("the '10278 proceeding").

claims subject to reexamination. No claim amendments were made during the reexamination proceeding.

- On August 5, 2009, patent owner filed a notice of concurrent proceedings, in which a June 15, 2009 order granting a stay of litigation in the case of *Research in Motion v. Motorola* pending resolution of specified reexamination proceedings was granted by the U.S. District Court for the Northern District of Texas, Dallas Division.
- On September 22, 2009, the Office granted a petition for extension of time filed by patent owner on 9 September 2009, extending the period for response to the final Office action to 23 October 2009.
- On October 23, 2009, patent owner filed a response to the final Office action, including a § 1.132 affidavit by Mr. John Friend.
- On December 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the October 23, 2009 Friend affidavit as failing to have a right of entry under 37 C.F.R. § 1.116 because there were not good and sufficient reasons why the declaration was necessary and not presented earlier. The action set a time period for response to run 6 months from the date of the final Office action.
- On December 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the Friend affidavit filed on October 23, 2009, and refused entry on December 16, 2009.
- On January 25, 2010, a Notice of Appeal was filed by patent owner.
- On March 11, 2010, the December 24, 2009 patent owner petition for continued reexamination was dismissed.
- On March 17, 2010, patent owner filed a petition entitled "REQUEST FOR RECONSIDERATION OF DISMISSED PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting reconsideration of the dismissal of the December 24, 2009 patent owner petition.
- On March 18, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.181 provides, in pertinent part:

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

37 CFR § 41.37 states, in pertinent part:

- (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
- (e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings. (emphasis added)

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

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

section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

DECISION

The present patent owner petition for extension of time was filed within period for submission of an Appeal Brief; the Notice of Appeal was filed on January 25, 2010, and the time to file a brief will expire on March 25, 2010 by operation of rule 37 C.F.R. § 41.37(a)(1). Patent owner filed the instant petition under § 1.183 “to suspend, for a reasonable duration, the current due date for filing an Appeal Brief.” Petition at 1. The time for filing an appeal brief in *ex parte* reexamination proceedings is controlled through the provisions of 37 CFR § 41.37. Upon filing a Notice of Appeal, by operation of rule 37 C.F.R. § 41.37, patent owner has a two month time period within which to file an Appeal Brief that may be extended through the provisions of § 1.550(c). For this reason, the instant request for extension of time will be considered pursuant to 37 C.F.R. § 1.550(c) rather than pursuant to 37 C.F.R. § 1.183.

In this instance, an outstanding petition under 37 C.F.R. § 1.182, for reconsideration of a dismissal of a petition seeking continued reexamination, was filed on March 17, 2010 and is currently under consideration at the Office. A decision on the § 1.182 petition has not yet been rendered. In the event patent owner were to have filed an Appeal Brief to keep the proceeding pending to obtain the result of the petition under § 1.182, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.182 be granted.

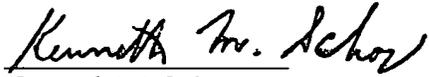
Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.550(c) is granted to the extent that patent owner petitioner’s time period to submit an Appeal Brief is extended to run 30 days from the due date; i.e., April 26, 2010.

If the petition under § 1.182 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed March 18, 2010 for filing an Appeal Brief is **granted to the extent stated above.**

2. The time for to file an Appeal Brief is extended to run **30 days** from the due date; i.e., through April 26, 2010.
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



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.
90/010,278	09/16/2008	5394140	347236US	8689

22850 7590 04/23/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/23/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689
22850	7590	04/23/2010	EXAMINER	

LAURA SHERIDAN
WILMER CUTLER PICKERING HALE
AND DORR, L.L.P.
399 PARK AVENUE
NEW YORK, NY 10022

ART UNIT	PAPER NUMBER
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DATE MAILED: 04/23/2010

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OBLON, SPIVAK, MCCLELLAND MAIER :
& NEUSTADT, L.L.P. :
1940 DUKE STREET : (For Patent Owner)
ALEXANDRIA VA 22314 :

LAURA SHERIDAN :
WILMER CUTLER PICKERING HALE :
AND DORR, L.L.P. :
399 PARK AVENUE : (For Requester)
NEW YORK, NY 10022 :

MAILED

APR 23 2010

CENTRAL REEXAMINATION UNIT

In re Wong et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/010,278 : **GRANTING EXTENSION**
Filed: September 16, 2008 : **OF TIME**
For: U.S. Patent No. 5,394,140 :

This is a decision on the April 13, 2010 patent owner petition entitled "SECOND PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF."

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

The petition under 37 C.F.R. § 1.183 to request a suspension of time is **granted** as to the underlying relief desired, to the extent that the time for to file an Appeal Brief is extended to run 30 days from the previously extended due date, pursuant to 37 CFR § 41.37(e) and 37 CFR § 1.550(c).

FEES

The requisite petition fee for a petition under 37 C.F.R. § 1.183 is \$400.00 pursuant to 37 C.F.R. § 1.17(f); however, as the petition is being taken as for an extension of time pursuant to 37 C.F.R. § 1.550(c), the fee pursuant to 37 C.F.R. § 1.17(g) of \$200 is applicable. Petitioner paid the \$200.00 fee by credit card payment as set forth on page 3 of the petition.

BACKGROUND

- On September 16, 2008, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/010,278 ("the '10278 proceeding").

- Prosecution in the '10278 proceeding progressed until, on July 23, 2009, a final Office action was mailed. The final Office action rejected claims 1-20, which are all of the claims subject to reexamination. No claim amendments were made during the reexamination proceeding.
- On August 5, 2009, patent owner filed a notice of concurrent proceedings, in which a June 15, 2009 order granting a stay of litigation in the case of *Research in Motion v. Motorola* pending resolution of specified reexamination proceedings was granted by the U.S. District Court for the Northern District of Texas, Dallas Division.
- On September 22, 2009, the Office granted a petition for extension of time filed by patent owner on 9 September 2009, extending the period for response to the final Office action to 23 October 2009.
- On October 23, 2009, patent owner filed a response to the final Office action, including a § 1.132 affidavit by Mr. John Friend.
- On December 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the October 23, 2009 Friend affidavit as failing to have a right of entry under 37 C.F.R. § 1.116 because there were not good and sufficient reasons why the declaration was necessary and not presented earlier. The action set a time period for response to run 6 months from the date of the final Office action.
- On December 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the Friend affidavit filed on October 23, 2009, and refused entry on December 16, 2009.
- On January 25, 2010, a Notice of Appeal was filed by patent owner.
- On March 11, 2010, the December 24, 2009 patent owner petition for continued reexamination was dismissed.
- On March 17, 2010, patent owner filed a petition entitled "REQUEST FOR RECONSIDERATION OF DISMISSED PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting reconsideration of the dismissal of the December 24, 2009 patent owner petition.
- On March 18, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF."
- On March 22, 2010, the March 18, 2010 patent owner petition for continued reexamination was granted to the extent that the time for filing an appeal brief was extended to run until April 26, 2010.

- On April 13, 2010, patent owner filed the instant petition entitled “SECOND PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF.”

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.181 provides, in pertinent part:

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

37 CFR § 41.37 states, in pertinent part:

- (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
- (e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings. (emphasis added)

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

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

DECISION

The present patent owner petition for extension of time was filed within the period for submission of an Appeal Brief; the Notice of Appeal was filed on January 25, 2010, and the time to file a brief will expire on April 26, 2010, the date to which the time to respond was previously extended. Patent owner filed the instant petition under § 1.183 “to suspend, for a reasonable duration, the current due date for filing an Appeal Brief.” Petition at 1. The time for filing an appeal brief in *ex parte* reexamination proceedings is controlled through the provisions of 37 CFR § 41.37. Upon filing a Notice of Appeal, by operation of rule 37 C.F.R. § 41.37, patent owner has a two month time period within which to file an Appeal Brief that may be extended through the provisions of § 1.550(c). For this reason, the instant request for extension of time will be considered pursuant to 37 C.F.R. § 1.550(c) rather than pursuant to 37 C.F.R. § 1.183.

In this instance, an outstanding petition under 37 C.F.R. § 1.182, for reconsideration of a dismissal of a petition seeking continued reexamination, was filed on March 17, 2010 and is currently under consideration by the Office. A decision on the § 1.182 petition has not yet been rendered. In the event patent owner were to have filed an Appeal Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.182 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.550(c) is granted to the extent that patent owner petitioner’s time period to submit an Appeal Brief is extended to run 30 days from the due date; i.e., May 26, 2010.

If the petition under § 1.182 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to

inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed April 13, 2010 for filing an Appeal Brief is **granted to the extent stated above.**
2. The time for to file an Appeal Brief is extended to run **30 days** from the previously extended due date; i.e., through May 26, 2010.
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



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689

22850 7590 05/19/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/19/2010

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

MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010278
PATENT NO. : 5394140
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)).



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

(For Patent Owner)

MAILED

MAY 19 2010

LAURA SHERIDAN
WILMER CUTLER PICKERING HALE
AND DORR, L.L.P.
399 PARK AVENUE
NEW YORK, NY 10022

(For Requester) **CENTRAL REEXAMINATION UNIT**

In re Wong et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,278
Filed: September 16, 2008
For: U.S. Patent No. 5,394,140

: **DECISION**
: **GRANTING EXTENSION**
: **OF TIME**

This is a decision on the May 13, 2010 patent owner petition entitled "THIRD PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF." The petition is being treated as a request for extension of time pursuant to 37 C.F.R. § 1.550(c).

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

The petition under 37 C.F.R. § 1.183 to request a suspension of time is **granted** as to the underlying relief desired, to the extent that the time for filing an Appeal Brief is extended to run 30 days from the previously extended due date, pursuant to 37 CFR § 41.37(e) and 37 CFR § 1.550(c).

FEES

The petition fee of \$400.00 pursuant to 37 C.F.R. § 1.17(f) for a petition under 37 C.F.R. § 1.183 is \$400.00 pursuant to 37 C.F.R. § 1.17(f); however, as the petition is being taken as for an extension of time pursuant to 37 C.F.R. § 1.550(c), the fee pursuant to 37 C.F.R. § 1.17(g) of \$200 is applicable. Petitioner paid \$400.00 by credit card payment as set forth on page 3 of the petition. Petitioner may request a refund of the remaining \$200.00 pursuant to 37 CFR 1.26(b).

BACKGROUND

- On September 16, 2008, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/010,278 ("the '10278 proceeding").

- Prosecution in the '10278 proceeding progressed until, on July 23, 2009, a final Office action was mailed. The final Office action rejected claims 1-20, which are all of the claims subject to reexamination. No claim amendments were made during the reexamination proceeding.
- On August 5, 2009, patent owner filed a notice of concurrent proceedings, in which a June 15, 2009 order granting a stay of litigation in the case of *Research in Motion v. Motorola* pending resolution of specified reexamination proceedings was granted by the U.S. District Court for the Northern District of Texas, Dallas Division.
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- On March 22, 2010, the March 18, 2010 patent owner petition under 37 C.F.R. § 1.183 for suspension of time to file an appeal brief was granted to the extent that the time for filing an appeal brief was extended to run until April 26, 2010.

- On April 13, 2010, patent owner filed a petition entitled "SECOND PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF."
- On April 23, 2010, the April 13, 2010 patent owner petition under 37 C.F.R. § 1.183 for suspension of time to file an appeal brief was granted to the extent that the time for filing an appeal brief was extended to run until May 26, 2010.
- On May 13, 2010, patent owner filed the instant petition entitled "THIRD PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF TIME TO FILE AN APPEAL BRIEF."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 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).

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

37 CFR § 41.37 states, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings. (emphasis added)

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

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

DECISION

The present patent owner petition for extension of time was filed within the period for submission of an Appeal Brief; the Notice of Appeal was filed on January 25, 2010, and the time to file a brief will expire on May 26, 2010, the date to which the time to respond was previously extended. Patent owner filed the instant petition under § 1.183 "to suspend, for a reasonable duration, the due date for filing an Appeal Brief." Petition at 1. The time for filing an appeal brief in *ex parte* reexamination proceedings is controlled through the provisions of 37 CFR § 41.37. Upon filing a Notice of Appeal, by operation of rule 37 C.F.R. § 41.37, patent owner has a two month time period within which to file an Appeal Brief that may be extended through the provisions of § 1.550(c). For this reason, the instant request for extension of time will be considered pursuant to 37 C.F.R. § 1.550(c) rather than pursuant to 37 C.F.R. § 1.183.

In this instance, an outstanding petition under 37 C.F.R. § 1.182, for reconsideration of a dismissal of a petition seeking continued reexamination, was filed on March 17, 2010 and is currently under consideration by the Office. A decision on the § 1.182 petition has not yet been rendered. In the event patent owner were to have filed an Appeal Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the

Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.182 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.550(c) is granted to the extent that patent owner petitioner's time period to submit an Appeal Brief is extended to run 30 days from the due date; i.e., June 26, 2010.

If the petition under § 1.182 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed May 13, 2010 for filing an Appeal Brief is **granted to the extent stated above.**
2. The time for to file an Appeal Brief is extended to run **30 days** from the previously extended due date; i.e., through June 26, 2010.
3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



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



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90/010,278	09/16/2008	5394140	347236US	8689

22850 7590 06/25/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/25/2010

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22850 7590 06/25/2010

EXAMINER

LAURA SHERIDAN
WILMER CUTLER PICKERING HALE
AND DORR, L.L.P.
399 PARK AVENUE
NEW YORK, NY 10022

ART UNIT PAPER NUMBER

DATE MAILED: 06/25/2010

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



OBLON, SPIVAK, MCCLELLAND MAIER :
& NEUSTADT, L.L.P. :
1940 DUKE STREET : (For Patent Owner)
ALEXANDRIA VA 22314 :

LAURA SHERIDAN :
WILMER CUTLER PICKERING HALE :
AND DORR, L.L.P. :
399 PARK AVENUE : (For Requester)
NEW YORK, NY 10022 :

In re Wong et al. :
Ex Parte Reexamination Proceeding : **DECISION ON**
Control No. 90/010,278 : **REQUEST FOR**
Filed: September 16, 2008 : **RECONSIDERATION**
For: U.S. Patent No. 5,394,140 :

MAILED
JUN 25 2010
CENTRAL REEXAMINATION UNIT

This is a decision on the March 17, 2010 patent owner paper entitled "REQUEST FOR RECONSIDERATION OF DISMISSED PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

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

The petition requesting reconsideration of the March 11, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review.

BACKGROUND

1. On September 16, 2008, a third party request for *ex parte* reexamination of U.S. Patent No. 5,394,140 met the filing date requirements for reexamination, and the resulting reexamination proceeding was assigned control number 90/010,278 ("the '10278 proceeding").
2. Reexamination was ordered on November 3, 2008 for all claims of the patent, and the '10278 proceeding progressed until, on July 23, 2009, a final Office action was mailed. The final Office action rejected claims 1-20, which are all of the claims subject to reexamination. No claim amendments were made during the reexamination proceeding.
3. On August 5, 2009, patent owner filed a notice of concurrent proceedings, in which a June 15, 2009 order granting a stay of litigation in the case of *Research in Motion v.*

Motorola, No. 3:08-CV-0284-G (N.D. Tex. 2008) pending resolution of specified reexamination proceedings was granted.

4. On September 22, 2009, the Office granted a petition for extension of time filed by patent owner on September 9, 2009, thereby extending the period for response to the final Office action to October 23, 2009.
5. On October 23, 2009, patent owner filed a submission for the purpose of responding to the final Office action, including a 37 C.F.R. § 1.132 affidavit by Mr. John Friend.
6. On December 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the Friend affidavit submitted on October 23, 2009 as failing to have a right of entry under 37 C.F.R. § 1.116, because there were not good and sufficient reasons why the declaration was necessary and not presented earlier. The action set a time period for response to the final Office action to run 6 months from the date of the final Office action.
7. On December 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the Friend affidavit filed on October 23, 2009, and refused entry on December 16, 2009.
8. On January 25, 2010, a Notice of Appeal was filed by patent owner.
9. On March 11, 2010, the Office mailed a decision dismissing patent owner's December 24, 2009 petition for continued reexamination.
10. On March 17, 2010, patent owner filed the instant petition requesting reconsideration of the March 11, 2010 Office decision dismissing patent owner's December 24, 2009 petition for continued reexamination.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.181 provides, in pertinent part:

(a) Petition may be taken to the Director:

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

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

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

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

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

DECISION

The instant March 17, 2010 patent owner paper sets forth a request for reconsideration of the March 11, 2010 dismissal of patent owner's December 24, 2009 petition requesting continued prosecution for entry and consideration of an affidavit under § 1.132 addressing construction of means-plus-function claims. Relief is requested under the § 1.182 petition procedure set forth as a transitional procedure in a March 1, 2005 Office Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that, until a continued reexamination procedure would be implemented by the Office, a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding. A

¹ 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

procedure for continued reexamination was never in-fact implemented by the Office, and was never issued as a proposed rule making notice; however, the transitional statement of the Notice was never withdrawn.

By filing a § 1.182 petition, as discussed in the Notice, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. This petition will be referred to herein as “the § 1.182 petition.”

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition is to make a showing of the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the showing in a petition for continuation of the reexamination prosecution is to identify the issue that the submission is intended to address, and explain how the issue arose at a point of the prosecution (here, the final Office action) such that patent owner had no earlier opportunity to address the issue. The above showings are critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 unequivocally mandates that reexamination proceedings must be conducted “with special dispatch within the Office.”² If a patent owner desires a remedy not provided by rule to obtain entry of a submission in a reexamination proceeding and thereby delay the proceeding, equity requires that a petition for such remedy must balance that delay with a showing that patent owner supported the Office’s unequivocal statutory mandate to carry out an *ex parte* reexamination proceeding with special dispatch.

Patent owner, in its petition of December 24, 2009, alleged that entry of the October 23, 2009 Friend declaration is a *bona fide* attempt to advance prosecution as entry would “lead to a proper interpretation of the claims’ true scope” and provide an interpretation of the claims prior to the Board’s review, thereby satisfying special dispatch.³ However, this petition was dismissed because patent owner failed to show that the declaration was submitted to address an issue that only arose for the first time in the final Office action or in the advisory Office action, and thereby satisfy the requirement that the reexamination be conducted with special dispatch within the

² In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit pointed out that:

“Special dispatch” is not defined in the statute. However, “a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning.” *Perrin v. United States*, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see *LSI Computer Systems, Inc. v. United States Int’l Trade Comm’n*, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed.Cir. 1987). According to Webster’s New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that “reexamination proceedings will be ‘special’ throughout their pendency” in the office, and provides for an accelerated schedule. MPEP § 2261. (*Ethicon*, at 1426.)

³ Petition of December 24, 2009, at 4-5.

Office. Additionally, patent owner failed to show that entry of the declaration would act to define the issues for appeal, or further the issuance of a reexamination certificate, rather than raise new issues.

In the instant request for reconsideration of the March 1, 2010 decision dismissing the petition for continued reexamination, patent owner argues that (1) the Office first stated in the December 16, 2009 advisory action that “Patent Holder has for the first time invoked 35 U.S.C. § 112 sixth paragraph after final action,”⁴ and (2) that the proceeding would be furthered because the declaration would supplement the factual record, prevent a remand by the Board of Appeals, and advance prosecution by necessarily distinguishing the claims from the art.⁵

Patent owner’s argument is not persuasive, since, in the present situation, the proffered declaration addresses an issue of claim construction that arose early in the reexamination proceeding. This will now be discussed:

Patent owner alleges that the declaration is necessary to provide proper evidence of non-equivalence relevant to means-plus-function limitations in the claims under rejection. These claims have not been amended during the prosecution, and are in the identical form those of the ‘140 patent under reexamination. The examiner rejected the claims at issue in the Office action of April 10, 2009, and repeated the rejection in the final Office action of July 23, 2009. Patent owner does not allege that the grounds of rejection have changed, or that the final Office action raised any new relevant issue. Rather, patent owner alleges that the examiner has never “analyzed, in a means-plus-function sense, the equivalent structures of the art,” and “has not met the burden of providing a *prima facie* case of structural equivalence for any means-plus-function claim limitation.”⁶ The Friend declaration proposed to be entered by patent owner is stated to address a matter of equivalence in a means-plus-function claim, and patent owner cites to MPEP 2184 for the fact that § 1.132 affidavits may be used to rebut an “inference of equivalence.”⁷ The petition, however, fails to point out which statements of equivalency, made by the examiner, are being rebutted by arguments supported by the Friend declaration – and why such statements were not earlier addressed by a timely evidence preparation and submission. Also, if patent owner believes, as is stated in the instant petition, that the examiner never “analyzed, in a means-plus-function sense, the equivalent structures of the art,”⁸ then there exists no matter of equivalence to be rebutted by proffered declaration.

⁴ Reconsideration Petition at 7.

⁵ Reconsideration Petition at 7-10. The petition addresses analysis in the March 11, 2010 Office decision concerning the weight to be accorded the Friend declaration. However, as discussed below, this factor is not dispositive to the grant of patent owner’s desired relief, and has been omitted in this decision.

⁶ Reconsideration Petition at 6-7.

⁷ MPEP 2184 [emphasis added] provides that “[w]here, however, the specification is silent as to what constitutes equivalents and the examiner has made out a *prima facie* case of equivalence, the burden is placed upon the applicant to show that a prior art element which performs the claimed function is not an equivalent of the structure, material, or acts disclosed in the specification If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification. Such reasons may include, but are not limited to:

...
(C) 37 CFR 1.132 affidavit evidence of facts tending to show nonequivalence.”

⁸ Reconsideration Petition at 6-7.

The proposed declaration submission is not in response to any newly raised issues; rather, the declaration would address issues that have been present since the first Office action.⁹ To the extent that the Friend declaration addresses whether the claimed and prior art structures are the same, patent owner has already once addressed the examiner's position on the means-plus-function claim limitations, e.g., the Office action's statement that "Breedon disclose[s] . . . a storage means (108) in patent owner's June 16, 2010 response to the April 10, 2009 Office action."¹⁰ Patent owner's argument in the petition for continued reexamination is that the examiner has never properly treated the claims, and patent owner requires a further opportunity to provide evidence that the examiner has never properly treated the claims. However, it is undeniable that the rejections have not changed since the initial Office action of April 10, 2009. And, accordingly, any issues relating to the examiner's analysis of the originally existing and unamended means-plus-function limitations in the patent claims arose at a point of the prosecution such that patent owner had an opportunity to address (or at least begin preparation to address) the issues prior to the final Office action.

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. Patent owner thus failed to submit such 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 Office's statutory mandate for special dispatch in reexamination.

Based on the facts in this proceeding, reopening of prosecution would delay the resolution of the substantial new questions of patentability raised by the request for reexamination contrary to the statutory mandate that the Office proceed towards resolution with special dispatch. As a final point, a cursory review of the substance of patent owner's declaration reveals that it amounts to nothing more than arguments, which arguments could be presented in patent owner's brief without delaying the proceeding.

In view of the above and the facts and circumstances presented by the present record, the petition is denied.

CONCLUSION

1. The petition requesting reconsideration of the March 11, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

⁹ With respect to petitioner's contention that the advisory action occasioned the Friend declaration, patent owner has not contended that the declarations proposed for entry address any issue not first raised in the initial Office action of April 10, 2009.

¹⁰ Patent owner's remarks of June 10, 2009.

2. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.
3. Patent owner's time to file an Appeal Brief was set to expire on June 26, 2010, in the Office decision of May 19, 2010. The time to file an Appeal Brief is hereby extended to run fifteen (15) days from the mailing date of this decision.
4. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
5. Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.
6. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 8, 2010
Pet8
FAA



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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Wood, Phillips, Katz, Clark & Mortimer
500 W. Madison Street
Suite 3800
Chicago, IL 60661

(For Patent Owner)

MAILED

Walter J. Steinkrauss
Vidas, Arrett & Steinkraus
6640 Shady Oak Road
Suite 400
Eden Prairie, MN 55344

(For 3rd Party Requester)

JAN 22 2009

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,119
Filed : March 10, 2008
For U.S. Patent No. : 4,739,672

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/010,287
Filed : September 19, 2008
For U.S. Patent No. : 4,739,672

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. 90/010,119 was ordered in a decision mailed May 27, 2008 indicating that claims 44-59 would be reexamined. A non-final Office action rejecting claims 44-59 was mailed October 15, 2008. A response was filed November 14, 2008. An interview was held November 14, 2008 and patent owner filed statements regarding the interview on December 4, 2008 and December 29, 2008. An Information Disclosure Statement was filed December 4, 2008 as well. There are no amendments to the claims, specification or drawings in this reexamination proceeding. No further Office action has taken place in this reexamination proceeding since the issuance of the non-final action mailed October 15, 2008.

Reexamination in application control No. 90/010,287 was ordered in a decision mailed November 17, 2008 indicating that claims 1-12, 14-23, and 25-29, all of the remaining live

claims in the patent would be reexamined¹. Patent owner filed a Waiver to Right to File Patent Owner Statement on November 25, 2008. No Office action has been issued and there are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/010,119 and reexamination control No. 90/010,287 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 the patent has expired, no amendments to the claims, drawings, or specifications can be made. See 37 CFR 1.530(j).

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-12, 14-23, and 25-59, all of the remaining live 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. 90/010,119 and 90/010,287 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.

¹ Claims 13 and 24 have been cancelled per Reexamination Certificate No. 3,650 issued October 27, 1998.

Anders Kalmbach

Gregory Morse, Director
Central Reexamination Unit

1/9



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.
90/010,288	01/07/2009	6716442	23264REX	3414

20999 7590 07/06/2009

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

Date:

MAILED

JUL 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010288
PATENT NO. : 6716442
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

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

(For Patent Owner)

MAILED

JUL 06 2009

CENTRAL REEXAMINATION UNIT

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

(For Requester)

In re Hunter et al
Reexamination Proceeding
Control No. 90/010,288
Filed: January 7, 2009
For: U.S. Patent No. 6,716,442

:
: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

The third party Requester filed a paper on April 17, 2009, entitled "Petition for Review of Reexamination Denial Under 37 C.F.R. §§ 1.515(c) and 1.181" (hereinafter the petition). The petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed March 18, 2009. 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.

Art Unit: 3991

REVIEW OF FACTS

1. U.S. Patent No. 6,716,442 (hereinafter, the '442 patent) issued on April 6, 2004.
2. A request for *ex parte* reexamination was filed on September 19, 2008. The resulting reexamination proceeding was assigned Control No. 90/010,288 (hereinafter, the '288 proceeding). Reexamination was requested for claims 1-11 of the '442 patent.
3. A Notice of Reexamination Request Filing Date for the '288 proceeding was issued on September 30, 2008.
4. A Decision *Sua Sponte Vacating Ex Parte* Reexamination Filing Date was mailed December 8, 2008.
5. A corrected request for *ex parte* reexamination was filed on January 7, 2009. Reexamination was requested for claims 1-11 of the '442 patent based upon The EPA TOP-SPOT Label 1996 ("TOP-SPOT Label" or "Label"); Animal Pharm No. 359, October 25, 1996 ("Animal Pharm"); U.S. Patent No. 6,096,329 to Jeannin; Meo et al., Proceedings AAVP, 41st Annual Meeting July 20-23, 1996 (hereinafter "Meo et al."); U.S. Patent No. 5,232,940 to Hatton; Defend ExSpot as evidenced by U.S. Patent No. 5,236,954 to Gladney; and EP 0 516 590.
6. A Notice of Reexamination Request Filing Date for the '288 proceeding was issued on January 14, 2009.
7. An order denying the request for reexamination for claims 1-11 in the '288 proceeding was mailed on March 18, 2009.
8. On April 17, 2009, the third party requester filed the present petition under 37 CFR §§ 1.515(c) and 1.181 in the '288 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner incorrectly concluded that the request did not present the "old art" in a new light or in a different way, and that the "new art" was relied upon for the same teachings present in the previously considered prior art.

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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 1-11 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-11 of the '442 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-11. 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) nor any additional SNQs proposed for the first time in the petition.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

In order to raise a SNQ for old art, the old art must be presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. An SNQ is not raised by the old prior art, however, 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

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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. 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.”^{2,3} 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.

¹ Public Law 96-517, enacted on December 12, 1980.

² See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

³ For additional discussion regarding technical teachings viewed “in a new light, see: *In re Melvin J. Swanson et al.*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

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If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 provides guidelines for such an order, and requires that the examiner's decision in the order state, for each patent and printed publication cited in the request, why the citation is:

(A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;

(B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);

(C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester, which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

The Request proposes 24 separate SNQs.

A. Requester considers claims 1-3, 5-7 and 9 unpatentable over the EPA TOP-SPOT label (proposed SNQs 1, 7, 9, 14, 16, 18 and 22). The Denial stated that the EPA TOP-SPOT label is a substantial duplicate of the "Frontline brochure" considered during prosecution of the application that became the '442 patent, 09/381,794; however the Frontline brochure is not present in the file of the '794 application. A copy of the Frontline document has been obtained (see attachment). It appears to be the label from a package of Frontline Top Spot for Dogs, for dogs 45-88 lbs. The relevant portions of the label read as follows:

Convenient, spot treatment for fast acting, long lasting control of fleas and ticks.

Kills fleas up to 3 months.

Kills ticks for 1 month.

ACTIVE INGREDIENT

fipronil...9.7%

INERT INGREDIENTS...90.3%

Contains 3 – 0.091 fl oz (2.68 ml) pipettes

Fast acting

Long lasting – up to 3 months for fleas

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Prevents reinfestation
Convenient to use
Kills newly emerged adult fleas before they lay eggs
Quickly eliminates the cause of flea allergy dermatitis
Kills all stages of brown dog ticks, American dog ticks, lone star ticks, and deer ticks (the major carrier of human and canine Lyme disease)

Frontline contains the active ingredient fipronil which has a unique mode of action that effectively targets fleas and ticks. Fipronil collects in the oils of the skin and hair follicles and continues to be released from hair follicles onto the skin and coat, resulting in long residual activity.

...apply to dogs or puppies (10 weeks or older) as follows: Wear household latex gloves and hold tube upright. Snap applicator tip away from face and body. Place applicator tip through animal's hair to the skin level between the shoulder blades. Squeeze tube, applying entire contents in a single spot to the animal's skin. Avoid superficial application to the animal's hair. Only one pipette per treatment is needed. For dogs weighing over 88 lbs use the appropriate combination of Top Spot sizes.

FREQUENCY OF APPLICATION

Research demonstrates that Frontline kills fleas up to three months and ticks for at least one month.

A once monthly use is recommended when there is a high risk of reinfestation, if the pet is allergic to fleas, or in situations where tick control is needed.

When used monthly, Frontline completely controls both flea and tick infestations.

In areas with less severe flea infestations, for animals without Flea Allergy Dermatitis, and in areas where ticks are not a threat, Frontline can be applied once every two to three months.

Frontline remains effective even after bathing, water immersion or exposure to sunlight. Spotted areas may appear wet or oily up to 24 hours post treatment.

Avoid contact with treated areas until dry. [illegible] Frontline for 90 days.

The disclosure of EPA TOP-SPOT is substantially the same, with minor differences in dosage and frequency of application for cats. Therefore EPA TOP-SPOT is considered cumulative to the Frontline Top Spot label considered during prosecution of the '794 application because it provides no new *technical* information that was not previously considered by the examiner. Moreover, the "old" technical information is not presented in a new light because the question of inherency was considered during prosecution of the '794 application.

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Turning to the points raised in the petition, Requester's arguments regarding the missing Frontline Top Spot label are moot in view of the obtention of said document. With regard to the Clemence declaration (Exhibit 1), Petitioner is reminded that evidence which was not presented in the Request for Reexamination will not be considered.

Therefore the EPA TOP-SPOT label, alone, does not raise a SNQ.

B. Requester considers claims 1-3, 9 and 11 unpatentable over Animal Pharm (proposed SNQs 2, 7, 9, 22 and 24). Animal Pharm is a brief article in a trade publication which discusses the launch of Frontline Top Spot in the U.S. It does not provide any technical information not already provided by the Frontline Top Spot label which was considered during prosecution of the '794 application. The petition's arguments regarding the missing Frontline Top Spot label are moot in view of the obtention of said document. The assertion that the product launch is an offer for sale is irrelevant, since this issue is not considered in reexamination (MPEP 2216). Thus Animal Pharm, alone, does not raise a SNQ.

C. Requester considers claims 1, 4 and 6-9 unpatentable over U.S. Patent 6,096,329 (proposed SNQs 3, 11, 15, 17, 19 and 21). Review of the prosecution history of the '794 application shows that the examiner applied the '329 patent exactly as suggested by Requester and subsequently withdrew the rejection. Both the Request and the petition assert that the examiner erred and should not have withdrawn the rejection, but no new technical information has been presented, nor is the '329 patent viewed in a different light. Thus the '329 patent, alone, does not raise a SNQ.

D. Requester considers claim 1 unpatentable over the '329 patent in combination with the EPA TOP-SPOT label (proposed SNQ 4). As discussed above, neither reference alone raises a SNQ because no new technical teaching is disclosed. The Request does not point out any new teaching that is provided by the combination of references. The petition argues that monthly application of fipronil was not disclosed in the "old" prior art, but this argument is not persuasive in view of the Frontline Top Spot label's recommendation of monthly treatment. Therefore the combination of the '329 patent and the EPA TOP-SPOT label does not raise a SNQ.

E. Requester considers claims 1-5 unpatentable over the EPA TOP-SPOT label in combination with U.S. Patent 5,232,940 (proposed SNQs 5, 8, 10, 12 and 13). The '940 patent discloses fipronil and a method for using fipronil for killing fleas and ticks on domestic animals. However the Request does not point out any new teaching that is not present in the '329 patent, which was considered during prosecution of the '794 application, and the disclosure of the '940 patent is therefore deemed cumulative. The EPA TOP-SPOT label is cumulative to the Frontline Top Spot label as discussed above. While the '329 patent and the Frontline Top Spot label were not combined in a rejection, the disclosure of each was clearly considered by the examiner of the '794 application,

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as rejections were made over each reference separately. The two new references do not offer any new technical teachings and, similarly, they are not seen to provide any new teaching when combined. The issue of inherency was also considered during prosecution of the '794 application. Thus the combination of the EPA TOP-SPOT label and the '940 patent does not raise a SNQ.

F. Requester considers claim 1 unpatentable over the '940 patent in combination with EP 516,590 and the '954 patent (proposed SNQ 6). The '940 patent is cumulative to the '329 patent as discussed above. EP 516,590 was considered and applied in combination with Meo, Frontline Top Spot and other references during prosecution of the '794 application. The '954 patent discloses monthly application of pyrethroid compounds to dogs for control of fleas and ticks, as well as killing fleas and ticks on bedding material exposed to said treated dogs. Use of the treated animal as a vector to treat the animal's environment is disclosed in EP 516,590, and the reference was relied upon for this teaching during prosecution of the '794 application. Treatment with pyrethroid compounds does not appear relevant to the claimed invention. Thus, even though the '954 patent is a new reference, it does not provide any new technical teaching that was not before the examiner during prosecution of the '794 application. While Requester has formulated a proposed obviousness rejection, neither the Request nor the petition point out what new technical information or new interpretation of the references is contained therein. Therefore the combination of the '940 patent, EP 516,590 and the '954 patent does not raise a SNQ.

G. Requester considers claim 8 unpatentable over Meo in combination with the EPA TOP-SPOT label and Animal Pharm (proposed SNQ 20). The EPA TOP-SPOT label and Animal Pharm do not provide any new technical information, as discussed above. Meo is a one paragraph abstract which was used in rejections under §102 and §103 during prosecution of the '794 application. The Request does not point out any teaching in Meo that was not previously considered, or is being viewed in a different light. The petition argues that Meo discloses the specific dosage of fipronil specified by the claim. This is not persuasive because this claim limitation was considered in the § 103 rejection over Frontline Top Spot in view of Meo and Postal. The examiner stated, "The amounts and proportions of active ingredients are result effective parameter [sic] chosen to obtain the desired effects" (Office action of June 6, 2001, p. 5). The references do not contain any new technical disclosure, nor are they being viewed in a different light, and thus the combination of Meo, the EPA TOP-SPOT label and Animal Pharm does not raise a SNQ.

H. Requester considers claim 10 unpatentable over Meo in combination with the EPA TOP-SPOT label (proposed SNQ 23). Meo is "old" art and the EPA TOP-SPOT label is cumulative to the Frontline Top Spot label, as discussed above. The Request does not point out any teaching in Meo that was not previously considered, or is being viewed in a different light. The petition argues that Meo discloses using fipronil where both dogs and cats are housed. This is not persuasive because this claim limitation was

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considered in the § 103 rejection over Frontline Top Spot in view of Meo and Postal. The examiner stated, "there is no difference between the applicants [sic] methods...and that of Meo" (Office action of June 6, 2001, p. 4). The references do not contain any new technical disclosure, nor are they being viewed in a different light, and thus the combination of Meo and the EPA TOP-SPOT label does not raise a SNQ.

REQUESTER'S RECOURSE

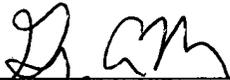
In the event that the third party requester desires to initiate an *ex parte* reexamination of the '442 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

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CONCLUSION

1. The PETITION is DENIED.
2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.



Gregory A. Morse, Director
Central Reexamination Unit

Attachment: "Frontline Top Spot brochure"



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,288	01/07/2009	6716442	23264REX	3414

20999 7590 01/14/2010
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/14/2010

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SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

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(For Patent Owner)

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

(For Requester)

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

MAILED

JAN 14 2010

CENTRAL REEXAMINATION UNIT

In re Hunter et al
Reexamination Proceeding
Control No. 90/010,288
Filed: January 7, 2009
For: U.S. Patent No. 6,716,442

:
: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

BACKGROUND

On July 7, 2009, a petition decision was mailed in this proceeding denying a petition of April 17, 2009 that asked for reconsideration of a denial of a reexamination request mailed March 18, 2009. While petitions following denial of a reexamination are not appealable¹, the present situation presents an unusual fact pattern such that reconsideration of the decision of July 7, 2009 is warranted.

In preparing the decision of July 7, 2009, the USPTO attempted to locate a document that was cited in the file of U.S. Patent 6,716,442. A document that appeared to be the relevant document was located and considered in the decision of July 7, 2009. However, third party requester should be afforded an opportunity to challenge the equivalence of the document cited with the decision of July 7, 2009 and the document considered by the examiner in the file of U.S. Patent 6,716,442, and had no opportunity to do so before the July 7, 2009 decision. As third party requester has challenged the equivalence of the original document, which has no copy in the file, and the newly cited

¹ 35 USC 303 (c)

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document, the petition of August 3, 2009 ("the present petition") will be treated as a request for reconsideration of the July 7, 2009 decision.

In the present petition, third party requester makes a credible case that the document cited by the USPTO with the decision of July 7, 2009 was not the same document as that considered by the examiner in the '442 patent. Present petition at 14-15. In light of the discrepancies identified in paragraphs numbered 14 and 15 in the petition, it is inappropriate to rely on the newly cited document in a decision reviewing the examiner's decision to grant or deny reexamination.

The present petition requests that the April 17, 2009 petition for review of reexamination denial be reconsidered on the factual record as it then existed. The petition is GRANTED to the extent that the decision of July 7, 2009 is vacated and the petition of April 17, 2009 will be reconsidered on the factual record as it then existed.

RECONSIDERATION OF THE DENIAL OF THE APRIL 17, 2009 DECISION

Third party Requester filed a paper on April 17, 2009, entitled "Petition for Review of Reexamination Denial Under 37 C.F.R. §§ 1.515(c) and 1.181" (hereinafter the petition). The petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed March 18, 2009. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

REVIEW OF FACTS

1. U.S. Patent No. 6,716,442 (hereinafter, the '442 patent) issued on April 6, 2004.
2. A request for *ex parte* reexamination was filed on September 19, 2008. The resulting reexamination proceeding was assigned Control No. 90/010,288 (hereinafter, the '288 proceeding). Reexamination was requested for claims 1-11 of the '442 patent.
3. A Notice of Reexamination Request Filing Date for the '288 proceeding was issued on September 30, 2008.
4. A Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Filing Date was mailed December 8, 2008.
5. A corrected request for *ex parte* reexamination was filed on January 7, 2009. Reexamination was requested for claims 1-11 of the '442 patent based upon The EPA TOP-SPOT Label 1996 ("TOP-SPOT Label" or "Label"); Animal Pharm No. 359, October 25, 1996 ("Animal Pharm"); U.S. Patent No. 6,096,329 to Jeannin; Meo et al., Proceedings AAVP, 41st Annual Meeting July 20-23, 1996 (hereinafter "Meo et al.");

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U.S. Patent No. 5,232,940 to Hatton; Defend ExSpot as evidenced by U.S. Patent No. 5,236,954 to Gladney; and EP 0 516 590.

6. A Notice of Reexamination Request Filing Date for the '288 proceeding was issued on January 14, 2009.

7. An order denying the request for reexamination for claims 1-11 in the '288 proceeding was mailed on March 18, 2009.

8. On April 17, 2009, the third party requester filed the present petition under 37 CFR §§ 1.515(c) and 1.181 in the '288 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner incorrectly concluded that the request did not present the "old art" in a new light or in a different way, and that the "new art" was relied upon for the same teachings present in the previously considered prior art.

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 1-11 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-11 of the '442 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-11. 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) nor any additional SNQs proposed 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

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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.

In order to raise a SNQ for old art, the old art must be presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. An SNQ is not raised by the old prior art, however, if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,² Congress stated:

"Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application.** H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination. Absent

² Public Law 96-517, enacted on December 12, 1980.

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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 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 provides guidelines for such an order, and requires that the examiner’s decision in the order state, for each patent and printed publication cited in the request, why the citation is:

- (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
- (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
- (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
- (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester, which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

The Request of January 7, 2009 proposes 24 separate SNQs based on exhibits B-D and F. However, despite the different references applied, the central technical feature of each is the use of fipronil as a localized treatment applied to mammals for the control of

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. 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

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fleas. (Request of 1/7/09, page 4 lines 14-17 for exhibit B; page 5 lines 1-4 for exhibit C; page 5 lines 10-12 for exhibit D; page 12 lines 5-6 and 19-22 for exhibit F).

A review of the record before the examiner in the prosecution of application 09/381,794 indicates that the examiner was aware of, and specifically considered, the use of fipronil as a spot-on formulation for control/eradication of fleas from dogs and cats. (e.g. Office action of June 6, 2001, page 4; office action of March 5, 2003, page 3)

It is understood that third-party requester vigorously disagrees with the conclusions reached by the examiner in the prosecution of that application. To pick an example, third party requester alleges that a 102(e) rejection was erroneously dropped (Petition of April 17, 2009, page 4).

However, reexamination of issued patents under 35 USC §301-317 is not a forum to revisit decisions made by the examiner outside the context of providing or explaining new technological information that was not previously considered by the examiner.

[I]n passing the original reexamination statute, Congress stated that "this new procedure will permit any party to petition the patent office to review the efficacy of a patent, 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," and explained that the substantial new question requirement bars "reconsideration of any argument already decided by the office, whether during the original examination or an earlier reexamination." H.R. Rep. No. 96-1307(I), at 3, 7 (1980) (emphasis added). The legislative history of the 2002 amendment similarly states that the test for a substantial new question of patentability should focus on what "the examiner" considered. (*In re Swanson*, 540 F.3d 1368, 1377)

In the final analysis, requester's sincere belief that the examiner in the parent case made the wrong decision is not a substantial new question of patentability. The reexamination statutes and procedures are not the proper venue for allegations that the examiner, given the same technological information, made the wrong decision or applied the wrong legal standard; they are a venue for adding new technical information that would have been important to a reasonable examiner in determining the patentability of one or more claims to the record or, as in the facts of *Swanson*, casting a new light on previously unappreciated feature of a previously considered reference.

As presented in the request for reexamination of January 7, 2009, the references do not contain any new technical disclosure (that is, one not already considered by the examiner in the parent file), nor are the technical disclosures being viewed in a different light. Accordingly, the relief requested in the petition of April 17, 2009 is denied.

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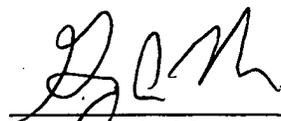
REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '442 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. The petition of August 3, 2009 is GRANTED to the extent that the decision of July 7, 2009 is vacated and the petition of April 17, 2009 will be reconsidered.
2. On reconsideration, the petition of April 17, 2009 is DENIED.
3. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.



Gregory A. Morse, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,289	09/19/2008	6673064	026484-017600US	3963

35437 7590 10/01/2009

MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:
MAILED

OCT 0 12 009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010289
PATENT NO. : 6673064
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

In re Application of 6673064
Appl. No.: 90/010,289
Filed: September 19, 2008
For: EXCIMER LASER CATHETER

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:
: **DECISION ON PETITION**
: **UNDER 37 CFR 1.59**

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: MAILED

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: **OCT 0 12 2009**

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: CENTRAL REEXAMINATION UNIT

This is a decision on the petition under 37 CFR 1.59(b), filed September 29, 2009, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a documents identified on Modified Form PTO-1449 as "D1-D7" (the documents are from the prosecution history of U.S. Patent Application Serial No. 11/646,743) filed July 31, 2009, be expunged from the record. Petitioner states that either (A) 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) 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 examiner in charge of the application 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

Application/Control Number: 90/010,289

Page 3

Art Unit: 3993

Enclosure to patent owner: Items identified as D1-D7 and Modified Form PTO-1449



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.
90/010,290	09/19/2008	6440125	RET-3.2001/2	4034

35437 7590 10/01/2009

MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHT FLOOR
SAN FARNCSICO, CA 94111-3834

Date:
MAILED

OCT 0 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010290
PATENT NO. : 6440125
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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In re Application of 6,440,125
Appl. No.: 90/010,290
Filed: September 19, 2008
For: EXCIMER LASER CATHETER

:
:
: **DECISION ON PETITION**
: **UNDER 37 CFR 1.59**
: **MAILED**

:
:
: **OCT 0 12 2009**

:
:
: CENTRAL REEXAMINATION UNIT

This is a decision on the petition under 37 CFR 1.59(b), filed September 29, 2009, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a documents identified on Modified Form PTO-1449 as "D1-D7" (the documents are from the prosecution history of U.S. Patent Application Serial No. 11/646,743) filed July 31, 2009, be expunged from the record. Petitioner states that either (A) 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) 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 examiner in charge of the application 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

Application/Control Number: 90/010,290
Art Unit: 3993

Page 3

Enclosure to patent owner: Items identified as D1-D7 and Modified Form PTO-1449



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.
90/010,293	09/22/2008	5741966	80000.010.966	6087

25225 7590 07/08/2009

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/08/2009

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010293
PATENT NO. : 5741966
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.
90/010,183	05/30/2008	5741966	626852000230	4442

25225 7590 07/08/2009

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/08/2009

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CLIFFORD A. ULRICH
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010183
PATENT NO. : 5741966
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

Richard C. Kim
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

(For Patent Owner)

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

Clifford A. Ulrich
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NEW YORK 10004

(For Third Party Requester)

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS
[37 CFR § 1.565(c)]

In re: Handfield et alia
Ex Parte Reexamination Proceeding
Control No. 90/010,183
Deposited : 30 May 2008
For: US Patent No. 5,741,966

In re: Handfield et alia
Ex Parte Reexamination Proceeding
Control No. 90/010, 293
Deposited : 22 September 2008
For: US Patent No. 5,741,966

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 21 April 1998 US Patent No. 5,741,966 was granted to Handfield *et alia*.
2. On 30 May 2008 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,183.
3. On 02 July 2008 the Order was granted for *ex parte* reexamination in control number 90/010,183.
4. On 12 March 2009 a non-final Office action was mailed in 90/010,183.
5. On 12 June and 16 June 2009 amendments and remarks were received in 90/010,183.
6. On 22 September 2008 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,293.
7. On 11 December 2008 the Order was granted for *ex parte* reexamination in control number 90/010,293.
8. There are no amendments to the claims in control number 90/010,293.

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. 90/010,183 and 90/010,293 *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. 90/010,183 and 90/010,293 *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/
for

Gregory A. Morse,
Director,
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OBLON, SPIVAK, MCCLELLAND MAIER &
NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

MAILED

APR 02 2009

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For *Inter Partes* Requester)

CENTRAL REEXAMINATION UNIT (For first *Ex Parte* Requester)

HAYES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

(For second *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,086
Filed: October 2, 2008
For: U.S. Patent No. 7,225,231

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Ex Parte Reexamination Proceeding
Control No. 90/008,981
Filed: January 9, 2008
For: U.S. Patent No. 7,225,231

: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**
:
:

Ex Parte Reexamination Proceeding
Control No. 90/010,299
Filed: October 2, 2008
For: U.S. Patent No. 7,225,231

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The above-captioned *inter partes* and *ex parte* reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,225,231 (the '231 patent) issued to Mendez *et al.* on May 29, 2007.

2. A first request for *ex parte* reexamination of claims 1-6 of the '231 patent was filed on January 9, 2008, by third party requester Research In Motion Limited, and the request was assigned control number 90/008,981 (the '8981 *ex parte* proceeding).
3. On February 29, 2008, *ex parte* reexamination was ordered for the '8981 proceeding based on the examiner's determination that the January 9, 2008 request raised a substantial new question of patentability.
4. A second request for *ex parte* reexamination of claims 1-6 of the '231 patent was filed on October 2, 2008, by third party requester Wei Wei Jeang, Haynes and Boone, LLP, and the request was assigned control number 90/010,299 (the '10299 *ex parte* proceeding).
5. Concurrently, on October 2, 2008, a request for *inter partes* reexamination of claims 1-6 of the '231 patent was filed by third party requester Research In Motion Limited, and the request was assigned control number 95/001,086 (the '1086 *inter partes* proceeding).
6. On November 28, 2008, *inter partes* reexamination was ordered for the '1086 proceeding based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.
7. On November 29, 2008, *ex parte* reexamination was ordered for the '10299 proceeding based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.
8. There has been no Office action in the '1086 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 expired in the '8981 *ex parte* proceeding after April 29, 2008 and expired in the '10299 *ex parte* proceeding after January 29, 2009.¹

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. One of the proceedings (the '1086 proceeding) is an *inter partes* proceeding. All of the proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

- (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where

¹ There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from the parties.

merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

In accordance with 37 CFR 1.989(a), the 95/001,086, 90/008,981 and 90/010,299 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Since the claims are the same in all files, a "housekeeping amendment" is NOT needed in this instance.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *ex parte* reexamination proceedings with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requesters of the *ex parte* reexamination proceedings are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '8981 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (Research In Motion) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, filed in triplicate, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
 Central Reexamination Unit
 Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://spotal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged

multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,086 and *ex parte* Reexamination Control Nos. 90/010,299 and 90/008,981 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.
3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,301	10/03/2008	6,891,838	STAT1090REEXAM	2732

6980 7590 09/25/2009

TROUTMAN SANDERS LLP
BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA, GA 30308-2216

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/25/2009

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED

SFP 25 2009

CENTRAL REEXAMINATION UNIT

TROUTMAN SANDERS LLP
600 PEACHTREE STREET, NE
ATLANTA, GA 30308

(For Patent Owner)

PHILIP KIRKPATRICK
CRESTRON ELECTRONICS, INC
15 VOLVO DRIVE
ROCKLEIGH, NJ 07647-2507

(For Third Party Requester)

CHARLES A. BLIENEMAN
RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

(For Third Party Requester)

CHARLES A. BLIENEMAN
RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

(For Third Party Requester)

CHARLES A. BLIENEMAN
RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

(For Third Party Requester)

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,301
Request Deposited: October 3, 2008
For: U.S. Patent No. 6,891,838

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,510
Request Deposited: May 15, 2009
For: U.S. Patent No. 6,891,838

Art Unit: 3992

In re PETITE *et alia*

Reexamination Proceeding

Control No. 90/010,511

Request Deposited: May 15, 2009

For: U.S. Patent No. 6,891,838

In re PETITE *et alia*

Reexamination Proceeding

Control No. 90/010,512

Request Deposited: May 15, 2009

For: U.S. Patent No. 6,891,838

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. 6,891,838 (hereinafter, the '838 patent), issued to Petite *et alia*, on May 10, 2005.
2. On October 3, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '838 patent. The reexamination proceeding was assigned Control No. 90/010,310 (hereinafter, the '10310 proceeding).
3. On May 15, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '838 patent. The reexamination proceeding was assigned Control No. 90/010,510 (hereinafter, the '10510 proceeding).
4. On May 15, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '838 patent. The reexamination proceeding was assigned Control No. 90/010,511 (hereinafter, the '10511 proceeding).
5. On May 15, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '838 patent. The reexamination proceeding was assigned Control No. 90/010,512 (hereinafter, the '10512 proceeding).
6. The Reexamination Order was granted in the '10310 proceeding on November 13, 2008.

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7. The Reexamination Order was granted in the '10510 proceeding on July 21, 2009.
8. The Reexamination Order was granted in the '10511 proceeding on July 21, 2009.
9. The Reexamination Order was granted in the '10512 proceeding on July 21, 2009.
10. There are currently no amendments in any pending 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 each 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 '10310, '10510, '10511 and the '10512 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

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CONCLUSION

1. Reexamination Control Nos. 90/010,310, 90/010,510, 90/010,511 and 90/010,512 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.

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,304	10/06/2008	4976320	16093:E/2 (73434-053RE2)	5422

60708 7590 03/17/2010

FOR: TYCO FIRE SUPPRESSION & BUILDING PRODUCTS
PERKINS COIE LLP
607 Fourteenth Street, NW
Washington, DC 20005-2003

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/17/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

Date:
MAILED

MAR 17 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010304
PATENT NO. : 4976320
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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FOR: TYCO FIRE SUPPRESSION
& BUILDING PRODUCTS
PERKINS COIE LLP
607 Fourteenth Street, NW
Washington DC 20005-2003

(For Patent Owner)

MAILED

MAR 17 2010

CENTRAL REEXAMINATION UNIT

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, M148303

(For Third Party Requester)

In re Polan : DECISION DISMISSING
Control No. 90/010,304 : PETITION
Deposited: October 6, 2008 : TO VACATE PROCEEDING
For: US Patent No. 4,976,320 : PURSUANT TO
: 37 CFR § 1.181(a)(3)

This is a decision on the February 23, 2009 petition filed by the patent owner entitled, "Petition under 37 CFR 1.181 to vacate a reexamination order" [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 March 6, 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. 4,976,320 [hereinafter “the ‘320 patent”] was granted to *Polan* on December 11, 1990.
2. On April 18, 2007, a request for *ex parte* reexamination for claims 1-3, 5, 6, 8(6), 9, and 11 of the ‘320 patent was submitted by a third party requester and, assigned control No. 90/008,582 [hereinafter, the ‘582 proceeding]. The request cited to the following references: U.S. Patent No. 4,139,062 to Rago; U.S. Patent No. 4,880,063 to Leininger et al.; U.S. Patent No. 4,066,129 to Anderson; U.S. Patent No. 2,558,450 to S.F. Martin; JP Patent Document No. 49-63798; U.S. Patent No. 4,630,682 to Pieczykolan; U.S. Patent No. 3,195,647 to L.E. Campbell; U.S. Patent No. 306,662 to W.H. Stratton; U.S. Patent No. 4,015,665 to Simons et al.; UK Patent Document No. 2195241; and U.S. Patent No. 1,816,016 to Knight.
3. On June 29, 2007, an Order granting *ex parte* reexamination was mailed in the ‘582 proceeding. The order determined, in part, that Rago raised a substantial new question of patentability (SNQ) as to claims 1-3; Leininger et al. raised a SNQ as to claims 1-3 and 5; Anderson raised a SNQ as to claims 1 and 2; Martin in view of JP 49-63798 raised a SNQ as to claims 1-3; Martin in view of Pieczykolan raised a SNQ as to claims 1-3; Martin in view of Campbell raised a SNQ as to claims 1-3; Martin in view of Stratton raised a SNQ as to claims 1-3; and Martin in view of JP 49-63798 and Simons et al. raised a SNQ as to claim 5. Patent claims 4, 7, 8(7), 10, and 12 were not subject to reexamination.
4. On October 6, 2008, a second request for *ex parte* reexamination for claims 1-3 and 5 of the ‘320 patent was submitted by the same third party requester and, assigned control No. 90/010,304 [hereinafter, the ‘304 proceeding].
5. On October 21, 2008, a “Notice of Intent to Issue Ex Parte Reexamination Certificate” was mailed in the ‘582 proceeding. The Notice confirmed patent claims 1-3, 5, and 11, found amended patent claim 8 patentable, and cancelled patent claims 6, 8(6), and 9.
6. On December 23, 2008, an Order granting *ex parte* reexamination was mailed in the ‘304 proceeding.
7. On January 13, 2009, a reexamination certificate issued for the ‘852 proceeding.
4. On February 23, 2009, the petition under 37 CFR 1.181 requesting that the order for reexamination be vacated as *ultra vires* was filed.
5. On March 6, 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 order of 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 2217 provides in relevant part:

III. ADMISSIONS

The consideration under 35 U.S.C. 303 of a request for *ex parte* reexamination is limited to prior art patents and printed publications. See *Ex parte McGaughey*, 6 USPQ2d 1334, 1337 (Bd. Pat. App. & Inter. 1988). Thus an admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication.

For handling of admissions during the examination stage of a proceeding (i.e., after reexamination has been ordered), see MPEP § 2258.

The admission can reside in the patent file (made of record during the prosecution of the patent application) or may be presented during the pendency of the reexamination proceeding or in litigation. Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art **in conjunction with patents and printed publications** in a prior art rejection, whether such admissions result from patents or printed publications or from some other source. An admission relating to *any* prior art established in the record or in court may be used by the examiner in combination with patents or printed publications in a reexamination proceeding. The admission must stand on its own. Information supplementing or further defining the admission would be improper.

MPEP 2242 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:

(A) the reexamination order is not based on prior art patents or printed publications;

...

(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 Office had no discretion to grant the request for reexamination. See MPEP 2246.

Patent owner contends that the order for reexamination of the ‘320 patent is *ultra vires* and must be vacated. Patent owner presents two related bases for this contention; first, that the order granting reexamination of claims 1-3 and 5 improperly relied upon an alleged admission in the ‘320 patent

that any conventional valve assembly can be used; and second, that the order improperly supplemented the admission by reliance on other cited documents, such as U.S. Patent Nos. 4,491,182 and 4,508,175 to Pieczykolan.

Requester opposes the petition on the grounds that the petition filed by the patent owner is mischaracterizing statements made in the request for reexamination, and the patent owner has not provided the necessary showing to support the petition.

The determination of whether an 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). An 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 for claims 1-3 and 5 were U.S. Patent No. 2,558,450 to Martin (Martin), admitted prior art in U.S. Patent No. 4,976,320 to Polan (the ‘320 patent under reexamination), U.S. Patent No. 4,508,175 to Pieczykolan (‘175 Pieczykolan), U.S. Patent No. 4,491,182 to Pieczykolan (‘182 Pieczykolan), U.S. Patent No. 4,732,216 to Polan (‘216 Polan), U.S. Patent No. 3,834,462 to Orloff et al. (Orloff), and U.S. Patent No. 4,015,665 to Simons et al. (Simons). Of these references found to form the basis of an SNQ, Martin, the ‘320 patent under reexamination, and Simons were applied to the claims or were of record in prior proceedings, i.e., are “old art.” Martin was relied upon or considered as a primary reference in combination with different secondary references than cited in the request for reexamination in the ‘304 proceeding. See pages 2-3 of the Office action dated December 20, 1989 in application 07/356,740, and pages 5-9 of the order dated June 29, 2007 in the ‘582 proceeding. The teachings of Simons were considered in regard to claim 5. See page 9 of the order dated June 29, 2007 in the ‘582 proceeding. ‘175 Pieczykolan, ‘182 Pieczykolan, ‘216 Polan, and Orloff were not considered by the Office in an earlier examination of the patent.

As discussed above, in the examination that resulted in the ‘320 patent, the examiner rejected claims 1-12 based upon Martin in view of U.S. Patent No. 506,704 to Lynde, U.S. Patent No. 506,929 to Newton, and U.S. Patent No. 1,816,016 to Newton. See pages 2-3 of the Office action dated December 20, 1989 in application 07/356,740. Specifically, Martin and Newton were applied for teaching the limitation of the arms of the frame having a free end, which are separated by a gap so that the arms are not subjected to assembly loads or system pressure loads. On March 22, 1990, the patent applicant responded to the December 20, 1989 Office action by arguing that Martin’s arms are in tension or compression and that Newton’s arms 13 fail to meet the claim 1 limitation that the arms are separated so that the arms are not subject to assembly loads or system pressure loads. See pages 2-3 of the response. No further art rejections were applied, and the application passed in due course to issue.

In the '582 reexamination proceeding, while the examiner agreed that Martin in view of a number of different secondary references raised a SNQ with respect to claims 1-3, and that Martin in view of JP 49-63798 and Simons raised a SNQ with respect to claim 5, the examiner did not apply these references against claims 1-3 and 5 in a prior art rejection. See pages 4-6 in the Office action dated June 24, 2008. Specifically, the examiner found there was no reason to modify the heat responsive unit of Martin or that the proposed modification would render Martin inoperable. The "Notice of Intent to Issue Ex Parte Reexamination Certificate" in the '582 proceeding determined that the prior art of record failed to teach:

"As to claim 1, the overall claimed combination of concealed sprinkler with a drop down deflector including a frame connected to the body and having opposed arms, each arm depending from the body and having a free end portion, is neither anticipated nor rendered obvious by the prior art of record. While Leininger teaches arms 13 and 14 having elements 38 and 39, the arms are connected together at portion 15. Therefore, elements 38 and 39 are not readable as free end portions. Claims 2,3,5 depend from claim 1 and are likewise patentable." See page 2 of the Notice.

The patentability of patent claims 1-3 and 5 were confirmed in the '582 proceeding. Therefore, the prior prosecution of the '320 patent established that the prior art of record, in both the original examination and the '582 reexamination proceeding, failed to teach a frame connected to the body and having opposed free arms, each arm depending from the body and having a free end portion as required by claim 1.

Patent Owner's Contentions

Patent owner contends that the order granting reexamination of claims 1-3 and 5 improperly relied upon an alleged admission in the '320 patent that any conventional valve assembly can be used, and improperly supplemented the admission by reliance on other cited documents, such as U.S. Patent Nos. 4,491,182 and 4,508,175 to Pieczykolan. Petition at 2-6. Patent owner's contentions are focused on the word "admission" but such terminology is not determinative as to whether the Office exceeded its statutory authority in granting the second request for reexamination. The essential inquiry is whether the order granting reexamination established a basis for granting the reexamination, as authorized by 35 U.S.C. 303 and 304 and 37 CFR 1.515 and 1.525.

The order of December 23, 2009 states that Martin in view of the admitted prior art of the '320 patent, '175 Pieczykolan, '182 Pieczykolan, '216 Polan and Orloff raises a SNQ with respect to claims 1-3 because admitted prior art of the '320 patent, '175 Pieczykolan, '182 Pieczykolan, '216 Polan and Orloff present the teachings of Martin in a new light. See pages 4-6 of the Order of December 23, 2009. Specifically, the order states that the new combined teachings are relevant to the free arm limitations found to missing in the prior examination. See page 5 of the order, which states "[t]he prior art combination of Martin taken with the admitted prior art of Polan ('320), Pieczykolan ('182 and '175), Polan ('216) and Orloff et al. ('462) teaches a concealed sprinkler with a drop down deflector assembly including a frame connected to the body and having opposed arms, each arm depending from the body and having a free end portion, the free end portions of the arms being separated by a gap." Therefore, the record shows that the examiner made his own determination that this combination of "old art" and newly cited art provided a new technical teaching pertaining to the free arm limitation, and accordingly, raised a SNQ in regards independent claim 1 and its dependent claims 2, 3, and 5. See MPEP 2244. In other words, the determination of that a SNQ was raised by the new combination of references, including the admitted prior art, was in

accordance with 35 U.S.C. 303 and 304, its implementing regulations, 37 CFR 1.515 and 1.525, and the guidelines set forth in MPEP 2240, 2242, 2244, and 2246.

Patent owner does not argue or show that the order failed to establish that the cited patents presented a new technical teaching that would be important to a reasonable examiner in determining the patentability of claims 1-3 and 5. Patent owner, instead, focuses on whether it was proper for the examiner to rely upon the “admission” or “the admitted prior art” as shown in Figure 6 of the ‘320 patent and the newly cited references, such as ‘175 Pieczykolan and ‘182 Pieczykolan. Petition at 5-6. Patent owner states that any “admission” used by the examiner must stand on its own and cites to MPEP 2217. See the petition at page 5. MPEP 2217 also states that “[a]n admission relating to any prior art established in the record or in court may be used by the examiner in combination with patents or printed publication in a reexamination proceeding.” See also MPEP 706.02 and 2258. This is exactly what the examiner has done in the order. The order did not base the determination of the SNQ on the admitted prior art alone, but instead, relied upon the combined teachings of the cited patents. The examiner combined the teachings of the admitted prior art as shown in Figure 6 of the ‘320 patent with the teachings of Martin and the newly cited prior art references, including ‘175 Pieczykolan, ‘182 Pieczykolan, ‘216 Polan and Orloff. The examiner did not state that the patent owner “admitted” that the valve assembly in ‘175 Pieczykolan or ‘182 Pieczykolan is conventional, and therefore, did not supplement or add to the “admission.” Instead, the examiner stated that the combined teachings of the admitted prior art with the teachings of Martin and the newly cited references raise a SNQ. In other words, the examiner had discretion to grant the request for reexamination and by reasoned analysis determined that Martin in view of the admitted prior art of the ‘320 patent, ‘175 Pieczykolan, ‘182 Pieczykolan, ‘216 Polan and Orloff presented a SNQ. Patent owner had or has a right to respond to the examiner’s substantive determinations made in the order, such as whether the valve assembly in ‘175 Pieczykolan or ‘182 Pieczykolan is conventional or shows the claimed structure, either via 37 CFR 1.530 and 1.550.

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner must have shown that the Office was without authority to grant a request for reexamination. In other words, the petition must show that there was no discretion to grant the reexamination and not just disagreement with substantive determinations in the order on what the prior art teaches.

Findings

It is found that the order was not based on an improper admission, was not based wholly on the same question of patentability raised by the prior art previously presented, and was based on prior art patents and printed publications. 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 an *ultra vires* action. 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:

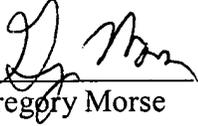
By Mail to: Mail Stop *Ex Parte* Reexam
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4. Telephone inquiries with regard to this decision should be directed to Andy Kashnikow, at (571) 272-4361, in the event that Andy Kashnikow to the undersigned at (571) 272-3838.



Gregory Morse
Director,
Central Reexamination Unit 3999



UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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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)).



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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
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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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MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

(For Patent Owner)

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JUN 22 2009

CENTRAL REEXAMINATION UNIT

GOODMAN, ALLEN & FILETTI PLLC
4501 HIGHWOODS PARKWAY
SUITE 210
GLEN ALLEN, VA 23060

(For Third Party Requester)

DAY CASEBEER MADRID & BATCHELDER
20300 STEVENS CREEK BLVD.
SUITE 400
CUPERTINO, CA 95014

(For Third Party Requester)

In re Barry et alia
Reexamination Proceeding
Control No. 90/009,204
For: U.S. Patent No. 6,081,786

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: 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).

Art Unit: 3992

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

Art Unit: 3992

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.



Gregory Morse
Director, Central Reexamination Unit



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United States Patent and Trademark Office
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MAR 03 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Troutman Sanders
600 Peachtree Street, NE
Atlanta, GA 30308

(For Requester)

Philip L. Kirkpatrick
Crestron Electronics Inc.
15 Volvo Drive
Rockleigh, NJ 07647-2507

In re Petite
Reexamination Proceeding
Control No. 90/010,315
Filed: October 14, 2008
For: U.S. Patent No. 7,103,511

:
: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

The paper filed by requester on December 4, 2008, styled as "Petition to the Commissioner under 37 C.F.R. § 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 November 28, 2008. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent) issued on September 5, 2006.
2. On October 14, 2008, the third party requester deposited a request for *ex parte* reexamination for claims 1-29, and the resulting reexamination proceeding was assigned Control No. 90/010,315 (hereinafter, the '315 proceeding).
3. On November 28, 2008, an order denying the request for reexamination for claims 1-29 was issued.
6. On December 4, 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 upon several errors. In support, the petitioner advances the following points:

1. Specific details of the IEEE standard 802.11-1997 would have been important to a reasonable examiner in determining the claims of the '511 patent (petition, page 2).
2. The examiner misinterpreted the significance of the BPAI decision of August 31, 2005 (petition, page 3). In particular, petitioner argues that the BPAI finding that the Canada reference discloses communication protocols is generic and a reasonable examiner would find the specific technical features of the 802.11-1997 document important in determining the patentability of claims 1-29 (petition, pages 4-8).

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*. That is, the review will determine whether the examiner's refusal to order reexamination for claims 1-29 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-29 of the '352 patent. Consideration is limited to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 1-29. 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) nor any additional SNQs made for the first time in the petition.

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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.

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 examination(s), in view of a material new argument or interpretation presented in the request" An SNQ is not raised by the old prior art, however, 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

¹ Public Law 96-517, enacted on December 12, 1980.

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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. 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.”^{2,3} 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 provides guidelines for such an order, and requires that the examiner’s decision in the order state, for each patent and printed publication cited in the request, why the citation is:

- (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
- (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
- (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
- (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester, which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

² See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

³ For additional discussion regarding technical teachings viewed “in a new light”, see: *In re Melvin J. Swanson et al.*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

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A. IEEE 802.11-1997: It must first be determined if the IEEE 802.11-1997 reference (“the IEEE reference” raises a substantial new question of patentability (SNQ) not considered in a prior examination or reexamination. In other words, does the IEEE reference, either singly or together with other references, raise an SNQ that is different from the technical teachings that were considered with respect to claim patentability in the prosecution of the prior examination?

In the prosecution of the ‘511 patent, U.S. patent 5,907,491 to Canada was applied by the examiner in a rejection under 35 U.S.C. 103 together with Shaughnessy, U.S. patent 6,141,347. That rejection was reversed by the BPAI on August 31, 2005. The present request uses the same Canada patent in the same light as a base reference and, in essence, proposes that the technical features shown in the IEEE reference remedy the deficiencies of the original rejection that was reversed by the BPAI.

While it is noted that reexamination of claims 1-29 was requested, new technical teachings that apply only to dependent claims will not be considered until and unless an SNQ is identified for their parent claim.⁴ In the present proceeding, reexamination of all the independent claims has been requested.

The request for reexamination, dated October 14 2008, identifies several technical features in the IEEE reference that allegedly would be important to a reasonable examiner in determining the patentability of claims 1, 8, 13, 20 and 27, which are all of the independent claims in the ‘511 patent. The request of October 14, 2008 on page 3 identifies the following technical features of the IEEE reference with respect to those claims:

- a predefined communications protocol (See section 7 and Figs. 12 and 13 [of IEEE])
- the transmitter to receiver architecture of the invention by teaching both a “receiver address” (RA) and a “transmitter address (TA) and both a destination address (DA) and a “source address” (SA) (see [IEEE], Section 4)

However, a review of the BPAI decision of 8/31/2005 in the file of application 09/925,269 shows that the BPAI concluded that Canada does disclose a predefined communications protocol (page 9, first paragraph) and further concluded that modification for a LAN/WAN configuration would have been obvious (page 9, last paragraph). The BPAI identified that “[b]ecause the machine monitors 4 do not transmit to other machine monitors 4, but rather transmit to repeaters or directly to command station 6, the limitations of claim 1 are not met by the teachings of Canada and Shaughnessy”.

⁴ It is difficult to see how a reference could have technical teachings that are important to the patentability of a dependent claim absent a question of the patentability of its patent claim except in situations where the effective priority date of the two claims appears to be different, which is not the situation here.

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Requestor, in the original request, identifies an element of the claim “and further configured to receive the original data message transmitted by one of the other wireless transceivers and transmit a repeated data message” (page 6) and contends that this is disclosed by Canada at Col. 4 lines 61-67 and by an IEEE disclosure of a “source address” and a “destination address”.

Upon *de novo* review, the examiner correctly determined that the “new” teaching of IEEE shows the same technical features that were previously considered. The record of the parent application 09/925,269, Examiner’s answer of 3/26/2004, page 6, page 10-11, and page 14, indicates that Shaughnessy was known and considered for showing a source address and a destination address, and the BPAI subsequently reversed rejections of the claim 1 as obvious in view of Canada and Shaughnessy. The USPTO previously considered technical teachings showing a WAN/LAN where the message has a source address and a destination address in conjunction with the system of Canada, and determined that the claims were patentable.

Accordingly, the Canada reference and the IEEE standard do not present a new technical teaching that would have been important to a reasonable examiner in deciding to allow one or more claims in the 09/925,269 application that matured into the ‘511 patent.

REQUESTER'S RECOURSE

This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

CONCLUSION

1. The PETITION is DENIED.
2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449, or in her 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TROUTMAN SANDERS LLP
BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA GA 30308-2216

(For Patent Owner)

MAILED

JUL 06 2009

OFFICE OF PETITIONS

Jon L. Roberts
The Marbury Law Group, PLLC
11800 Sunrise Valley Drive
Suite 1000
Reston VA 20191

(For Requester)

In re Sanders et al. :
Reexamination Proceeding :
Control No. 90/010,321 : **DECISION DISMISSING PETITION**
Request Deposited: October 16, 2008 :
Attorney Docket No. WID2REEX :
For: U.S. Patent No. 7,301,920 :

This is a decision on the "Petition Under 37 C.F.R. § 1.78(a)(3) to Accept an Unintentionally Delayed Claim Under 35 U.S.C. §120," The claim is set forth in the concurrently filed amendment.

The petition is **DISMISSED**

As stated in MPEP 2258, in reexamination,

[a] patent owner may correct the failure to adequately claim (in the application for the patent reexamined) benefit under 35 U.S.C. 120 of an earlier filed copending U.S. patent application. For a patent to be reexamined which matured from a utility or plant

application filed on or after November 29, 2000, the patent owner must file a grantable petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3).

The instant petition is filed on the basis that the patent owner failed to adequately claim benefit under 35 U.S.C. 120 of application No. 09/638,921 in the application for the patent being reexamined, Patent No. 7,301,920, which issued from application No. 10/694,449 filed October 27, 2003. A review of the record confirms that such a claim was not filed in the application for the '920 patent being reexamined within the time period set forth in 37 CFR 1.78(a)(2)(ii)¹. In addition, the patent being reexamined issued from an application filed on October 27, 2003, which is after November 29, 2000. Accordingly, filing of a petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3) is appropriate.

A grantable petition for acceptance of a claim for late priority under 37 C.F.R. § 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 37 C.F.R. § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition includes the required surcharge and the required statement of unintentional delay. However, the petition does not satisfy requirement (1) above.

The reference is properly made by amendment to add the prior-filed application to the first sentence of the specification following the title. In compliance with 37 CFR 1.530(d)(1), the requested change to the specification must be made by submission of the entire text of the first paragraph rewritten, including markings pursuant to 1.530(f). Further, the precise point in the specification where the rewritten paragraph is located is identified as at line 8.

Moreover, the reference properly states a relationship between the prior-filed application No. 09/638,921, (continuation-in-part) and the later-filed application. However, the reference is not acceptable as drafted, since it improperly incorporates by reference prior-filed application No. 09/638,921. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). Therefore, if an incorporation by reference statement is first included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b). In this instance,

¹ The application for the patent reexamined as filed included a claim for benefit of priority to provisional application No. 60/421,397. The twelve-month requirement of 35 U.S.C 119(e) was met as the provisional application was filed on October 25, 2002 and the instant application was filed on Monday, October 27, 2003, the next succeeding business day after the 12 month date of October 25, 2003.

on filing of the application for the patent being reexamined, applicants only incorporated by reference the prior-filed provisional application. Accordingly, submission of the instant reference including an incorporation by reference of both the provisional application and the nonprovisional application is not proper.

Before the petitions under 37 CFR 1.78(a)(3) can be granted, a renewed petition and an amendment (complying with the provisions of 37 CFR 1.530(d)) to correct the above matter is required. Petitioner is reminded that this correction cannot be made by way of a supplemental application data sheet. An application data sheet (ADS) under 37 CFR 1.76 cannot be submitted in a reexamination proceeding since a reexamination proceeding is not an "application."

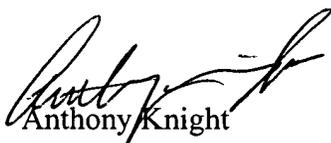
Further correspondence with respect to this matter, unless otherwise indicated, should be addressed as follows:

By mail: Mail Stop "Ex Parte Reexam"
 Attn: Central Reexamination Unit
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop "Ex Parte Reexam"
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Nancy Johnson, Senior Petitions Attorney at (571) 272-3219.


Anthony Knight
Supervisor
Office of Petitions



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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TROUTMAN SANDERS LLP
BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA GA 30308-2216

(For Patent Owner)

MAILED

AUG 10 2009

OFFICE OF PETITIONS

Jon L. Roberts
The Marbury Law Group, PLLC
11800 Sunrise Valley Drive
Suite 1000
Reston VA 20191

(For Requester)

In re Sanders et al. :
Reexamination Proceeding :
Control No. 90/010,321 : DECISION GRANTING PETITION
Request Deposited: October 16, 2008 :
Attorney Docket No. WID2REEX :
For: U.S. Patent No. 7,301,920 :

This is a decision on the "Renewed Petition Under 37 C.F.R. § 1.78(a)(3) to Accept an Unintentionally Delayed Claim Under 35 U.S.C. §120," for the benefit of priority to prior-filed nonprovisional application No. 09/638,921, filed August 3, 2009.

The petition is **GRANTED**.

A grantable petition for acceptance of a claim for late priority under 37 C.F.R. § 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 37 C.F.R. § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The patent owner failed to adequately claim benefit under 35 U.S.C. 120 of application No. 09/638,921 in the application for the patent being reexamined, application No. 10/694,449 filed October 27, 2003, now Patent No. 7,301,920. By decision mailed July 6, 2009, the initial petition was dismissed. The petition included the required surcharge and the required statement of unintentional delay, but did not include an acceptable reference. The reference improperly first incorporated by reference prior-filed application No. 09/638,921 after the application filing date.

On instant renewed petition, patent owner has submitted a supplemental amendment and a further statement of unintentional delay. This amendment has been reviewed and found to include a proper and acceptable reference. The amendment does not include an improper incorporation by reference statement. The amendment only incorporates the provisional application, which was incorporated by reference on filing of the application. The reference properly states a relationship between prior-filed application No. 09/638,921 (continuation-in-part) and the later filed application. In addition, the amendment is in compliance with §§1.530(d)(1) and (f).

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 3992 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed application.

Any questions concerning this matter may be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over a horizontal line.

Anthony Knight
Supervisor
Office of Petitions

Enclosure: Corrected Filing Receipt



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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Table with 7 columns: APPLICATION NUMBER, FILING or 371(c) DATE, GRP ART UNIT, FIL FEE REC'D, ATTY.DOCKET.NO, TOT CLAIMS, IND CLAIMS. Row 1: 90/010,321, 10/16/2008, 3992, 2520, WID2REEX, 22, 2

CONFIRMATION NO. 8007

CORRECTED FILING RECEIPT



6980
TROUTMAN SANDERS LLP
BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
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ATLANTA, GA 30308-2216

Date Mailed: 08/07/2009

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

7,301,920, Residence Not Provided;
TELECOM NETWORK OPTIMIZATION, INC. (OWNER), ATLANTA, GA;
ROBERTS, MARDULA & WERTHEIM, LLC (3RD.PTY.REQ.), RESTON, VA;
ROBERTS, MARDULA & WERTHEIM, LLC, RESTON, VA

Assignment For Published Patent Application

TELECOM NETWORK OPTIMIZATION, INC., ATLANTA, GA

Power of Attorney: The patent practitioners associated with Customer Number 06980

Domestic Priority data as claimed by applicant

This application is a REX of 10/694,449 10/27/2003 PAT 7,301,920
which claims benefit of 60/421,397 10/25/2002
and is a CIP of 09/638,921 08/15/2000 PAT 6,754,487

Foreign Applications

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

Title

System and Method for Identifying Co-Channel Interference in a Radio Network

Preliminary Class

370

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,331	11/06/2008	7,047,806	1706/5	3026

24024 7590 05/13/2010

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JENKINS, WILSON, TAYLOR & HUNT, P.A.
SUITE 1200 UNIVERSITY TOWER
3100 TOWER BLVD.
DURHAM, NC 27707

Date:
MAILED

MAY 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010331
PATENT NO. : 7047806
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
P.O. Box 1450
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CALFEE HALTER & GRISWOLD, LLP : (For Patent Owner)
800 SUPERIOR AVENUE :
SUITE 1400 :
CLEVELAND OH 44114: :

MAILED

MAY 13 2010

CENTRAL REEXAMINATION UNIT

JENKINS, WILSON, TAYLOR : (For Third Party
& HUNT, P. A. : Requester)
SUITE 1200 UNIVERSITY TOWER :
3100 TOWER BLVD., :
DURHAM, NC 27707 : :

In re: Kowalski et alia : DECISION
Ex Parte Reexamination Proceeding : DISMISSING-AS-MOOT
Control No. 90/010,331 : PETITION FOR EXTENSION
Deposited on: 06 November 2008 : OF TIME
For: US Patent No. 7,047,806 B2 : [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 07 May 2010 petition titled, "Request to Reset Period for Response or, Alternatively, Request for Extension of Time to Respond [37 CFR § 1.550(c)]" requesting the response period for response be reset to two (2) months or alternatively, to extended by one (1) month the period for response to the non-final Office action dated 16 April 2010. The petition submitted 07 May 2010 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 dismissed-as-moot for the reasons set forth below.

DECISION

The Patent Owner's representative requests the period for response be rest to two (2) months or alternatively, extended by one (1) month for responding to the non-final Office action dated 16 April 2010, which sets one(1) months time for filing a response thereto. The petition for extension of time was timely filed on 07 May 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 dismissed-as-moot.

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.550 (c) states:

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Addressing the requirement of 37 CFR § 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, **MPEP § 2265** states, in pertinent part:

Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. 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 reset to two (2) months or alternatively extended by one month. Upon review of the 16 April 2010 action it appears that the correct period for response is two (2) months.

This paper corrects the period for response of the non-final Office action to two (2) months period for response.

The petition request to extend the response time is hereby dismissed-as-moot.

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 07 May 2010 is hereby dismissed.

2. The period ends **two (2) months** from the mailing of the non-final Office action.
3. The response is due **16 June 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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,331	11/06/2008	7,047,806	1706/5	3026

24024 7590 06/23/2010

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER

ART UNIT PAPER NUMBER

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

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JENKINS, WILSON, TAYLOR & HUNT, P.A.
SUITE 1200 UNIVERSITY TOWER
3100 TOWER BLVD.
DURHAM, NC 27707

Date:

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010331
PATENT NO. : 7047806
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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CALFEE HALTER & GRISWOLD, LLP : (For Patent Owner)
800 SUPERIOR AVENUE :
SUITE 1400 :
CLEVELAND OH 44114: :

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

JENKINS, WILSON, TAYLOR : (For Third Party
& HUNT, P. A. : Requester)
SUITE 1200 UNIVERSITY TOWER :
3100 TOWER BLVD., :
DURHAM, NC 27707 : :

In re: Kowalski et alia : DECISION
Ex Parte Reexamination Proceeding : GRANTING
Control No. 90/010,331 : PETITION FOR EXTENSION
Deposited on: 06 November 2008 : OF TIME
For: US Patent No. 7,047,806 B2 : [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 16 June 2010 petition entitled, "Request for Extension of Time to Respond [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 granting 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 non-final Office action dated 16 April 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 16 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 request is hereby granted.

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.550 (c) states:

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Addressing the requirement of 37 CFR § 1.550 (c) to make a showing of "sufficient cause"

to grant an extension of time request, **MPEP § 2265** states, in pertinent part:

Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. 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 be extended by one month. The petition relates the actions taken thus far and notes additional time is needed for finalizing a declaration under 37 CFR § 1.131. 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 non-final Office action dated 16 June 2010 is hereby granted.
2. The period ends three (3) months from the mailing of the non-final Office action.
3. The response is due 16 July 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



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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.
90/010,332	11/07/2008	5,359,317	113518.123-US8	6075

20280 7590 03/22/2010

MOTOROLA INC
600 NORTH US HIGHWAY 45
W4 - 39Q
LIBERTYVILLE, IL 60048-5343

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/22/2010

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Patent Department
Motorola, Inc.
600 North U.S. Highway 45
W4-39Q
Libertyville, IL 60048-5343

(For Patent Owner)

MAILED

MAR 22 2010

CENTRAL REEXAMINATION UNIT

Wilmer Cutler Pickering Hale and Dorr LLP
399 Park Avenue
New York, New York 10022

(For Requester)

In re Gomez *et alia*
Reexamination Proceeding
Control No. 90/010,332
For: U.S. Patent No. 5,359,317

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the March 3, 2009 paper entitled "PETITION FROM DENIAL OF REQUEST FOR EX PARTE REEXAMINATION PURSUANT TO 37 C.F.R. §§ 1.515(c) AND 1.181". No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **DENIED** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,359,317 (hereinafter, the '317 patent) issued on October 25, 1994 to Gomez *et al.*
2. On November 7, 2008, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/010,332 (hereinafter, the '10332 proceeding).
3. An order denying the request for *ex parte* reexamination was mailed on February 3, 2009. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.
4. On March 3, 2009, the present petition was filed.

Art Unit: 3992

DECISION

Third party requester ("Petitioner") in the '10332 reexamination proceeding has petitioned seeking relief from the examiner's February 3, 2009 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for claims 1-6, 9-11, 13-19, 21, and 22 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo*.

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be

Art Unit: 3992

important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '317 Patent

The '317 patent issued on October 25, 1994 to Gomez *et al.* During the prosecution of the '317 patent, the claims were rejected using a combination of the DeLuca and Fennell patents. Following the rejections, claim amendments were submitted to require that a user select the partition used to store a message. A notice of allowance was then issued where the Examiner indicated that the prior art of record including the DeLuca and Fennell patents "does not include a plurality of file types located in the partitions of the memory and does not allow the user to select which partition the message is to be stored in." *'317 Patent, May 9, 1994 Notice of Allowance, pp. 2-3.*

Reexamination of claims 1-6, 9-11, 13-19, 21, and 22 was requested in view of the newly submitted Fascenda patent and the previously considered DeLuca and Fennell patents. An order denying reexamination was mailed on June 5th, 2009. In that order, the Examiner stated that reexamination was denied because the provided references were cumulative to the record. Specifically, it was noted that the Fascenda patent was cumulative to the prior art patents and publications currently on the record and thus no substantial new question of patentability was raised.

III. Summary of Petitioner's Grounds in Support of Requested Relief

Petitioner requests reconsideration of the November 7, 2008 request for reexamination. Specifically, Petitioner requests reconsideration of the Examiner's finding that Fascenda was cumulative to the record.

Petitioner requests the following relief:

Petitioner requests the granting of reexamination of claims 1-6, 9-11, 13-19, 21, and 22 if it is found that Fascenda is not cumulative. In support of this relief, Petitioner argues that Fascenda is not cumulative because it teaches features that distinguished the claimed invention over the prior art.

Alternatively, Petitioner requests the granting of reexamination of claims 1-5, 9-11, 13, 14, 17, 18, 21, and 22 if Fascenda is found to be cumulative. In support of this relief, Petitioner argues

Art Unit: 3992

that the reexamination Examiner acknowledged that Fennell teaches the features that distinguished the claimed invention over the prior art.

IV. De Novo Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, taking into account the third party requester's position as presented in the instant petition, has been made as to whether the November 7, 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 '317 patent filed in the '10322 reexamination proceeding has been found not to present a SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner first argues that the reexamination Examiner erred by finding that Fascenda was cumulative to the record. Petitioner asserts that Fascenda is not cumulative because Fascenda "discloses a plurality of partitions (e.g., allocated regions in RAM) corresponding to a plurality of file types (e.g., private messages, group messages, and database messages." Accordingly, Petitioner asserts that a SNQ has been raised and requests that the reexamination request be granted.

Similarly, the request alleges that Fascenda discloses:

"[a] flexible memory management in a pager. (See Fascenda, col. 3, ll. 24-27). In connection with multi-recipient messages in particular, Fascenda describes a system that "provides for a hierarchy of storage and retrieval" of the messages. (Fascenda, col. 3, 11.8-9). This hierarchy for storage of messages is described in Fascenda as "broadcast changeable," which "provides the system with great flexibility in the organization, storage and access of database information." (Fascenda, col. 3, 11.24-27). *See Request for Reexamination, Pages 12-13.*

The request does not raise a SNQ with respect to Fascenda because the request does not establish that Fascenda teaches the claimed features that the examiner identified as distinguishing the '317 patent over the prior art. During prosecution of the '317 patent, the Examiner stated that the DeLuca and Fennell patents did not teach "a plurality of file types located in the partitions of the memory and does not allow the user to select which partition the message is to be stored in." '317 Patent, May 9, 1994 Notice of Allowance, pp. 2-3. The request does not identify a new technical teaching in Fascenda that discloses these features and thus Fascenda would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '317 patent.

Art Unit: 3992

Fascenda does not teach a plurality of file types located in the partitions of the memory where the user selects which partition the message is to be stored in. Instead, Fascenda teaches a plurality of file types located in the partitions of the memory, but teaches those messages being stored in a partition automatically and without any user selection. *See Request for Reexamination, Pages 12-13.* Fascenda does not teach that a user could select the partition for message storage. Instead, Fascenda teaches that the hierarchy governing where messages storage "is changeable by over-the-air broadcasts" *See Request for Reexamination, Page 13.* The messages are then automatically placed in their respective partition based upon the message type without the distinguishing feature of user selection. Accordingly, Fascenda would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '317 patent.

Turning to Petitioner's second argument, Petitioner asserts that even if Fascenda is found to be cumulative, reexamination should be granted for claims 1-5, 9-11, 13, 14, 17, 18, 21, and 22 because the reexamination Examiner acknowledged that Fennell teaches the features that the prosecution Examiner found to be lacking.

The petition refers to the order where the reexamination Examiner stated:

"It is noted that Fennell, as pointed out by the Requestor on p. 16 of the Request, discloses two partitions where old messages are stored in a history file and the user can select which ones to keep in a personal file. Those indeed are two partitions in memory as claimed; however, the amended matter overcoming the references above includes a requirement of user selection of the partition the message is to be deposited in, whereas Fennell only allows the user to control the deposition of a message into one of the partitions (the "personal" file)." *Order Denying Reexamination, Page 4.*

The request suggests that if the claims are interpreted broadly then Fennell teaches the distinguishing features of the '317 patent. The request states:

"To the extent that that the phrase "selecting by the user one of the plurality of partitions" is interpreted broadly enough to read on an embodiment in which there are two memory partitions of which only one is selectable, the examiner may have misunderstood the combined teachings of the DeLuca '739 patent and Fennell. Namely, Fennell describes two allocated areas in memory for retention of messages, corresponding to a "history file" and a "personal file." Of these, the "personal file" is selectable by a user. Therefore, if the Examiner were broadly interpreting the limitation in the above manner, the limitation would have read on the combined teachings of the DeLuca '739 patent and Fennell." *See Request for Reexamination, Page 16, Footnote 2.*

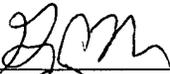
The request does not raise a SNQ with respect to Fennell since the technical features relied on in Fennell were considered in a prior examination where it was found that Fennell did not teach the distinguishing features of the '317 patent. Thus, the same question of patentability has been decided by the Office in a previous examination. As the technical features of Fennell are not presented in a new light by the request, Fennell does not raise an SNQ.

Art Unit: 3992

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.
2. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.



Gregory Morse, Director
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/14/2010

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
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:
MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
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.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/14/2010

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

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
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

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.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910
21906	7590	06/14/2010	EXAMINER	
TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			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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Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
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.



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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

JUN 14 2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON TX 77057-2631

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

~~Kenyon & Kenyon-LLP~~
One Broadway
New York, NY 10004

~~(For first Inter-Partes Requester)~~

Novak, Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For second Inter Partes Requester)

Knobbe, Martens Olson & Bear, LLP
5040 Main St. 14th Floor
Irvine, CA 92614

(For Ex Parte Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

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 (consolidated) at this time.

REVIEW OF RELEVANT FACTS

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) issued to White *et al.*
2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).
3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '10333 proceeding.
4. On August 5, 2009, a non-final Office action was mailed in the '10333 proceeding, rejecting all the claims of the '833 patent.
5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc.. The request was assigned control number 95/001,233 (the '1233 proceeding).
6. On October 2, 2009, patent owner timely filed, in the '10333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.
7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.
8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc... The request was assigned control number 95/001,264 (the '1264 proceeding).
9. On February 5, 2010, *inter partes* reexamination was ordered in the '1223 proceeding.
10. To date, no Office action has issued in the '1223 *inter partes* proceeding, nor in the '1264 *inter partes* proceeding, and no further Office action has issued in the '10333 *ex parte* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. Two of the proceedings are *inter partes* reexamination proceedings and one is an *ex parte* reexamination proceeding. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,080, 95/001,183 *inter partes* proceedings and the 90/010,623 *ex parte* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Amendments to patent claims 1 and 17 have been proposed in the '10333 proceeding, while there is no amendment in either the '1223 and '1264 proceedings. Thus, the claims are not currently the same in all files. An Office action requiring an amendment placing the claims of all the proceedings in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings and an *ex parte* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997, except that participation by the third party requester of the '10333 *ex parte* reexamination is governed by 37 CFR §§ 1.510 through 1.560.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings both *inter partes* requesters, Apple, Inc and Volkswagen Group of Americas, Inc., can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. Neither *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

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 all 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 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 files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

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 requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all 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 an *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.

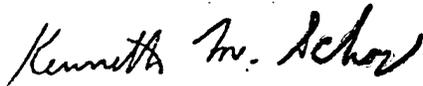
F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to 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 Nos. 95/001,223 and 95/001,264 and *ex parte* Reexamination Control No. 90/010,333 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Jurisdiction over the merged reexamination files is being forwarded to the Central Reexamination Unit (CRU).
3. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to place the same amendment in all proceedings and requesters' comments on that response, or (b) the expiration of the time for filing the required response and any comments requesters elect to file.
4. Any questions concerning this communication 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

5-13-10



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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Joseph W Price :
SNELL & WILMER LLP (OC) : (For Patent Owner)
600 ANTON BOULEVARD :
SUITE 1400 :
COSTA MESA CA 92626 :

Michael D. Harris :
KLEINBERG & LERNER, LLP : (for Third Party
2049 Century Park East : Requester)
Suite 1080 :
Los Angeles, CA 90067 :

Michael D Harris :
SOCAL IP LAW GROUP LLP : (For Third Party
310 N. WESTLAKE BLVD. STE 120 : Requester)
WESTLAKE VILLAGE, CA 91362 :

DECISION,
SUA SPONTE
MERGING
REEXAMINATION
PROCEEDINGS
[37 CFR § 1.565(c)]

In re: Fujisawa :
Ex Parte Reexamination Proceeding :
Control No. 90/007,861 :
Deposited on: 28 December 2005 :
For: US Patent No. 6,933,608 :

In re: Fujisawa :
Ex Parte Reexamination Proceeding :
Control No. 90/008,629 :
Deposited on: 4 May 2007 :
For: US Patent No. 6,933,608 :

In re: Fujisawa :
Ex Parte Reexamination Proceeding :
Control No. 90/010,340 :
Deposited on: 17 November 2008 :
For: US Patent No. 6,933,608 :

MAILED
FEB 26 2009
CENTRAL REEXAMINATION UNIT

The above-identified reexamination files are before the Director of the Central Reexam Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,933,608 issued on 10 July 2001.
2. *Ex Parte* Reexamination Proceeding, control no. 90/007,861 was requested by a third party requester on 13 April 2006.
3. The Reexamination Order was granted in proceeding, control no. 90/007,861 on 10 February 2006.
4. *Ex Parte* Reexamination Proceeding, control no. 90/008,629 was requested by a third party requester filed on 4 May 2007.
5. The Reexamination Order was granted in proceeding, control no. 90/008,629 on 19 July 2007.
6. Proceedings control numbers 90/007,861 and 90/008,629 were merged on 5 September 2007.
7. There are amendments in the merged proceedings 90/007,861 and 90/008,629.
8. *Ex Parte* Reexamination Proceeding, control no. 90/010,340 was requested by a third party requester on 17 November 2008.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in all of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/007,861; 90/008,629 and 90/010,340 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file.

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/007,861; 90/008,629 and 90/010,340 are hereby merged.
2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.
3. All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam

Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are “soft scanned” (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the “soft scanning” process is complete.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,340	12/10/2008	6933607	K008-P08796US	5572

21611 7590 05/11/2010

SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/11/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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Snell & Wilmer LLP (OC)
600 Anton Boulevard
Suite 1400
Costa Mesa, CA 92626

(For patent owner)

Michael D. Harris
SoCal IP Law Group LLP
310 N. Westlake Blvd.
Suite 120
Westlake Village, CA 91362

(For third party requester)

MAILED

MAY 11 2010

CENTRAL REEXAMINATION UNIT

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/007,861
Filed: December 28, 2005
For: U.S. Patent No. 6,933,608

:
: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/008,629
Filed: May 4, 2007
For: U.S. Patent No. 6,933,608

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/010,340
Filed: December 10, 2008
For: U.S. Patent No. 6,933,608

This is a decision on the March 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated merged reexamination ("the March 25, 2010 patent owner petition to revive").¹

The March 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

¹ Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged prosecution was "terminated" due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 7, 2009 final Office action.

The March 25, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 305 provides, in pertinent part:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*
*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

*

*

(d) *Terminal disclaimer.*

*

*

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 41.33 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing

unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

MPEP 2274 provides, in pertinent part:

I. AMENDMENT

Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.

*

*

IV. FAILURE TO TIMELY FILE APPEAL BRIEF

Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Regarding item (1), the instant merged reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 7, 2009 final Office action. Although patent owner filed a Notice of Appeal on December 4, 2009, patent owner failed to follow-up the Notice of Appeal with either (i) an Appeal Brief in accordance with 37 CFR 41.37(a)(1) or (ii) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the merged proceeding in condition for issuance of a reexamination

certificate by making all pending claims patentable, as provided in 37 CFR 41.33(a) and MPEP 2274(I).

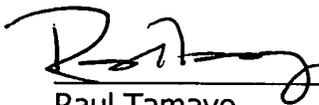
Patent owner submitted an Appeal Brief and paid the corresponding fee of \$540.00 on March 25, 2010, thereby satisfying item (1).

A petition fee of \$1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 25, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the March 25, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 25, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.
2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for treatment in due course of the March 25, 2010 Appeal Brief.
3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.
4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



Raul Tamayo
Legal Advisor
Office of Patent Legal Administration



Fish & Richardson PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Patent Owner)

MAILED

JUN 17 2009

Renner, Kenner, Greive, Bobak, Taylor & Weber
First National Tower, 4th Floor
106 S. Main Street
Akron, OH 44308

(For 3rd Party Request) **CENTRAL REEXAMINATION UNIT**
(90/009,413)

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,347	11/21/2008	5787449	6620-81781-01	3627

26111 7590 07/23/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RICHARD D. McLEOD
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET, #1600
PORTLAND, OR 97204

Date:

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010347
PATENT NO. : 5787449
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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STERNE, KESSLER, GOLDSTEIN & FOX LLC
1100 NEW YORK AVENUE, NW
WASHINGTON DC 20005

(For Patent Owner)

RECEIVED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

RICHARD D. MCLEOD
KLARKQUIST SPARKMAN LLP
121 SW SALMON STREET #1600
PORTLAND, OR 97204

(For Third-Party Requester)

In re VULPE et al.
Reexamination Proceeding
Control No. 90/010,347
Request Deposited: November 21, 2008
For: U.S. Patent No. 5,787,449

: DECISION ON
: PETITION FOR
: EXTENSION OF TIME
: [37 CFR 1.550(c)]
:

This is a decision on the July 17, 2009, "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to respond to the outstanding Office action be extended two months.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is **granted-in-part** and a one-month extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,787,449 (hereinafter, the '449 patent), issued to VULPE et al on July 28, 1998.
2. On November 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '449 patent. The reexamination proceeding was assigned Control No. 90/010,347(hereinafter, the '10347 proceeding).

Art Unit: 3992

3. The reexamination order was granted in the '10347 proceeding on January 23, 2009.

DECISION

The Patent Owner requests a two (2) month extension of time in which to file a response to the outstanding office action. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on July 17, 2009, together with the petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

(c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Addressing the requirement of 37 CFR 1,550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Patent Owner's Showing of Sufficient Cause to Grant an Extension of Time

The request notes that the office action was mailed by the Office on June 15, 2009 and present counsel was not retained until July 15, 2009. One month of the response period had lapsed when counsel was retained. Petitioner requests an additional two months for preparation of the response. Reference is made to the petition for details of this and other issues.

Art Unit: 3992

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a Patent Owner statement. However, as noted in MPEP 2265, second or subsequent requests for extensions of time or *requests for more than 1 month* will be granted only in extraordinary situations. The instant facts do not appear extraordinary. An extension of time of one month is considered sufficient.

Accordingly, the time for filing a Patent Owner statement is extended for one month and is due on or before September 15, 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. Petitioner's request is **granted-in-part**. The period during which Patent Owner may file a Patent Owner statement has been extended to November 20, 2008.

2. All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission

Art Unit: 3992

for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Jessica Harrison at (571) 272-4449, Eric Keasel at (571) 272-4929, or Mark Reinhart at (571) 272-1611.

/J. Harrison/ for

Gregory Morse
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,347	11/21/2008	5787449	6620-81781-01	3627
26111	7590	08/21/2009	EXAMINER	

Richard D. McLeod
Klarquist Sparkman LLP
121 SW Salmon Street, #1600
Portland, OR 97204

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 08/21/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,347	11/21/2008	5787449	6620-81781-01	3627

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 : (For Patent Owner)
& FOX P.L.L.C. :
1100 NEW YORK AVENUE, N.W. :
WASHINGTON DC 20005 :

Richard D McLeod : (For Third Party
Klarquist Sparkman LLP : Requester)
121 SW Salmon St. #1600 :
Portland OR 97204 :

In re: *Vulpe et alia* : DECISION
Ex Parte Reexamination Proceeding : DISMISSING
Control No. 90/010,347 : PETITION FOR EXTENSION
Deposited: 21 November 2009 : OF TIME
For: US Patent No. 5,787,449 : 37 CFR § 1.550(c) & 1.181

MAILED

AUG 21 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 19 August 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 Office action dated 15 June 2009, be further extended. The petition was timely filed with the petition fee.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time be extended in which to extend the response period for the Office action dated 15 June 2009, be extended for a second month. The patent owner's petition for extension of time was timely filed on 19 August 2009, together with the proper fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a

notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Addressing the requirement of 37 CFR § 1.550 (c) to make a showing of “sufficient cause” to grant an extension of time request, MPEP 2265 states, in pertinent part:

Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. ...

First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. (emphasis added) ...

ANALYSIS AND FINDINGS

The patent owner’s petition seeks to further extend the period for which to respond, is before the Director of the CRU. The decision to extend the period for response is evaluated based upon a showing of “sufficient cause.” There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

It is noted that a first extension of one-month time has already been granted. Pursuant to MPEP § 2265 Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. It is not clear what is extraordinary in this petition to support “sufficient cause” for a second and subsequent extension of time. It is unclear how the i4i team schedule over the next two weeks is extraordinary when the time for response is three months. It is unclear what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed. It is unclear what scheduling conflicts there were since the mailing of the Office action.

The petition request to extend the response time by one (1) month is hereby dismissed.

CONCLUSION

1. The patent owner's petition for further extending the period for response is hereby dismissed.
2. The period for response ends on 15 September 2009.
3. Correspondence to the Office should be addressed as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
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401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

3. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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Fish & Richardson PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Patent Owner)

MAILED

Novak Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(For 3rd Party Requester) MAY 12 2009
(90/010,354) CENTRAL REEXAMINATION UNIT

Brooke W. Quist
Steptoe & Johnson LLP
2121 Avenue of the Stars, Suite 2800
Los Angeles, CA 90067

(For 3rd Party Requester)
(90/009,319)

Reexam Control No.: 90/010,354
Filed : December 1, 2008
For U.S. Patent No. : 5,485,827

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/009,319
Filed : January 15, 2009
For U.S. Patent No. : 5,485,827

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.

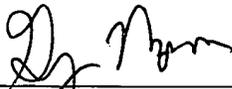
Conduct of Proceedings

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.
90/010,354	12/11/2008	5485827	8960.002.RXUS00	5696

26161 7590 09/04/2009

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date: **MAILED**

SEP 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010354
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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Fish & Richardson PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Patent Owner)

MAILED

SEP 04 2009

Novak Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(For Third Party Requester) CENTRAL REEXAMINATION UNIT
(90/010,354)

Brooke W. Quist
Steptoe & Johnston LLP
2121 Avenue of the Stars, Suite 2800
Los Angeles, CA 90067

(For Third Party Requester)
(90/009,319)

Ex Parte Reexamination Proceeding
Control No. 90/010,354
Filed: December 1, 2008
For: U.S. Patent No. 5,485,827

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

Ex parte Reexamination Proceeding
Control No. 90/009,319
Filed: January 15, 2009
For: U.S. Patent No. 5,485,827

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

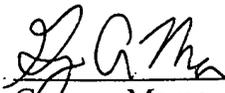
1. The Patent Owner's petition for withdrawal of the July 30, 2009 Office action is denied.
2. Response may be submitted as follows:

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE WA 98101-3045

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

(For Requester)

In re Balassanian
Reexamination Proceeding
Control No. 90/010,356
For: U.S. Patent No. 6,629,163

: DECISION DISMISSING
: PETITION FOR
: EXTENSION OF TIME
: [37 CFR 1.550(c)]

This is a decision on the August 3, 2009 and August 6, 2009 papers entitled "PETITION FOR EXTENSION OF TIME UNDER 37 CFR §1.550(c)" requesting that the time to submit a response be extended an additional 30 days from the current due date of August 7, 2009.

The petition is before the Central Reexamination Unit for consideration.

The petition is **dismissed** for the reasons set forth below.

DECISION

The Patent Owner requests an extension of time in which to file a response. The present petition for extension of time was timely filed on August 3, 2009 with the petition fee required by 37 CFR §1.550(c) and 37 CFR §1.17(g). However, the petition lacked an indication of service on the third party and a duplicate copy of the petition with an indication of service was filed on August 6, 2009.

37 CFR 1.550 (c) states:

(c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Art Unit: 3992

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.

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is insufficient to justify an extension of time. The request does not include 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. The petition merely outlines how responsibility of the proceeding was transferred between law firms with no one discussion of any action taken to respond to the outstanding office action.

Therefore, the request for a thirty-day extension of time is **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.
2. The dismissal is without prejudice to a request for reconsideration or higher-level review.
3. The Patent Owner's response is due August 7, 2009.
4. Patent Owner may wish to consider filing a petition under 37 CFR §1.137 (see MPEP 2268)
5. **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

Art Unit: 3992

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
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Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

6. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611, 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.
90/010,356	12/18/2008	6629163	90159-003US2	1023

7590 10/01/2009
IMPLICIT NETWORKS, INC.
INTELLECTUAL PROPERTY DEPT.
218 Main Street, Suite 498
Kirkland, WA 98033

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/01/2009

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David A. Jakopin
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
McLean, VA 22102

Date:

MAILED

OCT 01 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010356
PATENT NO. : 6629163
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90010356	12/18/08	6629163	90159-003US2

Davis Wright Tremaine, LLP/Seattle
1201 Third Avenue, Suite 2200
Seattle, WA 98101-3045

EXAMINER

ART UNIT	PAPER
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3992

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DATE MAILED: OCT 01 2009

CENTRAL REEXAMINATION UNIT

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United States Patent and Trademark Office
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www.uspto.gov

Implicit Networks, Inc. – Intellectual Property Department
218 Main Street, Suite 498
Kirkland, WA 98033

(For Patent Owner)

MAILED

DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE WA 98101-3045

(Courtesy Copy) OCT 01 2009
CENTRAL REEXAMINATION UNIT

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

(For Third Party Requester)

In re: Balassanian :
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No. 90/010,356 : FILED UNDER 37 CFR 1.181
Request Deposited: December 15, 2008 :
For: U.S. Patent No. 6,629,163 :

This is a decision on the September 1, 2009 petition entitled "PETITION TO WITHDRAW TERMINATION OF EX PARTE REEXAMINATION PROCEEDING BASED ON FAILURE TO RECEIVE OFFICE ACTION UNDER 37 CFR 1.181(a)".

The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR §1.181 and no fee is required.

For the reasons set forth below, the petition is **DISMISSED** with respect to the underlying relief requested.

BACKGROUND

1. U.S. patent No. 6,629,163 (the '163 patent) issued to Balassanian on September 30, 2003. The '163 patent matured from application number 09/474,664 (the '664 application).
2. On December 15, 2008, an *ex parte* request for reexamination of the '163 patent,

Art Unit: 3992

assigned control No. 90/010,356 (the '10356 proceeding), was filed by a third party requester (3PR).

3. On January 17, 2009, the Office issued an order granting the request for *ex parte* reexamination.
4. On July 7, 2009, the Office mailed a non-final office action setting a one-month period for response.
5. On July 27, 2009, papers entitled "POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO" were filed in the '10356 proceeding and the '664 application. Said papers appointed the practitioners of customer number 22504 (DAVIS WRIGHT TREMAINE) as attorneys representing patent owner. Said papers changed the correspondence address to

Implicit Networks, Inc. – Intellectual Property Department
218 Main Street, Suite 498
Kirkland, WA 98033

6. On August 31, 2009, a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) was mailed canceling all claims as no timely response was filed to the non-final office action.
7. On September 1, 2009, the present petition was filed along with a response to the non-final office action. A second petition was also filed under 37 CFR 1.137 on September 1, 2009. The merits of the 37 CFR 1.137 petition are not addressed herein.

DECISION

Petitioner requests "withdrawal of termination of the *ex parte* reexamination proceeding under 37 CFR 1.550(d) based on failure to receive a non-final Office Action dated July 7, 2009." A review of the record indicates that a change in power of attorney and change of correspondence address were filed on July 27, 2009. As the July 27, 2009 changes to the correspondence address and power of attorney were not in the record as of the mailing of the non-final office action on July 7, 2009, the non-final office action was mailed to the then-current address and was not mailed to nor received at the current (as of July 27, 2009) attorneys of record nor the patent owner (Implicit Networks, Inc.). No timely response to the July 7, 2009 action was filed, which resulted in the termination of prosecution of the '10356 proceeding.

The petition appears to simply request the office withdraw the termination. However, such an action alone would not make the response of September 1, 2009 timely and the '10356 proceeding still would not have a timely response filed after the non-final office action.

Art Unit: 3992

Accordingly, the petition as written is ungrantable. Presumably, petitioner would like the office to remail the non-final office action of July 7, 2009 and set a new period for response which would make the response of September 1, 2009 timely. Although the remailing of the July 7, 2009 action to the current address of record along with resetting the period for response would result in the response of September 1, 2009 being timely, there does not appear to be a basis for such a remailing.

In view of the above, the petition filed under 37 CFR 1.181 is **dismissed**.

It is noted that the current correspondence address of record is the IP department of patent owner while power of attorney has been appointed to a different law firm at a different address. As a courtesy, the present decision will be mailed to the attorneys of record at their address as well as to patent owner's current address of record. However, future correspondence will only be mailed to the address of record for patent owner.

CONCLUSION

1. Patent Owner's request to "withdraw termination" under 37 CFR 1.181 is **dismissed**.
2. This is not a final agency decision and is without prejudice to a request for reconsideration or higher-level review.
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
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street

Art Unit: 3992

Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.



Gregory Morse
Director, Center Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,356	12/18/2008	6629163	90159-003US2	1023

7590 10/02/2009

IMPLICIT NETWORKS, INC.
INTELLECTUAL PROPERTY DEPT.
218 Main Street, Suite 498
Kirkland, WA 98033

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/02/2009

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David A. Jakopin
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
McLean, VA 22102

Date:

MAILED
OCT 02 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010356
PATENT NO. : 6629163
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

Davis Wright Tremaine, LLP
1201 Third Avenue
Suite 2200
Seattle, WA 98101-3045

(For Patent Owner)

David J. Jakopin, Esq.
Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

(For Requester)

MAILED

OCT 02 2009

CENTRAL REEXAMINATION UNIT

In re Edward Balassanian
Ex Parte Reexamination Proceeding
Control No. 90/010,356
Filed: December 18, 2008
For: U.S. Patent No. 6,629,163

:
: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the September 1, 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 September 1, 2009 patent owner petition to revive").

The appropriate petition fee of \$1,620.00 set forth in 37 CFR 1.17(m) for the September 1, 2009 patent owner petition to revive has been paid.¹

The September 1, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 1, 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**.

¹ The Office's financial records reveal that, in addition to the fee of \$1,620.00 set forth in 37 CFR 1.17(m) for the September 1, 2009 patent owner petition to revive, patent owner's deposit account was charged \$1,410.00 on September 2, 2009, for acceptance of an unintentionally delayed claim for priority. If this was in error, please notify the Office by submitting a request for refund.

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 September 1, 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 July 7, 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 July 7, 2009 Office action set a one-month period for response. A proper response to the July 7, 2009 Office action was not filed until September 1, 2009, which was untimely. However, for the purpose of evaluating whether the September 1, 2009 patent owner petition to revive is a grantable petition, the submission of the September 1, 2009 response to the July 7, 2009 Office action satisfies item (1).²

Accordingly, the September 1, 2009 patent owner petition to revive is **granted**.

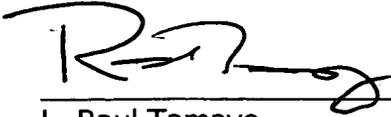
The August 31, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

CONCLUSION

1. The September 1, 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, Art Unit 3992, for processing of the September 1, 2009 Amendment and Response To Office Action Mailed July 7, 2009.
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.

² This decision is not directed to the persuasiveness and propriety of the arguments presented in the September 1, 2009 response as to each of the rejections set forth in the July 7, 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FEB 25 2010

CENTRAL REEXAMINATION UNIT

MICHAEL I. WOLFSON
MCCARTER & ENGLISH, LLP STAMFORD
CANTERBURY GREEN
201 BROAD STREET, 9TH FLOOR
STAMFORD, CT 06901

In re Application of :

WOOD, et al. :

Control No. 90/010,358 (U.S. Patent 6,337,114) :

Filed: December 16, 2008 :

Attorney Docket No. ITI-138CREX (118001.11105) :

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 01, 2010.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to MCCARTER & ENGLISH, LLP STAMFORD has been revoked by the assignee of the patent application on December 16, 2009. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Patricia Volpe at (571) 272-6825.

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: SENNIGER POWERS LLP
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS MO 63102

cc: CARLSON, GASKEY & OLDS, PC
400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM, MI 48009

(Third Party Requester)

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on February 01, 2010. There is no indication the documents were served on the 3rd Party Requester.

SUMMARY OF RELEVANT FACTS

1. On 23 October 2007 US Patent No. 7,287,119 was granted to Barth *et alia*.
2. On 16 December 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,365.
3. On 20 February 2008 the Order was granted for *ex parte* reexamination in control number 90/010,365.
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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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RAMBUS INC.
Morgan Lewis & Bockius, LLP
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

(For patent owner)

MAILED

OCT 02 2009

CENTRAL REEXAMINATION UNIT

David O'Dell
Haynes & Boone LLP, IP SECTION
2323 Victory Avenue, Suite 700
Dallas, TX 75202-3789

(For 95/001,189 Requester)

William H. Wright
Orrick, Herrington & Sutcliff, LLP
IP Prosecution Department
4 Park Plazas, Suite 1600
Irvine, California 92614-2589

(For 90/010,365 Requester)

Jon E. Wright
Sterne Kessler Goldstein Fox, PLLC
1100 New York Avenue, NW
Washington, DC 20005

(Courtesy Copy)

In re Barth, et al
Ex parte Reexamination Proceeding :
Control No. 90/010,365 :
Filed: December 18, 2008 :
For: U.S. Patent No. 7,287,119 :
:

**DECISION
TO MERGE
REEXAMINATION
PROCEEDINGS**

In re Barth et al. :
Inter partes Reexamination Proceeding :
Control No.: 95/001,189 :
Filed: May 18, 2009 :
For: U.S. Patent No. 7,287,119 :

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 7,287,119 (the '119 patent) issued to Barth et al. on October 23, 2007, with 23 claims.
2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/010,365 ('365 proceeding), was filed on December 18, 2008, by third party requester NVIDIA Corporation.
3. An order granting reexamination of claims 21-22 of the '119 patent was mailed in the '365 proceeding on February 20, 2009.
4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,189 ('1189 proceeding), was filed on May 18, 2009. NVIDIA Corporation is identified as the real party in interest.
5. An order granting reexamination of claims 1-23 of the '119 patent was mailed in the '1189 reexamination proceeding on August 3, 2009.
6. A First Office action was mailed on April 29, 2009 in the '365 *ex parte* reexamination proceeding. A response to the Office action was filed on July 29, 2009 and a Supplemental response was filed on August 25, 2009. No amendments were made to the claims.
7. No Office action has been mailed, and no amendments to the claims have been made, in the '1189 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

Under 37 CFR 1.989(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 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 '365 and the '1189 reexamination proceedings are currently pending. An order granting reexamination of claims 22 and 23 has been mailed in the '356 reexamination proceedings, an order granting reexamination of claims 1-23 has been mailed in the '1189 proceeding, and a decision under 37 CFR 1.989(a) 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, (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 90/010,365 and 95/001,189 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 90/010,365 and 95/001,189 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. The patent owner is required to continue 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 proceedings are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '365 *ex parte* reexamination 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.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be 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 duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters 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 *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

The patent owner and the 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.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. 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 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 which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though 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

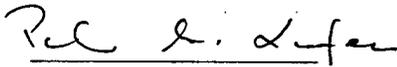
The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '365 proceeding and (3) the '1189 proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 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 should be done for 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. *Ex parte* Reexamination Control No. 90/010,365 and *inter partes* Reexamination Control No. 95/001,189 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 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 Maria Nuzzolillo, Legal Advisor, at (571) 272-8150.



Pinchus M. Laufer

Legal Advisor

Office of Patent Legal Administration



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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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)

DEC 11 2009

WILLIAM H. WRIGHT
ORRICK, HERRINGTON & SUTTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

(For 90/010,365 Requester)

DAVID O'DELL
HAYNES & BOONE LLP, IP SECTION
2323 VICTORY AVENUE SUITE 700
DALLAS TX 75202-3789

(For 90/001,189 Requester)

In re BARTH et alia
Reexamination Proceeding
Control No. 90/010,365
Request Deposited: December 18, 2008
For: U.S. Patent No. 7,287,119

: DECISION DISMISSING
: PETITION FOR
: EXTENSION OF TIME
: [37 CFR 1.956]
:

In re BARTH et alia
Reexamination Proceeding
Control No. /95/001,189
Request Deposited: May 18, 2009
For: U.S. Patent No. 7,287,119

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This is a decision on the December 7, 2009 patent owner's petition titled "Petition for Extension of Time for Respond Under 37 CFR § 1.956." Owner seeks two months additional time for response. The petition is before the Director of the Central Reexamination Unit for consideration of the above petition.

Art Unit: 3992

The petition is **granted –in - part** for the reasons set forth below

REVIEW OF RELEVANT FACTS

1. U.S. Patent Number 7,287,119 (the '119 patent) issued to Barth et al. on October 23, 2007, with 23 claims.
2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/010,365 ('365 proceeding), was filed on December 18, 2008, by third party requester NVIDIA Corporation.
3. An order granting reexamination of claims 21-22 of the '119 patent was mailed in the '365 proceeding on February 20, 2009.
4. A request for reexamination, assigned Reexamination Control No. 95/001,189 ('1189 proceeding), was filed on May 18, 2009. NVIDIA Corporation is identified as the real party in interest.
5. An order granting reexamination of claims 1-23 of the '119 patent was mailed in the '1189 reexamination proceeding on August 3, 2009.
6. A First Office action was mailed on April 29, 2009 in the '365 *ex parte* reexamination proceeding. A response to the Office action was filed on July 29, 2009 and a supplemental response was filed on August 25, 2009. No amendments were made to the claims.
7. A decision merging proceedings with *inter partes* reexamination 95/001,189 was mailed by the Office on October 2, 2009.
8. A first office action was mailed November 14, 2009.
9. A petition requesting dissolution of merger was filed October 21, 2009 and remains outstanding.

DECISION

Patent Owner petitions the director of the Central Reexamination Unit for a two (2) month extension of time. The petition is filed, together with the online credit card payment authorization of the required petition fee of \$200.00 as set forth in 37 CFR 1.17 (g) and as required by 37 CFR 1.956 for the extension of time.

CITATION OF PERTINENT PROCEDURE

37 CFR § 1.956 states:

Art Unit: 3992

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. (Emphasis added.)

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 therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. (Emphasis in the original.)

37 CFR 1.903. Service of papers on parties in inter partes reexamination.

The patent owner and the third party requester will be sent copies of Office actions issued during the inter partes reexamination proceeding. After filing of a request for inter partes reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

Analysis and Findings

The Patent owner has set forth that preparation of a response to the November 14, 2009 office action is ongoing and patent owner requests additional time to prepare Affidavits/Declarations regarding the status of an applied prior art printed publication, and well as other technical experts. Details are set forth on pages 4-6 and 9 of owner’s petition.

Art Unit: 3992

On balance, there is always a question whether to grant an extension of time when balancing the need for special dispatch with the need for the patent owner to have a fair opportunity for which to properly respond to the outstanding Office action. In this situation it is considered that the petition provides "sufficient cause" as to why an extension of time should be granted. The outstanding office action granted a two month response period. While owner insists two additional months are needed, on balance it appears fair that one month is sufficient additional time to provide for the preparation of Affidavits and Declaration evidence.

Therefore, an extension of time of one-month is hereby granted.

CONCLUSION

1. Patent owner's petition for a two-month extension of time in which to file a response to the Office action dated November 14, 2009 is hereby granted-in-part. A one-month extension is granted. The period for response is hereby extended to **February 14, 2009**.

2. All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission

Art Unit: 3992

for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to J. Harrison at (517) 272-4449, Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

/J. Harrison/

J. Harrison, SPE AU 3992
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,365	12/18/2008	7287119	2805.002REX4	6415

26111 7590 12/16/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/16/2009

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

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.
95/001,189	05/18/2009	7287119	2805.002REX8	8867
26111	7590	12/16/2009	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LLP IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

Date: **MAILED**
DEC 16 2009
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001189
PATENT NO. : 7287119
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.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ORRICK, HERRINGTON, & SUTCLIFFE, LLP
IP PROSECUTION DEPT.
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

Date: MAILED
DEC 16 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010365
PATENT NO. : 7287119
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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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

HAYNES & BOONE, LLP IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For *inter partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE, LLP
Attn: William H. Wright
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614

(For *ex parte* Requester)

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,189
Filed: May 18, 2009
For: U.S. Patent No. 7,287,119

- :
- :
- : DECISION
- : DISMISSING
- : PETITION TO
- : RECONSIDER
- : MERGER OF
- : REEXAMINATION
- : PROCEEDINGS
- :
- :

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,365
Filed: December 18, 2008
For: U.S. Patent No. 7,287,119

This is a decision on patent owner's October 21, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 TO RECONSIDER MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS".

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 22, 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.

REVIEW OF FACTS

1. On October 23, 2007, the Office issued U.S. Patent No. 7,287,119 (the '119 patent) to Barth *et al.*
2. The '119 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 1-23 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 18, 2008, a request for *ex parte* reexamination of claims 21 and 22 of the '119 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,365 (the '10365 proceeding).
5. On February 20, 2009, the Office issued an order granting the '10365 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 21 and 22 of the '119 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10365 *ex parte* reexamination proceeding expired on April 20, 2009.¹
7. On April 29, 2009, the Office issued a first Office action on the merits in the '10365 *ex parte* reexamination proceeding.
8. On May 18, 2009, a request for *inter partes* reexamination of all the claims (claims 1-23) of the '119 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,189 (the '1189 proceeding).
9. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '119 patent. Therefore, the '119 patent is no longer involved in the ITC investigation.
10. On July 29, 2009, Patent Owner filed a response in the '10365 *ex parte* 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.

- proceeding. The response did not amend, cancel or add new claims.²
11. On August 3, 2009, the Office issued an order granting the '1189 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 '119 patent, claims 1-23, would be subject to reexamination.
 12. On August 23, 2009, Patent Owner filed a supplemental response in the '10365 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
 13. On October 2, 2009, the Office, *sua sponte*, issued a decision merging the '1189 *inter partes* reexamination proceeding with the '10365 *ex parte* reexamination proceeding.
 14. On October 21, 2009, patent owner filed the present petition requesting reconsideration of the merger of the '10365 *ex parte* proceeding, with the '1189 *inter partes* proceeding.
 15. 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

² Patent Owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

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 states (in part):

(b) (2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(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 requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies Patent Owner of "*ex parte* reexamination rights" and expands the requester's *inter partes* rights. Therefore, Patent owner requests the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are neither vacated nor demerged.

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 Further, no expansion of the requester's statutory right is precipitated by the merging of the two proceedings. The merger process does not permit the *inter partes* requester, to go beyond the scope of commenting upon issues raised in the examiner's actions or the patent owner's response within thirty days. Therefore, merger of an *inter partes* and *ex parte* reexamination cannot be an *ultra vires* act. Accordingly, merger neither divests Patent Owner of any *ex parte* reexamination rights nor expands the *inter partes* requesters rights, because merger does not implicate any statutory 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 SNQs⁵ 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,

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

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 '1189 *inter partes* reexamination proceeding with the '10365 *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 request 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.

Regarding the requester’s strategy of filing reexamination requests, Patent Owner’s arguments are more in keeping with an allegation of harassment, rather than violation of 35 U.S.C. 317(a). However, Patent Owner has not established a clear showing that the “filing strategy” was based upon the intent to harass. Therefore, relief in the form of a suspension of the subsequently ordered proceeding for reexamination cannot be granted.

Finally, Patent Owner’s “parade of horrors” 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 horrors” 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 horrors" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Demerger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1189 *inter partes* reexamination proceeding and the '10365 *ex parte* reexamination proceeding, merger should not have been granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings, even if merger is maintained, 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,

⁶ Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

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.

Furthermore, merger does not expand the statutory rights of an *inter partes* third party requester. Patent Owner's argument is - that not only does the status of the requester, *inter partes* or *ex parte*, limit a requester's right to comment, but also the source of the issue raised, from an *inter partes* request or an *ex parte* request, limits the requester's right to comment. The statutory rights of an *inter partes* requester are set forth in 35 U.S.C. 314(b)(2). The plain language of the statute states:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

The statute defines the right to comment in the *inter partes* requester. Once the proceedings are merged, all issues are present in the *inter partes* reexamination, and the *inter partes* requester can comment on all such issues provided 35 U.S.C. 314(b)(2) is satisfied. As to the combination of all issues in both the *inter partes* and *ex parte* reexaminations, it is noted that there is nothing in the statute that prevents the combining of the two proceedings to efficiently resolve all issues as to the patent. To the contrary, 35 U.S.C. 312 explicitly permits the Office to consider information not cited in an *inter partes* reexamination (as does 35 U.S.C. 303 for *ex parte* reexamination), and the inclusion of the *ex parte* reexamination issues in the *inter partes* reexamination proceeding to facilitate special dispatch resolution of all issues is an efficient use of the consideration of other information.

In this instance, first, the *inter partes* requester's right to comment is contingent upon the patent owner commenting. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the Patent Owner's response to the action (hereafter the "issue source limitation"). Finally, the statute only confers this limited right to comment upon an "*inter partes*" requester, (hereafter the "status limitation").⁷ While Patent Owner is correct as to the status limitation that only an *inter partes* requester has the right to comment under 35 USC 314(b) (2), Patent owner is in error as to the issue source limitation placed upon the *inter partes*

⁷ In an *inter partes-ex parte* reexamination merger where the requesters are different parties the status limitation alone precludes the *ex parte* requester from having any right to comment in the merged proceeding. In an *inter partes-ex parte* reexamination merger where the same party is both the *inter partes* and *ex parte* requester then only the statutory issue source limitation precludes the requester from having a right to comment on a given issue.

requester's right to comment. The issue source limitation is not grounded in what is raised in the *inter partes* request verses an *ex parte* request, but instead by statute based upon what issues are raised in the Office action and the Patent Owner's response to the Office action, which is currently being commented upon. Patent Owner is conflating a requester's status limitation with the issue source limitation to arrive at the misplaced conclusion that an *inter partes* requester's rights are *ultra vires* expanded by merger with an *ex parte* reexamination request. However, merger does not expand the statutory rights of the *inter partes* requester, because merger leaves untouched the requester status and issue source limitations that 35 U.S.C. 314(b)(2) places upon a given requester's right to comment.

Therefore, Patent Owner's arguments to demerge, and for waiver of 37 CFR 1.989(b) if merger remains, are not persuasive. Accordingly, the petition to demerge the proceeding and stay the *inter partes* proceeding, or modify the merged proceeding to preserve "*ex parte* rights" and prevent expansion of requester rights is dismissed.

CONCLUSION

1. The October 14, 2009 Patent Owner petition is dismissed.
2. *Inter partes* Reexamination Control No. 95/001,189 and *ex parte* Reexamination Control No. 90/010,365 remain merged as a single proceeding.
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



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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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ALIX YALE & RISTAS LLP
750 MAIN STREET
SUITE 1400
HARTFORD CT 06103

CENTRAL REEXAMINATION UNIT (For Patent Owner)

Robert F. Scotti
Klarquist Sparkman, LLP
121 SW Salmon Street, Suite 1600
Portland, OR 97204

(For Third Party Requester)

In re Lekhtman
Reexamination Proceeding
Control No. 90/010,366
For: U.S. Patent No. 5,337,753

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Lekhtman
Reexamination Proceeding
Control No. 90/010,612
For: U.S. Patent No. 5,337,753

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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. 5,337,753 (hereinafter, the '753 patent), issued to Lekhtman, on August 16, 1994.
2. On December 19, 2008, a request for *ex parte* reexamination of the '753 patent was filed. The reexamination proceeding was assigned Control No. 90/010,366 (hereinafter, the '10366 proceeding).
3. On February 5, 2009, the reexamination order granting the request in the '9293 proceeding was mailed. A non-final rejection was mailed April 13, 2009. A response was filed on June 15, 2009 with no amendments.

Art Unit: 3992

4. On July 17, 2009, a third party deposited a request for *ex parte* reexamination of the '753 patent. The reexamination proceeding was assigned Control No. 90/010,612 (hereinafter, the '10612 proceeding).
5. On September 30, 2009, the reexamination order granting the request in the '10612 proceeding was mailed. The time to file 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 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 '10366 and '10612 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.

Art Unit: 3992

CONCLUSION

1. Reexamination Control Nos. 90/010,366 and 90/010,612 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



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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Scott D. Watkins
Steptoe & Johnson LLP
1330 Connecticut Avenue, N.W.
Washington, DC 20036

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FOR PATENT OWNER

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APR 22 2009

CENTRAL REEXAMINATION UNIT

Thomas E. Toner
Smith & Hopen, P.A.
180 Pine Avenue North
Oldsmar, FL 34677

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**FOR THIRD PARTY
REQUESTER**

In re John E. Taylor Jr.
Reexamination Proceeding
Control No. 90/010,372
Filed: December 26, 2008
For: U.S. Patent No. RE39,909 E

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**DECISION DISMISSING PETITION
TO VACATE ORDER GRANTING
REEXAMINATION**

This is a decision on the March 17, 2009 patent owner petition under 37 CFR 1.181 requesting that the February 17, 2009 order granting reexamination be vacated. This decision also addresses March 31, 2009, and April 2, 2009, third party requester papers in opposition to the patent owner's petition to vacate the reexamination order. The latter requester paper is apparently an exact copy of the prior petition, each having the facsimile cover page signed by a different member of the same firm; thus they are taken as one opposition paper.

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. Re.39,909 E (the '909 patent) issued from reissue application number 10/899,425 to John E. Taylor Jr. on November 6, 2007.
2. A request for reexamination of claims 20-49 of the '909 patent, assigned Control No. 90/010,372 (the '10372 proceeding), was filed by third party requester (hereinafter "requester") and was accorded a filing date as of its date of deposit- December 26, 2008.
3. On February 17, 2009, reexamination was ordered for claims 20-49 of the '909 patent in the '10372 reexamination proceeding, hereinafter the "Order."
4. On March 17, 2009, the patent owner filed the present petition under 37 CFR 1.181 to vacate the February 17, 2009 order for reexamination, which petition is the subject of this decision.
5. On March 31, 2009, the third party requester filed, pursuant to MPEP 2246(II), a paper in opposition to the patent owner's petition to vacate the reexamination order. An identical opposition paper was filed on April 2, 2009, signed by a different member of the same firm as the earlier opposition.

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:

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).

MPEP 2246 further 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 brings before the Office a petition under 37 CFR 1.181 to vacate a reexamination order as *ultra vires* as not raising an SNQ. For this petition to be entertained, 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. MPEP 2246.

Patent owner contends that the request for reexamination of the ‘909 patent does not raise a substantial new question (SNQ) of patentability. Patent owner presents three bases for this contention; first, that the Order does not identify any new technical teaching; second, that the art is either old art or merely cumulative to old art, and third, that the Order fails to provide a basis to support an SNQ based upon such old or cumulative art.

Requester opposes the petition on the grounds that patent owner has not provided the necessary showing to support the petition. Requester presents four bases for this opposition; first, that the petition does not allege that the reexamination order is “based wholly on the same question of patentability” raised by old art; second, that the new art provides a teaching absent from the initial examination and pertinent to the patentability of the claimed invention; third, that the initial examination involves an improper claim construction; and fourth, that the initial examination relied on an improper interpretation of the disclosure of a reference.

The determination of whether an 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). An 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 examiner 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. 4,812,283 to Dickenson (Dickenson), U.S. 5,497,149 to Fast (Fast); U.S. 5,523,740 to Burgmann (Burgmann), and U.S. 4,999,613 to Williamson (Williamson). Of these references found to form the basis of an SNQ, only Fast was of record in prior proceedings, i.e., only Fast was “old art.” Fast was cited, but not relied upon in any rejection, in the prior proceedings. The Dickenson, Burgmann, and Williamson references were not considered by the Office in an earlier examination of the patent.

In the prior proceedings, the examiner applied U.S. Patent Number 6,072,396 to Gaukel "Gaukel" in an anticipation rejection based upon 35 U.S.C. 102(e). Office action of January 24, 2006, in application number 10/899,425. The examiner, in a March 30, 2006 interview with applicant's representative to discuss a proposed amendment, agreed that Gaukel does not disclose a device "configured as a unit that is supported entirely about a single limb of [a] monitored person." Interview summary of March 30, 2006, in application number 10/899,425. Upon entry of an April 19, 2006 amendment to the claims adding such a limitation, the examiner withdrew the anticipation rejection based upon Gaukel without further comment. Office action of May 12, 2006, in application number 10/899,425. 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 references found to raise an SNQ in the Order do not present a "new" technical teaching. Petition at 2. The Order of February 17, 2009 states that the new teaching of each such reference relates to a one-piece unit supported entirely about a single limb of a person. Patent owner contends that the examiner in the previous proceeding considered this teaching, because the examiner had, in front of him, numerous references providing teachings of a one-piece unit supported entirely about a single limb of a person. Petition at 5. Patent owner urges that the court in *In re Portola* used the same underlying reasoning to find that an SNQ cannot be found where all of the references were in front of the examiner in a prior proceeding, stating "it must be presumed that the original examiner considered [the references in front of him], both alone and in combination with each other and with all of the other cited references, before allowing the original claims." *In re Portola Packaging*, 110 F.3d 786, 790 (Fed. Cir. 1997).

However, Congress amended 35 U.S.C. § 303 in 2002 to address and "overrule" *Portola*. Subsequent to this amendment, 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 combination. *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 6 and 13 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.

In the prior prosecution of the patent under reexamination, the examiner did not explicitly consider any rationales for the patentability of claims containing the "configured as a unit that is supported entirely about a single limb of that monitored person" limitation. Following the amendment by applicant to include that language in the independent claims, 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 '909 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 Fast reference was considered by the examiner in the context of a determination of obviousness or anticipation.

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 '909 patent. The discussion of anticipation in the claims of the '909 patent was limited to the Gaukel reference only. It may not be presumed that, since the claims were allowed, the examiner considered applying any specific

ground for obviousness stemming from the references in front of him. *Swanson*, 540 F.3d at 1380. Therefore, patent owner's contention, that the teachings of nonobviousness presented in the references 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 the art is either old art (i.e., Fast), or merely cumulative to old art. Petition at 2, 10. However, 35 U.S.C. § 303 states that 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." And, the art of record is newly applied to the claimed device configured as a unit that is supported entirely about a single limb of a monitored person, for which claim provision the art was not earlier applied, nor 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.

Patent Owner's Third Contention

Patent owner's last contention is that the previously considered art (i.e., Fast) was not stated in the Order to be viewed in, for instance, the "context of a new light" in accordance with statements of the court in *Swanson*. Petition at 11-12.

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 obviousness with respect to any references, new or old. There are no facts in the record showing that the examiner in the earlier proceeding considered the Fast reference for its teachings on the question of whether it would be obvious to "configure[] as a unit that is supported entirely about a single limb of that monitored person."

For this reason, the discussion of the disclosure of Fast in the Order, with respect to Fast's teaching of a unit supported entirely about a single limb of a person, represents a consideration of Fast for a purpose not presented in the record of the previous proceedings of the patent under reexamination; i.e., in the "context of a new light."

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 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

04/28/09

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UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Robert G. McMorrow Jr.
Connolly Bove Lodge & Hutz, LLP
PO Box 2207
Wilmington, DE 19899

For Patent Owner

Peter A. Sullivan
Hughes Hubbard & Reed LLP
One Battery Plaza
New York, NY 10004

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/010,376
Filed: December 31, 2008
For: US Patent No. 5,366,660

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on the petition filed July 29, 2009 to request a two-week extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated June 5, 2009.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted for two weeks for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated June 5, 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 the period for response to the Office action dated June 5, 2009 overlaps with pre-set vacation schedules of the U.S. counsel, the responsible European patent attorney and the technical expert being consulted in connection with the response. Additional time is needed to coordinate parties to review the response and the accompanying evidence. An extension of time for two weeks is requested to prepare a complete and substantive response with adequate input from all parties.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a two-week extension of time in which to file a response. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for a two-week extension of time in which to file a response to the Office action is **granted**.
2. The Patent Owner's response is due August 19, 2009.
3. Response may be submitted as follows:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at
<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

/Deborah Jones/
Deborah Jones, SPE
Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,378	01/06/2009	6280438	ALM-004RX2	4620

30623 7590 01/28/2009

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/28/2009

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

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET, EXCHANGE PLACE
BOSTON, MA 02109-2881

Date **MAILED**

JAN 28 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010378
PATENT NO. : 6280438
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)).



(For Patent Owner)

Mintz, Levin, Cohn, Ferris,
Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

(For Requester)

John V. Forcier
Goodwin Proctor, LLP
Exchange Place
Boston, MA 02109

<i>In re Eckhouse et al.</i>	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/010,378	:	TO REASSIGN
Filed: January 6, 2009	:	REEXAMINATION
For: U.S. Patent No. 6,280,438	:	PROCEEDING

This is a decision on a petition filed by the patent owner on January 23, 2009. The petition is entitled "EXPEDITED PETITION TO REASSIGN REEXAMINATION" [hereinafter "the petition"], and is facially a request under 37 CFR 1.182 and/or 1.183 that the Patent Office reassign the instant proceeding to a different examiner. As the assignment of proceedings to specific examiners is a management function, the petition has been treated as a request 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 to invoke the supervisory authority of the Director dated January 23, 2009 is dismissed with respect to reassigning the proceeding. This decision does not prevent USPTO management from assigning or reassigning this proceeding to any particular examiner.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,280,438 issued on August 28, 2001.
2. A request for *ex parte* reexamination of that patent, Control No. 90/010,065 (“the ‘065 proceeding”), was filed by a third party requester on December 5, 2007. The electronic record of the ‘065 proceeding indicates that it is in publications for issuance of a certificate but that the certificate has not yet issued.
3. A subsequent request for reexamination, Control No. 90/010,378 (“the ‘378 proceeding”) was filed by a third party requester on January 6, 2009. That proceeding has been assigned to a different examiner than was the ‘065 proceeding.
4. No decision granting or denying reexamination has been mailed in the ‘378 proceeding.

DECISION

MPEP 2236 gives USPTO management guidance as to the assignment of examiners in *ex parte* reexamination proceedings.

I. EXAMINER ASSIGNMENT POLICY

It is the policy of the Office that the CRU SPE will assign the reexamination request to an examiner different from the examiner(s) who examined the patent application. Thus, under normal circumstances, the reexamination request will not be assigned to a primary examiner or assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the patent. This would preclude assignment of the request to an examiner who was a conferee in an appeal conference or panel review conference in an earlier concluded examination of the patent (e.g., the application for patent, a reissue, or a prior concluded reexamination proceeding). The conferee is considered to have participated in preparing the Office action which is preceded by the conference.

Exceptions to this general policy include cases where the original examiner is the only examiner with adequate knowledge of the relevant technology to examine the case. In the unusual case where there is a need to assign the request to the original examiner, the assignment must be approved by the CRU Director, and the fact that such approval was given by the CRU Director must be stated by the examiner in the decision on the request for reexamination.

It should be noted that while an examiner who examined an earlier concluded reexamination proceeding is generally excluded from assignment of a newly filed reexamination, if the earlier reexamination is still ongoing, the same examiner will be assigned the new reexamination.

...

II. CONSEQUENCES OF INADVERTENT ASSIGNMENT TO AN "ORIGINAL EXAMINER"

Should a reexamination be inadvertently assigned to an "original examiner" (in a situation where the TC or CRU Director's approval is not stated in the decision on the request), the patent owner or the third party requester who objects must promptly file a paper alerting the Office of this fact. Any request challenging the assignment of an examiner to the case must be made within two months of the first Office action or other Office communication indicating the examiner assignment, or reassignment will not be considered. Reassignment of the reexamination to a different examiner will be addressed on a case-by-case basis. In no event will the assignment to the original examiner, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination.

It is for the director of the appropriate work group, and not a reexamination requester or patent owner, to determine how USPTO resources will be allocated to a given proceeding. While in some instances there may be some level of evidence that assignment of a particular examiner to a proceeding is an abuse of discretion, a simple petition unsupported by specific evidence (as is the case here) is insufficient. See *In re Ovshinsky*, 24 USPQ 2d 1241 (Comm'r Pats. 1992).

While patent owner's petition correctly identifies that "the Patent Office has flexibility to take untraditional actions to carry out the special dispatch mandate," this flexibility does not generally require reassignment of proceedings at the request of either patent owner or third part requester.

To the extent that patent owner's petition of 1/23/09 is a "paper alerting the Office to the assignment of a reexamination", the USPTO has been so alerted. To the extent that approval of the CRU Director pursuant to MPEP 2236 is needed to assign the case to an "original examiner" or to a different examiner, this petition decision constitutes such approval.

Accordingly, the petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.182/183, taken as a petition under 37 CFR 1.181, is dismissed.
2. An appropriate order granting reexamination or denying reexamination will follow in due course.

3. This decision does not prevent USPTO management from assigning or reassigning this proceeding to any particular examiner consistent with the resource needs of the USPTO.
4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse

Director

Central Reexamination Unit



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Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C.
One Financial Center
Boston, MA 02111

For Patent Owner

Goodwin Procter LLP
Patent Administrator
53 State Street, Exchange Place
Boston, MA 02109-2881

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,378
Filed: January 6, 2009
For: U.S. Patent No. 6,280,438

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,492
Filed: April 10, 2009
For: U.S. Patent No. 6,280,439

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of the petition filed July 14, 2009 (copy in each proceeding) to merge the above-identified proceedings.

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. 90/010,378 was ordered in a decision mailed March 31, 2009. It is noted that the request for this reexamination asked reexamination of claims 4-33, all of the claims present at that time in prior copending reexamination proceeding control No. 90/010,065. The decision granted reexamination for only original patent claim 4, noting section 2243 of the MPEP that indicates that amended and/or new

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CENTRAL REEXAMINATION UNIT

claims presented in any copending reexamination will not be considered in the new request. On April 21, 2009, patent owner filed an Information Disclosure Statement. On April 22, 2009, patent owner filed an amendment, amending claim 4 and adding claims 5-33. The amendment incorporated into the instant proceeding the claims as they appear in *Ex Parte* Reexamination Certificate number 6640 issued February 3, 2009, as a result of the termination of the first reexamination proceeding Control No. 90/010,065. On May 2, 2009, patent owner filed a Notice of Litigation involving the patent undergoing the instant reexamination. No Office action has been rendered since the mailing of the decision ordering reexamination.

Reexamination in application Control No. 90/010,492 was ordered in a decision mailed June 23, 2009, indicating that claims 4-33, all of the live claims in the patent per the issuance of *Ex Parte* Reexamination Certificate No. 6640. On July 13, 2009, patent owner filed a waiver of Patent Owner Statement and Notice of Concurrent Proceedings. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,378 and reexamination control No. 90/010,492 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. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

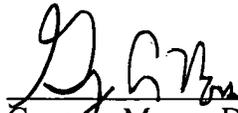
The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 4-33, all of the pending claims will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the 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(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 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 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. 90/010,378 and 90/010,492 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.



Gregory Morse, Director
Central Reexamination Unit



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Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C.
One Financial Center
Boston, MA 02111

(For Patent Owner)

OCT 13 2009

CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
Patent Administrator
53 State Street, Exchange Place
Boston, MA 02109-2881

(For 90/010,492 + 90/010,378 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,492
Filed: April 10, 2009
For: U.S. Patent No. 6,280,438

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Ex Parte Reexamination Proceeding
Control No.: 90/010,378
Filing Date: January 6, 2009
For: U.S. Patent No. 6,280,438

: **DECISION**
: **ON PETITIONS**
: **UNDER**
: **37 CFR 1.181**

This is a decision on the August 21, 2009 third party requester petition entitled "PETITION TO EXERCISE SUPERVISORY AUTHORITY UNDER 37 CFR 1.181(a)(3)" and on patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.181 AND/OR 1.182 TO DISMISS REQUESTER'S EXPEDITED PETITION TO REASSIGN EXAMINATION", which has been treated as a petition under 37 CFR 1.181.

The third party requester and patent owner petitions under 37 CFR 1.181 are before the Director of the Central Reexamination Unit for consideration.

For the reasons set forth below, both petitions are dismissed.

DECISION

This proceeding is one of several proceedings that are related and, in fact, have basically the same set of petitions therein. The proceedings are 90/010,492 (merged with 90/010,378), 90/010,388, 90/010,501 (merged with 90/010394), 90/010,493 (merged with 90/010,386), 90/010,444, and 90/010,400.

MPEP 2236 gives USPTO management guidance as to the assignment of examiners in *ex parte* reexamination proceedings.

I. EXAMINER ASSIGNMENT POLICY

It is the policy of the Office that the CRU SPE will assign the reexamination request to an examiner different from the examiner(s) who examined the patent application. Thus, under normal circumstances, the reexamination request will not be assigned to a primary examiner or assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the patent. This would preclude assignment of the request to an examiner who was a conferee in an appeal conference or panel review conference in an earlier concluded examination of the patent (e.g., the application for patent, a reissue, or a prior concluded reexamination proceeding). The conferee is considered to have participated in preparing the Office action which is preceded by the conference.

Exceptions to this general policy include cases where the original examiner is the only examiner with adequate knowledge of the relevant technology to examine the case. In the unusual case where there is a need to assign the request to the original examiner, the assignment must be approved by the CRU Director, and the fact that such approval was given by the CRU Director must be stated by the examiner in the decision on the request for reexamination.

It should be noted that while an examiner who examined an earlier concluded reexamination proceeding is generally excluded from assignment of a newly filed reexamination, if the earlier reexamination is still ongoing, the same examiner will be assigned the new reexamination.

...

II. CONSEQUENCES OF INADVERTENT ASSIGNMENT TO AN "ORIGINAL EXAMINER"

Should a reexamination be inadvertently assigned to an "original examiner" (in a situation where the TC or CRU Director's approval is not stated in the decision on the request), the patent owner or the third party requester who objects must promptly file a paper alerting the Office of this fact. Any request challenging the assignment of an examiner to the case must be made within two months of the first Office action or other Office communication indicating the examiner assignment, or reassignment will not be considered. Reassignment of the reexamination to a different examiner will be addressed on a case-by-case basis. In no event will the assignment to the original examiner, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination.

It is for the director of the appropriate work group, and not a reexamination requester or patent owner, to determine how USPTO resources will be allocated to a given proceeding. While in some instances there may be some level of evidence that assignment of a particular examiner to a

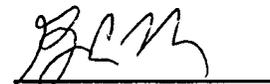
proceeding is an abuse of discretion, a simple petition unsupported by specific evidence (as is the case here) is insufficient. See *In re Ovshinsky*, 24 USPQ 2d 1241 (Comm'r Pats. 1992).

To the extent that petitions are a "paper alerting the Office to the assignment of a reexamination", the USPTO has been so alerted. To the extent that approval of the CRU Director pursuant to MPEP 2236 is needed to assign the case to an "original examiner" or to a different examiner, this petition decision constitutes such approval.

Accordingly, the petitions are dismissed.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.181 is **DISMISSED**.
2. The patent owner's petition under 37 CFR 1.181 is **DISMISSED**.
3. This decision does not prevent USPTO management from assigning or reassigning this proceeding to any particular examiner consistent with the resource needs of the USPTO.
4. Telephone inquiries related to the present decision should be directed to Andres Kashnikov, SPE, GAU 3991 at 571-272-4361 or, in his absence, to the undersigned at 571-272-3838.



Gregory A Morse
Director
Central Reexamination Unit

ADDITIONAL DISCUSSION

MPEP 2236 states the policy of the USPTO in assigning reexaminations. Generally, when a second request for reexamination is filed prior to the conclusion of a first reexamination, the same examiner is assigned, while if a second request is filed after the conclusion of a first reexamination, a different examiner is assigned. In at least some of the present requests, the second reexamination was filed prior to conclusion of the first reexamination (e.g. 90/010,394, 90/010,378) while in others the second request was filed after the conclusion of the first reexamination (e.g. 90/010,501, 90/010,492). It is also desirable, assuming the resources are available, to have related reexaminations handled by the same examiner. In the present set of proceedings, these preferences cannot all be vindicated.



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CENTRAL REEXAMINATION UNIT

Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C.
One Financial Center
Boston, MA 02111

(For Patent Owner)

Goodwin Procter LLP
Patent Administrator
53 State Street, Exchange Place
Boston, MA 02109-2881

(For 90/010,492 + 90/010,378 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,492
Filed: April 10, 2009
For: U.S. Patent No. 6,280,438

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Ex Parte Reexamination Proceeding
Control No.: 90/010,378
Filing Date: January 6, 2009
For: U.S. Patent No. 6,280,438

: **DECISION**
: **ON PETITIONS**
: **UNDER**
: **37 CFR 1.183**

This is a decision on the August 21, 2009 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.183 -- REQUEST FOR A WAIVER OF THE PROHIBITION OF CONSIDERATION OF A SUBMISSION BY THE REEXAMINATION REQUESTER" filed concurrently with a petition under 37 CFR 1.181 to request reassignment of the above captioned merged reexamination proceeding to an examiner other than the "original examiner."¹ On August 27, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.183 TO PRECLUDE SUSPENSION OF RULES" requesting that the Office dismiss the August 21, 2009 third party requester petition under 37 CFR 1.183.

The third party requester and patent owner petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the third party requester petition under 37 CFR 1.183 is granted to the extent set forth below, and the patent owner petition under 37 CFR 1.183 petition is dismissed.

¹ It is noted that a duplicate copy of the third party requester petition under 37 CFR 1.183 and a duplicate copy of the third party requester petition under 37 CFR 1.181 have not been filed in 90/010,378.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is \$400.00 pursuant to 37 CFR 1.17(f). The \$400.00 fee was charged to third party requester's Deposit Account No. 07-1700 on August 24, 2009, as authorized on page 2 of the third party requester's petition under 37 CFR 1.183. The \$400.00 fee was posted on August 28, 2009, for patent owner's petition under 37 CFR 1.183.

REVIEW OF RELEVANT FACTS

1. On August 28, 2001, the Office issued U.S. Patent No. 6,280,438 (the '438 patent) to Eckhouse et al.
2. On January 6, 2009, a first request for *ex parte* reexamination of claims 4-33 of the '438 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,378 (the '10378 proceeding).
3. On January 13, 2009, the Office issued a notice of the filing of the '10378 *ex parte* reexamination with an assigned filing date of January 6, 2009.
4. On January 23, 2009, patent owner filed a petition under 37 CFR 1.182 and/or 1.183 requesting that the Office reassign the '10378 proceeding to a specified examiner.
5. On January 28, 2009, the Office mailed a decision for the '10378 proceeding dismissing the January 23, 2009 patent owner petition, taken as a petition under 37 CFR 1.181 to invoke the supervisory authority of the Director.
6. On March 31, 2009, the Office issued an order granting reexamination of claim 4 for the '10378 proceeding.
7. On April 10, 2009, a second request for *ex parte* reexamination of the '438 patent was filed by the same third party requester, requesting reexamination of claims 4-33 of the '438 patent. The resulting reexamination proceeding was assigned control number 90/010,492 (the '10492 proceeding).
8. On April 17, 2009, the Office issued a notice of the filing of the '10492 *ex parte* reexamination with an assigned filing date of April 10, 2009.
9. On June 23, 2009, the Office issued an order granting reexamination of claims 4-33 for the '10492 proceeding.
10. On July 14, 2009, patent owner filed a petition in both the '10378 and '10492 proceedings to request merging of the two proceedings.
11. On July 23, 2009, the Office mailed a decision merging the '10378 and '10492 reexamination proceedings into a single proceeding.

12. On August 21, 2009, third party requester filed the present petition under 37 CFR 1.183 to waive the 37 CFR 1.535 prohibition of a paper submission by the reexamination requester. Third party requester concurrently filed a petition under 37 CFR 1.181 to request reassignment of the above-captioned merged reexamination proceeding to an examiner other than what requester deems to be the “original examiner.”
13. On August 27, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 21, 2009 third party requester petition. Patent owner concurrently filed a petition entitled “PETITION UNDER 37 C.F.R. §1.181 AND/OR §1.182 TO DISMISS REQUESTER'S EXPEDITED PETITION TO REASSIGN REEXAMINATION.”

DECISION

37 CFR 1.4(d)(2)(i) provides:

The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (e.g., /Dr. James T. Jones, Jr./)...

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 1.535 provides:

A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.

MPEP § 2236 provides in pertinent part:

I. EXAMINER ASSIGNMENT POLICY

It is the policy of the Office that the CRU SPE will assign the reexamination request to an examiner different from the examiner(s) who examined the patent application. Thus, under normal circumstances, the reexamination request will not be assigned to a primary examiner or assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the patent. This would preclude assignment of the request to an examiner who was a conferee in an appeal conference or panel review conference in an earlier concluded examination of the patent (e.g., the application for patent, a reissue, or a prior concluded reexamination proceeding). The

conferee is considered to have participated in preparing the Office action which is preceded by the conference.

Exceptions to this general policy include cases where the original examiner is the only examiner with adequate knowledge of the relevant technology to examine the case. In the unusual case where there is a need to assign the request to the original examiner, the assignment must be approved by the CRU Director, and the fact that such approval was given by the CRU Director must be stated by the examiner in the decision on the request for reexamination.

It should be noted that while an examiner who examined an earlier concluded reexamination proceeding is generally excluded from assignment of a newly filed reexamination, if the earlier reexamination is still ongoing, the same examiner will be assigned the new reexamination.

II. CONSEQUENCES OF INADVERTENT ASSIGNMENT TO AN “ORIGINAL EXAMINER”

Should a reexamination be inadvertently assigned to an “original examiner” (in a situation where the TC or CRU Director’s approval is not stated in the decision on the request), the patent owner or the third party requester who objects must promptly file a paper alerting the Office of this fact. Any request challenging the assignment of an examiner to the case must be made within two months of the first Office action or other Office communication indicating the examiner assignment, or reassignment will not be considered. Reassignment of the reexamination to a different examiner will be addressed on a case-by-case basis. In no event will the assignment to the original examiner, by itself, be grounds for vacating any Office decision(s) or action(s) and “restarting” the reexamination.

A situation may arise where a party timely (i.e., within the two months noted above) files a paper alerting the Office to the assignment of a reexamination to the “original examiner,” but that paper does not have a right of entry under the rules. An example of this is where a third party requester becomes aware of the assignment to the “original examiner” via that examiner signing the order for reexamination, and the patent owner does not file a statement under 37 CFR 1.530. In that situation, the third party requester cannot file a reply under 37 CFR 1.535, and thus has no way to present the paper directed to the examiner assignment (no right of entry under the rules). In situations where a paper directed to the examiner assignment has no right of entry under the rules, the Office may waive the rules to the extent that the paper directed to the examiner assignment will be entered and considered.

I. The August 21, 2009 Third Party Requester Petition Under 37 CFR 1.183

The present third party requester petition under 37 CFR 1.183 seeks relief by (i) requesting waiver of the prohibition under 37 CFR 1.535 of consideration of a submission by the reexamination requester, and (ii) entry and consideration of accompanying petition under 37 CFR 1.181 (the submission) requesting reassignment of the reexamination to an examiner other than the “original examiner.”

Initially, it is pointed out that MPEP § 2236 refers to the requester paper with respect to a reexamination “inadvertently assigned” to an original examiner (in a situation where the TC or CRU Director’s approval is not stated in the decision on the request) as “a paper alerting the

Office of this fact,” and as “a paper alerting the Office to the assignment of a reexamination to the ‘original examiner.’” The requester paper is not referred to as a petition under 37 CFR 1.181; it is simply a paper notifying the Office that a reexamination was assigned to an original examiner, and the TC or CRU Director’s approval is not stated in the decision on the request. Although the MPEP inadvertently refers to the paper as a “request challenging the assignment of an examiner” in one instance, the requester paper is, in truth, a notification paper.² Upon receipt of the notification paper, the TC or CRU Director will review the matter, and either issue a paper setting forth the TC or CRU Director’s approval (with reasons) or reassign the case. Therefore, the present third party requester petition under 37 CFR 1.183 is granted to the extent that the petition under 37 CFR 1.181 will be entered and considered as a notification paper, alerting the Office of the examiner-assignment situation. The CRU Director will then review the matter to the extent appropriate.

II. The August 27, 2009 Patent Owner Petition Under 37 CFR 1.183

The present patent owner petition under 37 CFR 1.183 requests that the Office dismiss the August 21, 2009 third party requester petition under 37 CFR 1.183. It is noted that the patent owner petition has an improper S-signature. The S-signature should be located within a first single forward slash mark before, and a second single forward slash mark after the S-signature as set forth in 37 CFR 1.4(d)(2)(i). The S-signature in the petition contains extra slashes, and thus it is an improper S-signature under 37 CFR 1.4(d)(2)(i). Accordingly, patent owner’s petition under 37 CFR 1.183 is viewed as unsigned and is therefore dismissed.

CONCLUSION

1. Third party requester’s petition under 37 CFR 1.183 is **GRANTED** to the extent that the petition under 37 CFR 1.181 will be entered and considered as a notification paper.
2. The patent owner’s petition under 37 CFR 1.183 is **DISMISSED**.
3. Jurisdiction is being returned to the Central Reexamination Unit.
4. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

10-13-09
Kenpet7/

² This is akin to the notification provided via MPEP § 2282, where the Office may take action based on the § 2282 notice pursuant to, for example, MPEP § 2286, part IV.