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Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C.
One Financial Center
Boston, MA 02111

For Patent Owner

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

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. 90/010,386
Filed: January 15, 2009
For: U.S. Patent No. 5,626,631

Ex Parte Reexamination Proceeding
Control No. 90/010,493
Filed: April 10, 2009
For: U.S. Patent No. 5,626,631

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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. 90/010,386 was ordered in a decision mailed April 8, 2009. It is noted that the request for this reexamination asked reexamination of claims 7 and 11-41, all of the claims present at that time in prior copending reexamination proceeding control No. 90/010,069 (merged with reexamination proceeding 90/010,134). The decision granted reexamination for only original patent

claim 7, noting section 2243 of the MPEP that indicates that amended and/or new 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, cancelling claims 1-6 and 8-10, and adding claims 11-41. The amendment incorporated into the instant proceeding the claims as they appear in *Ex Parte* Reexamination Certificate number 6682 issued March 3, 2009, as a result of the termination of the first reexamination proceeding Control No. 90/010,069 (merged with reexamination proceeding 90/010,134). On May 12, 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. 90/010,493 was ordered in a decision mailed June 30, 2009, indicating that claims 7 and 11-41, all of the live claims in the patent per the issuance of *Ex Parte* Reexamination Certificate No. 6682. 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. 90/010,386 and reexamination control No. 90/010,493 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 7 and 11-41, 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the

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

Conclusion

Reexamination Control Nos. 90/010,386 and 90/010,493 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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OCT 13 2009

CENTRAL REEXAMINATION UNIT

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
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Boston, MA 02111

(For Patent Owner)

Goodwin Procter LLP
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53 State Street, Exchange Place
Boston, MA 02109-2881

(For 90/010,493 + 90/010,386 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,493
Filed: April 10, 2009
For: U.S. Patent No. 5,626,631

Ex Parte Reexamination Proceeding
Control No.: 90/010,386
Filing Date: January 15, 2009
For: U.S. Patent No. 5,626,631

DECISION ON PETITIONS UNDER 37 CFR 1.183

This is a decision on the August 25, 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 25, 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 90/010,386.

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 26, 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 May 6, 1997, the Office issued U.S. Patent No. 5,626,631 (the '631 patent) to Eckhouse.

2. On January 15, 2009, a first request for *ex parte* reexamination of claims 7 and 11-41 of the '631 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,386 (the '10386 proceeding).

3. On January 21, 2009, the Office issued a notice of the filing of the '10386 *ex parte* reexamination with an assigned filing date of January 15, 2009.

4. On April 8, 2009, the Office issued an order granting reexamination of claim 7 of the '631 patent for the '10386 proceeding.

5. On April 10, 2009, a second request for *ex parte* reexamination of claims 7, and 11-41 of the '631 patent was filed by the same third party requester The resulting reexamination proceeding was assigned control number 90/010,493 (the '10493 proceeding).

6. On April 17, 2009, the Office issued a notice of the filing of the '10493 *ex parte* reexamination with an assigned filing date of April 10, 2009.

7. On June 30, 2009, the Office issued an order granting reexamination of claims 7 and 11-41 for the '10493 proceeding.

8. On July 14, 2009, patent owner filed a petition in both the '10386 and '10493 proceedings to request merging of the two proceedings.

9. On July 23, 2009, the Office mailed a decision merging the '10386 and '10493 reexamination proceedings into a single proceeding.

10. On August 25, 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."

11. On August 27, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 25, 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.

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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 25, 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 25, 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

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.

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

Goodwin Procter LLP
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(For 90/010,493 + 90/010,386 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,493
Filed: April 10, 2009
For: U.S. Patent No. 5,626,631

Ex Parte Reexamination Proceeding
Control No.: 90/010,386
Filing Date: January 15, 2009
For: U.S. Patent No. 5,626,631

DECISION ON PETITIONS UNDER 37 CFR 1.181

This is a decision on the August 25, 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 Kashnikow, 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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(For Patent Owner)

MAILED

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CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
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53 State Street, Exchange Place
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(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,388
Filing Date: January 20, 2009
For: U.S. Patent No. 5,964,749

: **DECISION**
: **ON PETITIONS**
: **UNDER**
: **37 CFR 1.183**

This is a decision on the August 24, 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." 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 24, 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.

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 25, 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 October 12, 1999, the Office issued U.S. Patent No. 5,964,749 (the '749 patent) to Eckhouse.

2. On January 20, 2009, a request for *ex parte* reexamination of claims 19-46 of the '749 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,388 (the '10388 proceeding).

3. On July 2, 2009, the Office issued an order granting reexamination of claims 19-46 of the '749 patent for the '10388 proceeding.

4. On August 24, 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."

5. On August 27, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 24, 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 24, 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.[1] 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 24, 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.

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[1] 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.

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

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

10-13-09
Kenpet7/

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United States Patent and Trademark Office
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Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C.
One Financial Center
Boston, MA 02111

(For Patent Owner)

MAILED

OCT 13 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

Ex Parte Reexamination Proceeding	: **DECISION**
Control No.: 90/010,388	: **ON PETITIONS**
Filing Date: January 20, 2009	: **UNDER**
For: U.S. Patent No. 5,964,749	: **37 CFR 1.181**

This is a decision on the August 24, 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 Kashnikow, 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,389	01/21/2009	RE36847	03871.00100	9925

22242 7590 07/26/2010

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/26/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Application of RE36847 ET AL. Appl. No.: 90/010,389 Filed: January 21, 2009 For: Automated Self-Cleaning Litter Box for Cats	**DECISION ON PETITION UNDER 37 CFR 1.59**

This is a decision on the petition under 37 CFR 1.59(b), filed June 1, 2010, to expunge information from the above identified reexamination proceeding.

The decision on the petition is dismissed.

Petitioner requests that the documents included in the "Fourteenth Supplemental Information Disclosure Statement", filed June 1, 2010, be expunged from the record.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

The petition is deficient because it lacks item (C) listed above.

Further as "materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims, a decision on whether the information in question is material or not to the examination of the instant proceeding cannot be made until the proceeding is ready for the issuance of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC).

If patent owner still wishes to have the material in question expunged, a renewed petition supplying the missing information noted above should be promptly filed for once a NIRC is mailed and the reexamination proceeding enters the reexamination certificate printing process, it may not be possible to address the renewed petition. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

cc: Steven E. Warner
Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3800
(3rd Party requester)

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.
90/010,393	01/23/2009	5452416	11800.1001	3259

25099 7590 11/30/2009

DAVID M QUINLAN, PC
32 NASSAU STREET
SUITE 300
PRINCETON, NJ 08542

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON, P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Date: MAILED
NOV 3 0 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010393
PATENT NO. : 5452416
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

David M. Quinlan, PC 32 Nassau Street Suite 300 Princeton NJ 08542	(For Patent Owner) : : :
Greg H. Gardella Fish & Richardson, P.C. P O Box 1022 Minneapolis, MN 55440-1022	(For Third-Party Requester) : : :
In re Hilton et al. Reexamination Proceeding Control No. 90/010,393 Request Deposited: January 23, 2009 For: U.S. Patent No. 5,452,416	: DECISION GRANTING : PETITION FOR : EXTENSTION OF TIME : [37 CFR 1.550(c)] :

MAILED

NOV 3 0 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the November 18, 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 one month.

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

The petition is **granted** and a one-month extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent 5,452,416 (hereinafter, the '416 patent), issued to Hilton *et alia* on September 19, 1995

2. On January 23, 2009 a third party requester requested ex parte reexamination of US Patent No. 5,452,416 which is identified under control no. 90/010,393.

3. The Order was granted for reexamination on April 2, 2009.

4. A non-final Office action was issued on September 28, 2009 setting a two-month period for response.

5. A petition for extension of time under 37 CFR 1.550(c) was filed November 18, 2009 requesting a one month extension.

DECISION

The Patent Owner requests an extension of time in which to file a response to the outstanding Office action. The present petition for extension of time was timely filed on May 22, 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 what steps Owner has taken to date in preparation of a response to the Office action. Further, the request outlines why, in spite of the actions taken thus far, the requested

additional time is believed necessary. In summary, additional time is needed for counsel of record to fully review the contents of the file to date and adequately prepare a proper response to the Final Rejection, including a full exploration of the status of prior art as a printed publicaiton. Reference is made to the petition pages 2-3 for details of these issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a response to the outstanding Office action. An extension of time of one month is considered sufficient.

Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

CONCLUSION

1. Petitioner's request is **granted**. The time for filing a response to the outstanding Office action is extended for one month and is due on or before **December 28, 2009**. Note the due date is calculated and extended from the date of mailing of the office action and not the date the prior response would have been considered timely, if filed, as requested in the petition.

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

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

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

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

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

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

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

/J. Harrison/

Jessica J. Harrison, SPE AU 3992
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,393	01/23/2009	5452416	11800.1001	3259

25099 7590 12/24/2009

DAVID M QUINLAN, PC
32 NASSAU STREET
SUITE 300
PRINCETON, NJ 08542

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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DEC 24 2009

David M. Quinlan, PC 32 Nassau Street Suite 300 Princeton NJ 08542	(For Patent Owner) : : :
Greg H. Gardella Fish & Richardson, P.C. P O Box 1022 Minneapolis, MN 55440-1022	(For Third-Party Requester) : : :
In re Hilton et al. Reexamination Proceeding Control No. 90/010,393 Request Deposited: January 23, 2009 For: U.S. Patent No. 5,452,416	: DECISION GRANTING : PETITION FOR : EXTENSTION OF TIME : [37 CFR 1.550(c)] :

This is a decision on the December 24, 2009, "REQUEST FOR EXTENSION OF TIME AND REQUEST FOR RECONSIDERATION OF FIRST REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner response be extended an additional three days from December 28, 2009 to December 31, 2009.

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

The petition is **granted** and a one-month extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent 5,452,416 (hereinafter, the '416 patent), issued to Hilton *et alia* on September 19, 1995

2. On January 23, 2009 a third party requester requested ex parte reexamination of US Patent No. 5,452,416 which is identified under control no. 90/010,393.

3. The Order was granted for reexamination on April 2, 2009.

4. A non-final Office action was issued on September 28, 2009 setting a two-month period for response.

5. A petition for extension of time under 37 CFR 1.550(c) was filed November 18, 2009 requesting a one month extension calculated to extend to December 31, 2009. This petition was granted on November 30, 2009 with the response period calculated to extend to December 28, 2009.

6. A request for reconsideration of the November 30, 2009 decision or in the alternative new request for extension of time for an additional three days was received on December 24, 2009.

DECISION

The Patent Owner requests an extension of time in which to file a response to the outstanding Office action. The present petition for extension of time was timely filed on December 24, 2009 and is being treated as a request for reconsideration of the prior extension of time decision. Accordingly, no fee is due.

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch ....
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor ....
>
> The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent

behavior by all those responsible for preparing a response within the statutory time period.

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

The request notes what steps Owner has taken to date in preparation of a response to the Office action. Further, the request outlines why, in spite of the actions taken thus far, the requested additional time is believed necessary. In summary, additional time is needed for counsel of record to fully review the contents of the file to date and adequately prepare a proper response to the Final Rejection, including a full exploration of the status of prior art as a printed publication. Reference is made to the petition pages 2-3 for details of these issues. Ongoing preparation has continued over two major holiday periods and in light of unexpected travel necessitated to prepare a complete response to the office action.

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 response to the outstanding Office action. An further extension of time for the requested three days is considered sufficient.

CONCLUSION

1. Petitioner's request is **granted**. The time for filing a response to the outstanding Office action is extended for one month and is due on or before **December 31, 2009**. Note the due date is calculated and extended from the date of mailing of the office action and not the date the prior response would have been considered timely, if filed, as requested in the petition.

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

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

/J. Harrison/

Jessica J. Harrison, SPE AU 3992
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

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JUL 23 2009

CENTRAL REEXAMINATION UNIT

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. 90/010,394
Filed: January 23, 2009
For: U.S. Patent No. 5,405,368

Ex Parte Reexamination Proceeding
Control No. 90/010,501
Filed: April 22, 2009
For: U.S. Patent No. 5,405,368

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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. 90/010,394 was ordered in a decision mailed April 17, 2009. It is noted that the request for this reexamination asked reexamination of claims 1, 8, 10-11, and 13-32, all of the claims present at that time in prior copending reexamination proceeding control No. 90/010,068 (merged with reexamination proceeding 90/010,136). The decision granted reexamination for only original patent

claims 13, and 16-18, noting section 2243 of the MPEP that indicates that amended and/or new 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, cancelling claims 2-7, 9 and 12, amending claims 1, 8, 10-11, and 14-15, and adding claims 19-32. The amendment incorporated into the instant proceeding the claims as they appear in *Ex Parte* Reexamination Certificate number 6712 issued March 24, 2009, as a result of the termination of the first reexamination proceeding Control No. 90/010,068 (merged with reexamination proceeding 90/010,136). On May 12, 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. 90/010,501 was ordered in a decision mailed June 29, 2009, indicating that claims 1, 8, 10-11, and 13-32, all of the live claims in the patent per the issuance of *Ex Parte* Reexamination Certificate No. 6712. 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. 90/010,394 and reexamination control No. 90/010,501 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, 8, 10-11, and 13-32, 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies

must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,394 and 90/010,501 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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CENTRAL REEXAMINATION UNIT

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
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(For Patent Owner)

Goodwin Procter LLP
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(For 90/010,501 + 90/010,394 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,501
Filed: April 22, 2009
For: U.S. Patent No. 5,405,368

Ex Parte Reexamination Proceeding
Control No.: 90/010,394
Filing Date: January 23, 2009
For: U.S. Patent No. 5,405,368

DECISION ON PETITIONS UNDER 37 CFR 1.181

This is a decision on the August 24, 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 Kashnikow, 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

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(For 90/010,501 + 90/010,394 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,501
Filed: April 22, 2009
For: U.S. Patent No. 5,405,368

Ex Parte Reexamination Proceeding
Control No.: 90/010,394
Filing Date: January 23, 2009
For: U.S. Patent No. 5,405,368

DECISION ON PETITIONS UNDER 37 CFR 1.183

This is a decision on the August 24, 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 26, 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 24, 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 90/010,394.

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 25, 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 27, 2009, for patent owner's petition under 37 CFR 1.183.

REVIEW OF RELEVANT FACTS

1. On April 11, 1995, the Office issued U.S. Patent No. 5,405,368 (the '368 patent) to Eckhouse.

2. On January 23, 2009, a first request for *ex parte* reexamination of claims 1, 8, 10-11, and 13-32 of the '368 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,394 (the '10394 proceeding).

3. On February 3, 2009, the Office issued a notice of the filing of the '10394 *ex parte* reexamination with an assigned filing date of January 23, 2009.

4. On April 17, 2009, the Office issued an order granting reexamination of claims 13, and 16-18 for the '10394 proceeding.

5. On April 22, 2009, a second request for *ex parte* reexamination of the '368 patent was filed by the same third party requester, requesting reexamination of claims 1, 8, 10-11, and 13-32 of the '368 patent. The resulting reexamination proceeding was assigned control number 90/010,501 (the '10501 proceeding).

6. On May 8, 2009, the Office issued a notice of the filing of the '10501 *ex parte* reexamination with an assigned filing date of April 22, 2009.

7. On June 29, 2009, the Office issued an order granting reexamination of claims 1, 8, 10-11, and 13-32 for the '10501 proceeding.

8. On July 14, 2009, patent owner filed a petition in both the '10394 and '10501 proceedings to request merging of the two proceedings.

9. On July 23, 2009, the Office mailed a decision merging the '10394 and '10501 reexamination proceedings into a single proceeding.

10. On August 24, 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."

11. On August 26, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 24, 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 24, 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 26, 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 24, 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

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.

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(For Patent Owner)

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(For Requester)

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MERIAL LIMITED 3239 SATELLITE BLVD.
DULUTH, GEORGIA 30096-4640

In re Donachie	:
Reexamination Proceeding	: DECISION ON
Control No. 90/010,395	: PETITION UNDER
Filed: January 23, 2009	: 37 CFR 1.181 AND
For: U.S. Patent No. 5,587,166	: 1.182

The third party Requester filed a paper on March 11, 2009, entitled "Petition for Review & Reversal of Denial of Request for *Ex Parte* Reexamination" (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 February 25, 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**.

REVIEW OF FACTS

1. U.S. Patent No. 5,587,166 (hereinafter, the '166 patent) issued on December 24, 1996.

2. A request for *ex parte* reexamination was filed on January 23, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,395 (hereinafter, the '395 proceeding). Reexamination was requested for claims 1-3, 8, 10-13 and 16-18 of the '166 patent based upon US 4,346,074 to Gilmour; GB 2202851A; Griffiths, Phil Trans. R. Soc. Lond. B 303, 85-96 (1983); Ungureanu et al, Arch exper Vet med, Leipzig 35 (1981) Mai, 3, s. 437-441; Lessley et al., Veterinary Immunology mad Immunopathology, 10 (1985) 279-296; Newman et al, Am J Vet Res, Vol. 43, No. 3, (1982) 417-422; Gilmour et al, Vaccine, Vol. 9, February 1991 (Gilmour 1991); and Donachie et al, FEMS Microbiology Letters, 56 (1988) 271-276.

3. A Notice of Reexamination Request Filing Date for the '395 proceeding was issued on January 29, 2009.

4. An order denying the request for reexamination for claims 1-3, 8, 10-13 and 16-18 in the '395 proceeding was mailed on February 25, 2009.

5. On April 17, 2009, the third party requester filed the present petition under 37 CFR §§ 1.181 and 1.182 in the '395 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 improperly construed the claims, misinterpreted the teachings of the references, and improperly determined the priority date which should be granted to certain claims.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-3, 8, 10-13 and 16-18 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-3, 8, 10-13 and 16-18 of the '166 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-3, 8, 10-13 and 16-18. 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 <u>new light</u>, 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 <u>same</u> 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 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

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[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

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 proposes 24 separate SNQs.

A. Requester considers claims 1, 2, 8, 10, 11, 16 and 17 unpatentable over Ungureanu, either alone or as evidenced by one or more of Griffiths, Lessley, Newman and Donachie (proposed SNQs 1-5). Ungureanu discloses a vaccine against *Pasteurella* made from *Pasteurella* cells. The claims require that the cells be grown under iron restriction conditions *in vitro*. The specification of the '166 patent explains that cells grown under such conditions contain an antigenic protein which is not present in cells grown under iron replete conditions. Griffiths teaches that bacteria growing *in vivo* (in an animal host) are under iron restriction conditions. Therefore Requester asserts that the vaccine of Ungureanu, being made from cells obtained from infected animals, must have contained the same antigenic protein that is produced by cells cultured under iron restricted conditions *in vitro*. However the Ungureanu reference does not disclose precisely how the vaccine was produced. It is not clear whether the vaccine was made directly from cells isolated from animals or from cells that had been cultured after isolation.

Turning to the petition, Requester argues that the Ungureanu vaccine was made directly from cells grown *in vivo*[4]. The basis for this assertion is that the vaccine is described as

[4] While new evidence is not considered in reviewing denial of a reexamination request, it is thought that a reasonable examiner would avail herself of a dictionary to ascertain

an "anaculture." Webster's defines an anaculture as "a mixed bacterial culture; *esp*: one used in the preparation of autogenous vaccines." The International Dictionary defines an autogenous vaccine as "bacteria...cultured from a patient, killed and injected..." Black's states that the term is "applied especially to bacterial vaccines manufactured from the organisms found in discharges from the body." The petition argues that these definitions prove that the Ungureanu vaccine was made directly from cells grown *in vivo*.

Requester's reasoning and assertions are not supported by the cited dictionary definitions. First, *especially* used in preparation of autogenous vaccines does not mean *necessarily* used for that purpose. Therefore production of an autogenous vaccine is not required for a product to meet the Webster's definition of an anaculture. Second, Webster's and the International Dictionary each describe anacultures as (open to) the products of *in vitro* culture: "a mixed bacterial *culture*" (Webster's); "*cultured* from a patient" (the International Dictionary). It is well known that the process of growing microorganisms in the laboratory is referred to as "culturing," and that the resulting product is referred to as a "culture." Even Black's definition does not exclude the possibility of the bacteria being cultured *in vitro* as part of the manufacturing process. Thus the cited definitions do not establish that the Ungureanu vaccine was made directly from bacterial cells isolated from infected animals, i.e. grown under iron restricted conditions. This may have been the case, but the fact that a certain characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that characteristic (MPEP 2112, IV). Griffiths, Lessley, Newman and Donachie do not discuss the Ungureanu reference, so they do not provide any insight into how the vaccine was made. Absent any evidence or reasoning to show that the Ungureanu vaccine was made from cells grown under iron restriction conditions, either *in vitro* or *in vivo*, a reasonable examiner would not consider the teachings of Ungureanu "new" or important in deciding whether the claims are patentable.

Therefore Ungureanu, either alone or supported by the cited evidentiary references, does not raise a SNQ.

B. Requester considers claims 10 and 11 unpatentable over Gilmour 1991 (proposed SNQ 6). Gilmour 1991 presents data very similar, if not identical, to that disclosed in the specification of the '166 patent (compare Table 1 of both documents).
The proposed rejection is based on the premise that claims 10 and 11 are not entitled to the 1988 priority date because claims reciting "prevention" of pasteurellosis were first presented when application 08/427,692 was filed in 1995. This argument is not persuasive. First, it is noted that 08/427,692 was a continuation of a continuation of the originally filed U.S. patent application. No new matter was added to the specification. The original specification discloses vaccination of animals (p. 3, lines 13-16; p. 4, lines

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the meaning of a technical term. Therefore the dictionary definitions (Black's, Webster's and the International Dictionary) provided with the petition have been considered.

15-21). With regard to the adjuvant recited in claim 11, the specification discloses the same adjuvant used in Gilmour 1991 (alhydrogel; p. 10, line 2). Thus the claimed subject matter was adequately supported in the specification as filed in 1988. Since Gilmour 1991 does not qualify as prior art, it does not present a SNQ with regard to claims 10 and 11.

The petition argues that "prevention" of pasteurellosis was not claimed until the application which matured into the '166 patent was filed in 1995. The petition also points out that the claims are broader in scope than the working examples disclosed in the specification. As noted above, no new matter was added to the disclosure upon filing of the continuing applications and prevention of pasteurellosis is clearly demonstrated in Example 1 of the specification. With regard to the scope of the claims, Requester is essentially arguing that the claims are not enabled and this question is outside the scope of reexamination. See MPEP 2258.

C. Requester considers claims 1, 3, 8, 10-13 and 16-18 unpatentable over Lessley as evidenced by Newman and the Gilmour patent (proposed SNQ 7). Lessley immunized mice with a saline extract of *P. haemolytica* cells, or with fractions (designated antigens) of said extract that were separated by chromatographic techniques. As with the Ungureanu reference, the relevance of the Lessley reference hinges on whether the "vaccine" was produced from bacterial cells grown under iron restriction conditions. Lessley does not state that the cells were grown under iron restriction conditions, but indicates that the cells were obtained from a calf and maintained as described by Newman. In Newman, bacteria were isolated from an animal and maintained in culture, with occasional passage in animals followed by re-isolation in order to maintain virulence. This suggests that the saline extract was not made <u>directly</u> from cells grown *in vivo*. Furthermore, Lessley states that the saline extract was made using bacteria in logarithmic phase (p. 281, first paragraph). Therefore the extract must have been made from bacteria growing in *in vitro* culture, because the determination that they were in logarithmic phase could only have been made using cultured cells. There is nothing in Lessley or Newman that would lead one to believe that the culture medium used was iron restricted. The Gilmour patent does not relate to the Lessley reference, and therefore it does not provide any insight into the nature of the proteins isolated by Lessley. Thus it can not be concluded that the saline extract, nor the "antigen" fractions obtained therefrom, were derived from bacteria grown under iron restricted conditions.

Requester's attempt to show that the Lessley extract contains an antigen identical to the "iron restriction protein" of the '166 application is not convincing. Each "antigen" produced by Lessley is actually a mixture of several proteins (Figs. 7 and 8). Requester asserts that the extract of Lessley contained the same 70 kD antigen as disclosed in the '166 patent. In discussing Donachie's previous work with sodium salicylate extracts Lessley states, "Results of that study and those of the present study are not readily comparable because of differences in extraction and analytical techniques" (p. 292, second paragraph). Furthermore, the SDS gel and immunoblot of Lessley's Figs. 7 and

8 show that each "antigen" contains a component in the range of 70 kD, but only two of the "antigens" were even moderately effective in protecting mice from subsequent challenge with *Pasteurella* (Table 3). It therefore seems unlikely that the 70 kD component seen in the saline extract is an effective antigen – any protective effect provided by "antigens" 2 and 6 could be attributed to one or more of the other proteins in the extract. There is also no evidence that the 70 kD protein is induced under iron restriction conditions. Finally, even *Pasteurella* cells grown under iron replete conditions produce effective antigens (see col. 1, lines 36-40 of the '166 patent). The mere fact that an immunogenic protein was isolated from *Pasteurella* does not demonstrate that it was the more effective antigen which is produced under iron restriction conditions.

A skilled artisan would not conclude that Lessley discloses bacteria grown under iron restriction conditions, nor antigens obtained therefrom. Accordingly, a reasonable examiner would not consider the combined teachings of the cited references "new" or important in deciding whether the claims are patentable. Therefore Lessley, taken in view of Newman and the Gilmour patent, does not present a SNQ with regard to claims 1-3, 8, 10-13 and 16-18.

D. Requester considers claims 1-3, 8, 10-13 and 16-18 unpatentable over Ungureanu, alone or in combination with one or more of Griffiths, Lessley, Newman, Donachie and the Gilmour patent (proposed SNQs 8-18). The proposed SNQs are based on different combinations of the references discussed above. The Donachie reference was published in 1988 and is therefore not prior art. For the reasons discussed in sections A and C above, neither Ungureanu nor Lessley can be said to disclose vaccines produced from bacterial cells grown under iron restriction conditions as required by the claims. Absent any such disclosure, none of the various combinations provides a new technical teaching that a reasonable examiner would find important in deciding whether the claims are patentable. Therefore Ungureanu, alone or in combination with one or more of Griffiths, Lessley, Newman, Donachie and the Gilmour patent, does not raise a SNQ with regard to claims 1-3, 8, 10-13 and 16-18.

E. Requester considers claims 1-3, 8, 10-13 and 16-18 unpatentable over Lessley alone or in combination with one or more of the Gilmour patent and Newman (proposed SNQs 19-21). The proposed SNQs are based on different combinations of the references discussed above. For the reasons discussed in section C above, Lessley can not be said to disclose vaccines produced from bacterial cells grown under iron restriction conditions as required by the claims. Absent any such disclosure, none of the various combinations provides a new technical teaching that a reasonable examiner would find important in deciding whether the claims are patentable. Therefore Lessley, alone or in combination with one or more of the Gilmour patent and Newman, does not raise a SNQ with regard to claims 1-3, 8, 10-13 and 16-18.

F. Requester considers claims 10-13 unpatentable over Gilmour 1991, alone or in combination with any one of Ungureanu, the Gilmour patent or GB 2202951A (proposed SNQs 22-24). As discussed in section B above, Gilmour 1991 is not prior art and so it does not raise an SNQ.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,395	01/23/2009	5587166	574313-5039.2	3746

23117 7590 06/29/2010

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED
JUN 29 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010395
PATENT NO. : 5587166
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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DULUTH, GEORGIA 30096-4640

MAILED

JUN 29 2010

CENTRAL REEXAMINATION UNIT

In re Donachie	:
Reexamination Proceeding	: DECISION DISMISSING
Control No. 90/010,395	: PETITION UNDER
Filed: January 23, 2009	: 37 CFR 1.181, 1.182
For: U.S. Patent No. 5,587,166	: AND 1.183

This is a decision on the August 31, 2009 third party requester petition entitled "PETITION TO THE HONORABLE DIRECTOR OF THE USPTO UNDER 37 CFR 181(a)(3), 1.182 & 1.183 FOR RECONSIDERATION AND WITHDRAWAL OF THE AUGUST 1 and JULY 31, 2009 DECISIONS ON PETITION IN REEXAMINATION CONTROL NOS. 90/010,395 & 90/010,461 AND AN ORDER OF EX PARTE REEXAMINATION OF US PATENT NO. 5,587,166 & REEXAMINATION CERTIFICATE NO. 5,587,166 C1."

The third party requester petition and the present record are before the Office of Patent Legal Administration for consideration.

The third party requester petition is dismissed, and is being expunged, for the reasons set forth below.

FEES

Pursuant to the authorization on page 2 of the petition, deposit account No. 50-2354 has been charged the required $400 petition fee.

BACKGROUND

1. U.S. Patent No. 5,587,166 (hereinafter, the '166 patent) issued on December 24, 1996.

2. A request for *ex parte* reexamination of the '166 patent was filed on January 23, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,395 (hereinafter, the '395 proceeding). Reexamination was requested for claims 1-3, 8, 10-13 and 16-18 of the '166 patent based upon U.S. Patent 4,346,074 to Gilmour; GB 2202851A; Griffiths, Phil Trans. R. Soc. Lond. B 303, 85-96 (1983); Ungureanu et al, Arch exper Vet med, Leipzig 35 (1981) Mai, 3, s. 437-441; Lessley et al., Veterinary Immunology mad Immunopathology, 10 (1985) 279-296; Newman et al, Am J Vet Res, Vol. 43, No. 3, (1982) 417-422; Gilmour et al, Vaccine, Vol. 9, February 1991 (Gilmour 1991); and Donachie et al, FEMS Microbiology Letters, 56 (1988) 271-276.

3. A Notice of Reexamination Request Filing Date for the '395 proceeding was issued on January 29, 2009.

4. An order denying the request for reexamination for claims 1-3, 8, 10-13 and 16-18 in the '395 proceeding was mailed on February 25, 2009.

5. On April 17, 2009, the third party requester filed a petition under 37 CFR §§ 1.181 and 1.182 in the '395 proceeding. The petition requested review of the February 25, 2009 denial of reexamination.

6. On August 1, 2009, the petition for review of the denial of reexamination was denied in a decision issued by the Director of the Central Reexamination Unit (CRU).

7. On August 31, 2009, the third party requester filed the present petition under 37 CFR §§ 1.181, 1.182 and 1.183, requesting withdrawal of the denial of reexamination.

DECISION

The third party requester petitions for supervisory review of the Office's August 1, 2009 decision denying the third party requester's petition under 37 CFR §§ 1.181 and 1.515(c), and of the initial examiner's July 31, 2009 decision denying the reexamination request.[1] It is 37 CFR 181(a)(3) that provides that petition may be taken to the Director "[t]o invoke the supervisory authority of the Director in appropriate circumstances" (emphasis added). In this instance, however, petitioner requests relief under 37 CFR §§ 1.182 and 1.183, [2] and supervisory review is not the

[1] The third party requester asks "the Director to invoke his supervisory authority, in the present situation that does not appear to be specifically provided for in the regulations, and as justice requires in this extraordinary situation, suspend as necessary any rules which may present an impediment to granting the relief requested, and thereby reconsider and withdraw the August 1 and July 31, 2009 Decisions on Petition in Reexamination Control Nos. 90/010,395 and 90/010,461, respectively, and order of ex parte Reexamination of claims 1-3, 8, and 10-13 of US Patent No. 5,587,166 and claims 1-3, 8, 10-13 and 16-18 of Reexam Certificate No. 5,587,166 C1." Paragraph bridging pages 1 and 2 of the reconsideration petition.

[2] The reconsideration petition states, in the paragraph bridging pages 5 and 6: "As it is an extraordinary situation when the Central Reexamination Unit commits clear errors of law and fact, this Petition asks that to the extent necessary to order *ex parte* Reexamination of Donachie that pursuant to **Rule 183** the Director also suspend any Rules that may present any impediment to granting that relief including, without limitation, suspending or waiving any portion of 37 CFR § 1.515 so as to grant the herein requested relief. Similarly, as appeals from clearly erroneous decisions of the Central Reexamination Unit may not be explicitly provided for in the Rules (see 37 CFR § 1.515(c), the suspension of which is explicitly herein requested), this Petition is also under **Rule 182**, to any extent necessary so that the Director orders *ex parte* Reexamination of Donachie, e.g., pursuant to 37 CFR § 1.520 (which allows the Director to initiate Reexamination proceedings *sua sponte*)." [Emphasis added]

purpose of the provisions of 37 CFR §§ 1.182 and 1.183. Accordingly, the present petition is dismissed [3]

It is to be noted that this decision is without prejudice to petitioner filing a new request for reexamination that includes any new argument/discussion to show that a new technical teaching is identified in the request for reexamination, and this may include any argument/discussion that has been set forth in the petitions filed in this case.

Improper paper is expunged:

As pointed out, 37 CFR 1.540 provides that "[n]o submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination." Since the present petition is neither a statement pursuant to 37 CFR 1.530 nor a requester reply pursuant to 37 CFR 1.535, it is not permitted by rule. Therefore, the petition paper requesting supervisory review is an improper paper, and lacks an entry right. In this instance, the petition paper has been scanned into the Image File Wrapper (IFW) and cannot be physically "removed" from the IFW. Therefore, the documents of the petition paper are being expunged by marking the papers "closed" and "non-public." The papers will remain in the IFW data base, as the system does not allow for purging it, but will not constitute a part of the record in the reexamination proceeding.

It is also to be observed that the petition contains argument over the merits of the proposed rejections. Thus, it contains information that is not needed, and may be considered detrimental to the record.

CONCLUSION

1. The third party requester petition filed on August 31, 2009 is **dismissed**.

2. The third party requester petition paper, including the documents concurrently filed in support thereof, is being **expunged**, by marking the papers "closed" and "non-public."

3. A copy of the present decision will be made of record in the '395 *ex parte* reexamination IFW.

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[3] It is to be observed that petitioner has filed the present petition under 37 CFR 1.181, and in addition, under 37 CFR 1.182 and/or 1.183. However, 37 CFR 1.4(c) provides that "[s]ince 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." Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. The present petition includes multiple requests: (1) The request under 37 CFR 1.181 for supervisory review of the CRU Director decision is addressed by the Technology Center 1600 Director. (2) The requests for relief that is not provided by the rules under 37 CFR 1.182 and for relief to waive the rules under 37 CFR 1.183 are addressed in the Office of Patent Legal Administration. Thus, the petition fails to comply with 37 CFR 1.4(c). It is also to be observed that the petition was improperly captioned as directed to two proceedings. Each petition should be captioned only as to the proceeding to which it applies.

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

Kenneth M. Schor

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

6-29-10
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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)

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Patent Administrator
53 State Street, Exchange Place
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(For Third Party Requester)

Ex Parte Reexamination Proceeding	: **DECISION**
Control No.: 90/010,400	: **ON PETITIONS**
Filing Date: April 15, 2009	: **UNDER**
For: U.S. Patent No. 6,174,325	: **37 CFR 1.181**

This is a decision on the August 25, 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 Kashnikow, 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

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(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,400
Filing Date: April 15, 2009
For: U.S. Patent No. 6,174,325

: **DECISION**
: **ON PETITIONS**
: **UNDER**
: **37 CFR 1.183**

This is a decision on the August 25, 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." 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 25, 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.

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 26, 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 January 16, 2001, the Office issued U.S. Patent No. 6,174,325 (the '325 patent) to Eckhouse.

2. On January 30, 2009, a request for *ex parte* reexamination of claims 39-56 of the '325 patent was initially deposited by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,400 (the '10400 proceeding).

3. On July 2, 2009, the Office issued an order granting reexamination of claims 39-56 of the '325 patent for the '10400 proceeding.

4. On August 25, 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."

5. On August 27, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 25, 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 25, 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.[1] 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 25, 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.

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[1] 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.

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

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

10-13-09
Kenpet7/

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.
90/010,416	02/17/2009	6108704	2655-0188	1061

42624 7590 11/25/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/25/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Edwin H. Taylor
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

Date:
MAILED
NOV 2 5 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010416
PATENT NO. : 6108704
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

Michael R Casey DAVIDSON BERQUIST JACKSON & GOWDEY LLP 4300 WILSON BLVD., 7TH FLOOR ARLINGTON VA 22203	:	(For Patent Owner
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040	:	(For Third Party Requester)
In re: Hutton *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,416 Deposited: 17 February 2009 For: US Patent No. 6,108,704	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME 37 CFR § 1.550(c) & 1.181

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CENTRAL REEXAMINATION UNIT

This is a decision on the 23 November 2009, "Supplemental Request for Extension of Time in a Re-Examination" filed under 37 CFR § 1.550(c) requesting that the time for responding to the non-final Office action dated 27 August 2009, be further extended by one (1) week. The petition was filed with the required certificate of service and petition fee. The petition was timely filed.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time be further extended in which to file a response to non-final Office action dated 27 August 2009 which set a two (2) month period for response thereto. A first petition for extension of time was granted extending the response period by one month in the decision dated 26 October 2009. The subsequent petition was timely filed with the required certificate of service and petition fee pursuant to 37 CFR §§ 1.550(c) and 1.17(g). Second requests for extension of time will only be granted in exception circumstances.

The petition for extension of time dated 23 November 2009 is dismissed.

37 CFR § 1.550 (c) states:

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

MPEP § 2265 Extension of Time (in-part)

...

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

...

ANALYSIS AND FINDINGS

The patent owner's representative petitions to extend the period for response by adding thirty (30) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The patent owner timely submitted a first petition for extension which was granted on 26 October 2009. This first extension of time granted one additional month for which the patent owner to respond to the outstanding Office action. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. The factual accounting presented by the petitioner does not meet the level of extraordinary circumstances.

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

CONCLUSION

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

2. The time to respond continues to run.

3. Response is due on **27 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://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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JUL 0 1 2009

CENTRAL REEXAMINATION UNIT

LINER GRODE STEIN YANKELEVITZ SUNSHINE REGENSTREIF & TAYLOR 1100 Glendon Avenue, 14th Floor Los Angeles, CA 90024	:	(For Patent Owner)
ORRICK HERRINGTON & SUTCLIFFE LLP IP Prosecution Department 4 Park Plaza, Suite 1600 Irvine, CA 92614-2558	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FILED UNDER 37 CFR § 1.181
In re Fast Memory Erase LLC *Ex Parte* Reexamination Proceeding Control No: 90/010,426 Deposited on: 26 February 2009 For: US Patent No: 6,236,608	:	

This is a decision on the June 22, 2009 patent owner "Petition to Withdraw Premature Office Action". The petition is treated under 37 CFR 1.181 as a petition to invoke the supervisory authority of the Director of the USPTO.

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

The petition is granted for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On February 26, 2009, a third-party requester filed a request for reexamination of U.S. patent 6,236,608. That request was assigned control number 90/010,426. (In several places in the record including the petition of June 22, 2009 the control number is indicated as 09/010,426. This error has the potential of misrouting incoming correspondence and is to be avoided.)

2. Reexamination of the patent was ordered on April 17, 2009.

3. A paper purporting to be a non-final action was mailed on May 1, 2009.

DISCUSSION

35 USC § 304 states:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

The patent owner petitions the director of the Central Reexamination Unit for withdrawal of the office action of May 1, 2009. The order of April 17, 2009 sets forth a period of two months from the mailing date of that order during which a patent owner's statement may be filed (page 3 of the electronic record). On May 1, 2009, that period had not expired; however, the period expired June 17, 2009 with no owner's statement. Accordingly, while the paper of May 1 was mailed prior to the expiration of the period, the proceeding is now ripe for a first action on the merits, taking into consideration the Information Disclosure Statement of June 11, 2009.

CONCLUSION

1. The patent owner's petition for withdrawal of the action of May 1, 2009 is granted.

2. The paper mailed May 1, 2009 is vacated and will be closed (made non-public) in the electronic record.

3. As the period for a patent owner statement ended June 17, 2009, an appropriate action will follow.

4. Future correspondence may be directed as follows:

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

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

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

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

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

Gregory Morse
Director, Central Reexamination Unit

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD 7th FLOOR LOS ANGELES CA 90025	: : : : :	(For Pant Owner)
LANDO & ANASTASI, LLP ONE MAIN STREET, SUITE 1100 CAMBRIDGE, MA 02142	: : :	(For Third Party Requester)

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

In re: Haddock *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,432 Deposited on: 03 March 2010 For: US Patent No. 6,678,248 B1	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 07 June 2010 petition titled, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting the response period for response be extended by one (1) month for response to the non-final Office action dated 06 April 2010, be extended by one (1) month. The petition submitted 07 June 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 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 06 April 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 07 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 dismissed.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a

petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

ANALYSIS AND FINDINGS

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

The petitioner notes that the petitioner has reviewed the patents and prosecution history and references cited. The Petitioner further notes the "number and length of cited references" and cites other proceedings which are not a part of the instant proceeding.

The review of the action finds that only two of the proposed rejections were actually a part of the Office action where all the others were cited as cumulative. Other proceedings are noted but since they are not directly a part of the instant proceeding are not germane to the issue.

MPEP § 2265 requires (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. Further, the petition lacks a statement that 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 clear why in spite of action taken thus far additional time is needed. There is also no specific outline of the factual accounting and why again in spite of this action additional time is needed. On balance, there is <u>not</u> "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

The petition request to extend the response time is hereby <u>dismissed.</u>

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 June 2010 is hereby **dismissed.**

2. The period ended two months from the mailing of the non-final Office action.

3. The proceeding is directed to the examiner in charge of the proceeding for termination since there was no timely response by the patent owner.

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD 7th FLOOR LOS ANGELES CA 90025	: : : : :	(For Pant Owner)
LANDO & ANASTASI, LLP ONE MAIN STREET, SUITE 1100 CAMBRIDGE, MA 02142	: : :	(For Third Party Requester)

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

In re: Haddock *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,432 Deposited on: 03 March 2010 For: US Patent No. 6,678,248 B1	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 07 June 2010 petition titled, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting the response period for response be extended by one (1) month for response to the non-final Office action dated 06 April 2010, be extended by one (1) month. The petition submitted 07 June 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 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 06 April 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 07 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 dismissed.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a

petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

ANALYSIS AND FINDINGS

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

The petitioner notes that the petitioner has reviewed the patents and prosecution history and references cited. The Petitioner further notes the "number and length of cited references" and cites other proceedings which are not a part of the instant proceeding.

The review of the action finds that only two of the proposed rejections were actually a part of the Office action where all the others were cited as cumulative. Other proceedings are noted but since they are not directly a part of the instant proceeding are not germane to the issue.

MPEP § 2265 requires (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. Further, the petition lacks a statement that 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 clear why in spite of action taken thus far additional time is needed. There is also no specific outline of the factual accounting and why again in spite of this action additional time is needed. On balance, there is <u>not</u> "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

The petition request to extend the response time is hereby <u>dismissed.</u>

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 June 2010 is hereby **dismissed.**

2. The period ended two months from the mailing of the non-final Office action.

3. The proceeding is directed to the examiner in charge of the proceeding for termination since there was no timely response by the patent owner.

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

(For Patent Owner)

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OCT 13 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,444
Filing Date: April 15, 2009
For: U.S. Patent No. 5,707,403

: **DECISION**
: **ON PETITIONS**
: **UNDER**
: **37 CFR 1.183**

This is a decision on the August 24, 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." 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 24, 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.

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 25, 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 January 13, 1998, the Office issued U.S. Patent No. 5,707,403 (the '403 patent) to Grove et al.

2. On March 6, 2009, a request for *ex parte* reexamination of claims 16-33 of the '403 patent was initially deposited by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,444 (the '10444 proceeding).

3. On July 2, 2009, the Office issued an order granting reexamination of claims 16-33 of the '403 patent for the '10444 proceeding.

4. On August 24, 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."

5. On August 27, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 24, 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.

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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 24, 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.[1] 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 24, 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.

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[1] 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.

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

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

10-13-09
Kenpet7/

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Boston, MA 02111

(For Patent Owner)

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OCT 13 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

Ex Parte Reexamination Proceeding	: **DECISION**
Control No.: 90/010,444	: **ON PETITIONS**
Filing Date: April 15, 2009	: **UNDER**
For: U.S. Patent No. 5,707,403	: **37 CFR 1.181**

This is a decision on the August 24, 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 Kashnikow, 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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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.
90/010,449	03/12/2009	7236905	02008/228002	9322

22511 7590 12/28/2009

OSHA LIANG L.L.P.
TWO HOUSTON CENTER
909 FANNIN, SUITE 3500
HOUSTON, TX 77010

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

Thomas Scherer
OSHA LIANG LLP
909 Fannin St, Suite 3500
Houston, TX 77010

MAILED

DEC 28 2009

CENTRAL REEXAMINATION UNIT

In re Donachie	:
Reexamination Proceeding	: DECISION ON
Control No. 90/010,449	: PETITION UNDER
Filed: March 12, 2009	: 37 CFR 1.515(c) AND
For: U.S. Patent No. 7,236,905 B2	: 1.181

The third party Requester filed a paper on May 29, 2009, entitled "PETITION UNDER 37 C.F.R. §1.515(c)" (hereinafter the petition). The petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks "not a reversal of the denial, but rather a reconsideration of the reasons on which the denial was based".

The Petition is **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,236,905 (hereinafter, the '905 patent) issued on June 26, 2007.

2. A request for *ex parte* reexamination was filed by the patent owner on March 12, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,449. Reexamination was requested for claims 1-4 of the '905 patent based upon a Chinese search report and portions of a translation of that report.

3. An order denying the request for reexamination for claims 1-4 in the '449 proceeding was mailed on April 30, 2009.

5. On May 29, 2009, the third party requester filed the present petition under 37 CFR §§ 1.515(c).

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 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. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-4. 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 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

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

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. Decision

Patent owner is seeking not a reversal of the decision of the examiner but rather a rewriting of the order denying reexamination to his liking. As a petition under 37 CFR 1.515(c) is to review the decision of the examiner rather than to express agreement or disagreement with specific points in the denial, the petition of May 29, 2009 is denied as the relief sought would not ultimately change the decision in this proceeding.

---

[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

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 Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse, Director
Central Reexamination Unit

ADDITIONAL DISCUSSION

As noted by patent owner on page 3 of the petition, the examiner mischaracterized the language of the request for reexamination. Any suggestion that the request of March 12, 2009 was an allegation of unpatentability is incorrect.

With regard to the discussion of the search report at pages 9-11 of the denial of April 30, 2009, that discussion appears to refer to the Japanese search report considered by the original examiner on September 28, 2006.

With regard to office action from Chinese application 2005800385291, the office action itself is not a printed publication with an effective date prior to the priority date of the '905 patent. Thus it is, not available against the claims per MPEP 2257 (B). It cannot be applied in a rejection under 35 USC 102 or 103 and, in addition, does not appear to have a "new technical teaching" within its four corners[4]. Moreover, it is not a substitute for argument from the requester that a previously cited piece of prior art has previously unappreciated technical teachings - that is, the foreign office action does not itself cast the teachings of the prior art in a new light. As the request does not identify specific technical teachings in the available prior art that were not appreciated by the examiner in the original examination outside of this context, those teachings would not have been

[4] While an office action could introduce a new technical teaching that was not part of an underlying reference, that situation is unlikely and does not appear to be the case here.

important to a reasonable examiner in determining the patentability of at least one claim. The apparent rejection by a foreign examiner, possibly under different legal standards, is not by itself a "new technical teaching" in the underlying prior art. Requester may file a request for reexamination at any time that uses the information from the foreign office actions or search reports to highlight a new technical teaching in a previously reference, but the foreign office action does not by itself cast a new light in this proceeding.

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CENTRAL REEXAMINATION UNIT

(For Requester)

JUDY JARECKI-BLACK, PH.D., J.D.
MERIAL LIMITED 3239 SATELLITE BLVD.
DULUTH, GEORGIA 30096-4640

In re Donachie	:
Reexamination Proceeding	: DECISION ON
Control No. 90/010,461	: PETITION UNDER
Filed: March 20, 2009	: 37 CFR 1.181 AND
For: U.S. Patent No. 5,587,166 C1	: 1.182

The third party Requester filed a paper on May 29, 2009, entitled "Petition for Review & Reversal of Denial of Request for *Ex Parte* Reexamination" (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 May 1, 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**.

REVIEW OF FACTS

1. U.S. Patent No. 5,587,166 C1 (hereinafter, the '166 patent) issued on December 24, 1996.

2. A request for *ex parte* reexamination was filed on March 20, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,461 (hereinafter, the '461 proceeding). Reexamination was requested for claims 1-3, 8, 10-13 and 16-18 of the '166 patent based upon Griffiths, Phil Trans. R. Soc. Lond. B 303, 85-96 (1983) ("Griffiths"); Gilmour et al, Vaccine, Vol. 9, February 1991 ("Gilmour 1991"); Ian R. Tizard, Veterinary Immunology, 206 (2d ed. 1982) ("Tizard"); Ungureanu et al, Arch exper Vet med, Leipzig 35 (1981) Mai, 3, s. 437-441 (12 May 1980) ("Ungureanu"); Webster's Medical Desk Dictionary p. 30 (1986) ("Webster's"); International Dictionary of Medicine and Biology, Vol. III p. 3083 (1986) ("the International Dictionary"); Black's Veterinary Dictionary p. 51 (15th ed. 1985) ("Black's"); Lessley et al., Veterinary Immunology and Immunopathology, 10 (1985) 279-296 ("Lessley"); Newman et al, Am J Vet Res, Vol. 43, No. 3, 417-422 (March 1982) ("Newman"); US Patent No. 4,346,074 ("the Gilmour patent"); Snipes, Ph.D. thesis, University of California, Davis (1985)pages iii-vii, 1-5, 19-25, 50-52, 108-116, 122, 123, 129, 130, 140-144, 161-165 and 182-189 ("Snipes"); and William Donachie and Neil J.L. Gilmour, FEMS Microbiology Letters 56 (1988) ("Donachie").

3. A Notice of Reexamination Request Filing Date for the '461 proceeding was issued on March 31, 2009.

4. An order denying the request for reexamination for claims 1-3, 8, 10-13 and 16-18 in the '461 proceeding was mailed on May 1, 2009.

5. On May 29, 2009, the third party requester filed the present petition under 37 CFR §§ 1.181 and 1.182 in the '461 proceeding.

<u>Petitioner's Grounds in Support of the Requested Relief</u>

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner improperly construed the claims, failed to appreciate the proper standard for obviousness, and misinterpreted the teachings of the references.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-3, 8, 10-13 and 16-18 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-3, 8, 10-13 and 16-18 of the '166 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-3, 8, 10-13 and 16-18. 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 <u>new light</u>, 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 <u>same</u> 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 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.

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[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

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 21 separate SNQs.

A. Requester considers claims 1, 2, 8, 10, 11, 16 and 17 unpatentable over Ungureanu, as evidenced by one or more of Tizard, Webster's, the International Dictionary, Black's, Griffiths, Lessley and Newman (proposed SNQs 1-4). Ungureanu discloses a vaccine against *Pasteurella* made from *Pasteurella* cells. The claims require that the cells be grown under iron restriction conditions *in vitro*. The specification of the '166 patent explains that cells grown under such conditions contain an antigenic protein which is not present in cells grown under iron replete conditions. Griffiths teaches that bacteria growing *in vivo* (in an animal host) are under iron restriction conditions. Therefore Requester asserts that the vaccine of Ungureanu, being made from cells obtained from infected animals, must have contained the same antigenic protein that is produced by cells cultured under iron restricted conditions *in vitro*. However the Ungureanu reference does not disclose precisely how the vaccine was produced. It is not clear whether the vaccine was made <u>directly</u> from cells isolated from animals or from cells that had been cultured after isolation.

Requester attempts to show that the Ungureanu vaccine was made directly from cells grown *in vivo* by citing Tizard, Webster's, the International Dictionary and Black's. Requester relies on the fact that the Ungureanu vaccine is described as an "anaculture." Webster's defines an anaculture as "a mixed bacterial culture; *esp*: one used in the preparation of autogenous vaccines." The International Dictionary defines an autogenous vaccine as "bacteria...cultured from a patient, killed and injected..." Black's states that the term is "applied especially to bacterial vaccines manufactured from the

organisms found in discharges from the body." Tizard teaches that autogenous vaccines contain organisms obtained from infected animals. Requester argues that these definitions prove that the Ungureanu vaccine was made directly from cells grown *in vivo*, and hence contained the same antigenic iron restriction protein produced by cells grown under iron restriction conditions *in vitro*.

Requester's reasoning and assertions are not supported by the cited dictionary definitions. First, *especially* used in preparation of autogenous vaccines does not mean *necessarily* used for that purpose. Therefore production of an autogenous vaccine is not required for a product to meet the Webster's definition of an anaculture. Second, the definitions provided by Webster's and the International Dictionary do not exclude the products of *in vitro* culture: "a mixed bacterial *culture*" (Webster's); "*cultured* from a patient" (the International Dictionary). It is well known that the process of growing microorganisms in the laboratory is referred to as "culturing," and that the resulting product is referred to as a "culture." Even Black's definition does not exclude the possibility of the bacteria being cultured *in vitro* as part of the manufacturing process. Thus the cited definitions do not establish that the Ungureanu vaccine was made directly from bacterial cells isolated from infected animals, i.e. grown under iron restricted conditions. Lessley and Newman do not discuss the Ungureanu reference, so they do not show that the Ungureanu vaccine was made from cells grown under iron restriction conditions. Absent any evidence or reasoning to show that the Ungureanu vaccine was made from cells grown under iron restriction conditions, either *in vitro* or *in vivo*, a reasonable examiner would not consider the teachings of Ungureanu "new" or important in deciding whether the claims are patentable. Therefore Ungureanu, taken in view of the cited evidentiary references, does not raise a SNQ.

Turning to the petition, Requester argues that the examiner improperly read process limitations into the product claims. This is incorrect because the examiner acknowledged that *Pasteurella* cells grown *in vivo* would be expected to contain the iron restriction proteins produced under iron restriction conditions *in vitro*. The fact remains that the Ungureanu reference <u>does</u> <u>not</u> disclose how the vaccine was made. Ambiguous dictionary definitions are no substitute for evidence. Requester argues that the vaccine <u>could</u> <u>have</u> <u>been</u> made from cells grown *in vivo*, but the fact that a certain characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that characteristic (MPEP 2112, IV). The petition further argues that it would be "obvious to try" producing a vaccine directly from cells grown *in vivo*. This argument is not persuasive because a reexamination is based on new technical information. One skilled in the art already knew that it was theoretically possible to produce a vaccine directly from samples taken from diseased animals. Because there are many reasons why a skilled artisan would not choose to do so (only a limited amount of vaccine could be produced, each batch of vaccine produced would be different, samples isolated from animals contain many different microorganisms, etc.), evidence that a vaccine was produced in large quantities (Ungureanu vaccinated thousands of animals) directly from samples taken from diseased animals would indeed

be a new teaching. But for the reasons discussed above the cited prior art does not provide such a teaching, only grounds for speculation.

B. Requester considers claims 10-13 unpatentable over Gilmour 1991, alone or in combination with one or more of Ungureanu, Tizard, Webster's, the International Dictionary, Black's and the Gilmour patent (proposed SNQs 5, 20 and 21). Gilmour 1991 presents data very similar, if not identical, to that disclosed in the specification of the '166 patent (compare Table 1 of both documents).

The proposed SNQs are based on the premise that claims 10-13 are not entitled to the 1988 priority date because claims reciting "prevention" of pasteurellosis were first presented when application 08/427,692 was filed in 1995. This argument is not persuasive. First, it is noted that 08/427,692 was a continuation of a continuation of the originally filed U.S. patent application. No new matter was added to the specification. The original specification discloses vaccination of animals (p. 3, lines 13-16; p. 4, lines 15-21). With regard to the adjuvant recited in claim 11, the specification discloses the same adjuvant used in Gilmour 1991 (alhydrogel; p. 10, line 2). Thus the claimed subject matter was adequately supported in the specification as filed in 1988. Since Gilmour 1991 does not qualify as prior art, it does not present a SNQ with regard to claims 10-13.

C. Requester considers claims 1, 3, 8, 10-13 and 16-18 unpatentable over Lessley as evidenced by Newman and the Gilmour patent (proposed SNQ 6). Lessley immunized mice with a saline extract of *P. haemolytica* cells, or with fractions (designated antigens) of said extract that were separated by chromatographic techniques. As with the Ungureanu reference, the relevance of the Lessley reference hinges on whether the "vaccine" was produced from bacterial cells grown under iron restriction conditions. Lessley does not state that the cells were grown under iron restriction conditions, but indicates that the cells were obtained from a calf and maintained as described by Newman. In Newman, bacteria were isolated from an animal and maintained in culture, with occasional passage in animals followed by re-isolation in order to maintain virulence. This suggests that the saline extract was not made <u>directly</u> from cells grown *in vivo*. Furthermore, Lessley states that the saline extract was made using bacteria in logarithmic phase (p. 281, first paragraph). Therefore the extract must have been made from bacteria growing in *in vitro* culture, because the determination that they were in logarithmic phase could only have been made using cultured cells. There is nothing in Lessley or Newman that would lead one to believe that the culture medium used was iron restricted. The Gilmour patent does not relate to the Lessley reference, and therefore it does not provide any insight into the nature of the proteins isolated by Lessley. Thus it can not be concluded that the saline extract, nor the "antigen" fractions obtained therefrom, were derived from bacteria grown under iron restricted conditions.

Requester's attempt to show that the Lessley extract contains an antigen identical to the "iron restriction protein" of the '166 application is not convincing. Each "antigen"

produced by Lessley is actually a mixture of several proteins (Figs. 7 and 8). Requester asserts that the extract of Lessley contained the same 70 kD antigen as disclosed in the '166 patent. In discussing Donachie's previous work with sodium salicylate extracts Lessley states, "Results of that study and those of the present study are not readily comparable because of differences in extraction and analytical techniques" (p. 292, second paragraph). Furthermore, the SDS gel and immunoblot of Lessley's Figs. 7 and 8 show that each "antigen" contains a component in the range of 70 kD, but only two of the "antigens" were even moderately effective in protecting mice from subsequent challenge with *Pasteurella* (Table 3). It therefore seems unlikely that the 70 kD component seen in the saline extract is an effective antigen – any protective effect provided by "antigens" 2 and 6 could be attributed to one or more of the other proteins in the extract. There is also no evidence that the 70 kD protein is induced under iron restriction conditions. Finally, even *Pasteurella* cells grown under iron replete conditions produce effective antigens (see col. 1, lines 36-40 of the '166 patent). The mere fact that an immunogenic protein was isolated from *Pasteurella* does not demonstrate that it was the more effective antigen which is produced under iron restriction conditions.

A skilled artisan would not conclude that Lessley discloses bacteria grown under iron restriction conditions, nor antigens obtained therefrom. Accordingly, a reasonable examiner would not consider the combined teachings of the cited references "new" or important in deciding whether the claims are patentable. Therefore Lessley, taken in view of Newman and the Gilmour patent, does not present a SNQ with regard to claims 1-3, 8, 10-13 and 16-18.

The petition argues that the Lessley "vaccine" could have been made directly from cells obtained from diseased animals. This is not persuasive for the reasons discussed in section A above, regarding the Ungureanu reference. Requester further argues that Lessley used cells grown in a "partially *in vivo*" process. This is not persuasive because the method of Newman involves culturing cells *in vitro* with periodic passage through animals (to ensure that virulence is not lost), followed by re-isolation and further *in vitro* culture. To make a rejection based on inherency, one must be certain of what the prior art teaches. In this case, it is not known how long cells were cultured before use. Given the fact that bacterial cells multiply exponentially in culture, how many *in vivo* grown cells remain after a day – or a week, or a month - in culture? Even if a significant number of *in vivo* grown cells remained in a culture, there is no evidence that they would continue to express iron restriction proteins once transferred to iron replete conditions. Reexamination deals in fact, not speculation, and Requester's arguments fail to demonstrate that the Lessley "vaccine" contains the iron restriction protein that is found in *Pasteurella* cells grown under iron restriction conditions *in vitro*.

D. Requester considers claims 1-3, 8, 10-13 and 16-18 unpatentable over Ungureanu in combination with one or more of Tizard, Webster's, the International Dictionary, Black's, Griffiths, Lessley, Newman and the Gilmour patent (proposed SNQs 7-13, 15

and 16). The proposed SNQs are based on different combinations of the references discussed above. For the reasons discussed in sections A and C above, neither Ungureanu nor Lessley can be said to disclose vaccines produced from bacterial cells grown under iron restriction conditions as required by the claims. Absent any such disclosure, none of the various combinations provides a new technical teaching that a reasonable examiner would find important in deciding whether the claims are patentable. Therefore Ungureanu, alone or in combination with one or more of Griffiths, Lessley, Newman, Donachie and the Gilmour patent, does not raise a SNQ with regard to claims 1-3, 8, 10-13 and 16-18.

E. Requester considers claims 1, 3, 10, 12, 16 and 18 unpatentable over the Gilmour patent in combination with Griffiths (proposed SNQ 14). The Gilmour patent was considered in prosecution of both the application that matured into the '166 patent and the subsequent reexamination proceedings that resulted in the reexamination certificate. The Gilmour vaccine uses heat killed bacteria cultured in iron replete conditions. Griffiths did not study *Pasteurella* and did not show that proteins induced under iron restriction conditions are effective antigens. Accordingly, a reasonable examiner would not consider the combined teachings of the cited references "new" or important in deciding whether the claims are patentable. Therefore the Gilmour patent in view of Griffiths does not present a SNQ with regard to claims 1, 3, 10, 12, 16 and 18.

F. Requester considers claims 1-3, 8, 10-13 and 16-18 unpatentable over Lessley alone or in combination with one or more of the Gilmour patent and Newman (proposed SNQs 17-19). The proposed SNQs are based on different combinations of the references discussed above. For the reasons discussed in section C above, Lessley can not be said to disclose vaccines produced from bacterial cells grown under iron restriction conditions as required by the claims. Absent any such disclosure, none of the various combinations provides a new technical teaching that a reasonable examiner would find important in deciding whether the claims are patentable. Therefore Lessley, alone or in combination with one or more of the Gilmour patent and Newman, does not raise a SNQ with regard to claims 1-3, 8, 10-13 and 16-18.

The petition argues that if the Lessley vaccine were made under iron restriction conditions, then the claims would be obvious in view of Ungureanu. This argument is not persuasive because the evidence of record does not show that the product of Lessley was made from cells grown under iron restriction conditions, for reasons discussed at length above.

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

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

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

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

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

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

LEGAL BASIS

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,592; 90/008,879; 90/009,066; and 90/010,462 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

CORRESPONDENCE

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

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

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

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

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

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

CONCLUSION

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

for

Greg Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,593	04/12/2007	6113963	235722000330	7758

25225 7590 06/19/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2009

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

25225 7590 06/19/2009

MORRISON & FOERSTER LLP
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SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT	PAPER NUMBER

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

25225 7590 06/19/2009
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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

PATENT NO. 6113963.

ART UNIT 3991.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Peng Chen and Elizabeth Cary Miller (for Patent Owner)
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

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JUN 1 9 2009
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Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq. (for Third Party)
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

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

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

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

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

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

LEGAL BASIS

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,593; 90/009,068 and 90/010,463 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

CORRESPONDENCE

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

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

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

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

CONCLUSION

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

for Deborah Jones
Greg Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,464	03/23/2009	6372460	2901645-000011	1311

21967 7590 08/05/2009

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/05/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER DONELSON BEARMAN, CALDWELL & BERKOWITZ, PC
555 ELEVENTH STREET, N.W.
SIXTH FLOOR
WASHINGTON, DC 20004

Date:
MAILED
AUG 05 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010464
PATENT NO. : 6342460
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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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

(For Patent Owner)

MAILED

AUG 05 2009

CENTRAL REEXAMINATION UNIT

BAKER DONELSON BEARMAN, CALDWELL
& BERKOWITZ, PC
555 ELEVENTH STREET, NW
SIXTH FLOOR
WASHINGTON, DC 20004

(For Third Party Requester)

In re Gladue *et al.*	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No.: 90/010,464	:	**GRANTING**
Filed: March 23, 2009	:	**PETITION**
For: U.S. Patent No. 6,372,460	:	

This is a decision on patent owner and third party requester's petition paper entitled "JOINT PETITION TO SUSPEND RULES AND FOR EXPEDITED ENTRY OF PATENT OWNER STATEMENT AND REPLY BY THIRD PARTY REQUESTER," filed on May 28, 2009, requesting waiver of 37 CFR 1.530(c) and 37 CFR 1.535 under 37 CFR 1.183 (hereinafter "the joint petition under 37 CFR 1.183").

The petition is before the Office of Patent Legal Administration.

The petition is granted to the extent set forth herein.

FEES

Petitioners paid the $400.00 petition fee pursuant to 37 CFR 1.17(f) for the joint petition under 37 CFR 1.183.

REVIEW OF FACTS

1. U.S. Patent No. 6,372,460 (hereinafter, the '460 patent) issued on April 16, 2002.

2. On March 23, 2009, third party requester filed a request for *ex parte* reexamination of the '460 patent, which proceeding was assigned control no. 90/010,464 (hereinafter "the '10464 proceeding").

3. Third party requester had previously filed a request for *inter partes* reexamination of the '460 patent, which proceeding was assigned control no. 95/000,380 (hereinafter "the '380 proceeding"); however, on April 23, 2009, the Office mailed a "Decision Vacating Filing Date" in the '380 proceeding, stating that the '460 patent is ineligible for *inter partes* reexamination.

4. Reexamination was ordered in the '10464 *ex parte* proceeding on May 8, 2009.

5. On May 28, 2009, patent owner and third party requester filed the instant joint petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.530(c) and 37 CFR 1.535. The petition was accompanied by, among other documents, (1) a copy of patent owner's March 2, 2009 "Response to Notice of Defective Paper in Inter Partes Reexamination, and Amendment in Response to Non-Final Office Action in Inter Partes Reexamination," with accompanying declarations, that had been filed in the now vacated '380 proceeding, and (2) a copy of third party requester's January 27, 2009 "Comments of Requester" that had been filed in the now vacated '380 proceeding.

DECISION

Relevant Statutes and Regulations

35 USC 304 provides:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

37 CFR 1.183 provides:

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

37 CFR 1.530(c) provides:

> Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the *ex parte* reexamination requester in accordance with § 1.248.

37 CFR 1.535 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.

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.

Joint Petition of May 28, 2009

As pointed out above, third party requester had previously filed a request for *inter partes* reexamination of the '460 patent, which proceeding was assigned control no. 95/000,380; however, on April 23, 2009, the Office vacated the filing date of the '380 proceeding, because the '460 patent is ineligible for *inter partes* reexamination. On May 28, 2009, patent owner and third party requester filed, in the present '10464 *ex parte* proceeding, the instant joint petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.530(c) and 37 CFR 1.535. The petition was

accompanied by, among other documents, (1) a copy of patent owner's March 2, 2009 "Response to Notice of Defective Paper in Inter Partes Reexamination, and Amendment in Response to Non-Final Office Action in Inter Partes Reexamination," with accompanying declarations, that had been filed in the now vacated '380 proceeding, and (2) a copy of third party requester's January 27, 2009 "Comments of Requester" that had been filed in the now vacated '380 proceeding.

In particular, patent owner and third party requester both request (i) that the above-referenced March 2, 2009 patent owner paper (as filed in the now vacated '380 *inter partes* proceeding) be treated as patent owner's statement under 37 CFR 1.530 in the '10464 *ex parte* proceeding, and (ii) that the above-referenced January 27, 2009 requester paper (as filed in the now vacated '380 *inter partes* proceeding) be treated as third party requester's reply under 37 CFR 1.535 in the '10464 *ex parte* proceeding. Patent owner and third party requester further request (iii) waiver of the two-month time period for filing requester's reply pursuant to 37 CFR 1.535, to the extent that third party requester's January 27, 2009 paper, a copy of which accompanied the instant petition, is treated as third party requester's reply under 37 CFR 1.535 in the present '10464 *ex parte* proceeding, and (iv) waiver of the service requirement of 37 CFR 1.550(f) for patent owner's March 2, 2009 paper and third party requester's January 27, 2009 paper, copies of which accompanied the instant petition and copies of which were previously served on the parties in the now vacated '380 proceeding.

Moreover, patent owner and third party requester request (v) waiver of the 37 CFR 1.530(c) requirement that "Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations" to the extent that patent owner's March 2, 2009 paper does not address all grounds of rejection that were made by third party requester in its request in the now vacated '380 *inter partes* proceeding, and again in the '10464 *ex parte* request, but not adopted in the first Office action in the now vacated '380 *inter partes* proceeding. Specifically, patent owner and third party requester "agree that the Patentee did not have occasion to comment on such proposed grounds as they were not adopted by the examiner" and further agree "that Patentee has not waived arguments as to any such grounds of rejection, and reserves the right to submit arguments traversing such grounds of rejection should they be asserted at a later time by the Patent Office in this ['10464] *ex parte* reexamination."[1]

Discussion

Pursuant to 35 U.S.C. 304, following an order for *ex parte* reexamination, patent owner may file a statement, including any amendment and new claim or claims, for consideration in the reexamination and must promptly serve the statement on the third party requester. Further, if patent owner files such a statement, third party requester may file a reply within two months from the date of service of patent owner's statement and must promptly serve the reply on patent owner. 37 CFR 1.530 and 1.535 are the regulations that implement 35 U.S.C. 304.

[1] Joint petition at page 2.

Thus, petitioners' requests in the joint petition for waiver of the service requirement of 37 CFR 1.550(f) for patent owner's March 2, 2009 paper and third party requester's January 27, 2009 paper cannot be granted, because the service requirement of the statute (35 U.S.C. 304) cannot be waived. Similarly, petitioners' requests in the joint petition for waiver of the two-month time period requirement of 37 CFR 1.535 for requester's January 27, 2009 paper cannot be granted, because the two-month time period requirement of the statute (35 U.S.C. 304) cannot be waived. However, the following is to be noted. The order granting *ex parte* reexamination was mailed in the '10464 proceeding on May 8, 2009, setting a two-month period from the mailing date of the order for patent owner to file its optional statement, and a two-month period from the date of service of any timely filed patent owner's statement for third party requester to file its optional reply. On May 28, 2009, patent owner and third party requester filed the instant joint petition, accompanied by copies of the documents that are being entered as patent owner's statement under 37 CFR 1.530 and third party requester's reply under 37 CFR 1.535, pursuant to this decision. A certificate of service accompanied the joint petition, stating that the joint petition was served on both parties on May 28, 2009. Accordingly, patent owner's statement under 37 CFR 1.530 and third party requester's comments under 37 CFR 1.535 are deemed to have been timely filed and served.

Petitioners' request for waiver of 37 CFR 1.530(c) is moot, as 37 CFR 1.530(c) would not preclude patent owner from submitting arguments traversing grounds of rejection asserted by the Office in '10464 *ex parte* reexamination that were made by third party requester in its request in the now vacated '380 *inter partes* proceeding, <u>and again in the '10464 *ex parte* request</u>, but not adopted in the first Office action in the now vacated '380 *inter partes* proceeding.

Aside from the above noted considerations, based on the individual facts and circumstances of this case and the requirement that *ex parte* reexamination proceedings be conducted with "special dispatch" pursuant to 35 U.S.C. 305, it is deemed equitable to waive 37 CFR 1.530 and 1.535 in this instance. Thus, the instant joint petition is <u>granted</u> to the extent that (i) the above-referenced March 2, 2009 patent owner paper (as filed in the now vacated '380 *inter partes* proceeding), a copy of which accompanied the instant petition on May 28, 2009, will be entered into the record as patent owner's statement under 37 CFR 1.530 in the '10464 *ex parte* proceeding, and (ii) the above-referenced January 27, 2009 requester paper (as filed in the now vacated '380 *inter partes* proceeding), a copy of which accompanied the instant petition on May 28, 2009, will be entered into the record as requester's reply under 37 CFR 1.535 in the '10464 *ex parte* proceeding.

CONCLUSION

1. The May 28, 2009 joint petition under 37 CFR 1.183 is <u>granted to the extent</u> that the above-discussed patent owner and requester papers <u>will be entered</u> into the record as patent owner's statement under 37 CFR 1.530 and third party requester's reply under 37 CFR 1.535, respectively.

2. Jurisdiction of the '10464 proceeding is being returned to the Central Reexamination Unit for entry of patent owner's statement under 37 CFR 1.530 and third party requester's reply

under 37 CFR 1.535 in the '10464 *ex parte* proceeding in accordance with this decision and for appropriate action by the examiner of record in the '10464 proceeding.

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

Kenneth M. Schor

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

Kenpet7
7-30-09

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.
90/010,467	04/22/2009	6352559	09-213	2481

22852 7590 11/25/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/25/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,467	04/22/2009	6352559	09-213	2481

McDonnell Boehnen Hulbert &
Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/25/2009

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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.
90/010,467	04/22/2009	6352559	09-213	2481

Novak, Druce & Quigg LLP
1300 Eye Street, N.W.
Washington, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/25/2009

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Finnegan, Henderson, Farabow, Garrett & Dunner LLP 901 New York Avenue, NW Washington, DC 20001-4413	:	(For Patent Owner)
McDonnell Boehnen Hulbert & Berghoff LLP 300 Wacker Drive, 32nd Floor Chicago, IL 60606	:	(For Third Party Requester)
In re Church *Ex Parte* Reexamination Proceeding Control No. 90/010,467 Filed: April 22, 2009 For: U.S. Patent No. 6,352,559	:	DECISION ON PETITION UNDER 37 CFR 1.181

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NOV 25 2009

CENTRAL REEXAMINATION UNIT

The paper filed by requester on June 12, 2009, entitled "Petition Under Rule 1.181and 1.515(c) For Review of the Examiner's Order Denying *Ex Parte* Reexamination" [1](hereinafter 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 May 14, 2009.

The Petition is **GRANTED**.

[1] The petition has been filed by a representative from a law firm that differs from the law firm that filed the instant request for reexamination. It is being accepted under the auspices of 37 CFR 1.34. Absent a formal request to have the correspondence address for third party requester changed, this communication and all future communications will continue to be addressed to the correspondence address of record. This time, and only this time, a courtesy copy of this communication will be mailed to the correspondence address of the person filing the petition.

REVIEW OF FACTS

1. U.S. Patent No. 6,352,559 (hereinafter, the '559 patent) issued on March 5, 2002.

2. A request for *ex parte* reexamination was filed by third party requestor on March 24, 2009. A corrected request for *ex parte* reexamination was filed by third party requestor on April 22, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,467 (hereinafter, the '0467 proceeding).

3. Reexamination was requested for claims 1-9, 11-25, 27-41, 43-57 and 59-64 of the '559 patent[2].

4. A Notice of Reexamination Request Filing Date was issued on April 28, 2009.

5. An order denying the request for reexamination for claims 1-9, 11-25, 27-41, 43-47 and 59-64 was mailed on May 14, 2009.

6. On June 12, 2009, the third party requester filed the present Petition under 37 CFR §§ 1.515(c) and 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following four main arguments:

1. The examiner's order improperly focuses on claim patentability instead of the existence of new, non-cumulative technical teachings.
2. The examiner's order fails to accurately identify the so-called "point of novelty" that formed the basis for allowance by the examiner who examined the patent applications that matured into the '559 patent.
3. The examiner's order does not properly address the Pipino disclosures.
4. The examiner's order does not properly construe the '559 patent claims.

[2] The petition filed on June 12, 2009, at page 1, mistakenly omits claims 60-64 from the list of claims for which reexamination was requested.

DECISION

I. Standard of Review

37 CFR 1.515(c) provides for the filing of a petition under 37 CFR 1.181 to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-9, 11-25, 27-41, 43-57 and 59 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 1-9, 11-25, 27-41, 43-57 and 59 of the '559 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 303 reveals that, by statute, *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. If a substantial new question of patentability is found to be raised, an order granting *ex parte* reexamination of the patent is issued.

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,[3] 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.[4] 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."[5,6] 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.

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[3] Public Law 96-517, enacted on December 12, 1980.
[4] This requirement is not applicable to Director ordered reexaminations.
[5] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).
[6] 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

III. Analysis of the Request for Reexamination

The Request sets forth the following substantial new questions (SNQ) of patentability:

(1) Claims 1-9, 12, 13, 17-25, 28, 29, 33-41, 44, 45, 49-57, 60 and 61 are unpatentable under 35 U.S.C. §102 over the Pipino patent.
(2) Claims 1, 7-9, 13, 17, 23, 24, 29, 33, 39-41, 45, 49, 55-57 and 61 are unpatentable under 35 U.S.C. § 103 over the Pipino patent in view of the Pipino paper.
(3) Claims 1-8, 12, 16-22, 24, 28, 32-38, 40, 44, 47-54, 56 and 64 are unpatentable under 35 U.S.C. § 103 over the Pipino patent in view of the Pipino paper and further in view of the Howmedica 1978 catalog.
(4) Claims 1-8, 16-22, 24, 31-38, 40, 47-54, 56 and 64 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of the Howmedica 1982 catalog.
(5) Claims 2, 3, 7-9, 18, 19, 23-25, 34, 35, 39-41, 50, 51, 55 and 57 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of Harris.
(6) Claims 6-9, 11, 13, 22-25, 27, 29, 38-41, 43, 45, 54-57 and 59-61 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of the Howmedica application.
(7) Claims 7-9, 11, 14, 23-25, 27, 30, 39-41, 43, 46, 55-57, 59 and 62 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of Deyerle.
(8) Claims 7-9, 14, 23-25, 30, 39-41, 46, 55-57 and 62 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of Noiles.
(9) Claims 15, 31, 47 and 63 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of the Oh Application.
(10) Claims 16, 32, 47, 48 and 64 are unpatentable under 35 U.S.C. § 103 over Pipino patent in view of the Pipino paper and further in view of the Oh Article.

The Request was denied in the May 14, 2009 Order Denying Request for *Ex Parte* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. With regard to the Pipino patent, which is the primary reference in all of the proposed SNQs, the examiner determined that this publication does not teach anything that was not taught in the prior art of record. Thus, the Pipino patent is stated, in the denial, to be cumulative and not to raise a substantial new question of patentability.

As pointed out above, 37 CFR 1.515(c) provides for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination.

The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

The Director has reviewed the entire record, and has determined that there is at least one substantial new question of patentability presented by the teachings of the Pipino patent for reasons set forth below. Accordingly, the petition is granted, and reexamination is hereby ordered.

Turning to the petition, requester's chief argument is that the examiner "conflated" issues of claim patentability with the question of whether or not reexamination should be ordered.[7] This argument then branches into two prongs: 1) That the examiner improperly focuses on claim patentability instead of the existence of new, non-cumulative teachings and 2) that the "point of novelty" that formed the basis for allowance is not properly identified by the examiner.[8]

At the outset, it is correctly noted by the examiner that the Pipino patent is "old art" that was cited and made of record during the previous prosecution of the application that became the '559 patent.[9] It is also correctly noted by the requester that the fact that a cited document was "signed off on" in a prior proceeding for a patent does not *necessarily* equate to consideration of that document on the record of the proceeding (emphasis added).[10]

With respect to the first prong, a review of the record indicates that the examiner reviewed the prosecution history and did indeed determine what he believed was the "point of novelty" of the '559 patent claims, namely, the "non-captive family concept of acetabular cups."[11] The examiner then stated:

> "for a reference to raise a substantial new question of patentability of the '559 patent claims, it would be necessary for the reference to teach or suggest a two-part prosthetic joint "cup and core" system comprising at least a outer cup and a supply of geometrically different bearing elements ("cores") that are designed to mount within the outer cup element."[12]

The examiner then reviewed the Pipino patent and determined that it did not teach or suggest a "cup and core" system including a set of geometrically different "cores" and therefore, the Pipino reference was merely cumulative to references applied an discussed during the prosecution of the '559 patent, such as FR 2099259.[13]

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[7] Petition filed June 12, 2009 at page 3.
[8] Petition filed June 12, 2009 at pages 3-8.
[9] Denial mailed May 14, 2009 at page 4.
[10] Petition filed June 12, 2009 at page 9, footnote 8.
[11] Denial mailed May 14, 2009 at page 3.
[12] Denial mailed May 14, 2009 at page 4.
[13] Denial mailed May 14, 2009 at pages 4-5.

During reexamination, it is often imperative for the examiner to determine the "point of novelty" of the prior prosecution, e.g., the feature that caused the previous examiner to conclude that the claims were patentable over the prior art. However, it is improper for the examiner to use this "point of novelty" *solely* as the basis for determining whether an SNQ exists. As noted above, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. This new presentation or new light must lead to the existence of 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. There is no requirement that the new presentation or new light *must* equate to the "point of novelty" of the prior prosecution. Accordingly, it is deemed that the correct standard for determining whether the Pipino patent raised an SNQ was not applied in the instant situation.

With respect to the second prong, requester disagrees with the examiner's determination of the "point of novelty" of the '559 patent. A review of the entire extended prosecution history indicates that requester's interpretation of the file history is correct. The "8/1/00 Interview Summary" that the examiner refers to does not discuss a supply of bearing elements from which one element could be selected for use with a femoral head, as is recited in the issued claims. Specifically, the request enumerates the prosecution history, where the patent owner distinguished the invention from the prior art:

> "...non-constrained geometric modularity. . .patentably Distinguishes over all known prior art. . .none of this art Discloses a family of non-constrained bearings, where each Bearing in the family has a different geometrical relationship Between its exterior surface and interior surfaces. Nor does This art appreciate or recognize the unexpected benefits Flowing from the use of a prosthesis assembly employing a Family of geometrically different, non-constrained bearings."[14]

Using this interpretation as the "point of novelty", the corrected request, filed April 22, 2009, clearly sets forth the features of the Pipino patent that raise an SNQ. For example, with respect to claim 1, the request states:

> . . .the Pipino patent (Ex. 1) discloses with respect to '559 claim 1, prosthetic assemblies, joint systems, and methods that comprise a supply, including a plurality of bearing elements (p. 50, *infra*); an outer member having an external surface adapted for securement to bone and an internal engagement surface shaped to receive a bearing element selected from the supply of bearing elements (p. 53, *infra*); each bearing element having an exterior

[14] Corrected request filed April 22, 209 at page 3.

> engagement surface for engagement with the internal engagement surface of the outer member (p. 54, *infra*); each bearing element having an interior surface shaped to engage a femoral head in a non-captive manner (p. 55, *infra*); and each bearing element in the supply being configured to exhibit a geometrical relationship between its exterior and interior surfaces which is different from the relationship of another bearing element in the supply (p. 51, *infra*).[15]

This analysis by requester establishes the necessary new light under which the Pipino patent is considered and properly raises an SNQ.

It is thus concluded that a reasonable examiner would consider the above evaluation of the Pipino patent as important in determining the patentability of claims 1-9, 11-25, 27-41, 43-57 and 59-64 of the '559 patent. As such, it is agreed with requester that the Pipino patent raises a substantial new question of patentability with respect to claims 1-9, 11-25, 27-41, 43-57 and 59-64 of the '362 patent.

Because it is agreed that the Pipino patent raises a SNQ with respect to claims 1-9, 11-25, 27-41, 43-57 and 59-64 of the '559 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested.

CONCLUSION

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

2. Accordingly, the request for *ex parte* reexamination of claims 1-9, 11-25, 27-41, 43-57 and 59-64 of the '559 patent is GRANTED, and reexamination is hereby ordered.

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

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

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served

[15] Corrected request filed April 22, 2009 at page 4.

upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

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

5. Telephone inquiries related to this decision should be directed to Andres Kashnikow Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-8383.

Gregory A. Morse
Director
Central Reexamination Unit

cc: Novak Druce & Quigg, LLP
1300 Eye Street, N.W.
Washington, DC 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

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For Patent Owner

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

Richard D. McLeod
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121 SW Salmon Street, #1600
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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

Ex Parte Reexamination Proceeding
Control No. 90/010,472
Filed: March 26, 2009
For: U.S. Patent No. 5,292,125

DECISION ON PETITION
TO MERGE REEXAMINATION
PROCEEDINGS

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

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.
90/010,476	04/06/2009	6324404	B02.0007REX1	9968

68242 7590 12/30/2009

FIALA & WEAVER, P.L.L.C.
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MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Jeffrey L. Waters
JONES DAY, LLP
1420 Peachtree Avenue, Suite 800
Atlanta, GA 30309

Date: MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010476
PATENT NO. : 6324404
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
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(For Patent Owner)

MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

Jones Day
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(For Requester)

In re Dennison *et alia*	: DECISION DENYING
Reexamination Proceeding	: PETITION UNDER
Control No. 90/010,476	: 37 CFR 1.181 AND
For: U.S. Patent No. 6,324,404	: 37 CFR 1.515(c)

This is a decision on the July 6, 2009 paper entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.515(c)". 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. 6,324,404 (hereinafter, the '404 patent) issued on November 27, 2001 to Dennison *et alia.*

2. On March 30, 2009, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/010,476 (hereinafter, the '10476 proceeding).

3. On April 1, 2009, the office mailed a NOTICE OF FAILURE TO COMPLY WITH *EX PARTE* REEXAMINATION REQUEST FILING REQUIREMENTS.

4. On April 6, 2009, the third party requester deposited a corrected request for *ex parte* reexamination. The corrected requested was granted a filing date.

5. An order granting the request for ex parte reexamination was mailed on June 5, 2009. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for three of the claims for which reexamination was requested (i.e. claims 9, 12, and 13).

6. On July 6, 2009, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '10476 reexamination proceeding has petitioned seeking relief from the examiner's June 5, 2009 Order granting *ex parte* reexamination for less than all claims requested.

35 U.S.C. § 303(c) provides:

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

37 CFR § 1.515(c) provides:

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

MPEP § 2248 provides, in pertinent part:

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

Each decision by the CRU Director will conclude with the paragraph:

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

Initially, it is noted that the petition is not properly signed.

Respectfully submitted,

s/ Mark V. Campagna 42,380 (Reg. No.)

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Petitioner attention is directed to 37 CFR 1.4(d), which states, in part:

(1) Handwritten signature . Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

(i) Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or

(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(2) S-signature . An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by § 1.4(d)(1). An S- signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by a handwritten signature of § 1.4(d)(1). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office electronic filing system as an attachment as provided in § 1.6(a)(4), for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (i.e., with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

(i) 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./); and

(ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

Papers filed by a third party requester which are unsigned or not signed by the third party requester or requester's attorney/agent of record or attorney/agent acting in representative capacity will be denied consideration.

For this reason alone the petition is not grantable and accordingly will be denied.

However, as a courtesy to requester, a cursory review of the petition was made and revealed that the arguments set forth in the petition as to any alleged SNQs are substantially different than what was set forth in the initial and/or corrected requests. It is important to recognize that the examiner's denial of the request as to claims 9, 12, and 13 was based on the record before him when the determination was made. The request outlined each of the seven alleged SNQs in generally the same format, for example:

> "Claims 9, 12-13 and 38 are obvious under 35 U.S.C. § 103 over New Jersey Bell in view of the '482 patent. The combination of New Jersey Bell and the '482 patent discloses, *inter alia*, making call management decisions based on the exact geographic location of the mobile unit, including the customer service requested, and automatically selecting parameters such as call routing or billing rate to complete the call without user input. The Examiner stated that these limitations were not present in the prior art of record. Requestor believes a reasonable examiner would consider this teaching important in determining whether or not the claims are patentable. The detailed explanation for this rejection is set forth below in section III.C.1."

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

The request before the examiner at the time of determination offered little in terms of what requester thought might present a new, non-cumulative technological teaching. The present petition is detailed and points to specific passages within the references that may, in fact, raise an SNQ. However, Petitioner cannot persuasively bootstrap new discussions of the references into establishing a SNQ in the request for reexamination in the '10476 proceeding by now, for the first time in the record, bringing in new discussions of old references directed to these particular teachings via the present petition. If requester wishes to attempt to assert the references in the manner outlined in the present petition, requester is free to do so in a new filing of a reexamination request.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

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

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,477	04/06/2009	6847822	925367-105163-822	1019

68242 7590 04/27/2010

FIALA & WEAVER, P.L.L.C.
C/O CPA GLOBAL
P.O. BOX 52050
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/27/2010

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EXAMINER

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(For Patent Owner)

MAILED

APR 27 2010

CENTRAL REEXAMINATION UNIT

Jones Day
1420 Peachtree Street, N.E.
Suite 800
Atlanta, GA 30309

(For Requester)

In re Dennison *et alia*
Reexamination Proceeding
Control No. 90/010,477
For: U.S. Patent No. 6,847,822

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the July 6, 2009 paper entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.515(c)". 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. 6,847,822 (hereinafter, the '822 patent) issued on January 25, 2005 to Dennison *et alia.*

2. On March 30, 2009, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/010,477 (hereinafter, the '10477 proceeding).

3. On April 1, 2009, the office mailed a NOTICE OF FAILURE TO COMPLY WITH *EX PARTE* REEXAMINATION REQUEST FILING REQUIREMENTS.

4. On April 6, 2009, the third party requester deposited a corrected request for *ex parte* reexamination. The corrected request was granted a filing date.

5. An order denying the request for *ex parte* reexamination was mailed on June 5, 2009. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

6. On July 6, 2009, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '10477 reexamination proceeding has petitioned seeking relief from the examiner's June 5, 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, 9-14, 21-27, 31, 32, and 34-37 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

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

37 CFR § 1.515(c) provides:

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

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the

examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '822 Patent

The '822 patent issued on January 25, 2005. During the prosecution of the '822 patent, the Examiner indicated that claims 1 and 9 (original claims 66 and 74) were allowable because the cited prior art did not teach or suggest:

> "means in said management means for making data management decision based on said comparison and means for routing a call from the mobile unit to an element selected by said mobile unit based on the exact geographic location of the mobile unit." *'822 Patent, Non-Final Action mailed 3/12/04, Pages 3-4.*

The Examiner later issued a notice of allowance and indicated that claims 10, 24, and 34-37 (originally 75, 89, and 99-102) were allowable because the cited prior art did not teach or suggest:

> "a positioning system obtaining a position for said specific mobile unit identifying an exact geographic location of the specific mobile unit, a data storage system for recording said exact geographic location and [sic] specific mobile unit identification for use in subsequent services." *'822 Patent, Notice of Allowability mailed 6/29/04, Page 2.*

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, has been made as to whether the April 6, 2009 request for ex parte reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '822 patent filed in the '10477 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner first requests reconsideration of whether the claims of the '822 patent were sufficiently supported by the disclosure of the '445 and '633 patent. In the order denying reexamination, the Examiner found that the '822 patent was sufficiently supported by the '445 and '633 patent. As a result, priority for the '822 patent extended to Dec 26, 1991 and the newly cited Chapman, Grimes, Newman, Lardner, and Loomis references did not qualify as prior art. Petitioner asserts that the reexamination Examiner erred and the '822 patent is only entitled to priority to March 21, 1996.

To be entitled to priority under 35 U.S.C. 120, the previously filed application of the parent patent must comply with 35 U.S.C. 112, first paragraph. Specifically:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States... shall have the same effect, as to such invention, as though filed on the date of the prior application ....
>
> 35 U.S.C. 112, first paragraph, in turn, requires the written description of the application describe the claimed invention with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991). See also MPEP § 2163.

Beginning with claim 1, Petitioner asserts that the '633 and '445 patent specifications do not support the limitations of claim 1. The request states that '633 patent and the '445 patent:

> [did not] "include any discussion of means for making a data management decision. In fact, the applications do not even include the term data management decision. Rather, the disclosure of both applications is limited to call management decisions such as hand-offs between cellular towers." *See Request for Reexamination, Pages 12-13.*

While the '633 patent and '445 patent do not use the term "data management decision," the '633 patent describes the limitations of claim 1 with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The '633 patent describes "means for making a data management decision based on said comparison" where the comparison is "between the exact geographic location of the mobile unit and the land based data stored in said management means" (*'633 patent, column 6 lines 27-37*). The '633 patent sufficiently describes the claimed data management decision by teaching a mobile telephone switching office (MTSO) receiving the exact geographic location of a mobile phone and comparing that location with a look-up table of cell site locations in order to route the mobile call to the most appropriate cell site (*'633 patent, column 6 lines 27-37)*. Thus, the '633 patent's

data management decision compares the mobile phone location to the cell site locations to determine the proper cell site to service the mobile phone. Accordingly, the '633 patent describes the claimed invention with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention and claim 1 is properly entitled to priority back to Dec 26, 1991.

Moving on to claim 9, Petitioner asserts that the '633 and '445 patent specifications do not support the limitations of claim 9. The request states:

> "Claim 9 of the '822 patent recites "means for making a data management decision based on said comparison ..." and "means for automatically routing information based services requested for said mobile unit." Neither application no. 07/813,494 nor application no. 08/555,844 include any discussion of means for making a data management decision. In fact, the applications do not even include the term data management decision. Rather, the disclosure of both applications is limited to call management decisions such as hand-offs between cellular towers. Likewise, neither application no. 07/813,494 nor application no. 08/555,844 include any disclosure relating to, or even use the term, information based services.

While the '633 patent and '445 patent do not use the term "data management decision," the '633 patent describes the limitations of claim 9 with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The '633 patent describes "means for making a data management decision based on said comparison ..." and "means for automatically routing information based services requested for said mobile unit" by teaching a mobile telephone switching office (MTSO) receiving the exact geographic location of a mobile phone and comparing that location with a look-up table of cell site locations in order to route the mobile call to the most appropriate cell site (*'633 patent, column 6 lines 27-37).* Thus, the '633 patent's data management decision compares the mobile phone location to the cell site locations to determine the proper cell site to service the mobile phone. Accordingly, the '633 patent describes the claimed invention with sufficient particularity that one skilled in the art would reasonably conclude that the inventor had possession of the claimed invention and claim 9 is properly entitled to priority back to Dec 26, 1991.

Moving on to claims 10, 24, and 34-37, Petitioner asserts that the '633 specification does not support the limitations of claims 10, 24, and 34-37. Petitioner argues that "[t]he '633 patent contains no disclosure of a "data storage system" for recording the "exact geographic location and specific mobile unit identification." The request states:

> "Claims 10, 24 and 34-37 of the '822 patent recite, inter alia, "recording said exact geographic location and specific mobile unit identification for use in subsequent

> services." Neither application no. 07/813,494 nor application no. 08/555,844 disclose recording said exact geographic location and specific mobile unit identification for use in subsequent services. Rather, the applications only mention that the recording of information associated with the call could be used for billing or taxing, not in association with providing location based services to the cellular phone.
>
> In its opening Markman brief, Emsat asserts that the term "subsequent service" should be construed to mean "A service that obtains the recorded exact geographic location and mobile unit identification after completion of the communication process that recorded them." Ex. P at Pg. 7. Emsat contends that this construction is supported by Fig. 11A and '633 Patent, Col. 3, 11.26- 28, Col. 2, 11.62-66, Col. 6, 11.54-56. Requestor submits that Emsat's construction of the term "subsequent service" is improper and that the '633 patent does not provide sufficient enabling written description to support the Emsat's proposed construction of "subsequent service." *Request for Reexamination, page 13.*

The '633 patent describes the limitations of claims 10, 24 and 34-37 with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The '633 patent describes "recording said exact geographic location and specific mobile unit identification for use in subsequent services" by disclosing a mobile telephone switching office (MTSO) receiving the exact geographic location of a mobile phone and comparing that location with a look-up table of cell site locations in order to route the mobile call to the most appropriate cell site (*'633 patent, column 6 lines 27-37; column 3 line 62 – column 4 line 13).* The claimed "subsequent service" is adequately supported by the providing of cellular service. This is consistent with the broadest reasonable interpretation of the term "subsequent services" and with the patent owner's construction of "subsequent service" as a service that obtains the recorded exact geographic location and mobile unit identification after completion of the communication process that recorded them. "Subsequent services" is sufficiently described because the cellular service is provided after recording the exact location of the mobile phone to determine the proper cell site to service the mobile phone. Accordingly, the '633 patent describes the claimed invention with sufficient particularity that one skilled in the art would reasonably conclude that the inventor had possession of the claimed invention and claims 10, 24 and 34-37 are properly entitled to priority back to Dec 26, 1991.

Turning to the question of whether a SNQ was raised by the request, the request alleges that a SNQ is raised by the following references:

U.S. Patent No. 5,504,491 to Chapman
U.S. Patent No. 5,479,482 to Grimes
U.S. Patent No. 5,043,736 to Darnell et al.
U. S. Patent No. 5,835,907 to Newman
U. S. Patent No. 5,594,425 to Ladner et al.
U. S. Patent No. 5,625,668 to Loomis et al.
Gojanovich, B.K. et al., New Jersey Bell Network Proposal

As noted above, the requestor has not shown that the priority claim of the '822 patent is improper. The '822 patent has a priority claim to Dec 26, 1991. As a result, the Chapman, Grimes, Newman, Lardner, and Loomis references are not prior art to the '822 patent and would not be important to a reasonable examiner in determining patentability for that reason. The remaining references, Darnell and Gojanovich have not previously been considered.

First turning to Darnell, Petitioner asserts that Darnell teaches every claim limitation of claims 10-14, 24-27, and 34-37 and thus a reasonable examiner would have considered Darnell important in determining whether or not the claim is patentable. The request states:

> "The '736 patent raises substantial new questions of patentability in that it discloses technical teachings substantially different from the prior art considered during prosecution of the '822 patent and accordingly not considered in the original examination of the patent by the Examiner. The '736 patent discloses, inter alia, a data storage system for recording the exact geographic location of a mobile unit, which the Examiner stated was not present in the prior art of record. Requestor believes a reasonable examiner would consider this teaching important in determining whether or not the claims are patentable." *Request for Reexamination, page 8.*

The request does not raise a SNQ with respect to Darnell because the request does not establish that Darnell teaches the features that distinguished the '822 patent over the prior art. During prosecution of the '822 patent, the Examiner stated that the cited prior art did not teach a positioning system obtaining a position for said specific mobile unit identifying an exact geographic location of the specific mobile unit, a data storage system for recording said exact geographic location and [sic] specific mobile unit identification for use in subsequent services." *'822 Patent, Notice of Allowability mailed 6/29/04, Page 2.* The request does not establish that Darnell discloses these features and thus Darnell would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '822 patent.

Darnell does not teach the distinguishing features because Darnell does not teach the claimed "data storage system." The request correctly points out that Darnell teaches the determining of the exact geographic location. However, the request does not establish that Darnell teaches a data storage system for recording the exact geographic location and specific mobile unit identification. Darnell only discloses the transmission of a location to a base station for displaying the location on a map. There is no specific disclosure of the storage of the specific mobile unit identification. Accordingly, Darnell would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '822 patent.

Turning to Gojanovich, Petitioner asserts that Gojanovich in combination with the submitted intervening references raises a SNQ regarding claims 1 and 9. The request states that Gojanovich (referred to as New Jersey Bell) discloses:

> "means in said management means for making data management decision based on said comparison and means for routing a call from the mobile unit to an element selected by said mobile unit based on the exact geographic location of the mobile unit." *Request for Reexamination, pages 9-10.*

> "New Jersey Bell discloses an emergency calling system for use with cellular telephones. New Jersey Bell at 12. The system stores information regarding cell site locations in a database and uses the cell site locations to selectively route incoming emergency calls to a public-safety answering point (PSAP) based on the location of the cell site handling the cell phone making the emergency call Id. at 12-13. New Jersey Bell contemplates enhancements to subdivide cells into smaller units for PSAP transfer. Id. at 14." *Request for Reexamination, page 61.*

These features of Gojanovich do not teach the features that distinguished the '822 patent over the prior art. Gojanovich's teachings differ from the claimed invention's comparing and automatic routing steps because the exact geographic location is not determined. Gojanovich does "not specifically identify the location of the mobile telephone" and at most "will narrow down the geographic area from which the call originated" (*Gojanovich, Page 13*). Thus there can be no comparison of the exact geographic location as claimed or the automatic routing based on the comparison. Accordingly, Gojanovich would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '822 patent.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

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

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,478	04/06/2009	7289763	925367-105163-763	1043

68242 7590 05/26/2010
FIALA & WEAVER, P.L.L.C.
C/O CPA GLOBAL
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MINNEAPOLIS, MN 55402

EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,478	04/06/2009	7289763	925367-105163-763	1043

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EXAMINER

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(For Patent Owner)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Jones Day
1420 Peachtree Street, N.E.
Suite 800
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(For Requester)

In re Dennison *et alia*
Reexamination Proceeding
Control No. 90/010,478
For: U.S. Patent No. 7,289,763

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the July 6, 2009 paper entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.515(c)". No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 7,289,763 (hereinafter, the '763 patent) issued on October 30, 2007 to Dennison *et alia.*

2. On March 30, 2009, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/010,478 (hereinafter, the '10478 proceeding).

3. On April 1, 2009, the office mailed a NOTICE OF FAILURE TO COMPLY WITH *EX PARTE* REEXAMINATION REQUEST FILING REQUIREMENTS.

4. On April 6, 2009, the third party requester deposited a corrected request for *ex parte* reexamination. The corrected request was granted a filing date of April 6, 2009.

5. An order denying the request for *ex parte* reexamination was mailed on June 5, 2009. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

6. On July 6, 2009, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '10478 reexamination proceeding has petitioned seeking relief from the examiner's June 5, 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, 9-13, 20, 21, and 23-32 was correct.

The following rules and procedures are applicable to this review:

> 35 U.S.C. § 303(c) provides:
>
> A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.
>
> 37 CFR § 1.515(c) provides:
>
> The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."
>
> MPEP § 2248 provides, in pertinent part:
>
> If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU

Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '763 Patent

The '763 patent issued on October 30, 2007. During the prosecution of the '763 patent, the Examiner indicated that claims 1, 9 and 23 were allowable because:

> "With respect to claim 1...a search of the prior art does not specifically disclose wherein a updating response system responsive to an inaccuracy in the geographic location associated with the mobile unit identification number that exceeds an interval defined by said updating system." *'763 Patent, Notice of Allowance mailed 8/22/2007, Page 3.*
>
> "With respect to claim 9...the prior art does not specifically disclose the positioning system obtaining a position for said specific mobile unit identifying an exact geographic location of the specific mobile unit, and forwarding said exact geographic location and specific mobile unit identification for use in subsequent services." *'763 Patent, Notice of Allowance mailed 8/22/2007, Pages 3-4*
>
> "With regards to claim 23... the prior art does not disclose wherein an acquiring positional data corresponding to an exact geographical location for the mobile unit via the cellular system; comparing the positional data with stored geographic data for the location based service; and responding to the request for a location based service based on the comparison." *'763 Patent, Notice of Allowance mailed 8/22/2007, Page 4*

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, has been made as to whether the April 6, 2009 request for ex parte reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate

decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '763 patent filed in the '10478 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner sets forth the following arguments in support of the granting of this petition:

(A) The Examiner erred in finding that the claims of the 7,289,763 ("the '763 patent") were sufficiently supported by the disclosure of U.S. Patent Nos. 5,546,445 ("the '445 patent) and 5,235,633 ("the '633 patent").

(B) The intervening prior art references, which were not previously considered by the PTO, raise a substantial new question of patentability.

(C) The pre-1991 reexamination references, which were not previously considered by the PTO, raise a substantial new question of patentability.

(D) The Examiner did not consider the obviousness arguments made in the reexamination request.

A. The request does not show that the priority claim of claims 9 and 23 of the '763 patent is improper.

Petitioner first requests reconsideration of whether claims 9 and 23 of the '763 patent were sufficiently supported by the disclosure of the '445 and '633 patent. In the order denying reexamination, the Examiner found that claims 9 and 23 (and all claims dependent therefrom) of the '763 patent was sufficiently supported by the '445 and '633 patent. The Examiner further found that claim 1 and its dependents were not sufficiently supported to have priority to the '445 and'633 patents. As a result, priority for claims 9 and 23 of the '763 patent extended to Dec 26, 1991 and the newly cited Chapman, Grimes, Newman, Lardner, Loomis, and Schipper references did not qualify as prior art. Petitioner asserts that the reexamination Examiner erred and that every claim of the '763 patent is only entitled to priority to March 21, 1996.

To be entitled to priority under 35 U.S.C. 120, the previously filed application of the parent patent must comply with 35 U.S.C. 112, first paragraph. Specifically:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States... shall have the same effect, as to such invention, as though filed on the date of the prior application ....
>
> 35 U.S.C. 112, first paragraph, in turn, requires the written description of the application describe the claimed invention with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991). See also MPEP § 2163.

Beginning with claim 9, Petitioner asserts that the '633 and '445 patent specifications do not support the limitations of claim 9. The request states:

> "Claim 9 of the '763 patent recites a "a positioning system obtaining a position for said specific mobile unit identifying an exact geographic location of the specific mobile unit, and forwarding said exact geographic location and specific mobile unit identification for use in subsequent services." Application no. 07/813,494 and application no. 08/555,844 fail to provide written description support for the subject matter of claim 9. Specifically, application no. 07/813,494 and application no. 08/555,844 only mentions recording information associated with the call for billing or taxing, not in association with providing location based services to the cellular phone. As shown in Exhibit I, the forwarding of the position for uses in subsequent services, subsequent calls, was added to the specification at page 20, lines 25 through 28.
>
> In its opening Markman brief, Emsat asserts that the term "subsequent service" should be construed to mean "A service that obtains the recorded exact geographic location and mobile unit identification after completion of the communication process that recorded them." Ex. Q at Pg. 7. Emsat contends that this construction is supported by Fig. 11A and '633 Patent, Col. 3, 11.26- 28, Col. 2, 11.62-66, Col. 6, 11.54-56. Requestor submits that Emsat's construction of the term "subsequent service" is improper because the '633 patent does not provide sufficient enabling written description to support Emsat's proposed construction." *See Request for Reexamination, Page 18.*

The '633 patent describes the limitations of claim 9 with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The '633 patent describes "a positioning system obtaining a position for said specific mobile unit identifying an exact geographic location of the specific mobile unit, and forwarding said exact geographic location and specific mobile unit identification for use in subsequent services" by disclosing a mobile telephone switching office (MTSO) receiving the exact geographic location of a mobile phone and comparing that location with a look-up table of cell site locations in order to route the mobile call to the most appropriate cell site and using the location for communication or emergency based services (*'633 patent, column 6 lines 27-37; column 3 line 62 – column 4 line 13).* The claimed "subsequent service" is adequately supported by the providing of cellular service or the providing of emergency services. This is consistent with the broadest reasonable interpretation of the term "subsequent services" and with the patent owner's construction of "subsequent service" as a service that obtains the recorded exact geographic location and mobile unit identification after completion of the communication process that recorded them. "Subsequent services" is sufficiently described because the cellular service is provided after recording the exact location of the mobile phone to determine the proper cell site to service the mobile phone. Accordingly, the '633 patent describes the claimed invention with sufficient particularity that one skilled in the art would reasonably conclude that the inventor had

possession of the invention of claim 9 and thus claim 9 is properly entitled to priority back to Dec 26, 1991.

Moving on to claim 23, Petitioner asserts that the '633 specification does not support the limitations of claim 23. Petitioner argues that "[t]he '633 patent does not provide an enabling disclosure for "receiving a request for a location-based service," "comparing the position data with stored geographic data for the location-based service," and "responding to the request for a location-based service based on the comparison." The request states:

> "Claim 23 of the '763 patent recites a "receiving a request for a location-based service from the mobile unit; acquiring positional data corresponding to an exact geographic location for the mobile unit via the cellular communication system; comparing the positional data with stored geographic data for the location-based service; and responding to the request for a location-based service based on the comparison." Application no. 07/813,494 and application no. 08/555,844 fail to provide written description support for the subject matter of claim 23. Specifically, neither application no. 07/813,494 nor application no. 08/555,844 include any discussion of providing any location-based services to the mobile unit.
>
> In its opening Markman brief, Emsat asserts that the term "location-based service" should be construed to mean "A service that provides information based at least in part on the location of the requesting mobile unit." Ex. Q at Pg. 23. Emsat contends that this construction is supported by Fig. 11A and '633 Patent, Col. 6, 11.54-56. Requestor submits that Emsat's construction of the term "location-based service" is improper because the '633 patent does not provide sufficient enabling written description to support Emsat's proposed construction." *Request for Reexamination, pages 18-19.*

While the '633 patent and '445 patent do not use the term "location-based service," the '633 patent describes the limitations of claim 9 with sufficient particularity that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The '633 patent describes "receiving a request for a location-based service from the mobile unit; acquiring positional data corresponding to an exact geographic location for the mobile unit via the cellular communication system; comparing the positional data with stored geographic data for the location-based service; and responding to the request for a location-based service based on the comparison" by teaching a mobile telephone switching office (MTSO) receiving the exact geographic location of a mobile phone and comparing that location with a look-up table of cell site locations in order to route the mobile call to the most appropriate cell site to provide cellular service or the providing of emergency based services using location data (*'633 patent, column 6 lines 27-37 and lines 54-56; column 3 line 62 – column 4 line 13).* Thus, the '633 patent's location-based service compares the mobile phone location to the cell site locations to determine the proper cell site to service the mobile phone or to provide emergency services. Accordingly,

the '633 patent describes the claimed invention with sufficient particularity that one skilled in the art would reasonably conclude that the inventor had possession of the claimed invention and claim 23 is properly entitled to priority back to Dec 26, 1991.

Accordingly, Petitioner has not shown that the priority claim of claims 9 and 23 of the '763 patent is improper. As a result, the Chapman, Grimes, Newman, Lardner, Schipper, and Loomis references are not prior art to claims 9 and 23 of the '763 patent and would not be important to a reasonable examiner in determining patentability for that reason. The remaining references, Patel and Gojanovich have not previously been considered and have priority dates that precede the priority date of the '763 patent.

(B) The intervening prior art references do not raise a substantial new question of patentability.

Petitioner next requests reconsideration of whether the intervening reference Grimes, Chapman, Ladner, Loomis, Newman, and Schipper references would have been considered important in deciding whether or not the claims of the '763 patent are patentable. As noted above, Petitioner has not shown that the priority claim of claims 9 and 23 of the '763 patent is improper. As a result, the Chapman, Grimes, Newman, Lardner, Schipper, and Loomis references are not prior art to claims 9 and 23 of the '763 patent and would not be important to a reasonable examiner in determining patentability for that reason.

Turning to claim 1, the request does not raise a SNQ with respect to the Grimes, Chapman, Ladner, Loomis, Newman, and Schipper references because either the request does not establish that these references teach the distinguishing features of claim 1 or the teachings are cumulative to prior art already on the record. The critical feature that defined claim 1 over the prior art of record was "an updating response system responsive to an inaccuracy in the geographic location associated with the mobile unit identification number that exceeds an interval defined by said updating system." *'763 Patent, Notice of Allowance mailed 8/22/2007, Page 3.*

Turning first to Grimes, the request sets forth that Grimes teaches the distinguishing feature by disclosing:

> "In addition, controller 301 constantly monitors the geo- coordinates by accessing GPS device 302 on an on-going basis. If the coordinates are changing, controller 301 transmits the direction and rate at which the coordinates are changing via voice messages to the assigned agent plus the new coordinates at predefined time intervals." Col. 7, 11.22-28.
>
> "With the exception, that block 626 periodically allows the execution of blocks 621 through 625. These latter blocks allow the agent to manually enter either geo- coordinates or location information and to have the location information displayed on the agent's terminal. Block 622 converts the geo-coordinates into the location information." Col. 9, 11. 17-25.

> "After the previously described blocks have been executed, blocks 1327 through 1333 are continuously executed until the call is terminated. Decision block 1327 checks to see if location button 307 has been actuated. If the latter button has been actuated, block 1328 transmits the location information again in digital form." Col. 16, 11. 12-17.
>
> "In order to determine if cellular terminal 133 is in motion, block 1329 obtains the geo-coordinates from GPS device 302 and converts those coordinates to location information, and decision 1331 determines from the location information whether cellular terminal 133 is in motion. If cellular terminal 133 is in motion, block 1332 transmits the rate and direction of the change plus the new location information to PSAP 117 in the form of a digital message." Col. 16, 11. 18-25.
>
> "FIG. 1 shows a typical cellular telephone unit having a unique mobile identification number stored in a suitable location such as an electrically erasable programmable read-only memory [not shown]. Telephone units of this kind are known to those skilled in this art, and thus will not be described in detail." Admitted Prior Art U.S. Patent No. 7,289,763, col. 2, 11. 18-23. *Request for Reexamination, Exhibit K, Pages 1-2.*

Grimes' technical teachings are cumulative to the teachings set forth by at least US Patent No. 5,356,415 (hereafter "Wang") that was considered in the previous examination. Grimes teaches the updating of a mobile unit's location at set intervals. However, Wang discloses similar technical features such as the updating of a mobile unit's location at set intervals (*Wang, Abstract; column 3 lines 14-61)*. Wang's system continually checks the location of a mobile unit and determines if there is an inaccuracy in the location data stored at the network due to the mobile unit passing a boundary and if so, updates the network with the new location. These technical features of Wang were considered in a previous examination. Grimes' teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in the previous examination. Accordingly, Grimes would not be important to a reasonable examiner in determining the patentability of claim 1 and all claims dependent therefrom.

Turning next to Chapman, the request sets forth that Chapman teaches the distinguishing feature by disclosing:

> "The invention provides a global status and position reporting system for a remote unit having a status and position transmit/receive unit with at least one status and/or event input connected to a respective status and/or event sensor for reporting at least one system status and/or event and position of the remote unit, and a status output connected to a communication interface; at least one base unit adapted for receiving a status and position report, disposed at a position spaced away from the remote unit; position independent communications means including communications interfaces respectively disposed in the remote unit and in the base unit for transmitting a status and position report from the remote unit to the base unit upon receipt of an activating prompt from the status sensor or a prompt initiated at the base unit. A global positioning satellite receiver is provided in the remote unit for receiving global positioning information from a system

of global positioning satellites having a position output connected to the communications means for entering position information upon receiving the activating prompt." Col. 2, 11. 18-37.

"The remote unit 1 further includes a global positioning satellite receiver GPS 13 receiving continuous position information for the remote unit from a system of GPS satellites 7 in accordance with, for example, the currently installed GPS satellite system. The GPS receiver transmits the continuously updated position information for the remote unit to a base unit selection facility 12, which enables the remote unit to transmit status information from status sensors 16 for the remote unit to a selected one of the base units 6,6', selected in response to base unit selection data determined by the base selection facility 12." Col. 4, 11.38-48.

"FIG. 3 further shows a time and position deviation table 25 which stores anticipated locations combined with respective times for the remote unit. The time and position deviation table 25 is advantageously arranged such that the anticipated position coordinates, e.g. longitude and latitudes of the remote unit, are entered into the table, and each coordinate point of the table contains stored in memory an anticipated time value within which the remote unit is anticipated to be located. Any deviation in real time from the stored time value will be reported as a reportable status. It follows that a given deviation tolerance is also to be applied to the time deviation before a deviation is reported. The allowable tolerances may be variable stored parameters, or it can be a fixed parameter. Also, any deviation in actual position from an anticipated position stored in the time and position deviation table can be a reportable status. The actual position is known from the GPS receiving unit 13, and actual time, including date, is obtained from a time and date circuit 35 connected to the CPU 36. Also, a given allowable deviation in position can be stored in the time and position deviation table 25." Col. 6, 11.47-67.

"The operator may manually respond from keyboard 128 with an actuation order which is adapted to generate an actuation in the remote unit via the remote unit actuation circuit 50 in FIG. 3. If no operator is present or available as indicated by a time-out before an operator response, or in response to the operation of a No-Operator (NO) switch 132 on the operator console, the status information with the position information and remote unit identity code is stored in the status and actuation order memory 131. If an actuation order, which is pertinent to the received status and remote unit identity code, the actuation order will be transmitted back to the responding remote unit as described above." Col. 8, 11. 41-52.

"FIG. 1 shows a typical cellular telephone unit having a unique mobile identification number stored in a suitable location such as an electrically erasable programmable read-only memory (not shown). Telephone units of this kind are known to those skilled in this art, and thus will not be described in detail." Admitted Prior Art U.S. Patent No. 7,289,763, col. 2, 11. 18-23. *Request for Reexamination, Exhibit L, Pages 2-4.*

Chapman's technical teachings are cumulative to the teachings set forth by at least the Wang reference in the previous examination. Chapman does teach the updating of a mobile unit's location when there is some deviation from the expected location. However, Wang discloses similar technical features such as the updating of a mobile unit's location at set intervals when the mobile unit's location deviates from the location expected by the network (*Wang, Abstract; column 3 lines 14-61)*. Wang's system determines if there is an inaccuracy in the location data stored at the network due to the mobile unit passing a boundary and if so, updates the network with the new location. These technical features of Wang were considered in a previous examination. Chapman's teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in the previous examination. Accordingly, Chapman would not be important to a reasonable examiner in determining the patentability of claim 1 and all claims dependent therefrom.

Turning next to Ladner, the request sets forth that Ladner teaches the distinguishing feature by disclosing:

> "Data processor station 18 can also perform a tracking and extrapolation function. Control computer 26 in portable locator 12 is programmed to periodically store additional information in memory 25 at predetermined time intervals. In a preferred embodiment, the position information is updated in memory 25 every five seconds. However, it should be noted that any suitable interval can be programmed into control computer 26." Col. 6, 11.40- 48.
>
> "The GPS receiver 24 decodes the satellite information and provides the decoded position information in digital form to control computer 26. Control computer 26 stores the position information in memory 25, along with the time and date when the position information was received. In the preferred embodiment, control computer 26 stores fifty sets of position information in memory 25, at predetermined time intervals, and then updates the information in memory 25 by erasing the oldest information in memory 25 and replacing it with the newest position information." Col. 4, 11.20-29. *Request for Reexamination, Exhibit M, Page 2.*

Ladner's technical teachings are cumulative to the teachings set forth by at least the Wang reference in the previous examination. Ladner does teach the updating of a mobile unit's location at set intervals. However, Wang discloses similar technical features such as the updating of a mobile unit's location at set intervals (*Wang, Abstract; column 3 lines 14-61)*. Wang's system determines if there is an inaccuracy in the location data stored at the network due to the mobile unit passing a boundary and if so, updates the network with the new location. These technical features of Wang were considered in the previous examination. Ladner's teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in the previous examination. Accordingly, Ladner would not be important to a reasonable examiner in determining the patentability of claim 1 and all claims dependent therefrom.

Turning next to Loomis, the request sets forth that Loomis teaches the distinguishing feature by disclosing:

> "Another service provided by system 10 is polling the whereabouts of the cellular telephone 12, e.g., a telephone number associated with cellular telephone 12 and an access code to release such information. In such scenarios, the database processing facility 22 accesses the cellular telephone 12 through the nearest cellular station 20, and causes the cellular transceiver 16 to answer but not ring the handset. Such a function is conventionally provided by FAX modems which do a silent answer to see if a FAX machine is calling in. GPS receiver 14 then provides latitude, longitude and bearing information which is converted by database processing facility 22 into terms useful to lay persons, e.g., 'North-bound on Highway 101 near the Mathilda interchange in Sunnyvale, Calif.'. Such responses are preferably spoken automatically with a speech synthesizer to obviate the need for special equipment by the caller. However, an automated polling system with a digital information input for position and bearing data are useful in a real-time fleet dispatch system, such as police and fire response dispatching where each mobile unit is equipped with a cellular telephone 12." Col. 4, ll.7-28.
>
> "Database 87 is a zip code database that includes relational data for each mailing code in a regional geographic area and the earth navigation locations of such areas and their corresponding numbers." Col. 5:. ll. 26-30.
>
> "FIG. 1 shows a typical cellular telephone unit having a unique mobile identification number stored in a suitable location such as an electrically erasable programmable read-only memory [not shown]. Telephone units of this kind are known to those skilled in this art, and thus will not be described in detail." Admitted Prior Art U.S. Patent No. 7,289,763, col. 2, ll. 18-23. *Request for Reexamination, Exhibit N, Page 2.*

These features of Loomis fail to teach the features that distinguished claim 1 of the '763 patent over the prior art. While Loomis teaches the polling of a cellular telephone to determine its location, Loomis fails to teach an updating response system *responsive to an inaccuracy* in the geographic location associated with the mobile unit identification number that exceeds an interval defined by said updating system. The request does not set forth any teachings of Loomis which meet the requirements of a response to an inaccuracy that exceeds an interval. Accordingly, Loomis would not have been important to a reasonable examiner in determining the patentability of claim 1.

Turning next to Newman, the request sets forth that Newman teaches the distinguishing feature by disclosing:

> "Alternatively, step 204 shows the emergency PCS device 100 utilizing an internal clock to keep track of time for receiving signals from the GPS satellites. At the expiration of a predetermined, user-selected time period, the emergency PCS device 100 will request its coordinates from the GPS satellites. Thus, in step 206, a decision is made on whether the time period has expired. This decision is important because it prevents the emergency PCS device 100 from constantly determining its coordinates and expending PCS resources in updating the database. If the time period has expired, the emergency PCS device 100 will update its coordinates using the GPS satellite signals. Otherwise, the process is returned to step 204 in order to wait for the expiration of the time period." Col. 7, 11. 1-14.
>
> "Once the emergency PCS device 100 has determined its coordinates using GPS, it accesses a PCS system in step 212. Through this access, the emergency PCS device 100 can interface with a computer network to store the device's distinct coordinates. An identification number of the emergency PCS device 100 is transmitted along with its coordinates, as well as the emergency signal if applicable, as shown in step 214." Col. 7, 11. 15-21.
>
> Column 304 illustrates a periodic update based on the subscriber's movement. The centralized database may be updated every five minutes, for example, depending on the subscriber's requirements. In the illustrative example, the periodic update shows that after five minutes from the previous update, the subscriber is now located at 130 Elm Street, New Orleans, La., USA, which is a few blocks from the previous location." Col. 8, 11. 15-22.
>
> "As shown in column 300, prior to its activation the emergency PCS device 100 keeps only the current time and its assigned identification number designated as WEPD (wireless emergency PCS device) ID in a non\- volatile memory." Col. 7, 11.62-67. *Request for Reexamination, Exhibit O, Pages 2-3.*

Newman's technical teachings are cumulative to the teachings set forth by at least the Wang reference in the previous reexaminations. Newman does teach the updating of a mobile unit's location after a time period expires. However, Wang discloses similar technical features such as the updating of a mobile unit's location at set intervals (*Wang, Abstract; column 3 lines 14-61).* Wang's system determines the location of the mobile unit at set intervals. Next, Wang's system determines if there is an inaccuracy in the location data stored at the network due to the mobile unit passing a boundary and if so, updates the network with the new location (*Wang, Abstract; column 3 lines 14-61).* These technical features of Wang were considered in the previous examination. Newman's teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in the previous examination. Accordingly, Newman would not be important to a reasonable examiner in determining the patentability of claim 1 and all claims dependent therefrom.

Turning next to Schipper, it is noted that the Request sets forth that Patel, Grimes, Ladner, Loomis, and Newman in combination with Schipper renders claim 6 obvious. *See Request for Reexamination, Pages 6-16.* The request does not rely upon Schipper to teach the features of claim 1 that distinguished the '736 patent over the prior art. Accordingly, Schipper would not have been important to a reasonable examiner in determining the patentability of the claims.

(C) The pre-1991 reexamination references do not raise a substantial new question of patentability.

Petitioner next requests reconsideration of whether Patel raises a SNQ over the requested claims. Regarding claim 1, the request sets forth that Patel (the '636 patent) raises a SNQ because Patel discloses:

> "Through the transceiver, the communicator and the nearest remote base station maintain radio communication to continually update the present location of the subscriber. Each remote base station periodically polls its surrounding area for proximately located subscriber personal communicators. Each personal communicator in the area responds by notifying the polling base station of the subscriber's presence. This location information is then relayed by the network of remote base stations to the central base station at the personal telecommunications system service node where the subscriber's current location and communications routing information is updated and stored in a look-up table in anticipation of future need." *Request for Reexamination, Exhibit P.*

These features of Patel do not teach the features that distinguished the '763 patent over the prior art. While Patel teaches the storing of a subscriber's location in a look-up table and the updating of that location as the location changes, Patel fails to teach an updating response system *responsive to an inaccuracy* in the geographic location associated with the mobile unit identification number *that exceeds an interval defined by said updating system.* The request does not set forth any teachings of Patel which meet the requirements of a response to an inaccuracy that exceeds an interval. Accordingly, Patel would not have been important to a reasonable examiner in determining the patentability of claim 1.

Regarding claim 9, the request sets forth that Patel (the '636 patent) raises a SNQ because Patel discloses:

> "The subscriber location information is transmitted from the base stations to the service node for storage and subsequent access when a call is placed to the subscriber's personal telephone number. The service node will then transfer the call to the proper telephone number at the location where the subscriber is currently or last known to be located, or if not at a fixed location with a known phone, notify the subscriber through the base stations and the personal communicator of the incoming call." Abstract. "Each personal communicator 26 and base station 28 is assigned a unique identification number." Col. 6, 11.25- 26. "The location of the subscriber is determined by the personal telecommunications system through a radio messaging system that monitors and tracks the subscriber's location by means of a personal communicator carried by the subscriber.

> This location information is stored in a look-up table at the service node along with communications routing information and accessed as needed to route incoming personal telephone calls." *Request for Reexamination, Exhibit P.*

These features of Patel do not teach the features that distinguished the '763 patent over the prior art. Patel does not teach the distinguishing feature of obtaining a position for said specific mobile unit identifying an exact geographic location of a the specific mobile unit, and forwarding said exact geographic location and specific mobile unit identification for use in subsequent services because Patel fails to teach the identification of an exact geographic location. Instead, Patel teaches the determination that a mobile device is within an area serviced by a particular base station (*Patel, column 3 lines 15-26*). Accordingly, Patel would not have been important to a reasonable examiner in determining the patentability of claim 9.

Regarding claim 23, the request sets forth that Patel (the '636 patent) raises a SNQ because Patel discloses:

> "The location of the subscriber is determined by the personal telecommunications system through a radio tracking system comprised of a number of radio base stations that monitor the subscriber's location by communicating with a personal communicator carried by the subscriber." Abstract To the extent that determining the exact geographic location for a mobile unit is not expressly or inherently disclosed, it would have been obvious to one of ordinary skill in the art in view of, for example, U.S. Patent No. 5,479,482 to Grimes (priority date 08/30/1993), which discloses: "In accordance with the invention, a cellular terminal includes a GPS device; and upon the user of the cellular terminal placing an emergency telephone call, the cellular terminal interrogates the GPS device to obtain the geo-coordinates. The cellular terminal then transmits the geo-coordinates to a cellular telecommunication switching system." U.S. Patent No. 5,479,482, col. 2, 11. 10-16.
>
> "The subscriber location information is transmitted from the base stations to the service node for storage and subsequent access when a call is placed to the subscriber's personal telephone number. The service node will then transfer the call to the proper telephone number at the location where the subscriber is currently, or last known to be located, or if not at a fixed location with a known phone, notify the subscriber through the base stations and the personal communicator of the incoming call." Abstract "The location of the subscriber is determined by the personal telecommunications system through a radio messaging system that monitors and tracks the subscriber's location by means of a personal communicator carried by the subscriber. This location information is stored in a look-up table at the service node along with communications routing information and accessed as needed to route incoming personal telephone calls." Col. 2, 11.40-44. "In addition, the subscriber can signal, through the personal communicator, an emergency situation. This signal will be transmitted to the service node over the radio messaging system. The service node will then contact emergency services, for example by dialing "911", and provide location information on the subscriber to the service." Col. 9, 11.52-59. *Request for Reexamination, Exhibit P, Pages 16-17.*

These features of Patel do not teach the features that distinguished the '763 patent over the prior art. Patel does not teach the distinguishing feature of acquiring positional data corresponding to an exact geographical location for the mobile unit via the cellular system; comparing the positional data with stored geographic data for the location based service; and responding to the request for a location based service based on the comparison. First, Patel fails to teach the identification of an exact geographic location. Instead, Patel teaches the determination that a mobile device is within an area serviced by a particular base station (*Patel, column 3 lines 15-26*). Furthermore, Patel fails to teach the claimed comparison step. When Patel's system is used to make an emergency call, the subscriber's location information is provided to the emergency service (*Request for Reexamination, Exhibit P, Page 17 citing Patel, column 9 lines 52-62*). However, the location is not used for comparison and is instead merely used to inform the emergency service of the subscriber's location. Accordingly, Patel would not have been important to a reasonable examiner in determining the patentability of claim 23.

Petitioner next requests reconsideration of whether Gojanovich would have been considered important in deciding whether or not the claims are patentable. *See Petition for Review, Pages 14-16.* It is noted that the Request sets forth that Ladner in combination with Gojanovich renders claims 24-27 obvious. *See Request for Reexamination, Page 13.* The request does not rely upon Gojanovich to teach the limitations of claims 1, 9, and 23 that distinguished the '736 patent over the prior art. Accordingly, Gojanovich would not have been important to a reasonable examiner in determining the patentability of the claims.

(D) Obviousness Arguments.

Petitioner asserts that the Examiner improperly disregarded the obviousness argument set forth in the request. This argument is not material to the determination of whether the April 6, 2009 request for ex parte reexamination raises at least one SNQ. A determination of whether an SNQ exists focuses upon the teachings of the prior art as set forth in the record as it appeared before the Examiner at the time of the order. For all the reasons stated above, the request fails to establish a SNQ for the requested claims.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

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

Gregory Morse, Director
Central Reexamination Unit

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REEXAMINATION CONTROL NO. *90/010,479*.

PATENT NO. *5428699*.

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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CENTRAL REEXAMINATION UNIT

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In re Russell Pon
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Filed: March 30, 2009
For: U.S. Patent No. 5,428,699

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

This is a decision on the March 23, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the March 23, 2010 patent owner petition to revive").

The March 23, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 23, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the December 18, 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 March 23, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the December 18, 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 December 18, 2009 Office action set a two-month period for response, and a one-month extension of time was granted on January 29, 2010. In view of the April 1, 2010 Decision Granting Petition for Expungement of Papers, a proper response to the December 18, 2009 Office action was not filed until March 19, 2010, which was untimely. However, for the purpose of evaluating whether the March 23, 2010 patent owner petition to revive is a grantable petition, the submission of the March 19, 2010 Response To Office Action Mailed December 18, 2009 satisfies item (1).[2]

Accordingly, the March 23, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 23, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for treatment of the Response To Office Action Mailed December 18, 2009.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Minh Nguyen, of CRU Art Unit 3992, at (571) 272-1748.

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 March 19, 2010 Response To Office Action Mailed December 18, 2009 as to each of the rejections set forth in the December 18, 2009 Office action; such is the examiner's province.

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For Patent Owner

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CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
Patent Administrator
53 State Street, Exchange Place
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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

Ex Parte Reexamination Proceeding
Control No. 90/010,492
Filed: April 10, 2009
For: U.S. Patent No. 6,280,439

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure

that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,378 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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(For Patent Owner)

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(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

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 Kashnikow, 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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(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

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

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.

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For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,386
Filed: January 15, 2009
For: U.S. Patent No. 5,626,631

Ex Parte Reexamination Proceeding
Control No. 90/010,493
Filed: April 10, 2009
For: U.S. Patent No. 5,626,631

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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. 90/010,386 was ordered in a decision mailed April 8, 2009. It is noted that the request for this reexamination asked reexamination of claims 7 and 11-41, all of the claims present at that time in prior copending reexamination proceeding control No. 90/010,069 (merged with reexamination proceeding 90/010,134). The decision granted reexamination for only original patent

claim 7, noting section 2243 of the MPEP that indicates that amended and/or new 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, cancelling claims 1-6 and 8-10, and adding claims 11-41. The amendment incorporated into the instant proceeding the claims as they appear in *Ex Parte* Reexamination Certificate number 6682 issued March 3, 2009, as a result of the termination of the first reexamination proceeding Control No. 90/010,069 (merged with reexamination proceeding 90/010,134). On May 12, 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. 90/010,493 was ordered in a decision mailed June 30, 2009, indicating that claims 7 and 11-41, all of the live claims in the patent per the issuance of *Ex Parte* Reexamination Certificate No. 6682. 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. 90/010,386 and reexamination control No. 90/010,493 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 7 and 11-41, 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the

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

Conclusion

Reexamination Control Nos. 90/010,386 and 90/010,493 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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OCT 13 2009

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For 90/010,493 + 90/010,386 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,493
Filed: April 10, 2009
For: U.S. Patent No. 5,626,631

Ex Parte Reexamination Proceeding
Control No.: 90/010,386
Filing Date: January 15, 2009
For: U.S. Patent No. 5,626,631

DECISION ON PETITIONS UNDER 37 CFR 1.183

This is a decision on the August 25, 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 25, 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 90/010,386.

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 26, 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 May 6, 1997, the Office issued U.S. Patent No. 5,626,631 (the '631 patent) to Eckhouse.

2. On January 15, 2009, a first request for *ex parte* reexamination of claims 7 and 11-41 of the '631 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,386 (the '10386 proceeding).

3. On January 21, 2009, the Office issued a notice of the filing of the '10386 *ex parte* reexamination with an assigned filing date of January 15, 2009.

4. On April 8, 2009, the Office issued an order granting reexamination of claim 7 of the '631 patent for the '10386 proceeding.

5. On April 10, 2009, a second request for *ex parte* reexamination of claims 7, and 11-41 of the '631 patent was filed by the same third party requester The resulting reexamination proceeding was assigned control number 90/010,493 (the '10493 proceeding).

6. On April 17, 2009, the Office issued a notice of the filing of the '10493 *ex parte* reexamination with an assigned filing date of April 10, 2009.

7. On June 30, 2009, the Office issued an order granting reexamination of claims 7 and 11-41 for the '10493 proceeding.

8. On July 14, 2009, patent owner filed a petition in both the '10386 and '10493 proceedings to request merging of the two proceedings.

9. On July 23, 2009, the Office mailed a decision merging the '10386 and '10493 reexamination proceedings into a single proceeding.

10. On August 25, 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."

11. On August 27, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 25, 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.

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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 25, 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 25, 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

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

10-13-09
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[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.

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OCT 13 2009

CENTRAL REEXAMINATION UNIT

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Boston, MA 02111

(For Patent Owner)

Goodwin Procter LLP
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53 State Street, Exchange Place
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(For 90/010,493 + 90/010,386 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,493
Filed: April 10, 2009
For: U.S. Patent No. 5,626,631

Ex Parte Reexamination Proceeding
Control No.: 90/010,386
Filing Date: January 15, 2009
For: U.S. Patent No. 5,626,631

DECISION ON PETITIONS UNDER 37 CFR 1.181

This is a decision on the August 25, 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 Kashnikow, 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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Mintz, Levin, Cohn, Ferris, Glovsky
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For Patent Owner

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JUL 23 2009

CENTRAL REEXAMINATION UNIT

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. 90/010,394
Filed: January 23, 2009
For: U.S. Patent No. 5,405,368

Ex Parte Reexamination Proceeding
Control No. 90/010,501
Filed: April 22, 2009
For: U.S. Patent No. 5,405,368

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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. 90/010,394 was ordered in a decision mailed April 17, 2009. It is noted that the request for this reexamination asked reexamination of claims 1, 8, 10-11, and 13-32, all of the claims present at that time in prior copending reexamination proceeding control No. 90/010,068 (merged with reexamination proceeding 90/010,136). The decision granted reexamination for only original patent

claims 13, and 16-18, noting section 2243 of the MPEP that indicates that amended and/or new 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, cancelling claims 2-7, 9 and 12, amending claims 1, 8, 10-11, and 14-15, and adding claims 19-32. The amendment incorporated into the instant proceeding the claims as they appear in *Ex Parte* Reexamination Certificate number 6712 issued March 24, 2009, as a result of the termination of the first reexamination proceeding Control No. 90/010,068 (merged with reexamination proceeding 90/010,136). On May 12, 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. 90/010,501 was ordered in a decision mailed June 29, 2009, indicating that claims 1, 8, 10-11, and 13-32, all of the live claims in the patent per the issuance of *Ex Parte* Reexamination Certificate No. 6712. 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. 90/010,394 and reexamination control No. 90/010,501 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, 8, 10-11, and 13-32, 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies

must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,394 and 90/010,501 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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OCT 13 2009

CENTRAL REEXAMINATION UNIT

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Ex Parte Reexamination Proceeding
Control No. 90/010,501
Filed: April 22, 2009
For: U.S. Patent No. 5,405,368

Ex Parte Reexamination Proceeding
Control No.: 90/010,394
Filing Date: January 23, 2009
For: U.S. Patent No. 5,405,368

DECISION ON PETITIONS UNDER 37 CFR 1.183

This is a decision on the August 24, 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 26, 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 24, 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 90/010,394.

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 25, 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 27, 2009, for patent owner's petition under 37 CFR 1.183.

REVIEW OF RELEVANT FACTS

1. On April 11, 1995, the Office issued U.S. Patent No. 5,405,368 (the '368 patent) to Eckhouse.

2. On January 23, 2009, a first request for *ex parte* reexamination of claims 1, 8, 10-11, and 13-32 of the '368 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/010,394 (the '10394 proceeding).

3. On February 3, 2009, the Office issued a notice of the filing of the '10394 *ex parte* reexamination with an assigned filing date of January 23, 2009.

4. On April 17, 2009, the Office issued an order granting reexamination of claims 13, and 16-18 for the '10394 proceeding.

5. On April 22, 2009, a second request for *ex parte* reexamination of the '368 patent was filed by the same third party requester, requesting reexamination of claims 1, 8, 10-11, and 13-32 of the '368 patent. The resulting reexamination proceeding was assigned control number 90/010,501 (the '10501 proceeding).

6. On May 8, 2009, the Office issued a notice of the filing of the '10501 *ex parte* reexamination with an assigned filing date of April 22, 2009.

7. On June 29, 2009, the Office issued an order granting reexamination of claims 1, 8, 10-11, and 13-32 for the '10501 proceeding.

8. On July 14, 2009, patent owner filed a petition in both the '10394 and '10501 proceedings to request merging of the two proceedings.

9. On July 23, 2009, the Office mailed a decision merging the '10394 and '10501 reexamination proceedings into a single proceeding.

10. On August 24, 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."

11. On August 26, 2009, patent owner filed the present petition under 37 CFR 1.183 to request that the Office dismiss the August 24, 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 24, 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 26, 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 24, 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

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.

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OCT 13 2009

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 90/010,501 + 90/010,394 Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,501
Filed: April 22, 2009
For: U.S. Patent No. 5,405,368

Ex Parte Reexamination Proceeding
Control No.: 90/010,394
Filing Date: January 23, 2009
For: U.S. Patent No. 5,405,368

DECISION ON PETITIONS UNDER 37 CFR 1.181

This is a decision on the August 24, 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 Kashnikow, 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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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

TROUTMAN SANDERS LLP
600 PEACHTREE STREET, NE
ATLANTA, GA 30308-2216

(For Patent Owner)

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(For Third Party Requester)

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,505
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,507
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,508
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,509
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent), issued to Petite *et alia*, on September 5, 2006.

2. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,505 (hereinafter, the '10505 proceeding).

3. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,507 (hereinafter, the '10507 proceeding).

4. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,508 (hereinafter, the '10508 proceeding).

5. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,509 (hereinafter, the '10509 proceeding).

6. The Reexamination Order was granted in the '10505 proceeding on June 22, 2009.

7. The Reexamination Order was granted in the '10507 proceeding on June 22, 2009.

8. The Reexamination Order was granted in the '10508 proceeding on June 22, 2009.

9. The Reexamination Order was granted in the '10509 proceeding on June 22, 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 '10505, '10507, '10508 and the '10509 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. 90/010,505, 90/010,507, 90/010,508 and 90/010,509 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Third Party Requester)

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,505
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,507
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,508
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,509
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent), issued to Petite *et alia*, on September 5, 2006.

2. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,505 (hereinafter, the '10505 proceeding).

3. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,507 (hereinafter, the '10507 proceeding).

4. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,508 (hereinafter, the '10508 proceeding).

5. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,509 (hereinafter, the '10509 proceeding).

6. The Reexamination Order was granted in the '10505 proceeding on June 22, 2009.

7. The Reexamination Order was granted in the '10507 proceeding on June 22, 2009.

8. The Reexamination Order was granted in the '10508 proceeding on June 22, 2009.

9. The Reexamination Order was granted in the '10509 proceeding on June 22, 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 '10505, '10507, '10508 and the '10509 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. 90/010,505, 90/010,507, 90/010,508 and 90/010,509 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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In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,505
Request Deposited: May 13, 2009
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In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,507
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In re PETITE *et alia*
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Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,509
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent), issued to Petite *et alia*, on September 5, 2006.

2. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,505 (hereinafter, the '10505 proceeding).

3. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,507 (hereinafter, the '10507 proceeding).

4. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,508 (hereinafter, the '10508 proceeding).

5. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,509 (hereinafter, the '10509 proceeding).

6. The Reexamination Order was granted in the '10505 proceeding on June 22, 2009.

7. The Reexamination Order was granted in the '10507 proceeding on June 22, 2009.

8. The Reexamination Order was granted in the '10508 proceeding on June 22, 2009.

9. The Reexamination Order was granted in the '10509 proceeding on June 22, 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 '10505, '10507, '10508 and the '10509 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. 90/010,505, 90/010,507, 90/010,508 and 90/010,509 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

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

TROUTMAN SANDERS LLP
600 PEACHTREE STREET, NE
ATLANTA, GA 30308-2216

(For Patent Owner)

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(For Third Party Requester)

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(For Third Party Requester)

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,505
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,507
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,508
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,509
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent), issued to Petite *et alia*, on September 5, 2006.

2. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,505 (hereinafter, the '10505 proceeding).

3. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,507 (hereinafter, the '10507 proceeding).

4. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,508 (hereinafter, the '10508 proceeding).

5. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,509 (hereinafter, the '10509 proceeding).

6. The Reexamination Order was granted in the '10505 proceeding on June 22, 2009.

7. The Reexamination Order was granted in the '10507 proceeding on June 22, 2009.

8. The Reexamination Order was granted in the '10508 proceeding on June 22, 2009.

9. The Reexamination Order was granted in the '10509 proceeding on June 22, 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 '10505, '10507, '10508 and the '10509 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. 90/010,505, 90/010,507, 90/010,508 and 90/010,509 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**.

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

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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SEP 28 2009

CENTRAL REEXAMINATION UNIT

TROUTMAN SANDERS LLP
600 PEACHTREE STREET, NE
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(For Patent Owner)

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(For Third Party Requester)

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,505
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,507
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,508
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,509
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent), issued to Petite *et alia*, on September 5, 2006.

2. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,505 (hereinafter, the '10505 proceeding).

3. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,507 (hereinafter, the '10507 proceeding).

4. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,508 (hereinafter, the '10508 proceeding).

5. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,509 (hereinafter, the '10509 proceeding).

6. The Reexamination Order was granted in the '10505 proceeding on June 22, 2009.

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9. The Reexamination Order was granted in the '10509 proceeding on June 22, 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.

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CONCLUSION

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/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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TROUTMAN SANDERS LLP
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ATLANTA, GA 30308-2216

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(For Third Party Requester)

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BLOOMFIELD HILLS, MI 48304-0610

(For Third Party Requester)

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,505
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,507
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,508
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,509
Request Deposited: May 13, 2009
For: U.S. Patent No. 7,103,511

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1. U.S. Patent No. 7,103,511 (hereinafter, the '511 patent), issued to Petite *et alia*, on September 5, 2006.

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4. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,508 (hereinafter, the '10508 proceeding).

5. On May 13, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '511 patent. The reexamination proceeding was assigned Control No. 90/010,509 (hereinafter, the '10509 proceeding).

6. The Reexamination Order was granted in the '10505 proceeding on June 22, 2009.

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8. The Reexamination Order was granted in the '10508 proceeding on June 22, 2009.

9. The Reexamination Order was granted in the '10509 proceeding on June 22, 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.

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CONCLUSION

1. Reexamination Control Nos. 90/010,505, 90/010,507, 90/010,508 and 90/010,509 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**.

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

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, 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.
90/010,510	05/14/2009	6891838	STAT90010510-838	1256

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
www.uspto.gov

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SEP 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
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(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

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.

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.

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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. 90/010,310, 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

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

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, 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.
90/010,511	05/15/2009	6,891,838	STAT90010511-838	1266

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

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

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RADER, FISHMAN & GRAUER PLLC
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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

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.

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.

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:

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/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, Central Reexamination Unit

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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.
90/010,512	05/15/2009	6,891,838	STAT90010512-838	1272

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

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SEP 25 2009

CENTRAL REEXAMINATION UNIT

TROUTMAN SANDERS LLP
600 PEACHTREE STREET, NE
ATLANTA, GA 30308

(For Patent Owner)

PHILIP KIRKPATRICK
CRESTRON ELECTRONICS, INC
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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

In re PETITE *et alia*
Reexamination Proceeding
Control No. 90/010,511
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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).

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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.

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

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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. 90/010,310, 90/010,510, 90/010,511 and 90/010,512 are MERGED.

2. The reexamination files are being forwarded to the examiner for action.

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/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, 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.
90/010,519	06/08/2009	6181297	9043.002	9592

37086 7590 09/25/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 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
www.uspto.gov

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

MAILED

SEP 25 2009

CENTRAL REEXAMINATION UNIT

In re Leisten et al. :
Reexamination Proceeding :
Control No. 90/010,519 :
Request Deposited: June 8, 2009 :
For: U.S. Patent No. 6,181,297 :

This is a decision dismissing as moot the petition under 37 C.F.R. §§ 1.182 and/or 1.183 in reexamination proceeding no. 90/010,519 ("the '519 proceeding"), requesting that the United States Patent and Trademark Office ("USPTO") accept a replacement or substitute Request for Reexamination to correct printing errors made in the originally filed Request for Reexamination of U.S. Patent No. 6,181,297 ("the '297 patent") filed on May 6, 2009.

The Patent Owner's petition and *ex parte* reexamination control number 90/010,519 are before the Office of Patent Legal Administration.

Summary

The petition is dismissed because a Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements permitting submission of a corrected request for *ex parte* reexamination by the patent owner has mooted the petition. It is also noted that (a) the petition fails to indicate any particular errors in the original reexamination request, (b) 35 U.S.C. § 302 permits any person at any time to file a request for reexamination (only one request that has been given a filing date), and (c) an extraordinary situation has not been established in this instance.

Review of Facts

The '297 patent was granted to Oliver Paul Leisten on January 30, 2001, based on an application for patent filed on December 3, 1998. The patent is assigned to Sarantel Ltd.

On April 30, 2009, the patent owner deposited an original request for reexamination of the '297 patent.

On May 6, 2009, the patent owner deposited a "Substitute Request" correcting the printing errors in the original request for reexamination of the '297 patent.

Concurrently on May 6, 2009, the present petition for entry of the Substitute Request was filed.

On May 7, 2009, a Notice of Failure to Comply with *Ex parte* Reexamination Request Filing Requirements was mailed to the Patent Owner.

On June 8, 2009, a corrected request for *ex parte* reexamination of the '297 patent was deposited. A filing date of June 8, 2009, was assigned to the resulting reexamination proceeding.

On July 23, 2009, reexamination of the '297 patent was ordered.

Decision

I. The Reexamination Statute permits a request, not multiple requests in a single proceeding

Section 302 of Title 35 permits any person at any time to file a request for reexamination (emphasis added). There is no statutory authority for the USPTO to accept a second request for reexamination when a first original request has already been submitted and granted a filing date as a complete reexamination filing. If the request is not sufficiently clear, such that the USPTO can determine whether a statement pointing out each substantial new question of patentability is present, then a filing date will not be granted to the request papers. In such circumstances, a notice requiring details of each substantial new question of patentability is mailed to the requester.

In the present case, such a notice of failure to comply with *ex parte* reexamination request filing requirements was mailed on May 7, 2009. On June 8, 2009, the requester/patent owner provided a corrected original *ex parte* request for reexamination, which was given a filing date.

While the reexamination statute only permits one complete request and not multiple requests in any given proceeding, patent owner's petition is considered moot in this instance, since the corrected request filed on June 8, 2009 was accepted in response to the notice mailed May 7, 2009.

II. Neither 37 C.F.R. § 1.182 nor § 1.183 would permit filing of a second request for *ex parte* reexamination in a single proceeding

The petition is filed under 37 C.F.R. §§ 1.182 and 1.183. The specific language of 37 C.F.R. § 1.182 permits petitions to be filed in the USPTO for situations not provided for by any other regulation. Rule 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).

In the present case, the patent owner failed to identify any "printing errors" in the original request for reexamination of the '297 patent, and thus failed to explain the specific relief requested. When the UPTO issued a Notice of Failure to Comply with *Ex parte* Reexamination Request Filing Requirements in the present case, the present petition was mooted, because requester was entitled to file an entirely new corrected request addressing the asserted "printing errors."

Patent owner also relies on the provisions of 37 C.F.R. § 1.183, without citing to any rule to be suspended or waived. Moreover, the patent owner does not explain how the printing errors constitute an "extraordinary situation where justice requires" suspension or waiver of any regulation. In the present case, patent owner is petitioning for acceptance of a supplemental request for *ex parte* reexamination because of "printing errors" in the original request. Since this is not an extraordinary situation and in light of the Notice of Failure to Comply with *Ex parte* Reexamination Request Filing Requirements which permitted submission of a corrected request for *ex parte* reexamination by the patent owner, the 37 C.F.R. § 1.183 petition is dismissed as moot.

CONCLUSION

1. The present petition is dismissed as moot. The petition is deemed moot in light of the USPTO's acceptance of the corrected request for reexamination filed on June 8, 2009 in response to the USPTO's Notice of Failure to Comply with *Ex parte* Reexamination Request Filing Requirements mailed May 7, 2009.
2. Any further correspondence with respect to this matter should be addressed as follows:

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

By Mail 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
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at (571) 272-7755, and in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

9-24-09

Kenpet7/

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.
90/010,520	04/30/2009	5440749	0081-011X3	9626

40972 7590 09/23/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

Date:
MAILED
SEP 24 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010520
PATENT NO. : 5440749
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,034	03/31/2008	5440749	0081-011X1	3309

40972 7590 09/23/2009

HENNEMAN & ASSOCIATES, PLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RAMAN N. DEWAN
JACKSON WALKER, L.L.P.
100 CONGRESS AVENUE, SUITE 1100
AUSTIN, TX 78701

Date:
MAILED
SEP 24 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009034
PATENT NO. : 5440749
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,389	01/16/2009	5440749	0081-011X2	9206

40972 7590 09/23/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEPOLIS, MN 55440-1022

Date: MAILED

SEP 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009389
PATENT NO. : 5440749
ART UNIT : 3992

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CENTRAL REEXAMINATION UNIT

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70 N. MAIN ST.
THREE RIVERS MI 49093
(For Patent Owner)

RAMAN N. DEWAN
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WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036
(For Third Party Requester)

In re Moore *et alia*
Reexamination Proceeding
Control No. 90/009,034
For: U.S. Patent No. 5,440,749

In re Moore *et alia*
Reexamination Proceeding
Control No. 90/009,389
For: U.S. Patent No. 5,440,749

In re Moore *et alia*
Reexamination Proceeding
Control No. 90/010,520
For: U.S. Patent No. 5,440,749

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,440,749 (hereinafter, the '749 patent), issued to Moore *et alia*, on August 8, 1995.

2. On March 31, 2008, a corrected request for *ex parte* reexamination of the '749 patent was filed. The reexamination proceeding was assigned Control Nos. 90/009,034 (hereinafter, the '9034 proceeding).

3. On June 3, 2008, the reexamination order granting the request in the '9034 proceeding was mailed. There were amendments to the claims in '9034 proceeding.

4. On January 16, 2009, a third party deposited a request for *ex parte* reexamination of the '749 patent. The reexamination proceeding was assigned Control No. 90/009,389 (hereinafter, the '9389 proceeding).

5. On April 8, 2009, the reexamination order granting the request in the '9389 proceeding was mailed. There are no amendments in the '9389 proceeding.

6. On April 30, 2009, a third party deposited a request for *ex parte* reexamination of the '749 patent. The reexamination proceeding was assigned Control No. 90/010,520 (hereinafter, the '10520 proceeding).

7. On July 24, 2009, the reexamination order granting the request in the '10520 proceeding was mailed. There are no amendments in the '10520 proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9034, '9389 and '10520 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims have been amended in the '9034 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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

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

CONCLUSION

1. Reexamination Control Nos. 90/009,034, 90/009,389 and 90/010,520 are **merged**.

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

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

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

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

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

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

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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,526	05/05/2009	6195662	348237US91RX	4481

22850 7590 04/16/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,526	05/05/2009	6195662	348237US91RX	4481

22850 7590 04/16/2010

EXAMINER

RICHARD D. MCLEOD
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET, #1600
PORTLAND, OR 97204

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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United States Patent and Trademark Office
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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,526	05/05/2009	6195662	348237US91RX	4481

22850 7590 04/16/2010

EXAMINER

P. WESTON MUSSELMAN, JR.
FISH & RICHARDSON P.C.
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DALLAS, TX 75201

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,526	05/05/2009	6195662	348237US91RX	4481

22850 7590 04/16/2010

JOHN M. DESMARAIS
KIRKLAND & ELLIS LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
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ALEXANDRIA, VA 22314 (For Patent Owner)

RICHARD D. MCLEOD
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET, #1600
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P. WESTON MUSSELMAN, JR.
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DALLAS, TX 75201 (Courtesy Copy)

JOHN M. DESMARAIS
KIRKLAND & ELLIS LLP
601 LEXINGTON AVENUE
NEW YORK, NY 10022 (Courtesy Copy)

MAILED

APR 16 2010

CENTRAL REEXAMINATION UNIT

In re Ellis *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,526
Filed: May 5, 2009
For: U.S. Patent No. 6,195,662

DECISION GRANTING PETITION

This is a decision on the January 29, 2010 "PETITION UNDER 37 C.F.R. § 1.182 TO RETURN/DESTROY INFORMATION FILED UNDER SEAL WITHOUT CONSIDERATION," as supplemented on March 2, 2010. This is also a decision on the February 25, 2010 "PETITION UNDER 37 C.F.R. § 1.182 AND/OR 37 C.F.R. § 1.183 TO RETURN/DESTROY CONFIDENTIAL INFORMATION SUBMITTED IN VIOLATION OF PROTECTIVE ORDER," as amended on February 26, 2010.

The petitions under 37 CFR 1.182 are before the Office of Patent Legal Administration.

The petitions are granted.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the January 29, 2010 petition under 37 CFR 1.182 was charged on February 1, 2010, and the $400.00 petition fee pursuant to 37 CFR 1.17(f) for the February 25, 2010 petition under 37 CFR 1.182 was charged on February 26, 2010.

BACKGROUND

1. U.S. Patent No. 6,195,662 ("the '662 patent") issued to Ellis *et al.* on February 27, 2001.

2. The '662 patent is currently the subject of litigation involving Microsoft Corporation and IBM Corporation ("the litigation defendants") and other defendants in the case styled, *JuxtaComm Tech. Int'l. v. Ascential Software Corp., et al.*, No. 2:07-CV-00359 LED, which is pending in the United States District Court for the Eastern District of Texas ("the concurrent litigation").

3. On June 27, 2008, a "STIPULATED PROTECTIVE ORDER" ("the protective order") was issued in the concurrent litigation.

4. On May 5, 2009, a third party requester filed a request for *ex parte* reexamination, which proceeding was assigned Control No. 90/010,526 ("the '10526 proceeding").

5. On July 31, 2009, the Office mailed an Order granting the request for *ex parte* re-examination in the '10526 proceeding.

6. On December 16, 2009, the Office issued a non-final Office action in the '10526 proceeding.

7. On January 7, 2010, patent owner submitted the following papers in the '10526 proceeding (collectively referred to herein as "the January 7, 2010 IDS submissions," totaling 133 pages):
   - Four (4) papers entitled "PETITION FOR EXPUNGEMENT OF PROTECTIVE ORDER MATERIALS UNDER 37 C.F.R. §1.59(B),"
   - Four (4) papers entitled "STATEMENT UNDER 37 CFR 1.555,"
   - Two (2) papers entitled "SUBMISSION UNDER 37 C.F.R. § 1.555/1.565 IN EX PARTE REEXAMINATION OF U.S. PATENT NO. 6,195,662," and
   - Four (4) papers entitled "INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97."

8. Concurrently, on January 7, 2010, seven (7) boxes of corresponding materials from the concurrent litigation that were identified in the January 7, 2010 IDS submissions (see previous paragraph) were filed under seal pursuant to MPEP § 724.02.

9. On January 29, 2010, patent owner filed a petition paper in the'10526 proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO RETURN/DESTROY INFORMATION FILED UNDER SEAL WITHOUT CONSIDERATION," requesting non-entry and return/release to patent owner of the materials submitted under seal on January 7, 2010.

10. On February 25, 2010, the litigation defendants in the concurrent litigation filed a petition paper in the '10526 proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 AND/OR 37 C.F.R. § 1.183 TO RETURN/DESTROY CONFIDENTIAL INFORMATION SUBMITTED IN VIOLATION OF PROTECTIVE ORDER."

11. On February 26, 2010, the litigation defendants in the concurrent litigation filed a petition paper in the '10526 proceeding entitled "AMENDED PETITION UNDER 37 C.F.R. §

1.182 AND/OR 37 C.F.R. § 1.183 TO RETURN/DESTROY CONFIDENTIAL INFORMATION SUBMITTED IN VIOLATION OF PROTECTIVE ORDER."

12. On March 2, 2010, patent owner filed a paper in the '10526 proceeding entitled "SUPPLEMENTAL INFORMATION TO PREVIOUSLY FILED PETITION UNDER 37 C.F.R. § 1.182 TO RETURN/DESTROY INFORMATION FILED UNDER SEAL WITHOUT CONSIDERATION."

DECISION

In the above-identified petitions under 37 CFR 1.182, the patent owner and the litigation defendants assert that materials submitted by the patent owner under seal on January 7, 2010 in the '10526 proceeding are subject to the above-identified protective order issued by the Eastern District of Texas in the concurrent litigation. Petitioners request that the materials be returned to the patent owner or destroyed.[1] The litigation defendants further assert that public disclosure of these materials would cause them irreparable harm.[2]

As an initial matter, it is noted that the petition of the litigation defendants is not entitled to entry under the rules – see 37 CFR 1.550(g) and (h). Although the Office does accept submissions from third parties pursuant to MPEP § 2282 that are limited to bare notice of prior or concurrent litigation involving the patent undergoing reexamination, such notice is not the subject of the instant petition. The litigation defendants fail to suggest any provision of the regulations which could provide a basis for entry of its petition, and the Office can identify none. Thus, by rule, the litigation defendants are not entitled to consideration of the instant petition. Pursuant to 37 CFR 1.183, however, "[i]n 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." In the present instance, the petition alleges that significant property rights are at stake, and because it may be possible for the Office to act to protect those rights, the interests of justice require that the reexamination entry right rules be *sua sponte* waived, and the Office is waiving the rules in order to enter and consider the litigation defendants' petition papers. Entry of the present petition papers in the reexamination proceeding is akin to entry of bare notice of prior or concurrent litigation in a reexamination proceeding (pursuant to MPEP § 2282), as both serve a legitimate interest, and both do not go to the merits of the proceeding, and as such, do not involve prohibited participation in the proceeding. The petition papers were presented solely to assert the parties' rights in protecting the confidentiality of their materials and in no way deals with the merits or the procedure of the '10526 proceeding.

A review of the record of the '10526 proceeding reveals that the accompanying materials that were identified in the patent owner's January 7, 2010 IDS submissions were filed by the patent owner <u>under seal</u> on January 7, 2010 and have not been scanned into the image file wrapper (IFW) of the '10526 proceeding, nor have the materials been reviewed by the Office.

---

[1] *See* March 2, 2010 supplement to patent owner's January 29, 2010 petition under 37 CFR 1.182 at pages 2-3 and litigation defendants' February 26, 2010 amended petition under 37 CFR 1.182 at pages 6-8.

[2] *See* litigation defendants' February 26, 2010 amended petition under 37 CFR 1.182 at page 8.

Only the following papers identified above as "the January 7, 2010 IDS submissions" have been scanned into the IFW of the '10526 proceeding (totaling 133 pages): four (4) papers entitled "PETITION FOR EXPUNGEMENT OF PROTECTIVE ORDER MATERIALS UNDER 37 C.F.R. §1.59(B)," four (4) papers entitled "STATEMENT UNDER 37 CFR 1.555", two (2) papers entitled "SUBMISSION UNDER 37 C.F.R. § 1.555/1.565 IN EX PARTE REEXAMINATION OF U.S. PATENT NO. 6,195,662," and four (4) papers entitled "INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97."

While the accompanying materials that were identified in the patent owner's January 7, 2010 IDS submissions were filed under seal with petitions to expunge, the procedures set forth in MPEP § 724.04(c) would require the Office to review the submitted information and make a determination as to whether or not any of the information submitted is material to patentability. If any of the submitted information is found to be material to patentability, the Office would deny the respective petition to expunge and make such information a permanent part of the reexamination file and open to the public. The protective order, however, precludes the Office from being able to review the protected materials, as paragraph 5 of the protective order prohibits disclosure of the protected materials to anyone, except as expressly provided in the protective order, and paragraph 6 of the protective order prohibits the use of the protected materials for patent prosecution.[3]

In view of the terms of the protective order, the irreparable harm to the litigation defendants that would be caused by public disclosure of the protected materials, and the facts and circumstances in this instance, the patent owner's January 29, 2010 petition under 37 CFR 1.182, as supplemented on March 2, 2010, and the litigation defendants' February 25, 2010 petition under 37 CFR 1.182, as amended on February 26, 2010, are granted.

Patent owner's 133-page January 7, 2010 IDS submissions will not be considered and will be expunged from the record of the '10526 proceeding by marking the papers "closed" and "not public."[4] In addition, patent owner is required, within 30 days from the mailing date of this decision, to retrieve from the Office the boxes of accompanying materials that were identified in the January 7, 2010 IDS submissions and filed under seal in the '10526 proceeding on January 7, 2010.

ADDITIONAL DISCUSSION

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the "material" information can be classified as a trade secret, or as proprietary

[3] The protected materials are defined in paragraph 2 of the protective order as materials marked "CONFIDENTIAL," "HIGHLY-CONFIDENTIAL – ATTORNEYS' EYES ONLY" AND "HIGHLY CONFIDENTIAL SOURCE CODE – OUTSIDE COUNSEL ONLY."

[4] This includes the petitions to expunge, which will not be considered because the papers that those petitions refer to are being retuned in accordance with this decision.

material, or whether it is subject to a protective order.[5] MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose. Attention is directed to paragraphs 17-18 of the protective order. Should a situation arise where the duty to disclose is in conflict with the protective order (i.e. if the disclosure of protected information would be needed in order to comply with patent owner's duty), patent owner should approach the court for relief from the protective order.

CONCLUSION

1. Patent owner's January 29, 2010 petition under 37 CFR 1.182, as supplemented on March 2, 2010 and litigation defendants' February 25, 2010 petition under 37 CFR 1.182, as amended on February 26, 2010, are granted.

2. Patent owner's 133-page January 7, 2010 IDS submissions will not be considered and will be expunged from the record of the '10526 proceeding by marking the papers "closed" and "not public."

3. Patent owner is required, within 30 days from the mailing date of this decision, to retrieve from the Office the boxes of accompanying materials that were identified in the January 7, 2010 IDS submissions and filed under seal in the '10526 proceeding on January 7, 2010, by contacting Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or in his absence, Nicole Dretar, Legal Advisor, at 571-272-7717, to arrange a date and time for pick-up by the patent owner's courier.

4. Jurisdiction over the '10526 proceeding is being returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or Nicole Dretar, Legal Advisor, at 571-272-7717.

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

4-15-09
Kenpet8

[5] *See* MPEP § 724. *See also* paragraph 21 of the protective order.

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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Squire, Sanders & Dempsey L.L.P.
8000 Towers Crescent Drive
14TH Floor
Vienna, VA 22182-6212

For Patent Owner

MAILED

OCT 06 2009

CENTRAL REEXAMINATION UNIT

Malloy & Malloy
2800 S.W. Third Avenue
Historic Coral Way
Miami, FL 33129

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,417
Filed: February 25, 2009
For: U.S. Patent No. 6,325,085

Ex Parte Reexamination Proceeding
Control No. 90/010,528
Filed: May 6, 2009
For: U.S. Patent No. 6,325,085

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/009,417 was ordered in a decision mailed March 26, 2009. The decision granted reexamination for only original patent claim 10, the only claim for which reexamination was requested. On May 1, 2009, patent owner filed a letter waiving his rights to file a Patent Owner Statement under 37 CFR 1.530. On May 21, 2009, a non-final Office action was mailed rejecting claim 10. On July 21, 2009,

patent owner filed a response to the Office action. The response amended claim 10. In addition, on July 21, 2009, patent owner also filed an Information Disclosure Statement. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/010,528 was ordered in a decision mailed June 25, 2009. The decision indicating that claim 10, the only claim for which reexamination was requested, would be reexamined. On July 22, 2009, patent owner filed a waiver of his rights to file a Patent Owner Statement under 37 CFR 1.530. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,417 and reexamination control No. 90/010,528 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claim 10, the only claim subject to reexamination, was amended in reexamination Control No. 90/009,417 by virtue of the July 21, 2009 amendment. No amendment has been filed in reexamination control No. 90/010,528.The patent owner is required to maintain identical claims, drawings, and specification in both files. **Accordingly, patent owner is hereby required to provide a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claim10, the only claim for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief fee, brief fee, etc.) only a single feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,417 and 90/010,528 are hereby merged into a single proceeding. **As stated above, patent owner has one-month from the mailing date of this decision within which to submit a 'housekeeping' amendment placing the same claim in each of the files**. Upon receipt of the response or expiration of the time period indicated above, whichever comes first, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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OCT 22 2009

CENTRAL REEXAMINATION UNIT

BRAD Y. CHIN
SQUIRE SANDERS & DEMPSEY LLP
8000 TOWERS CRESCENT DRIVE
14TH FLOOR
VIENNA, VA 22182-6212

In re Application of	:	
TED GOWER	:	
Control No. 90/010,528 (U.S. 6,325,085)	:	DECISION ON PETITION
Filed: May 6, 2009	:	TO WITHDRAW
Attorney Docket No. 087558.00022	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 20, 2009.

The request is **APPROVED**.

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

The request was signed by Brad Y. Chin on behalf of all attorneys of record. Applicant is reminded that there is no attorney of record at this time. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: PETER A. MATOS, ESQ. (Third Party Requester)
MALLOY & MALLOY, PA
2800 S.W. THIRD AVENUE
MIAMI, FL 33129

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on October 20, 2009. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Derek Donahoe
DORSEY & WHITNET, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET SUITE 4700
DENVER, CO 80202-5647

: (For Patent Owner)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Robert M. Abrahansen
WOLF GREENFIELD & SACKS, PC
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

: (For Third-Party Requester)

In re KLUG
Reexamination Proceeding
Control No. 90 / 010,532
Request Deposited: June 10, 2009
For: U.S. Patent No. 5,799,320

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

This is a decision on patent owner's petition for extension of time under 37 CFR 1.550(c) filed on May 20, 2010. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 5,799,320 was ordered in the Determination mailed August 28, 2009.

2. A first office action on the merits issued May 25, 2010 setting a one month period for response.

3. A petition for extension of time for one month was granted on April 21, 2010. The response was set as due May 25, 2010.

4. On Maay 20, 2010 owner filed the instant petition requesting an additional 14 days (two weeks) response period in order to complete the response to the outstanding office action.

DECISION

The Patent Owner requests an extension of time of an additional 14 days (two weeks) within which to schedule and conduct a personal interview with the examiner. The request for extension is the **second** request for an extension of time during the proceeding, and for the same response. The present petition for extension of time was timely filed on May 20, 2010 together with the requisite 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.

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 ....
>
> **Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations...**
>
> 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 states the Owner "has already begun analyzing the rejections and the references cited...and preparing a response. However, the Patent Owner believes that an interview with the

examiner would aid the examiner in understanding...As such, a two-week extension of time is requested herein in order to provide sufficient time for the Patent Owner to schedule and conduct an interview...".

Analysis and Findings

On balance it is considered that the petition fails to explain the "sufficient cause" and the "extraordinary circumstances " warranting grant of a second extension of time. Second and subsequent requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time. At bare minimum, no explanation of why Owner could not or did not request an interview with the examiner sooner has been offered. Accordingly no basis for relief is seen.

CONCLUSION

1. Petitioner's request is **dismissed.** The period during which Patent Owner may file a response to the rejection remains running and Patent Owner's response is due May 25, 2010.

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

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.
90/010,537	05/13/2009	6304937	9278.002.RX0000	3576

86497 7590 12/11/2009

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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90/010,537	05/13/2009	6304937	9278.002.RX0000	3576

86497 7590 12/11/2009

EXAMINER

Tracy Druce
Novak Druce & Quigg, LLP
1000 Louisiana Ave.
53rd Floor
Houston, TX 77002

ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Austin TX 78716

(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

MAILED

DEC 11 2009

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,188
Filed: May 12, 2009
For: U.S. Patent No. 6,304,937

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,537
Filed: May 13, 2009
For: U.S. Patent No. 6,304,937

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 6, 2009 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO PREVENT MERGER" filed in *ex parte* reexamination proceeding 90/010,537. On November 5, 2009, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition, which has also been considered.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, and it was charged to Patent Owner's credit card on October 7, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

The Third Party Requester opposition 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 will be charged to Requester's deposit account no. 14-1437 pursuant to the authorization on page one of Requester's November 5, 2009 petition.

The Patent Owner petition and Requester opposition are before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in

accordance with 37 CFR 1.989, for the reasons set forth below.

REVIEW OF FACTS

1. On October 16, 2001, the Office issued U.S. Patent No. 6,304,937 (the '937 patent) to Farmwald *et al.*

2. On May 12, 2009, a request for *inter partes* reexamination of all the claims (claims 1-40) of the '937 patent was filed by third party requester (requester) NVIDIA Corporation. The request was assigned Control No. 95/001,188 (the '1188 proceeding).

3. On May 13, 2009, a request for *ex parte* reexamination of all the claims (claims 1-40) of the '937 patent was filed by the same Requester (NVIDIA Corporation). The request was assigned Control No. 90/010,537 (the '10537 proceeding).

4. The '937 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}. The initial complaint was filed July 10, 2008. Based upon the initial complaint, patent owner appears to be enforcing at least one of claims 1-40 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '1188 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '10537 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10537 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On October 6, 2009, patent owner filed the present petition to prevent merger, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition. Concurrently, Patent Owner filed a petition requesting suspension of the '1188 *inter partes* reexamination proceeding.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

9. On November 5, 2009, third party requester filed an opposition petition to patent owner's October 6, 2009 petition to prevent merger. Concurrently, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition to suspend.

10. This decision addresses the Patent Owner petition to prevent merger and the Requester's opposition to the request to prevent merger. The Patent Owner petition to stay the '1188 proceeding and the Requester's opposition to the staying of the '1188 proceeding are addressed in a separate decision issued on even date with this decision.

11. As of the date of this decision, an Office action on the merits has not issued.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 304 states:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.33(a) states:

> (1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
>
> (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
>
> (3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.182 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 1.935 states:

> The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

> (a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939 states:

> (a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.
>
> (b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

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 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 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 (1) - The earlier (pending) reexamination is an *inter partes* reexamination:
>
> (1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for inter partes reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party

who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. **Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.** (Emphasis added)

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

MPEP 2686.01 IV. PROCEEDINGS NOT MERGED states:

Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

DECISION

I. Preliminary Matter: Waiver of 37 CFR 1.939(b)

As noted, *supra*, the present request for reexamination of the '937 patent was filed on May 12, 2009, and reexamination was granted on July 7, 2009. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above, the Examiner of record has not issue an Office action. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, both Patent Owner's petition dated October 6, 2009 and Requester's opposition dated November 5, 2009 are not authorized. However, based upon the unique facts and circumstances of the present proceeding, in the interests of justice and special dispatch, to the extent necessary 37 CFR 1.939 is waived.

II. Findings and Analysis

Patent owner asserts the filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, by the same requester, constitutes harassment. Patent owner further asserts that the reexamination filing pattern of the requester constitutes a gaming of the system that frustrates the Office's statutory mandate of special dispatch. Patent owner also asserts that merging an earlier filed *inter partes* reexamination proceeding with a later filed *ex parte* reexamination proceeding, when both proceedings were filed by the same third party requester, circumvents the statutory prohibition of 35 U.S.C. 317(a), which prohibits an *inter partes* requester or its privies from filing subsequent *inter partes* reexamination requests on the same patent until an *inter partes* reexamination certificate issues.

Patent owner requests as remedies, in the alternative, of: (1) Dismissal and termination of the reexamination proceedings due to harassment; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged. Granting the first remedy is asserted to preserve the integrity of the Office, by not entertaining requester "gamesmanship" and maintaining Office fidelity to the statutory mandate of special dispatch. Granting the second or third remedies is asserted to "preserve" the patent owner's *ex parte* rights, e.g. a right to an interview, and to prevent the improvident expansion of the third party requester's right to comment upon issues raised solely in the *ex parte* reexamination.

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 no 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. Nor do the statutes place a "volume" limitation on the number of issues that may be raised by a single or multiple reexamination proceedings.

In regards to the 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 §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, since Patent Owner has no such right.

Finally, in order to facilitate the statutory mandate of special dispatch, the relevant rules and MPEP guidance that govern the merger of reexamination proceedings an *inter partes* reexamination proceeding place the public on notice that the *inter partes* reexamination rules control a merged proceeding. Any arrangement to the contrary, e.g. permitting a patent owner to conduct an *ex parte* interview on the SNQs presented in the *ex parte* reexamination and only letting the requester comment on the 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 also in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings would clearly further 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

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[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

[3] See MPEP §§ 713 *et seq.*, 2281 and 2685

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.

Harassment. Patent Owner alleges the existence of "harassment" to justify dismissal and termination of the '1188 *inter partes* reexamination proceeding and the '10537 *ex parte* reexamination proceeding due to the Requester's filing of two allegedly voluminous requests for reexamination in two days for the '937 patent, in addition to multiple reexamination requests filed against patents related to the '937 patent. The filing of *inter partes* and *ex parte* reexamination requests on other patents, albeit patents related to the '937 patent, is not relevant to the issue of harassment toward the Patent Owner in the reexamination of the '937 patent. Therefore, the issue of harassment will focus upon the actions of the Requester in the reexamination requests with respect to the reexamination of the '937 patent only. MPEP 2640 II states that the procedure for filing a petition based upon harassment calls for the relief of suspension and not dismissal and termination of the second or subsequently filed reexamination proceeding that is allegedly harassing. Petitioner, by filing the petition requesting dismissal and termination has erred.

Even if Patent Owner had filed the petition requesting the relief of suspension, it would be the second proceeding that provided harassment, if such were the case, and thus the *ex parte* reexamination proceeding for which Patent Owner requests interviews would be the one to suspend – not the *inter partes* proceeding in which interviews are barred. Further, the allegation of harassment in the second proceeding is unsupported. MPEP 2640 II requires that the Patent Owner "clearly show" that the second or subsequent request was filed for purposes of harassment. Patent Owner has stated on the record that the second reexamination, the '10537 proceeding, consisted of less that half the number of substantial new questions (SNQ) and claim chart pages as presented in the '1188 *inter partes* reexamination request. Patent Owner then speculates that Requester "recognized" that a single request containing 123 SNQs would not be granted by the Office; yet, Patent Owner provides no evidence to support this asserted Requester recognition. Furthermore, Patent Owner points to no authority that sets forth that a single request verses a set of two requests containing 123 SNQs is tantamount to *per se* harassment of the Patent Owner. Patent Owner merely sets forth the conclusory statement that such a filing is not reasonable. Patent Owner then goes on to cite several other reexamination requests for patents related to the '937 patent. However, as noted previously, the reexaminations of other related patents are not relevant to the present proceedings. Finally, Patent Owner alleges that requester has partaken in a form of gamesmanship of the reexamination system at the expense of the Office and Patent Owner that should not be tolerated. However, the degree of burden would be the same if all issues had presented in one reexamination request, and the employment of multiple SNQs has not been shown to be for the purpose of harassment. To the contrary,

estoppel attaches in *inter partes* reexamination to all issues that requester could have raised (35 U.S.C. 315(c) and 35 U.S.C. 317(b)), and bringing all issues to the table could have easily been Requester's motive, as opposed to harassment.

Patent Owner has not made an evidentiary showing that the '10537 *ex parte* reexamination proceeding was filed with an intent to harass. Patent Owner has not shown that the Requester was aware of and intentionally withheld the references in the '10537 *ex parte* reexamination request from the '1188 *inter parte* reexamination request with the intent to harass. The Requester has only filed two reexamination requests and has not been shown to have had the intent to withhold references for purposes of harassment. Therefore, Patent Owner's arguments are not persuasive, as no evidence of harassment in the filing of the '10537 *ex parte* reexamination proceeding has been shown. The facts and circumstances surrounding the filing of the *inter partes* and subsequent *ex parte* reexamination proceeding in this instance does not evidence harassment by the Requester of the Patent Owner. Accordingly, Patent Owner's arguments that Requester's filing of two requests for reexamination in two days for the same patent is not persuasive as a basis for "harassment" dismissal and termination of the reexamination proceedings.

A point to be noted *re* Requester's argument: Requester cites and discusses *Fed. Reg.*, Vol. 65, No. 67 at 18168-69 (PTO Discussion of Specific Rules, Proposed rule 37 CFR 1.948) in support of the assertion that there was no harassment. (Requester's November 5, 2009 opposition, page 4.) 37 CFR 1.948 places regulatory limitations upon the submission of prior art by a third party Requester following the order for *inter partes* reexamination, to prevent harassment of the Patent Owner. The rule does not regulate an *inter partes* Requester's right to file *ex parte* reexamination requests. The Federal Register discussion of then proposed rule 37 CFR 1.948 does acknowledge an *inter partes* Requester's right to file *ex parte* reexamination requests for the purposes of submitting art, when the Requester's art submission is precluded by the rule. However, neither the rule, nor the cited Federal Register discussion, state that an attempt to submit prior art by an *inter partes* Requester via an *ex parte* reexamination request cannot constitute harassment (on which to base suspension). Nor does the rule or discussion intimate that the timing alone of an *ex parte* request relative to the *inter partes* proceeding is determinative on the issue of harassment. Moreover, none of Requester's arguments in the opposition changes the fact that the Office has absolute discretion to either merge or suspend, based upon the equities of each fact situation as it arises, on a case-by-case basis. If the equities were decided to be in favor of suspension in this instance, the relevant proceeding would have been suspended.

<u>Circumvention of 35 U.S.C. 317(a).</u> Patent Owner alleges that merging the '1188 *inter partes* reexamination proceeding with the '10537 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes the third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination request 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 converts the *ex parte* reexamination into an *inter partes* reexamination, as the requester obtains *inter partes* participation rights regarding the SNQs raised in the later filed, now merged *ex parte* reexamination request. 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 logic for denying merger between the present proceedings. Patent owner's logic apparently is that the filing of a subsequent *ex parte* reexamination proceedings by the same requester is a "*de facto*" *inter partes* reexamination request, and hence a violation of the statute. However, as Patent Owner concedes, the present proceedings are not under suspension based on a district court decision adverse to requester, as was the case in the '093 and '094 proceedings. Further, as pointed out by Requester, 37 CFR 1.989(a) and MPEP 2686.01 indicate that the *inter partes* requester retains the right to file subsequent an *ex parte* reexamination request on the same patent as the *inter partes* request. Further, the Requester notes that the decision not to merge the "Sony cases" was based upon preventing a circumvention of the Office suspension the '093 and '094 *inter partes* reexamination proceedings. As the '1188 *inter partes* reexamination proceeding is not under suspension, the logic of the '093 and '094 proceeding decisions not to merge is not applicable.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request one day after the filing of an inter partes reexamination request. The plain language of the statute states, in part (emphasis added):

> . . . **[O]nce an <u>order</u> 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 <u>until an *inter partes* reexamination certificate is issued and published under section 316</u>, unless authorized by the Director.

The requester filed an *ex parte* reexamination request one day after the requester had filed its *inter partes* reexamination request. The statute does not prohibit the filing of *ex parte* reexamination requests by a requester, that previously filed an *inter partes* reexamination request on the same patent. Furthermore, on the day requester filed the subsequent *ex parte* reexamination request, the '1188 *inter partes* reexamination had not yet been ordered. Therefore, even if requester's *ex parte* reexamination request were to be taken as a "*de facto*" *inter partes* reexamination request, the statutory prohibition is still not implicated, as the '1188 *inter partes* reexamination request was not yet ordered by the Office. The non-merger 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 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" is then stated 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 concluded 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. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1188 *inter partes* reexamination proceeding and the '10537 *ex parte* reexamination proceeding, even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination rights. Patent Owner restates the argument that merger under 37 CFR 1.989(a) violates 35 U.S.C. 317(a) and that 37 CFR 1.989(b) has no statutory basis. Patent Owner also states the Office should not reward Requester's conduct. Finally, Patent Owner states that merger would burden the Office, allow the Requester to game the reexamination system and set a precedent that undermines the integrity of the Office.

As pointed out by Requester: Waiver of 37 CFR 1.989(b) would unduly burden the Office, slow down the reexamination process and be contrary to the statutory mandate of special dispatch. Further, the disparate procedures between *ex parte* and *inter parte* reexamination would burden the Office if both proceedings on the same patent were conducted simultaneously and unmerged. Even further, the conduct of interviews in the *ex parte* proceeding would be difficult to monitor and prevent discussions that would affect the merits of the concurrent *inter partes* reexamination, and likely resulting in a violation of 37 CFR 1.955. Finally, the result of granting Patent Owner's request would be an impediment to the statutory mandate of special dispatch, which is the very basis for 37 CFR 1.989(b).

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory violation, and it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte* reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte*" rights. Merger, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as

argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133 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, since Patent Owner has no such right.

Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to dismiss and terminate, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

III. Merger of the Proceedings

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

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/001,188 and 90/010,537 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout

the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an ex parte reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. Papers mailed/filed:

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

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

By EFS:

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

By U.S. Postal Service Mail:

> Mail Stop *Inter Partes* Reexam
> Central Reexamination Unit
> Commissioner for Patents
> United States Patent & Trademark Office
> P.O. Box 1450
> Alexandria, VA 22313-1450

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

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

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

3. Amendments:

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

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

4. Fees:

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

5. Citation of Patents and Printed Publications:

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

CONCLUSION

1. The October 6, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,188 and *ex parte* Reexamination Control No. 90/010,537 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 09/24/2009

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2009

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

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Date: SEP 24 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
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.

PTOL-2070(Rev.07-04)

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

SEP 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
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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SEP 24 2009
CENTRAL REEXAMINATION UNIT

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, Texas 78716

(For Patent Owner)

Tracy Druce
Novak Druce & Quigg, LLP
1000 Louisiana Avenue, 53rd Floor
Houston, Texas 77002

(For Third Party Requester)

In re Farmwald, et al.	
Inter partes Reexamination Proceeding	
Control No. 95/000,470	
Filed: May 14, 2009	
For: U.S. Patent No. 6,564,281	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
Ex parte Reexamination Proceeding	
Control No. 90/010,540	
Filed: May 14, 2009	
For: U.S. Patent No. 6,564,281	

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

REVIEW OF FACTS

1. United States Patent Number 6,564,281 (the '281 patent) issued to Farmwald et al., on May 13, 2003.

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2. A request for *ex parte* reexamination was filed by third party requester NVIDIA Corporation, on May 14, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,540 (the '540 proceeding). Reexamination was requested for claims 1-46 of the '281 patent.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,470 (the '470 proceeding), was filed by third party requester on May 14, 2009. Reexamination was requested for claims 1-46 of the '281 patent. The request identified NVIDIA Corporation as the real party in interest.

4. An order granting reexamination of claims 1-46 in the '281 patent was mailed for the '540 *ex parte* reexamination proceeding on July 6, 2009.

5. An order *granting* the request for *inter partes* reexamination for claims 1-46 in the '470 *inter partes* reexamination proceeding was mailed on July 6, 2009.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of facts, both the '470 and the '540 reexamination proceedings are currently pending. An order granting reexamination of claims 1-46 of the '281 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

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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 95/000,470 and 90/010,540 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,470 and 90/010,540 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, 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 '540 *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 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

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By U.S. Postal Service Mail:

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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 (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, 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*

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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. 95/000,470 and *ex parte* Reexamination Control No. 90/010,540 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.

3. 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 the undersigned at (571) 272-7726.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,540	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 12/16/2009

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 12/16/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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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:

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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HOUSTON, TX 77002

Date: MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
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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(For Patent Owner)

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Farmwald *et al.* *Inter partes* Reexamination Proceeding Control No.: 95/000,470 Filed: May 14, 2009 For: U.S. Patent No. 6,564,281	DECISION DISMISSING PETITION TO RECONSIDER MERGER OF REEXAMINATION PROCEEDINGS
In re Farmwald *et al.* *Ex Parte* Reexamination Proceeding Control No.: 90/010,540 Filed: May 14, 2009 For: U.S. Patent No. 6,564,281	

This is a decision on patent owner's October 13, 2009 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER DECISION, *SUA SPONTE,* TO MERGE REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, and it was charged to Patent Owner's credit card on October 14, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

Patent Owner's petition is before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of

the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 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}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding.

9. On October 13, 2009, patent owner filed the present petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. This decision addresses the October 13, 2009 Patent Owner petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. As of the date of this decision, an Office action on the merits has not issued in either of the two reexamination proceedings.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 304 states:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued

under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.33(a) states:

(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.182 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 1.935 states:

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939 states:

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

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 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 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 (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for inter partes reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. **Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.** (Emphasis added)

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within

the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

MPEP 2686.01 IV. PROCEEDINGS NOT MERGED states:

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

DECISION

I. Preliminary Matter: Waiver of 37 CFR 1.939(b)

As noted, *supra*, the *inter partes* request for reexamination of the '281 patent was filed on May 14, 2009, and reexamination was granted on July 6, 2009 and the now merged proceeding is governed by the *inter partes* reexamination rules. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above, the Examiner of record has not issue an Office action. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, Patent Owner's petition dated October 13, 2009 is not authorized. However, based upon the unique facts and circumstances of the present proceeding, in the interests of justice and

special dispatch, 37 CFR 1.939 is waived to the extent necessary to permit consideration of the petition presently before the Office of Patent Legal Administration.

II. Findings and Analysis

Patent owner asserts the filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, by the same requester, constitutes harassment. Patent owner further asserts that the reexamination filing pattern of the requester constitutes a gaming of the system that frustrates the Office's statutory mandate of special dispatch. Patent owner also asserts that merging an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding filed on the same day, when both proceedings were filed by the same third party requester, circumvents the statutory prohibition of 35 U.S.C. 317(a), which prohibits an *inter partes* requester or its privies from filing subsequent *inter partes* reexamination requests on the same patent until an *inter partes* reexamination certificate issues.

Patent owner requests as remedies, in the alternative, of: (1) Dismissal and termination of the reexamination proceeding due to harassment; (2) Dissolution of the merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings remain merged. Granting the first remedy is asserted to preserve the integrity of the Office, by not entertaining requester "gamesmanship" and maintaining Office fidelity to the statutory mandate of special dispatch. Granting the second or third remedies is asserted to "preserve" the patent owner's *ex parte* rights, e.g. a right to an interview, and to prevent the improvident expansion of the third party requester's right to comment upon issues raised solely in the *ex parte* reexamination.

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 no 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. Nor do the statutes place a "volume" limitation on the number of issues that may be raised by a single or multiple reexamination proceedings.

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 §§

1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, in order to facilitate the statutory mandate of special dispatch, the relevant rules and MPEP guidance that govern the merger of reexamination proceedings an *inter partes* reexamination proceeding place the public on notice that the *inter partes* reexamination rules control a merged proceeding. Any arrangement to the contrary, e.g. permitting a patent owner to conduct an *ex parte* interview on SNQs[4] presented in the *ex parte* reexamination and only letting the requester comment on SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Harassment. Patent Owner alleges the existence of "harassment" to justify dismissal and termination of the '470 *inter partes* reexamination proceeding and the '10540 *ex parte* reexamination proceeding due to the Requester's filing of two allegedly voluminous requests for reexamination on the same day for the '281 patent, in addition to multiple reexamination requests filed against patents related to the '281 patent. The filing of *inter partes* and *ex parte* reexamination requests on other patents, albeit patents related to the '281 patent, is not relevant

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[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

[3] See MPEP §§ 713 *et seq.*, 2281 and 2685

[4] Substantial New Question of Patentability

to the issue of harassment toward the Patent Owner in the reexamination of the '281 patent. Therefore, the issue of harassment focuses upon the actions of the Requester in the reexamination requests with respect to the reexamination of the '281 patent only. MPEP 2640 II states that the procedure for filing a petition based upon harassment calls for the relief of suspension and not dismissal and termination of the second or subsequently filed reexamination proceeding that is allegedly harassing. Petitioner, by filing the petition requesting dismissal and termination has erred.

The allegation of harassment is unsupported. MPEP 2640 II requires that the Patent Owner "clearly show" that the second or subsequent request was filed for purposes of harassment. Patent Owner has stated on the record that the '10540 *ex parte* reexamination request consisted of 150 pages and asserted 15 substantial new questions of patentability (SNQ). Patent owner further stated on the record that the '470 *inter partes* reexamination request consisted of 454 pages and asserted 60 additional SNQs. Patent Owner notes that the 15 SNQs of the '10540 *ex parte* reexamination request was supported by 799 pages of claim charts and the 60 SNQs of the '470 *inter partes* reexamination request was supported by 2,637 pages of claim charts. Patent Owner then speculates that Requester "recognized" that a single request containing 75 SNQs would not be granted by the Office; yet, Patent Owner provides no evidence to support this asserted Requester recognition. Finally, Patent Owner noted that the Office agreed that 59 of the 75 total SNQs asserted by requester did in fact raise a substantial new question of patentability. Patent owner did not present a by reexamination request breakdown of the number of SNQs found to lack merit. Patent Owner points to no authority that sets forth that a single request verses a set of two requests containing 75 SNQs is tantamount to *per se* harassment of the Patent Owner. Patent Owner merely sets forth the conclusory statement that such a filing is not reasonable. Patent Owner then goes on to cite several other reexamination requests for patents related to the '281 patent. However, as noted previously, the reexaminations of other related patents are not relevant to the present proceeding. Finally, Patent Owner alleges that requester has partaken in a form of gamesmanship of the reexamination system at the expense of the Office and Patent Owner that should not be tolerated. However, the degree of burden would be the same if all issues had been presented in one reexamination request, and the employment of multiple SNQs has not been shown to be for the purpose of harassment. To the contrary, estoppel attaches in *inter partes* reexamination to all issues that requester could have raised (35 U.S.C. 315(c) and 35 U.S.C. 317(b)), and bringing all issues to the table could have easily been Requester's motive, as opposed to harassment.

Patent Owner has not made an evidentiary showing that either reexamination request was filed with the intent to harass. The Requester has only filed two reexamination requests on the same day and has not been shown to have had the intent to withhold references at all, let alone for purposes of harassment. Therefore, Patent Owner's arguments are not persuasive, as no evidence of harassment in the filing of the two reexamination requests has been shown. The facts and circumstances surrounding the filing of the *inter partes* and *ex parte* reexamination

proceeding in this instance does not evidence harassment by the Requester of the Patent Owner. Accordingly, Patent Owner's arguments that Requester's filing of two requests for reexamination on the same day for the same patent is not persuasive as a basis for "harassment" dismissal and termination of the reexamination proceedings.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes the third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination request 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 converts the *ex parte* reexamination into an *inter partes* reexamination, as the requester obtains *inter partes* participation rights regarding the SNQs raised in the now merged *ex parte* reexamination request. 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 logic for denying merger between the present proceedings. Patent owner's logic apparently being that the concurrent filing of an *ex parte* reexamination proceedings by the same requester is a "*de facto*" *inter partes* reexamination request, and hence a violation of the statute. However, as Patent Owner concedes, the present proceedings are not under suspension based upon a district court decision adverse to requester, as was the case in the '093 and '094 proceedings.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request on the same day as an *inter partes* reexamination request. The plain language of the statute states, in part (emphasis added):

> . . . **[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 on the same day the requester filed its *inter partes* reexamination request. The statute does not prohibit the filing of *ex parte* reexamination requests by a requester, that concurrently files an *inter partes* reexamination request on the same patent. Furthermore, on the day requester filed the *ex parte* reexamination request, the '470 *inter partes* reexamination had not yet been ordered. Therefore, even if requester's *ex parte* reexamination request were to be taken as a "*de facto*" *inter partes* reexamination request, the statutory prohibition is still not implicated, as the '470 *inter partes* reexamination request was not yet ordered by the Office. The non-merger 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 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. 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 '470 *inter partes* reexamination proceeding and the '10540 *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 patent owner rights. Patent Owner restates the argument that merger under 37 CFR 1.989(a) violates 35 U.S.C. 317(a) and that 37 CFR 1.989(b) has no statutory basis. Patent Owner also states the Office should not reward Requester's conduct. Finally, Patent Owner states that merger burdens the Office, allows the Requester to game the reexamination system and sets a precedent that undermines the integrity of the Office.

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, 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 dissolution of the merger or retention of the merger, but permitting Patent Owner *ex parte* interviews in a merged proceeding, both burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings

on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to dismiss and terminate, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

CONCLUSION

1. The October 13, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/000,471 and *ex parte* Reexamination Control No. 90/010,542 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

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.
90/010,540	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 06/22/2010

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 06/22/2010

Paul M. Anderson, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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HOUSTON, TX 77002

Date:

MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
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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JUN 22 2010

CENTRAL REEXAMINATION UNIT

Paul M. Anderson, PLLC
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(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
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Houston, TX 77002

(For Third Party Requester)

In re Farmwald *et al.* *Inter partes* Reexamination Proceeding Control No.: 95/000,470 Filed: May 14, 2009 For: U.S. Patent No. 6,564,281	DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS
In re Farmwald *et al.* *Ex Parte* Reexamination Proceeding Control No.: 90/010,540 Filed: May 14, 2009 For: U.S. Patent No. 6,564,281	

This is a decision on patent owner's January 19, 2010 petition entitled "PETITION FOR RECONSIDERATION OF DECISION DISMISSING RAMBUS'S PETITION REGARDING MERGER OF REEXAMINATION PROCEEDINGS" and on third party requester's January 29, 2010 opposition to patent owner's January 19, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on January 20, 2010 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

The Third Party Requester opposition 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, which was charged to Requester's deposit account no. 14-1437 on February 2, 2010, pursuant to the authorization on page two of requester's January 29, 2010 petition.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 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}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

---

[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed the present petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

DECISION

I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

Patent owner requests as remedies in the now merged proceeding that:

(1) The requester be prevented from participating with respect to the issues the requester raised in the *ex parte* proceeding; and patent owner's meaningful opportunity to be heard before the Office pursuant to 37 CFR 1.560 be restored with respect to the issues raised by the requester in the *ex parte* proceeding.

(2) Should the Office not grant the proposed relief (identified in the previous sentence) within the context of the merged proceeding, patent owner requests that the merger of the two proceedings be dissolved and that each proceeding be prosecuted separately.

II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's second, subsequent request for reexamination was filed with an "intent to harass" and the finding of a substantial new question of patentability precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

III. Findings and Analysis

Reexamination of the '281 patent has been ordered in the '10540 *ex parte* proceeding and '470 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance, where both requests were filed on the same day by the same party.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, the determination whether to merge two reexamination proceedings is an act reserved to the discretion of the Office. (See 37 CFR 1.565(c), 37 CFR

1.989(a), MPEP 2686.01 I.,[2] MPEP 2686.01 IV,[3] 2283,[4] MPEP 2286.[5])

First, the statute is silent as to the procedural housekeeping issue of merger. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[6] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[7] Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. Given the complexities and/or particularities that may arise in a proceeding, requester's position that merger in every circumstance where two co-pending reexamination proceedings on the same patent exists would be in accord with special dispatch is not persuasive. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.[8,9]

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[2] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[3] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[4] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[5] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[6] "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. . . ." (Emphasis added).

[7] Id.

[8] See "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

[9] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '281 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.[10] Therefore, requester determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

It is observed that requester argues that since the *ex parte* requester is the same as the *inter partes* requester, the *quid pro quo* for the requester commenting upon the issues raised in the *ex parte* request a statutory estoppel will occur under 35 U.S.C. 315(c). Requester cites no legal authority for this conclusion; however, it is not relevant to an instance where the Office has decided that, in the best interest of its administrative management of the proceedings and housekeeping, the proceedings will not be merged.

Based upon the specific facts and circumstances of the reexamination proceedings on the '281 patent, the Office has decided that merger would not be the best alternative in this instance..

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

As an ancillary point, the Office concurs with requester that the act of filing an *ex parte* request is not a forfeiture of a right to file a subsequent *inter partes* request on the same patent as long as it raises a new, non cumulative SNQ and the references were not intentionally withheld with an intent to harass the patent owner. And, the Office also concurs with requester in regard to patent owner's arguments regarding the existence of interview rights. See *infra* section V of this decision.

IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.[11] Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public.

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[10] See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.
[11] This does not include the decisions to order reexamination; they are not deemed Office actions in this context.

2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.

3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133, which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[12] The relevant sections of the MPEP provide

[12] 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, on an as-needed-per-interview basis.

guidance on the conduct of interviews to include denial of an interview.[13] None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

CONCLUSION

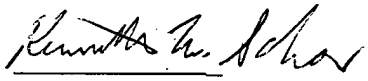
1. The January 19, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.[14]

3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action in accordance with this decision.

5. 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 6-21-10

[13] See MPEP §§ 713 *et seq.*, 2281 and 2685.
[14] As pointed out above, this does not apply to the decisions to order reexamination.

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CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,542
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

: DECISION
: DISMISSING
: PETITION TO
: RECONSIDER MERGER
: OF REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 13, 2009 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER DECISION, *SUA SPONTE,* TO MERGE REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, and it was charged to Patent Owner's credit card on October 14, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

Patent Owner's petition is before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of

the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 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}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding.

9. On October 13, 2009, patent owner filed the present petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. This decision addresses the October 13, 2009 Patent Owner petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. As of the date of this decision, an Office action on the merits has not issued in either of the two reexamination proceedings.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 304 states:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued

under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.33(a) states:

(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.182 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 1.935 states:

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939 states:

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

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 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 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 (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for inter partes reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. **Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.** (Emphasis added)

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged

where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

MPEP 2686.01 IV. PROCEEDINGS NOT MERGED states:

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

DECISION

I. Preliminary Matter: Waiver of 37 CFR 1.939(b)

As noted, *supra*, the *inter partes* request for reexamination of the '997 patent was filed on May 15, 2009, and reexamination was granted on July 7, 2009 and the now merged proceeding is governed by the *inter partes* reexamination rules. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above, the Examiner of record has not issue an Office action. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, Patent Owner's petition dated October 13, 2009 is not authorized. However, based

upon the unique facts and circumstances of the present proceeding, in the interests of justice and special dispatch, 37 CFR 1.939 is waived to the extent necessary to permit consideration of the petition presently before the Office of Patent Legal Administration.

II. Findings and Analysis

Patent owner asserts the filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, by the same requester, constitutes harassment. Patent owner further asserts that the reexamination filing pattern of the requester constitutes a gaming of the system that frustrates the Office's statutory mandate of special dispatch. Patent owner also asserts that merging an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding filed on the same day, when both proceedings were filed by the same third party requester, circumvents the statutory prohibition of 35 U.S.C. 317(a), which prohibits an *inter partes* requester or its privies from filing subsequent *inter partes* reexamination requests on the same patent until an *inter partes* reexamination certificate issues.

Patent owner requests as remedies, in the alternative, of: (1) Dismissal and termination of the reexamination proceeding due to harassment; (2) Dissolution of the merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings remain merged. Granting the first remedy is asserted to preserve the integrity of the Office, by not entertaining requester "gamesmanship" and maintaining Office fidelity to the statutory mandate of special dispatch. Granting the second or third remedies is asserted to "preserve" the patent owner's *ex parte* rights, e.g. a right to an interview, and to prevent the improvident expansion of the third party requester's right to comment upon issues raised solely in the *ex parte* reexamination.

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 no 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. Nor do the statutes place a "volume" limitation on the number of issues that may be raised by a single or multiple reexamination proceedings.

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 §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, in order to facilitate the statutory mandate of special dispatch, the relevant rules and MPEP guidance that govern the merger of reexamination proceedings an *inter partes* reexamination proceeding place the public on notice that the *inter partes* reexamination rules control a merged proceeding. Any arrangement to the contrary, e.g. permitting a patent owner to conduct an *ex parte* interview on the SNQs[4] presented in the *ex parte* reexamination and only letting the requester comment on the SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Harassment. Patent Owner alleges the existence of "harassment" to justify dismissal and termination of the '471 *inter partes* reexamination proceeding and the '10542 *ex parte* reexamination proceeding due to the Requester's filing of two allegedly voluminous requests for reexamination on the same day for the '997 patent, in addition to multiple reexamination requests filed against patents related to the '997 patent. The filing of *inter partes* and *ex parte*

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[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

[3] See MPEP §§ 713 *et seq.*, 2281 and 2685

[4] Substantial New Question of Patentability

reexamination requests on other patents, albeit patents related to the '997 patent, is not relevant to the issue of harassment toward the Patent Owner in the reexamination of the '997 patent. Therefore, the issue of harassment focuses upon the actions of the Requester in the reexamination requests with respect to the reexamination of the '997 patent only. MPEP 2640 II states that the procedure for filing a petition based upon harassment calls for the relief of suspension and not dismissal and termination of the second or subsequently filed reexamination proceeding that is allegedly harassing. Petitioner, by filing the petition requesting dismissal and termination has erred.

The allegation of harassment is unsupported. MPEP 2640 II requires that the Patent Owner "clearly show" that the second or subsequent request was filed for purposes of harassment. Patent Owner has stated on the record that the '10542 *ex parte* reexamination request consisted of 410 pages and asserted 40 substantial new questions of patentability (SNQ). Patent owner further stated on the record that the '471 *inter partes* reexamination request consisted of 641 pages and asserted 80 additional SNQs. Patent Owner notes that the 40 SNQs of the '10542 *ex parte* reexamination request was supported by 3,383 pages of claim charts and the 80 SNQs of the '471 *inter partes* reexamination request was supported by 5,198 pages of claim charts. Patent Owner then speculates that Requester "recognized" that a single request containing 120 SNQs would not be granted by the Office; yet, Patent Owner provides no evidence to support this asserted Requester recognition. Finally, Patent Owner noted that the Office agreed that 90 of the 120 total SNQs asserted by requester did in fact raise a substantial new question of patentability. Patent owner did not present a by reexamination request breakdown of the number of SNQs found to lack merit. Patent Owner points to no authority that sets forth that a single request verses a set of two requests containing 120 SNQs is tantamount to *per se* harassment of the Patent Owner. Patent Owner merely sets forth the conclusory statement that such a filing is not reasonable. Patent Owner then goes on to cite several other reexamination requests for patents related to the '997 patent. However, as noted previously, the reexaminations of other related patents are not relevant to the present proceeding. Finally, Patent Owner alleges that requester has partaken in a form of gamesmanship of the reexamination system at the expense of the Office and Patent Owner that should not be tolerated. However, the degree of burden would be the same if all issues had been presented in one reexamination request, and the employment of multiple SNQs has not been shown to be for the purpose of harassment. To the contrary, estoppel attaches in *inter partes* reexamination to all issues that requester could have raised (35 U.S.C. 315(c) and 35 U.S.C. 317(b)), and bringing all issues to the table could have easily been Requester's motive, as opposed to harassment.

Patent Owner has not made an evidentiary showing that either reexamination request was filed with the intent to harass. The Requester has only filed two reexamination requests on the same day and has not been shown to have had the intent to withhold references at all, let alone for purposes of harassment. Therefore, Patent Owner's arguments are not persuasive, as no evidence of harassment in the filing of the two reexamination requests has been shown. The

facts and circumstances surrounding the filing of the *inter partes* and *ex parte* reexamination proceeding in this instance does not evidence harassment by the Requester of the Patent Owner. Accordingly, Patent Owner's arguments that Requester's filing of two requests for reexamination on the same day for the same patent is not persuasive as a basis for "harassment" dismissal and termination of the reexamination proceedings.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes the third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination request 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 converts the *ex parte* reexamination into an *inter partes* reexamination, as the requester obtains *inter partes* participation rights regarding the SNQs raised in the now merged *ex parte* reexamination request. 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 logic for denying merger between the present proceedings. Patent owner's logic apparently being that the concurrent filing of an *ex parte* reexamination proceedings by the same requester is a "*de facto*" *inter partes* reexamination request, and hence a violation of the statute. However, as Patent Owner concedes, the present proceedings are not under suspension based upon a district court decision adverse to requester, as was the case in the '093 and '094 proceedings.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request on the same day as an *inter partes* reexamination request. The plain language of the statute states, in part (emphasis added):

> . . . **[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 on the same day the requester filed its *inter partes* reexamination request. The statute does not prohibit the filing of *ex parte* reexamination requests by a requester, that concurrently files an *inter partes* reexamination request on the same patent. Furthermore, on the day requester filed the *ex parte* reexamination request, the '471 *inter partes* reexamination had not yet been ordered. Therefore, even if requester's *ex parte* reexamination request were to be taken as a "*de facto*" *inter partes* reexamination request, the statutory prohibition is still not implicated, as the '471 *inter partes* reexamination request was not yet ordered by the Office. The non-merger 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 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. 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 '471 *inter partes* reexamination proceeding and the '10542 *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 patent owner rights. Patent Owner restates the argument that merger under 37 CFR 1.989(a) violates 35 U.S.C. 317(a) and that 37 CFR 1.989(b) has no statutory basis. Patent Owner also states the Office should not reward Requester's conduct. Finally, Patent Owner states that merger burdens the Office, allows the Requester to game the reexamination system and sets a precedent that undermines the integrity of the Office.

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, 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 dissolution of the merger or retention of the merger, but permitting Patent Owner *ex parte* interviews in a merged proceeding, both burden the Office and

frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to dismiss and terminate, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

CONCLUSION

1. The October 13, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/000,471 and *ex parte* Reexamination Control No. 90/010,542 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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,542 95/000,471	05/15/2009	7,209,997	9278.002.RX0000	7391

86497 7590 06/22/2010

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,471 90/010,542	05/15/2009	7,209,997	9278.002.RXUS00	5654

86497 7590 06/22/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000471; 90/010,542
PATENT NO. : 7209997
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,542
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

DECISION
DISSOLVING
MERGER OF
REEXAMINATION
PROCEEDINGS

This is a decision on patent owner's January 19, 2010 petition entitled "PETITION FOR RECONSIDERATION OF DECISION DISMISSING RAMBUS'S PETITION REGARDING MERGER OF REEXAMINATION PROCEEDINGS" and on third party requester's January 29, 2010 opposition to patent owner's January 19, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on January 20, 2010 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

The Third Party Requester opposition 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, will be charged to Requester's deposit account no. 14-1437, pursuant to the authorization on page two of requester's January 29, 2010 petition.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 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}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On December 17, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed the present petition requesting reconsideration of the December 17, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 17, 2009 decision.

DECISION

I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

Patent owner requests as remedies in the now merged proceeding that:

(1) The requester be prevented from participating with respect to the issues the requester raised in the *ex parte* proceeding; and patent owner's meaningful opportunity to be heard before the Office pursuant to 37 CFR 1.560 be restored with respect to the issues raised by the requester in the *ex parte* proceeding.

(2) Should the Office not grant the proposed relief (identified in the previous sentence) within the context of the merged proceeding, patent owner requests that the merger of the two proceedings be dissolved and that each proceeding be prosecuted separately.

II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's second, subsequent request for reexamination was filed with an "intent to harass" and the finding of a substantial new question of patentability precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

III. Findings and Analysis

Reexamination of the '997 patent has been ordered in the '10542 *ex parte* proceeding and '471 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance, where both requests were filed on the same day by the same party.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, the determination whether to merge two reexamination proceedings is an act reserved to the discretion of the Office. (See 37 CFR 1.565(c), 37 CFR

1.989(a), MPEP 2686.01 I.,[2] MPEP 2686.01 IV,[3] 2283,[4] MPEP 2286.[5])

First, the statute is silent as to the procedural housekeeping issue of merger. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[6] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[7] Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. Given the complexities and/or particularities that may arise in a proceeding, requester's position that merger in every circumstance where two co-pending reexamination proceedings on the same patent exists would be in accord with special dispatch is not persuasive. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.[8,9]

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[2] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[3] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[4] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[5] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[6] "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. . . ." (Emphasis added).

[7] Id.

[8] See "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

[9] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '997 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.[10] Therefore, requester determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

It is observed that requester argues that since the *ex parte* requester is the same as the *inter partes* requester, the *quid pro quo* for the requester commenting upon the issues raised in the *ex parte* request a statutory estoppel will occur under 35 U.S.C. 315(c). Requester cites no legal authority for this conclusion; however, it is not relevant to an instance where the Office has decided that, in the best interest of its administrative management of the proceedings and housekeeping, the proceedings will not be merged.

Based upon the specific facts and circumstances of the reexamination proceedings on the '997 patent, the Office has decided that merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

As an ancillary point, the Office concurs with requester that the act of filing an *ex parte* request is not a forfeiture of a right to file a subsequent *inter partes* request on the same patent as long as it raises a new, non cumulative SNQ and the references were not intentionally withheld with an intent to harass the patent owner. And, the Office also concurs with requester in regard to patent owner's arguments regarding the existence of interview rights. See *infra* section V of this decision.

IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.[11] Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public.

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[10] See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.
[11] This does not include the decisions to order reexamination; they are not deemed Office actions in this context.

2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.

3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133, which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[12] The relevant sections of the MPEP provide

[12] 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, on an as-needed-per-interview basis.

guidance on the conduct of interviews to include denial of an interview.[13] None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

CONCLUSION

1. The January 19, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.[14]

3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action in accordance with this decision.

5. 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 6-21-10

[13] See MPEP §§ 713 *et seq.*, 2281 and 2685.
[14] As pointed out above, this does not apply to the decisions to order reexamination.

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Cichosz & Cichosz, PLLC
129 E. Commerce Street
Milford, MI 48381

For Patent Owner
(both requests)

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/010,202
Filed: July 30, 2008
For: U.S. Patent No. 6,659,074

Ex Parte Reexamination Proceeding
Control No. 90/010,545
Filed: May 19, 2009
For: U.S. Patent No. 6,659,074

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/010,202 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,202 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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,549	05/22/2009	7279018	2835-0141PUS4	5242

2292 7590 07/16/2010

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/16/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRACEWELL & GIULIAN LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

Date: MAILED
JUL 16 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010549
PATENT NO. : 7279018
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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JUL 16 2010

CENTRAL REEXAMINATION UNIT

Birch Stewart Kolasch & Birch (For Patent Owner)
P.O. Box 747
Falls Church, VA 22040-0747

Bracewell & Giuliani LLP (For Requester)
P.O. Box 61389
Houston, TX 77208-1389

Ex Parte Reexamination Proceeding
Control No. 90/010,549
Filed: May 22, 2009
For: US Patent No. 7,279,018

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed May 4, 2010 under 37 CFR 1.182 to consider the paper filed December 18, 2009 to meet the requirements of a Statement of the Interview Summary under 37 CFR 1.560(b). This petition is being considered under 37 CFR 1.181 to withdraw or vacate the Notice of Intent to Issue a Reexamination Certificate. The alternative petition filed under 37 CFR 1.137(b) will not be addressed here. Patent Owner is advised to file this petition separately as it is not decided in the Central Reexamination Unit. 37 CFR 1.4(c)

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

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

Review of Facts

A request for Reexamination was submitted on May 2, 2009.

Reexamination was ordered on July 7, 2009.

A non-final Office action was mailed on October 23, 2009.
A personal interview was held on December 17, 2009.

A first request for an extension of time was submitted on December 18, 2009.

The request for the extension was granted for two months on December 23, 2009.

A second request for an extension of time was submitted on February 11, 2010.

The request for the extension was granted for one month on February 18, 2010.

A response to the non-final Office action was submitted on March 23, 2010.

A Notice of Intent to Issue a Reexamination Certificate was mailed April 27, 2010.

The present petition was submitted on May 4, 2010.

Analysis and Findings

MPEP 2281 states in pertinent part:

In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reason presented at the interview as warranting favorable actions, **must** be filed by the patent owner. 37 CFR 1.560(b). The written statement must be filed either as a separate paper within one month after the date of the interview, or as a separate part of a response to an outstanding Office action, whichever is later.
The requirement for a patent owner's statement of the interview cannot be waived by the examiner. It should be noted that, pursuant to 37 CFR 1.550(d), the failure to filed a written statement of an interview as required under 37 CFR 1.560(b) will result in the termination of the reexamination prosecution (in the same way that failure to timely respond to an Office action results in the rumination of the reexamination prosecution).

37 CFR 1.560(b) states:

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reason presented at the interview as warranting favorable action must be filed by the patent owner. An interview

does not remove the necessity for response to Office actions as specified in 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

37 CFR 1.550(d) states:

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 thee reexamination proceeding under 1.570 in accordance with the last action of the Office.

Decision

The petition states that the request for the extension of time filed December 18, 2009 described the content of the interview of December 17, 2009 and this should be considered a Statement of the Interview. Accordingly, patent owner requests the Office withdraw the *ex parte* Reexamination Certificate from issue, and substantively address the response and amendment filed March 23, 2010.

As stated in MPEP 2281, the written statement summarizing the discussion of the interview must be filed either as a separate paper within one month after the date of the interview, or as a separate part of a response to an outstanding Office action, whichever is later. The requirement for a patent owner's statement of the interview cannot be waived by the examiner.

No such written statement has been received as a separate paper. A separate paper must not include other matters, such a requesting an extension of time. See 37 CFR 1.4(c). Therefore, this paper cannot satisfy the requirement for a written statement of the interview. Furthermore, the request does not provide a summary of the discussion of the interview. It only discusses the interview as the basis for the request for additional time to conduct experiments and fails to provide any details of the discussion of the interview.

In addition, the record is clear that the response submitted by patent owner on March 23, 2010 did not include a separate section discussing the interview. Accordingly, the record shows that no written statement of the interview was received as required by 37 CFR 1.560(b), and that the proceeding was properly terminated in accordance with 37 CFR 1.550(d).

The proceeding was properly terminated in accordance with Office rules and procedures.

Conclusion

1. The Patent Owner's petition to consider the paper filed December 18, 2009 to meet the requirements of a Statement of the Interview Summary under 37 CFR 1.560(b) and to withdraw or vacate the Notice of Intent to Issue a Reexamination Certificate is **denied**.

2. Any future response may be submitted as follows:

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

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

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,549	05/22/2009	7279018	2835-0141PUS4	5242

2292 7590 07/22/2010

BIRCH STEWART KOLASCH & BIRCH
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date: MAILED
JUL 22 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010549
PATENT NO. : 7279018
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Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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CENTRAL REEXAMINATION UNIT

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Bracewell & Giuliani LLP (For third party requester)
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In re Juha Jakkula et al. :
Ex Parte Reexamination Proceeding : **DECISION GRANTING**
Control No. 90/010,549 : **PETITION UNDER**
Filed: May 22, 2009 : **37 CFR 1.137(b)**
For: U.S. Patent No. 7,279,018 :

This is a decision on the May 4, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Statement of the Interview and revive the present terminated reexamination prosecution ("the May 4, 2010 petition to revive").

The May 4, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) and is ripe for consideration. In this regard, the Office issued on July 16, 2010, a Decision on Petition Under 37 CFR 1.181 denying patent owner's petition filed May 4, 2010 under 37 CFR 1.182 to consider the paper filed December 18, 2009, to meet the requirements of a Statement of the Interview Summary under 37 CFR 1.560(b).

The May 4, 2010 petition to revive is **granted**.

The April 27, 2010 Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file a written statement of an interview as required under 37 CFR 1.560(b) is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

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

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

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.550 provides, in pertinent part:

(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.[1]

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the December 17, 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 proper statement under 37 CFR 1.560(b) was not filed until May 4, 2010, which was untimely. For the purpose of evaluating whether the May 4, 2010 petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on May 4, 2010, satisfies item (1).

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the May 4, 2010 petition to revive has been paid, which satisfies item (2).

A proper statement under 37 CFR 1.137(b)(3) with respect to the May 4, 2010 statement under 37 CFR 1.560(b) was submitted as part of the May 4, 2010 petition to revive. Item (3) has thus been satisfied.

Accordingly, the May 4, 2010 patent owner petition to revive is **granted**.

The April 27, 2010 Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file a written statement of an interview as required under 37 CFR 1.560(b) is **withdrawn**.

Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The May 4, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The April 27, 2010 Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file a written statement of an interview as required under 37 CFR 1.560(b) is **withdrawn**.

3. Jurisdiction over this reexamination proceeding is being returned to Art Unit 3991 for processing of the May 4, 2010 Statement of the Interview.

---

[1] *See*: 37 CFR 1.137(d)(3).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, of Art Unit 3991, at (571) 272-1448.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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.
90/010,557	06/04/2009	6103490	379574-490RX (103035)	9227

37509 7590 12/22/2009

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVOZYMES NORTH AMERICA, INC
500 FIFTH AVENUE
SUITE 1600
NEW YORK, NY 10110

Date:
MAILED
DEC 2 2 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010557
PATENT NO. : 6103490
ART UNIT : 3991

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DECHERT LLP
P.O. Box 390460
Mountain View, CA 94039-0460

(For Patent Owner)

NOVOZYMES NORTH AMERICA, INC
500 Fifth Ave. Ste 1600
New York, NY 10110

(For Requester)

Ex Parte Reexamination Proceeding
Control No. 90/010,557
Filed: June 4, 2009
For: US Patent No. 6,103,490

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

This is a decision on the petition filed December 14, 2009 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated October 23, 2009.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated October 23, 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 attorney and patent owner have been reviewing this case in an effort to prepare a response. It's been determined that a declaration of an expert would enhance the patent owner's position and efforts to obtain the declarations have also begun. Additional time is needed to complete the review, obtain the declaration, 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 October 23, 2009 is extended to run three (3) months from the date of the Office action and is due on January 23, 2010. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated October 23, 2009 is **granted** for one (1) month.
2. The Patent Owner's response is due January 23, 2010.
3. Response may be submitted as follows:

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

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

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

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

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

/Deborah Jones/
SPE, Art Unit 3991
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,561	07/16/2009	5,411,474	7034/136	2877

5073 7590 06/26/2010

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/26/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

Date:
MAILED

JUN 26 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010561
PATENT NO. : 5411474
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
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ALEXANDRIA, VA 22313-1450
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BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980

(For Patent Owner)

MAILED

JUN 26 2010

CENTRAL REEXAMINATION UNIT

TIMOTHY P. LUCIER
BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO, IL 60610

(For 3rd Party Requester)

In re Ott et al.	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/010,561	: **DISMISSING PETITION**
Filed: July 16, 2009	: **UNDER 37 CFR 1.182**
For: U.S. Patent No.: 5,411,474	:

This is a decision on the April 26, 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 April 26, 2010, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,411,474 (the '474 patent) issued on May 2, 1995.

2. On August 14, 2009, the Office issued an order granting a July 16, 2009 request for reexamination of claims 11 and 12 of the '474 patent by a third party requester, which was accorded control number 90/010,561 (the '10561 proceeding).

3. The proceeding progressed until, on March 31, 2010, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '10561 proceeding.

4. On April 8, 2010, the present proceeding entered the publication cycle.

5. The instant petition was filed on April 26, 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 April 26, 2010, after the proceeding entered the publication cycle on April 8, 2010. Patent owner states that references were filed "to keep the Office apprised of litigation activity."[1] The petition 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 litigation proceedings. There is no statement by the patent owner that unequivocally state why any of 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(s) 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 requiring 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 March 31, 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

[1] Petition at 4.

proceeding and the failure to set forth a statement of unpatentability as to at least one claim under reexamination, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS paper.

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

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on April 26, 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

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

June 16, 2010

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.
90/010,562	05/29/2009	6,598,148	0081-011D3C1X2	3053

40972 7590 10/02/2009

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2009

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,562	05/29/2009	6,598,148	0081-011D3C1X2	3053

40972 7590 10/02/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2009

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United States Patent and Trademark Office
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HENNEMAN & ASSOCIATES, PLC (For Patent Owner)
70 N. MAIN ST.
THREE RIVERS MI 49093

FOLEY AND LARDNER LLP (For Third Party Requester)
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

WHITE & CASE LLP (For Third Party Requester)
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

In re Moore *et alia*	: DECISION *SUA SPONTE*
Reexamination Proceeding	: MERGING
Control No. 90/008,227	: REEXAMINATION
For: U.S. Patent No. 6,598,148	: PROCEEDINGS
In re Moore *et alia*	:
Reexamination Proceeding	:
Control No. 90/010,562	:
For: U.S. Patent No. 6,598,148	:

MAILED

OCT 02 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. 6,598,148 (hereinafter, the '148 patent), issued to Moore *et alia*, on July 22, 2003.

2. On September 21, 2006, a request for *ex parte* reexamination of the '148 patent was filed. The reexamination proceeding was assigned Control Nos. 90/008,227 (hereinafter, the '8227 proceeding).

3. On November 22, 2006, the reexamination order granting the request in the '8227 proceeding was mailed. There are amendments to the claims in '8227 proceeding.

4. On May 29, 2009, a third party deposited a request for *ex parte* reexamination of the '148 patent. The reexamination proceeding was assigned Control No. 90/010,562 (hereinafter, the '10562 proceeding).

5. On August 20, 2009, the reexamination order granting the request in the '10562 proceeding was mailed. There are no amendments in the '10562 proceeding. Patent owner waived the right to a patent owner statement in a paper filed September 17, 2009.

DECISION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in 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 '8227 and '10562 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims have been amended in the '8227 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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

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

CONCLUSION

1. Reexamination Control Nos. 90/008,227 and 90/010,562 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
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Alexandria, VA 22313-1450

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

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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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,565	06/04/2009	7290288	120.0002-00REX	8800

22882 7590 04/28/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MARTIN & FERRARO, LLP
1557 Lake O'Pines Street, NE
Hartville, OH 44632

(for Owner)

Haynes and Boone, LLP
IP Section
2323 Victory Avenue Suite 700
Dallas, TX 75219

(for Requester)

In re Patent of: Gregg et al.
Control No.: 90/010565
Deposited: June 4, 2009
For: US Patent No. 7,290,288

DECISION ON PETITION UNDER 37 C.F.R. 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed April 2, 2010 to expunge information from the above identified proceeding.

The petition is granted.

Petitioner requests that the proprietary material submitted April 2, 2010 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to **not** be material to the examination of the instant proceeding. Applicant is required to retain the expunged material(s) for the life of any patent which issues with a reexamination certificated based on the above-identified proceeding .

The expunged material has been removed from the official file.

Any questions regarding this decision should be directed to Jessica Harrison, SPE AU 3992 of the Central ReExamination Unit at 571-272-4449

PETITION GRANTED

/J. Harrison/

Jessica Harrison
SPE, AU 3992
Central ReExamination Unit

PETITION TO EXPUNGE 1.59

Serial No. _____ Date of Review: _____ Reviewer: _____

Filing Date _____ Expunge what? _____

Date of Petition _____ Reconsideration? Y N

Applicant: _____ TITLE _____

ABEYANCE/ Grant/ DISMISS/Deny AU _____ Director Young/Schmidt
IF ABEYANCE, In PALM grouping TC3700Expunge? Y N Artifact or Closed in IFW?

I. INFORMATION SUBMITTED UNDER MPEP § 724.02 Trade Secret, Proprietary, and/or Protective Order Materials: petition must contain:

_____(A) a clear identification of the information to be expunged without disclosure of the details thereof;

_____(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

_____(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

_____(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

_____(E) the fee as set forth in 37 CFR 1.17(*>g<) for a petition under 37 CFR 1.59(b).

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

_____(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

_____(B) it is stated 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;

_____(C) the information has not otherwise been made public;

_____(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

_____(E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and

_____(F) the petition fee as set forth in 37 CFR 1.17(*>g<) is included.

III. INFORMATION SUBMITTED IN INCORRECT APPLICATION

37 CFR 1.59(b) also covers the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such a situation, a petition should request that the papers be expunged rather than transferred to the correct application file. For Image File Wrapper (IFW) processing, see IFW Manual. The grant of such a petition will be governed by the factors enumerated in paragraph II of this section in regard to the unintentional submission of information.

IV. INFORMATION FORMING PART OF THE ORIGINAL DISCLOSURE

A petition to expunge a part of the original disclosure must be filed under 37 CFR 1.183, since such a request requires a waiver of the requirements of 37 CFR 1.59(a). Petitions under 37 CFR 1.183 should be directed to the Office of Petitions.

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NOV 13 2009

CENTRAL REEXAMINATION UNIT

Proskauer Rose LLP
One International Place
Boston, MA 02110

Patent Owner

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,112
Filed: February 22, 2008
For: U.S. Patent No. 6,743,222

Ex Parte Reexamination Proceeding
Control No. 90/010,567
Filed: July 10, 2009
For: U.S. Patent No. 6,743,222

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/010,112 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,112 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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,571	06/10/2009	7,084,859	REEX-0901	7106

69753 7590 05/12/2010

APPLE C/O MORRISON AND FOERSTER ,LLP
LOS ANGELES
555 WEST FIFTH STREET SUITE 3500
LOS ANGELES, CA 90013-1024

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WPAT, PC
7225 BEVERLY ST.
ANNANDALE, VA 22003

Date: MAILED

MAY 12 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010571
PATENT NO. : 7084859
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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APPLE C/O MORRISON AND FOERSTER ,LLP LOS ANGELES 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES CA 90013-1024	:	(For Patent Owner)
WPAT, PC INTELLECTUAL PROPERTY ATTORNEYS 7225 BEVERLY ST. ANNANDALE, VA 22003	:	(For Third Party Requester)

MAILED

MAY 12 2010

CENTRAL REEXAMINATION UNIT

In re: Timothy R Pryor *Ex Parte* Reexamination Proceeding Control No. 90/010,571 Deposited on: 10 June 2009 For: US Patent No. 7,084,859 B1	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 07 May 2010 petition titled, "Petition for Extension of Time (37 CFR § 1.550(c): MPEP § 2265" requesting the response period for response be extended by one (1) month for response to the non-final Office action dated 11 March 2010, be extended by one (1) month. 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 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 11 March 2010, which sets two (2) 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.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual

> accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

ANALYSIS AND FINDINGS

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

The petitioner has <u>not</u> demonstrated "sufficient cause" for granting the extension of time. The petitioner has noted that patent owner has begun to identify potential declarants but this statement lacks any specificity as to what actions were undertaken in the period for response for which a declarant is needed and specifically why this additional time is needed. The petitioner has not provided a statement of what specific action the patent owner has taken to provide a response and why in spite of the action taken thus far the requested time is needed. MPEP § 2265 requires (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. Further, the petition lacks a statement that must provide a factual accounting of reasonably <u>diligent behavior</u> by all those responsible for preparing a response to the outstanding Office action within the statutory time period. On balance, there is <u>not</u> "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

The petition request to extend the response time is hereby <u>dismissed.</u>

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 months from the mailing of the non-final Office action.

3. The response is due **11 May 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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
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EXAMINER

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.
90/010,175	05/22/2008	5843073	CRD-001RX	5404

76808 7590 11/17/2009

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81 Main Street
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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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90/009,188; 90/010,175; 90/010,196; 90/010,578;

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

76808 7590 11/17/2009

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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;

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

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81 Main Street
Suite 503
White Plains, NY 10601

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2009

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NOV 17 2009

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 90/009,188
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	

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

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

Reexamination proceedings control Nos. 90/009,188; 90/010,175; 90/010,194; and 90/010,196 (hereinafter: "the first set") were previously merged in a decision mailed November 19, 2008, and these proceedings are still pending and prosecution has not been terminated. Reexamination proceeding control No. 90/010,578 was filed June 18, 2009 and reexamination ordered in a decision mailed July 30, 2009. Accordingly, the above two sets of reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

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

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

As evidenced by the above facts, the first set of reexamination proceedings and reexamination control No. 90/010,578 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely and the proceedings are hereby

merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, no amendments have been made to the claims or drawings. However, the specification has been amended by virtue of the amendment filed March 13, 2009 in the first set of proceedings. The patent owner is required to maintain identical claims, drawings, and specification in both files. **Accordingly, patent owner is hereby required to provide a "housekeeping" amendment within one month of the mailing date of this decision placing identical specifications in each of the files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

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

Conclusion

Reexamination control Nos. 90/009,188; 90/010,175; 90/010,194; 90/010,196; and 90/010,578 are hereby merged into a single proceeding. **As stated above, patent owner has one-month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same specification in each of the files**. Upon receipt of the response or expiration of the time period indicated above, whichever comes first, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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

Senniger Powers LLP
100 North Broadway
17th Floor
St. Louis, MO 63102

For Patent Owner

MAILED

JAN 29 2010

CENTRAL REEXAMINATION UNIT

Townsend & Townsend & Crew, LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,583
Filed: June 24, 2009
For: U.S. Patent No. 5,910,088

Ex Parte Reexamination Proceeding
Control No. 90/009,596
Filed: September 24, 2009
For: U.S. Patent No. 5,910,088

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/010,583 was ordered in a decision mailed September 4, 2009 granting reexamination of claims 1-9, all of the claims then pending in US Patent No. 5,910,088[1]. Patent owner filed an Information Disclosure Statement on December 30, 2009. No Office action has been rendered since the mailing of the decision ordering reexamination.

[1] At the time of filing of this request, proceedings in prior reexamination proceeding Control No. 90/010,156 had not concluded, thus the request and order were based on original patent claims 1-9, the claims then in effect.

Reexamination in application control No. 90/009,596 was ordered in a decision mailed November 20, 2009 granting reexamination of claims 2-7 and 10-16, all of the claims pending in US Patent No. 5,910,088 following the publication of reexamination certificate No. 7,038 on September 1, 2009. Patent owner filed an Information Disclosure Statement on December 30, 2009. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,583 and reexamination control No. 90/009,596 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

The patent owner is required to maintain identical claims, drawings, and specification in both files. As noted above, when reexamination Control 90/010,583 was filed, only claims 1-9 were in effect at that time and the submitted copy of the patent for which reexamination was requested only contained original patent claims 1-9. However, when the second reexamination request was filed, i.e., reexamination Control No. 90/009,596, by virtue of the publication of first reexamination certificate No. 7,038, original patent claims 1, 8 and 9 had been cancelled; original patent claims 2, 6 and 7 had been amended, and new claims 10-16 added. Thus, the proceedings do not include identical claims. **Accordingly, patent owner is hereby required to provide a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently all of the pending claims, namely claims 2-7 and 10-16, are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester(s) and requester(s) will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief fee, brief fee, etc.) only a single feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and

copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,583 and 90/009,596 are hereby merged into a single proceeding. **As stated above, patent owner has one-month from the mailing date of this decision within which to submit a 'housekeeping' amendment placing the same claim in each of the files**. Upon receipt of the response or expiration of the time period indicated above, whichever comes first, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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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APR 26 2010

CENTRAL REEXAMINATION UNIT

Leader Technologies, Inc.
Ste. 118
921 Eastwind Dr.
Westerville, OH 43081 (Patent Owner)

White & Case LLP
Patent Department
1155 Avenue of Americas
New York, NY 10036 (*Ex Parte* Requester)

Cooley Godward Kronish LLP
Patent Group – Suite 1100
777 – 6th Street NW
Washington, DC 20001 (For *Inter Partes* Requester)

King & Spaulding LLP
1700 Pennsylvania Ave. NW
Suite 200
Washington, DC 20006 (Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/010,591
Filed: July 2, 2009
For: U.S. Patent No. 7,139,761

Inter Partes Reexamination Proceeding
Control No. 95/001,261
Filed: Nov.13, 2009
For: U.S. Patent No. 7,139,761

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,139,761 (the '761 patent) issued to McKibben et al. with the assignee listed as Leader Technologies, Inc. on Nov. 21, 2006, with 35 claims.

2. A request for *ex parte* reexamination of claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent was filed on July 2, 2009, by a third party requester, and was assigned control number 90/010,591 (the '591 *ex parte* proceeding).

3. On Sept. 25, 2009, *ex parte* reexamination was ordered for claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent based on the examiner's determination that the July 2, 2009 request raised a substantial new question of patentability affecting these claims.

4. A request for *inter partes* reexamination of claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent was filed on Nov. 13, 2009, by a third party requester representing Facebook, Inc as the real party in interest. The request was assigned control number 95/001,261 (the '1261 *inter partes* proceeding).

5. On Feb. 9, 2010, *inter partes* reexamination was ordered for claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent based on the examiner's determination that the Nov. 13, 2009 request raised a substantial new question of patentability affecting these claims.

6. A concurrent litigation styled *Leader Technologies, Inc. v. Facebook, Inc.*, U.S. District Court of Delaware, 1:08cv00862 filed Nov. 19, 2008 involving the '761 patent is presently pending.

7. There has been no Office action in either proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '591 *ex parte* proceeding expired after Nov. 25, 2009. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1261 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

[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.

the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

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

In accordance with 37 CFR 1.989(a), the 90/010,591 and 95/001,261 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. CONDUCT OF MERGED PROCEEDING

A. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Presently, the claims and the specification are the same in each proceeding.

B. Governing regulations for the merged proceeding:

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

It is noted that reexamination was ordered for claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent in the '591 proceeding and for claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent in the '1261 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-16, 21-29, and 31-35 of the '761 patent.

C. Papers mailed/filed:

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

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

III. . CORRESPONDENCE ADDRESS FOR PATENT OWNER

The correspondence address for the patent to be reexamined is the address of the patent owner in the patent file. See MPEP 2222 and 37 CFR 1.33(c). The correspondence address of the '761 patent is not the same as the correspondence address listed in the newly filed power of attorney for patent owner in the *ex parte* request. The desired correspondence address must be corrected **in the patent file** to change the correspondence address in this merged proceeding to that listed in the power of attorney. Additionally, a statement establishing the right of the assignee to take action under 37 CFR 3.73(b) must be filed in the patent file along with the power of attorney, in order to support the power of attorney.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/010,591 and *inter partes* Reexamination Control No. 95/001,261 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.

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

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

April 22, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,591	07/02/2009	7,139,761	LTI0001-RXM	6253

74877 7590 07/15/2010

King and Spalding LLP
1700 Pennsylvania Ave, NW
Suite 200
Washington, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

Date:
MAILED
JUL 15 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010591
PATENT NO. : 7139761
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUL 15 2010

CENTRAL REEXAMINATION UNIT

King and Spalding LLP 1700 Pennsylvania Ave, NW Suite 200 Washington DC 20006	: : : :	(For Patent Owner)
WHITE & CASE LLP PATENT DEPARTMENT 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036	: : : :	(For Third Party Requester)
In re: McKibben *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,591 Deposited on: 02 July 2009 For: US Patent No. 7,139,761 B2	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 08 July 2010, "Petition for Extension of Time Under 37 CFR 1.956 (*sic*) to Reply to Office Action" requesting the response period be extended by two (2) months for responding to the non-final Office action mailed 21 May 2010. The petition submitted 08 July 2010 was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response to be extended by two (2) months for responding to the non-final Office action mailed on 21 May 2010, which sets two (2) month's time for filing a response thereto. It is noted that the petition was filed under 37 CFR § 1.956 which is directed to *inter partes* proceedings only, the petition will be addressed under 37 CFR 1.550(c) which is directed to *ex parte* proceedings extensions of time. The petition for extension of time was timely filed on 08 July 2010, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

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

The request is granted-in-part.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

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

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

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. The petitioner notes extensive nature of the Office action and the preparation of a declaration under 37 CFR § 1.132. On balance there is "sufficient cause" for granting-in-part the extension of time. While the concurrent proceedings are noted since they are outside the scope of the instant proceeding they are not germane to the petitioner's request for extension of time.

The petition request to extend the response time is hereby granted-in-part for a period fourteen (14) days.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action mailed on 21 May 2010 is hereby **granted-in-part.**

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

3. The response is extended to **21 August 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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MAR 03 2010

CENTRAL REEXAMINATION UNIT

Shawn O'Dowd KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON DC 20005	: : : : :	(For Patent Owner)
WILMERHALE/NEW YORK 399 PARK AVENUE NEW YORK, NY 10022	: : :	(For Third Party Requester)
In re: Muncaster *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,592 Deposited on: 06 July 2009 For: US Patent No. 6,826,046	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 02 March 2010, "Petition for One-Month Extension of Time Pursuant to 37 CFR § 1.550(c)" requesting the response period be extended by one-month for responding to the non-final Office action mailed 26 January 2010. The petition submitted 02 March 2010 was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response to be extended by one-month for responding to the non-final Office action mailed on 26 January 2010, which sets two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 02 March 2010, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

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

ANALYSIS AND FINDINGS

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

The petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. The petitioner notes in their factual accounting the weather which forced the closing of the federal government in and around the Washington DC metropolitan area, the delay in viewing the file through PAIR and the federal holiday. Additionally, the petitioner notes that they are seeking an interview. Since there was no indication that the examiner was not available during the response period, it is understood that the interview could have been scheduled during the response period. On balance there is "sufficient cause" for granting-in-part the extension of time.

The petition request to extend the response time is hereby granted-in-part for a period of fourteen (14) days.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action mailed on 26 January 2010 is hereby **granted-in-part.**

2. The period for response is extended by fourteen (14) days.

3. The response is extended to **09 April 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

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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.
90/010,593	07/07/2009	7114297	P200038.US.01	8254

20449 7590 11/18/2009

KARL R CANNON
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SANDY, UT 84091

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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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DENVER, CO 80202-5647

Date:

MAILED

NOV 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010593
PATENT NO. : 7114297
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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NOV 18 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

Lee R. Osman
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In re Mathis et al.	:
Reexamination Proceeding	: DECISION ON
Control No. 90/010,593	: PETITION UNDER
Filed: July 7, 2009	: 37 CFR 1.181
For: U.S. Patent No. 7,114,297	:

The paper filed by requester on September 14, 2009, styled as "Petition from Partial Denial of Request for Reexamination under 37 C.F.R. §§ 1.515(c) and 1.181," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order dated August 14, 2009 and which denied-in-part the Request for *Ex Parte* Reexamination. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists for claims 10, 12, 21-33, and 35 based upon the references cited pursuant to substantial new questions 1, 3, 4, and 5, as set forth in the request for reexamination.

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

REVIEW OF FACTS

1. U.S. Patent No. 7,114,297 (hereinafter, the '297 patent) issued on October 3, 2006.

2. On July 7, 2009, the third party requester deposited a request for *ex parte* reexamination for claims 1-36, and the resulting reexamination proceeding was assigned Control No. 90/010,593 (hereinafter, the '593 proceeding).

3. On August 14, 2009, an order granting the request for reexamination for claims 1-9, 11, 13-20, 34, and 36 was issued. The order stated that the request for reexamination did not raise any SNQ for claims 10, 12, 21-33, and 35.

6. On September 14, 2009, 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 U.S. Patent No. 3,974,605 to Beatty, alone and in combination, with respect to claims 10 and 30. See pages 2-3 of the petition.
2. The examiner incorrectly concluded that the teachings of U.S. Patent No. 5,333,428 to Taylor is nonanalogous art and does not raise a substantial new question of patentability in combination with Beatty with respect to claims 10, 12, 21-24, 29-33, and 35 and in combination with Beatty and U.S. Patent No. 6,418,572 to Epple et al. with respect to claims 25-28. See pages 3-8 of the petition.
3. The examiner incorrectly determined that the combination of Beatty and U.S. Patent No. 3,950,907 to Dahowski to not raise a substantial new question of patentability with respect to claims 10 and 30. See pages 8-10 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 10, 12, 21-33, and 35 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 10, 12, 21-33, and 35 of the '297

patent. Consideration is limited to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 10, 12, 21-33, and 35. 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.

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]

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

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.

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

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. The Beatty reference: It must be determined if Beatty raises a substantial new question of patentability (SNQ) not considered in a prior examination or reexamination. In other words, does Beatty, either singly or together, raise an SNQ for claims 10 and 30 that is different from the technical teachings that were considered with respect to claim patentability in the prosecution of application number 10/347,161, which issued as the 7,114,297 patent?

In the prosecution of the '297 patent, claim 4 (issued as patent claim 10) was rejected as being obvious over U.S. Patent No. 1,782,147 to Merryweather in view of U.S. Patent No. 3,008,273 to Widin and claim 56 (issued as patent claim 30) was rejection as being anticipated by U.S. Patent No. 1,782,147 to Merryweather. See pages 5-6 of the Office action dated September 12, 2005. These claims were allowed after an examiner's amendment, dated June 8, 2006, added the following limitation to both claims:

> "and wherein said curved portion comprises a curved portion slot for receiving said corner plate."

The request for reexamination, dated July 7, 2009, stated that claims 10 and 30 of the '297 patent are obvious under 35 U.S.C. § 103 in view of Beatty alone or in view of Beatty and U.S. Patent No. 3,950,907 to Dahowski. See, e.g., pages 6 and 82 of the request.

As stated in the section above, in order to raise a SNQ, the cited art must present a substantial new technological teaching, which was not present in the earlier concluded examination(s). Because claims 10 and 30 were allowed only after the inclusion of the above-cited limitation, it is clear that the prior examination did not include a teaching pertaining to the curved portion comprising a curved portion slot for receiving the corner plate. In an attempt to meet this limitation, the request does not state that Beatty teaches this limitation but instead states that "...it would be an obvious alternative to form a slot in the corner clip 115 to receive a portion of the corner top 116 in order to join the two pieces" (e.g., see, e.g., pages 16 and 21 of the request). Therefore, the request does not advance that Beatty teaches the claim limitation found to be lacking in the prior examination, but instead relies upon a conclusion that the claim limitation requiring a curved portion slot for receiving the corner plate is an obvious equivalent to the structure taught in Beatty. No evidence is provided to support this conclusion. In the order denying the request for reexamination, the examiner explicitly found that Beatty does not teach this claim limitation and therefore, does not raise a substantial new question of patentability. See page 5 of the order denying reexamination dated August 14, 2009.

Upon *de novo* review, the examiner correctly determined that the request fails to show that Beatty raises a substantial new question of patentability. In reviewing the request, it is clear that Beatty does not teach that curved portion comprise a curved portion slot for receiving said corner

plate and no evidence is provided to establish that Beatty teaches an "obvious equivalent." This unsupported conclusion concerning obvious equivalents is not sufficient to establish a new technological teaching in Beatty. As stated above, reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. Without a showing of a new technological teaching that was not present in the prior examination, the Office does not have the jurisdiction to order reexamination for claims 10 and 30. Therefore, the examiner correctly concluded that Beatty fails to raise a substantial new question of patentability with respect to the claims 10 and 30.

B. The Taylor reference: The request for reexamination proposes obviousness rejections of claims 1-24 and 29-36 based on Beatty in view of Taylor and claims 25-28 based on Beatty in view of Taylor and Epple. The request relies upon the teachings of Taylor to establish the substantial new question of patentability to support the above-mentioned proposed rejections (see, e.g., pages 37-39 and 75). In the order, the examiner stated that Taylor is directed to an invention to mount insulated glass in buildings and as such, one of ordinary skill in the art would not look to Taylor for teachings of improvements in swimming pool construction. Additionally, the examiner stated there would be no reasonable expectation of success of modifying the teachings of Beatty by the teachings of Taylor to arrive at the claimed invention because of the differences in materials, constructions, and issues attributed to their different uses. See page 7 of the order dated August 14, 2009.

Upon review, the order does not clearly set forth why the Taylor reference fails to raise a substantial new question of patentability. According to MPEP 2247, the examiner must explicitly set forth for each reference that is cited to raise an SNQ, why the citation is:

> (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
>
> (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
>
> (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
>
> (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

The examiner's explanation seems to be indicating that Taylor is nonanalogous art and that there is not a reasonable expectation of success. These criteria or tests are required in performing an obviousness analysis under 35 U.S.C. 103(a). See, e.g., MPEP 2141.01(a) and 2143.02. Such criteria need not be met in order to establish a substantial new question of patentability. See MPEP 2242, which states, "'a substantial new question of patentability' as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully

anticipated by, or obvious in view of, the prior art patents or printed publications." Although the order may be interpreted as stating that Taylor is not deemed important to a reasonable examiner in deciding the patentability of the claims, the order did not clearly explain in detail why this is so.

Upon review of the request for reexamination, pages 37-39 of the request show that Taylor provides teachings that may be deemed relevant to the limitation that the "curved portion comprises a curved portion slot for receiving said corner plate" or the curved portion includes a "receptor slot or portion" found in claims 10, 12, 21, 22-33 and 35. Therefore, Taylor provides a new technological teaching that was not present in the prior examinations of the '297 patent. Accordingly, the Taylor reference raises a substantial new question of patentability for claims 10, 12, 21, 22-33 and 35 of the '297 patent.

C. The Beatty and Dahowski references: As stated in the section A above, Beatty fails to raise a substantial new question of patentability with respect to claims 10 and 30 of the '297 patent. Petitioner states that Dahowski shows that it was known to provide "... a slot in the back of a corner spandrel component to receive a corner piece. See pages 8-10 of the petition. The application of Dahowski to the claim limitations in the petition is different from the application stated in the request for reexamination. In the request, it is stated that:

> "One of ordinary skill in the art would understand from the '907 patent that a curved portion of a modular corner piece for a pool could not only have a channel for receiving the pool liner, but also a "slot for receiving said corner plate" as set forth in claim 3, to cover the corner of the pool." See pages 83-84 of the request

In other words, the request did not state that Dahowski teaches the limitation pertaining to the curved slot, as the petition now seemingly advances, but instead that "[o]ne of ordinary skill in the art would understand from the '907 patent [Dahowski] that a curved portion of a modular corner piece for a pool could, in addition to a channel for receiving the pool liner, have a slot for attaching a corner plate to cover the corner of the pool." See page 84 of the request.
As stated above, this 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. Therefore, based upon the SNQ presented in the request, the examiner correctly determined that the request fails to show that Beatty in view of Dahowski raises a substantial new question of patentability. In reviewing the request, it is clear that Beatty in view of Dahowski does not teach that the curved portion comprises a curved portion slot for receiving said corner plate and no evidence is provided to establish that Beatty in view of Dahowski renders such claimed structure obvious. The unsupported conclusion concerning obvious in the request is not sufficient to establish a new technological teaching in Beatty in view of Dahowski.

CONCLUSION

1. The PETITION is GRANTED-IN-PART. The Taylor reference raises a substantial new question of patentability for claims 10, 12, 21, 22-33 and 35 of the '297 patent.

2. The proceeding will be returned to the examiner to await further action as appropriate. The next Office action will consider the proposed obviousness rejections of claims 1-24 and 29-36 based on Beatty in view of Taylor and claims 25-28 based on Beatty in view of Taylor and Epple, including whether the proposed rejections meet the analogous art and reasonable expectation of success criteria.

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

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

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

4. 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.

5. 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,598	08/12/2009	7411080	705116	9865

38647 7590 05/11/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2010

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010598
PATENT NO. : 7411080
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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MAILED

MAY 11 2010

CENTRAL REEXAMINATION UNIT

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(For third party requester)

In re Gang Zhao
Ex Parte Reexamination Proceeding
Control No. 90/010,598
Filed: August 12, 2009
For: U.S. Patent No. 7,411,080

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

This is a decision on the March 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the March 25, 2010 patent owner petition to revive").

The March 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

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 ...

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the January 8, 2010 Office action.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

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

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

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.550 provides, in pertinent part:

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

*

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee 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.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the January 8, 2010 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The January 8, 2010 Office action set a two-month period for response. A proper response to the January 8, 2010 Office action was not filed until March 25, 2010, which was untimely. However, for the purpose of evaluating whether the March 25, 2010 patent owner petition to revive is a grantable petition, the submission of the March 25, 2010 Response To Office Action satisfies item (1).[2]

Accordingly, the March 25, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 25, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3991, for treatment of the March 25, 2010 Response To Office Action.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, of CRU Art Unit 3991, at (571) 272-1448.

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 March 25, 2010 Response To Office Action as to each of the rejections set forth in the January 8, 2010 Office action; such is the examiner's province.

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.
90/010,599	07/10/2009	6188988	1911-001	2664

20792 7590 04/15/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2010

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

United States Patent and Trademark Office

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MAILED
APR 15 2010
CENTRAL REEXAMINATION UNIT

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

(For Patent Owner)

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039

(For Third Party Requester)

In re *Barry et al.*
Reexamination Proceeding
Control No. 90/010,599
Filed: July 10, 2009
For: U.S. Patent No. 6,188,988

DECISION DISMISSING AND EXPUNGING IMPROPER PAPERS

This is a decision on the October 23, 2009, and October 29, 2009 third party requester petitions, both entitled "Petition to Merge Pending Reexaminations of U.S. Patent 6,188,988." These petitions, submitted with a $400 petition fee charged to requester's deposit account, are treated as petitions under 37 CFR 1.183.

The petitions are before the Office of Patent Legal Administration for decision.

The petitions are **dismissed**.

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

REVIEW OF THE FACTS

1. U.S. Patent 6,188,988 (the '988 patent) issued to Barry et al. on February 13, 2001.

2. On July 10, 2009, a third party requester fulfilled the filing date requirements for a request for *ex parte* reexamination of the '988 patent, assigned control number 90/010,599 (the '599 proceeding).

[1] See MPEP 2267.

3. On October 9, 2009, reexamination was ordered for the '599 proceeding.

4. On October 23, 2009, and on October 29, 2009 third party requester filed the instant petitions entitled "Petition to Merge Pending Reexaminations of U.S. Patent 6,188,988." [2]

5. On March 23, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '599 proceeding.

APPLICABLE REGULATIONS

35 U.S.C. 305 addresses the conduct of reexamination proceedings:

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

37 CFR 1.182 addresses questions not specifically provided for:

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

37 CFR 1.183 provides for suspension of rules:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on

[2] The merged proceeding of reexamination numbers 95/001,088 and 90/009,213 of the 6,188,988 patent was pending at this time.

> 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 as to third party requesters:

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

37 CFR 1.550 provides as to third parties in general:

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

MPEP 2283(VII) sets forth the procedure for a third party requester to petition for merger in *ex parte* 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.

DECISION

Third party requester has filed the instant petitions requesting merger. Third party requester has not, however, specified any rule or regulation permitting such third party requester papers. A third party requester may petition to merge multiple copending reexamination proceedings as part of a reply pursuant to 37 CFR 1.535, as set forth at MPEP 2283(VII). However, the instant petitions are not part of a reply pursuant to 37 CFR 1.535. In the '599 proceeding, the patent owner did not file a statement under § 1.530, and the time for filing such a statement has passed; therefore, the submissions do not meet the requirements for a reply under § 1.535 in the '599 proceeding. Therefore, the instant petitions do not follow the procedure set forth in MPEP 2283(VII) for third party requests to merge multiple copending reexamination proceedings.

Furthermore, neither present petition is a request for reexamination in compliance with the requirements of 37 CFR 1.510, nor qualifies as a prior art citation under 37 CFR 1.501. A submission by a third party is governed by 37 CFR 1.550. The instant third party requester submissions, not meeting the requirements of § 1.550(g)(1) or (g)(2), is therefore prohibited under 37 CFR 1.550.

While the petition states that the Patent Office may "charge any fee," the petition does not present any arguments specific to particular regulations for which a fee would be required. Requester has not, for instance, asked to waive 37 CFR 1.550(g) pursuant to 37 CFR 1.183; neither has requester identified a situation existing under 37 CFR 1.181(a).

Since the requester has not identified any specific rule or regulation permitting the third party requester paper, the instant petition could be treated as a petition under 37 CFR 1.182, which addresses "[a]ll situations not specifically provided for in the regulations." However, 37 CFR 1.550 specifically forbids entry of any third party requester submission in an *ex parte* reexamination proceeding which does not meet the requirements of the regulation. Therefore § 1.182 would not be available for relief.

Neither can relief be granted under 37 CFR 1.183, since third party requester has not provided arguments that the instant situation is "an extraordinary situation", such that "justice requires" waiver of 37 CFR 1.510. Furthermore, § 1.183 is unavailable where the situation is "a requirement of the statutes." In *ex parte* reexamination proceedings, 35 U.S.C. 305 requires that "[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination." For the instant '599 proceeding the time set forth by §304 has expired; therefore the petition is forbidden, by statute, any right of entry in the instant '599 proceeding. Since § 305 forbids third party participation outside the time limit set by §304, §1.183 is unavailable to waive "requirement of the statutes," and permit consideration of the instant petition.

Furthermore, since the reexamination certificate has already issued in the '599 proceeding, on March 23, 2010, the question of merger is now moot, as the '599 proceeding has been concluded.

CONCLUSION

1. The third party requester petitions filed October 23, 2009, and October 29, 2009 are <u>dismissed</u> as not having a right of entry.

2. The petition papers filed by the third party requester on October 23, 2009, and October 29, 2009 are **<u>expunged</u>** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '599 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

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

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

5. Telephone inquiries relating to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to the undersigned, at (571) 272-7726.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

April 14, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

32233 7590 01/27/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,910	10/31/2007	5191525	DIS 03741 PTRX	6175

32233 7590 01/27/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANTON HOPEN
SMITH AND HOPEN, P.A.
180 PINE AVENUE N.
OLDSMAR, FL 34677

Date:

MAILED

JAN 27 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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

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

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

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Date: JAN 2 7 2010

CENTRAL REEXAMINATION UNIT

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

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010609
PATENT NO. : 5191525
ART UNIT : 3992

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

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

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

(For Patent Owner)

MAILED

JAN 27 2010

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re LeBrun *et alia*
Reexamination Proceeding
Control No. 90/008,910
Request Deposited: November 6, 2007
For: U.S. Patent No. 5,191,525

In re LeBrun *et alia*
Reexamination Proceeding
Control No. 90/010,609
Request Deposited: July 17, 2009
For: U.S. Patent No. 5,191,525

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,191,525 (hereinafter, the '525 patent), issued to LeBrun *et alia*, on March 2, 1993.

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

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

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

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

DECISION

Under 37 C:F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8910 and the '10609 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, numerous original claims have been amended in the '8910 reexamination proceedings. It appears that original claims 17, 37, 61, 81 and 89 were amended with the paper of 11/25,2008, claims 37, 51, 71, 75, 87 were amended and claims 93-98 were added with the paper of 7/7/2009 and claims 37, 51, 71, 73, 75, 87, were amended and claim 74 was cancelled with the paper of 8/24/2009. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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

III. Conduct of Merged Proceeding.

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

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

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

CONCLUSION

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

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

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

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

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

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

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

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

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

/J. Harrison/

Jessica Harrison
SPE AU 3992 Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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DEC 14 2009

CENTRAL REEXAMINATION UNIT

ALIX YALE & RISTAS LLP
750 MAIN STREET
SUITE 1400
HARTFORD CT 06103

(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

In re Lekhtman
Reexamination Proceeding
Control No. 90/010,612
For: U.S. Patent No. 5,337,753

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,337,753 (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.

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.

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

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,623	07/28/2009	7321783	R107440C	2837

40401 7590 12/30/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 12/30/2009
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,183	04/29/2009	7321783	RIK107440B	7201

40401 7590 12/30/2009
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date MAILED
DEC 30 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001080
PATENT NO. : 7321783
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
AKIN GUMP STRAUSS HAUER & FELD, LLP
P.O. BOX 688
DALLAS, TX 75313-0688

Date: MAILED
DEC 30 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001183
PATENT NO. : 7321783
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.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314
(For Patent Owner)

Novak, Druce & Quigg LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002
(For first *Inter Partes* & *ex parte* Requester)

MAILED
DEC 30 2009
CENTRAL REEXAMINATION UNIT

Akin, Gump, Strauss, Hauer & Feld LLP
1700 Pacific Avenue, Suite 4100
Dallas, TX 75201-4675
(For second *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,080
Filed: September 9, 2008
For: U.S. Patent No. 7,321,783

Inter Partes Reexamination Proceeding
Control No. 95/001,183
Filed: April 29, 2009
For: U.S. Patent No. 7,321,783

Ex Parte Reexamination Proceeding
Control No. 90/010,623
Filed: July 28, 2009
For: U.S. Patent No. 7,321,783

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,321,783 (the '783 patent) issued to Ki Il Kim on January 22, 2008.

2. On September 9, 2008, a first request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27, /39, /55), 70, 76-78, 79 (/27, /55, /70, /76, /77, /78), 80 (/1, /2, /76), 83, 85 (/32), 87 (/1, /2), 89 (/1, /2, /76) 106-107, 111, 118, 119 (/70, /118), and 120-123, was filed by third party requester and real party in interest, Apple Inc. The request was assigned control number 95/001,080 (the '1080 proceeding).

3. On November 29, 2008, *inter partes* reexamination was ordered on the claims requested in the '1080 proceeding based on the examiner's determination that the September 9, 2008 request raised a substantial new question of patentability.

4. On February 24, 2009, a non-final Office action was mailed in the '1080 proceeding, rejecting claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27, /39, /55), 70, 76-78, 79 (/27, /55, /70, /76, /77, /78), 80 (/1, /2, /76), 83, 85 (/32), 87 (/1, /2), 89 (/1, /2, /76) 106-107, 111, 118, 119 (/70, /118), and 120-123 of the '783 patent.

5. On April 23, 2009, patent owner timely filed in the '1080 proceeding an amendment and response to the February 24, 2009 Office action, presenting new claims 126-150. No claims were amended or canceled.

6. On April 29, 2009, a second request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10-21, 27-31, 43, 45 (/43), 46, 48 (/46), 49, 51, 53, 55, 56, 57 (/1, /2, /27, /43, /46, /51, /56), 58 (/27, /43, /46, /51, /55), 59-78, 79 (/27, /43, /46, /55, /56, /61, /64, /66, /70, /74, /76, /77, /78), 80 (/1, /2, /27, /46, /51, /55, /61, /66, /72, /73, /74, /77), 81(/51, /74, /76, /77, /78), 83, 85 (/51), 86, 87 (/1, /2, /51, /73, /74, /77), 88 (/51), 89 (/1, /2, /27, /43, /46, /55, /56, /61, /64, /66, /70, /72, /73, /74, /76, /77, /78), 90-101, 106-107, 111, 114-119 and 121-125, was filed by third party requester and real party in interest, ALLTEL Communications, LLC. The request was assigned control number 95/001,183 (the '1183 proceeding).

7. On June 4, 2009, third party requester Apple, Inc., timely filed in the '1080 proceeding written comments.[1]

8. On July 21, 2009, *inter partes* reexamination was ordered on the claims requested in the '1183 proceeding, based on the examiner's determination that the April 29, 2009 request raised a substantial new question of patentability.

9. On July 28, 2009, an *ex parte* request for reexamination of the '783 patent, on claims 18 (/16, /1), 18 (/16, /2), 33(/32), 34 (/33, /32), 35 (/32), 36 (/32), 40 (/39), 42, 48 (/46), 50, 52 (/50), 54 (/50), 82 (/1, /2, /55, /76), 84 (/50), 88 (/50), 102 (/42), 103 (/42), 104, 105 (/104), 108 (106), 109 (/106), 110 (/108), 110 (/109), and 112-113, was filed by the first *inter partes* requester, Apple Inc. The request was assigned control number 90/010,623 (the '10623 proceeding).

10. On August 28, 2009, *ex parte* reexamination was ordered on the claims requested in the '10623 proceeding, based on the examiner's determination that the July 28, 2009 request raised a substantial new question of patentability.

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[1] Third party requester's comments are considered timely as patent owner's April 23, 2009 response was non-compliant with regards to 37 CFR 1.943 page limit requirements until May 5, 2009 when the Office issued a waiver of the page limit requirement.

11. To date, no Office action has issued in the '1183 *inter partes* proceeding, nor in the '10623 *ex parte* proceeding, and there has been no further Office action than stated above in the '1080 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same patent regarding different, overlapping sets of claims.[2] Two of the proceedings are *inter partes* reexamination proceedings and one is an *ex parte* proceeding initiated by one of the *inter partes* requesters. All 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(a) provides:

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,080, 95/001,183 *inter partes* proceedings and the 90/010,623 *ex parte* proceedings <u>are merged</u>.

Claims 1-5, 7-8, 10-21, 27-32, 33(/32), 34 (/33, /32), 35 (/32), 36 (/32), 39, 40 (/39), 42-43, 45 (/43), 46, 48 (/46), 49-51, 52 (/50), 53, 54 (/50), 55-56, 57 (/1, /2, /27, /43, /46, /51, /56), 58 (/27, /39, /43, /46, /51, /55), 59-78, 79 (/27,/43, /46, /55,/56, /61, /64, /66,/70,/74, /76, /77, /78), 80 (/1, /2, /27, /46, /51, /55, /61, /66, /72, /73, /74, /76,/77), 81(/51, /74, /76, /77, /78), 82 (/1, /2, /55, /76), 83, 84 (/50), 85 (/32, /51), 86, 87 (/1, /2, /51, /73, /74, /77), 88 (/50, /51), 89 (/1, /2, /76), 89 (/1, /2, /27, /43, /46, /55, /56, /61, /64, /66, /70, /72, /73, /74, /76, /77, /78), 90-101, 102 (/42), 103 (/42), 104, 105 (/104), 106-107, 108 (106), 109 (/106), 110 (/108), 110 (/109), 111-125 and 126-150 are before the Office in this merged reexamination proceeding, which 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 all files throughout the merged proceeding. Claims 126-150 have been newly presented in the '1080 proceeding, but they are not present in either the '1183 or '10623 proceedings. Therefore, the claims are not currently the same in all three proceedings. Accordingly, an amendment is needed to place the same claims in all three proceedings.

---

[2] See paragraphs 2, 6 and 9 of the "Review of the Relevant Facts" section of this decision.

2. Claims 126-150 **are rejected under 35 U.S.C. 112, paragraph 2, as being indefinite** as to the content of the claims, and thus fail to particularly point out the invention, because claims 126-150 are not in all three proceedings.

3. Patent owner is required to submit an appropriate amendment within one month of this decision, such amendment placing the same amendment in all three proceeding.

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 presented new claims 126-150 in the '1080 proceeding. Failure to include the remarks that set forth the basis for having presented new claims 126-150 in patent owner's response will result in a holding that the amendment is non-responsive and non-enterable, leading to cancellation of claims 126-150 from the merged reexamination proceeding.

5. After patent owner files a response to this decision, each 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 solely 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 requesters is statutory, and it may not be extended.

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 the rights of the third party requester of the '10623 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '10623 *ex parte* reexamination was requested by Apple, Inc., the same third party as in the '1080 *inter partes* reexamination proceeding. Therefore, Apple Inc. has full *inter partes* reexamination third party participation rights and the *ex parte* reexamination third party requester participation restrictions are not applicable. Accordingly, the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

Upon merger of proceedings both *inter partes* requesters, Apple, Inc and ALLTEL Communications, LLC, can comment on all issues provided 35 U.S.C. 314(b)(2) is satisfied.[3]

[3] 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

First, an *inter partes* requesters' rights to comment are contingent upon the patent owner responding. Second, the *inter partes* requesters' rights to comment are 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. Therefore, in the merged proceeding, the two *inter partes* requesters, Apple, Inc. and ALLTEL Communications, LLC, both have a right to comment upon all issues raised in the relevant Office action and the patent owner's response to that action. Neither *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in any previous Office actions, any previous patent owner response papers, any previous comment papers from another requester, and the reexamination request papers. The statutory time period of 30 days from date of service of patent owner's response is applicable to both *inter partes* third party requesters.

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 files 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

---

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.

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. 95/001,080 and 95/001,183 and *ex parte* Reexamination Control No. 90/010,623 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. An amendment must be filed, pursuant to Part II of this decision, within ONE MONTH of the mail date of this decision, placing the same claims in all three files of the present merged

proceeding, together with remarks as to the addition of the new claims included in the response (as discussed above).

3. After patent owner files a response to this decision, each 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 newly presented claims. Such issues may include the issue of claim patentability based on prior patents/printed publications applicable to any newly presented claims in patent owner's response. The time for submitting comments by the third party requesters 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 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.

6. 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,630	07/31/2009	5493335	18768-0043RX2	8515

1333 7590 03/18/2010

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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90/010,630	07/31/2009	5493335	18768-0043RX2	8515

1333 7590 03/18/2010

EXAMINER

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P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER NY 14650-2201	: : : :	(For Patent Owner)
W Karl Renner FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022	: : : :	(For Third Party Requester)

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

In re: Parulski *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,630 Deposited on: 31 July 2009 For: US Patent No. 5,493,335	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 17 March 2010 patent owner submitted petition entitled, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting the response period for response be extended by one (1) month for response to the non-final Office action dated 05 February 2010, be extended by one (1) month. The petition submitted 17 March 2010 was timely filed without certificate of service.

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

The petition is dismissed 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 05 February 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 17 March 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.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a

petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

37 CFR § 1.550 (f). Conduct of ex parte reexamination proceedings.

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office. (emphasis added)

ANALYSIS AND FINDINGS

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

The petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner has noted that there is a request for an interview and complexity of the Office action. The petitioner has not provided a statement of what action the patent owner has taken to provide a response and why in spite of the action taken thus far the requested time is needed. On balance, there is not "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

The petitioner is reminded of conduct in ex parte reexamination requires service of all papers on the third party requester pursuant to 37 CFR § 1.550(f). according to 37 CFR 1.550(f) the document must reflect service or the document may be refused consideration by the Office.

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

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 05 February 2010 is hereby **dismissed.**

2. The period ends two months from the mailing of the non-final Office action.

3. The response is due **05 April 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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90/010,631	07/31/2009	6,292,218	18768-0043RX1	8831

1333 7590 03/18/2010

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,631	07/31/2009	6,292,218	18768-0043RX1	8831

1333 7590 03/18/2010

EXAMINER

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

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER NY 14650-2201	: : : :	(For Patent Owner)
W Karl Renner FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022	: : : :	(For Third Party Requester)
In re: Parulski *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,631 Deposited on: 31 July 2009 For: US Patent No. 6,292,218	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

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CENTRAL REEXAMINATION UNIT

This is a decision on the 17 March 2010 patent owner submitted petition entitled, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting the response period for response be extended by one (1) month for response to the non-final Office action dated 05 February 2010, be extended by one (1) month. The petition submitted 17 March 2010 was timely filed without certificate of service.

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

The petition is dismissed 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 05 February 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 17 March 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.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a

petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

37 CFR § 1.550 (f). Conduct of ex parte reexamination proceedings.

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office. (emphasis added)

ANALYSIS AND FINDINGS

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

The petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner has noted that there is a request for an interview and complexity of the Office action. The petitioner has not provided a statement of what action the patent owner has taken to provide a response and why in spite of the action taken thus far the requested time is needed. On balance, there is not "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

The petitioner is reminded of conduct in ex parte reexamination requires service of all papers on the third party requester pursuant to 37 CFR § 1.550(f). according to 37 CFR 1.550(f) the document must reflect service or the document may be refused consideration by the Office.

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

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 05 February 2010 is hereby **dismissed.**

2. The period ends two months from the mailing of the non-final Office action.

3. The response is due **05 April 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,634	08/03/2009	6284770	021825-013001US	1249

20350 7590 12/30/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
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In re Mangel et al.
Reexamination Proceeding
Control No. 90/010,634
Filed: August 3, 2009
For: U.S. Patent No. 6,284,770

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181 AND
: 1.515(c)

Patent Owner filed a paper on October 30, 2009, entitled "PETITION UNDER 37 C.F.R. 1.515(c) AND 1.181 REQUESTING REVIEW OF DENIAL OF REEXAMINATION" (hereinafter the petition). The petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the patent owner and reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed October 1, 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 **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,284,770 (hereinafter, the '770 patent) issued on September 4, 2001.

2. A request for *ex parte* reexamination was filed on August 3, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,634 (hereinafter, the '634 proceeding). Reexamination was requested for claims 1-9 of the '770 patent based upon GLAXO WELLCOME; New Product Makes a Difference: M Magnet - The Magazine for Glaxo Wellcome plc staff; page 6, July 1997 ("Magnet") and GLAXO

WELLCOME: For Women Only; Rubicon - The International news magazine for Glaxo Wellcome R & D staff; page 9, August 1997 ("Rubicon").

3. A Notice of Reexamination Request Filing Date for the '634 proceeding was issued on September 11, 2009.

4. An order denying the request for reexamination for claims 1-9 in the '634 proceeding was mailed on October 1, 2009.

5. On October 30, 2009, Patent Owner / Requester filed the present petition under 37 CFR §§ 1.181 and 1.515(c) in the '634 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the patent owner and requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner erred in finding the Magnet and Rubicon references cumulative to the prior art relied upon during prosecution of the application that became the '770 patent (09/529,050, "the '050 application").

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 1-9 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 1-9 of the '770 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-9. 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 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

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

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

The Request includes a preliminary amendment which cancels or amends claims 1-9 and adds new claims 10-18. The claims of the patent in effect at the time of the determination will be the basis for deciding whether a SNQ is present (MPEP 2243).

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[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

Therefore the present *de novo* review is limited to claims 1-9 as they appear in the '770 patent.

Magnet and Rubicon were considered by the examiner of the '050 application, but were not discussed or relied upon in any ground of rejection. Magnet describes the results of phase II clinical trials of alosetron in patients with irritable bowel syndrome (IBS) and states that "women responded better to the therapy than men" (p. 6, col. 3). Rubicon summarizes data from phase II clinical trials of alosetron (p. 9, col. 1). The data indicate that alosetron is more effective in women than men. Consequently, phase III trials were to be restricted to an all-female test population.

In the remarks filed October 30, 2000 Applicant argued that greater efficacy in female patients was an unexpected result. The examiner was not persuaded by this argument. In maintaining the § 103 rejection she stated that it was well known that IBS afflicts more women than men (Office action of January 12, 2001, pp. 3-4). The examiner's position was weak – why would the greater prevalence of IBS in women predict greater drug efficacy in women if all the test subjects had IBS? Citing the Magnet and Rubicon disclosures, which show better results in female patients, would have provided a much stronger rebuttal to Applicant's argument.

The record is not clear as to why the claims were ultimately allowed. A telephonic interview was held on February 15, 2001. That same day, Applicant filed an amendment which only slightly modified the claims. Applicant's remarks thanked the examiner for indicating that the amended claims would be allowed, but did not indicate what was discussed during the interview. The examiner's interview summary likewise did not describe the substance of the interview, nor were reasons for allowance provided with the subsequently issued notice of allowability.

Petitioner speculates that the last argument on the record (i.e. Applicant's argument of unexpected results) must have ultimately persuaded the examiner to allow the claims. This is impossible to verify, but given the examiner's failure to cite Rubicon and Magnet in response, it appears likely that the examiner overlooked the disclosure of greater drug efficacy in women when reviewing these documents. Moreover, stating that a greater proportion of women suffer from IBS is not equivalent to stating that alosetron is more effective in women; therefore the Rubicon and Magnet disclosures are <u>not</u> cumulative to the other references cited by the examiner.

There is a substantial likelihood that a reasonable examiner would consider the Magnet and Rubicon publications important in deciding whether or not claims 1-9 of the '770 patent are patentable, and therefore a SNQ exists.

CONCLUSION

1. The PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-9 of the '770 patent is GRANTED, and reexamination is hereby ordered.

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

4. 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.

for Deborah Jones

Gregory A. Morse, Director
Central Reexamination Unit

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For Patent Owner

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CENTRAL REEXAMINATION UNIT

Procopio, Cory, Hargreaves & Savitch LLP
530 B Street
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San Diego, CA 92101

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,643
Filed: August 12, 2009
For: U.S. Patent No. 5,109,651

Ex Parte Reexamination Proceeding
Control No. 90/010,920
Filed: March 18, 2010
For: U.S. Patent No. 5,109,651

DECISION *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/010,643 was ordered in a decision mailed September 4, 2009. The decision granted reexamination for claims 1-3, and 5-32, the

claims for which reexamination was requested. Prosecution has progressed to a point where claims 1-3, 5, and 7-32 have been cancelled.[1]

Reexamination in application Control No. 90/010,920 was ordered in a decision mailed March 31, 2010. The decision indicating that claim 2, the only claim for which reexamination was requested, would be reexamined. On April 7, 2010, patent owner filed a waiver of his rights to file a Patent Owner Statement under 37 CFR 1.530. On April 8, 2010, patent owner filed an amendment cancelling claim 2, the claim for which reexamination was requested.

As evidenced by the above facts, reexamination Control No. 90/010,643 and reexamination control No. 90/010,920 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, above-captioned 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

In merged reexamination proceedings, patent owner is required to maintain identical claims, drawings, and specification in both files. As noted above, in reexamination control No. 90/010,643, claims 1-3, 5, and 7-32 have been cancelled leaving only 6 subject to reexamination.[2] In reexamination control No. 90/010,920, claim 2, the only claim for which reexamination was requested, has been cancelled.[3] It is assumed that no instructions have been given in reexamination control No. 90/010,920 to cancel claims 1, 3, 5 and 7-32 in view of the instructions to cancel these claims given in first reexamination proceeding control No. 90/010,643. In view of the above-noted assumption, both proceedings are deemed identical at this point and 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. Claim 6, the only remaining claim for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal

[1] Claims, 1, 3, 5, and 7-32 were cancelled per the amendment filed March 24, 2010. Claim 2 was cancelled per the amendment filed April 7, 2010.
[2] No reexamination for claim 4 was requested.
[3] No reexamination for claim 4 was requested.

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

Conclusion

Reexamination Control Nos. 90/010,643 and 90/010,920 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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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For 3rd Party Requester
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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

Ex Parte Reexamination Proceeding
Control No. 90/010,647
Filed: August 17, 2009
For: U.S. Patent No. 7,089,201

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

Conclusion

Reexamination control Nos. 90/010,233 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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,649	08/18/2009	6114635	9065.007.000000	7345

24197 7590 06/17/2010

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2010

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

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United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED
JUN 17 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010649
PATENT NO. : 6114635
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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Klarquist Sparkman, LLP (For patent owner)
121 SW Salmon Street
Suite 1600
Portland, OR 97204

MAILED

JUN 17 2010

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

CENTRAL REEXAMINATION UNIT

In re Kenneth Meade Lakin et al.	:
Ex Parte Reexamination Proceeding	: **DECISION**
Control No. 90/010,649	: **GRANTING**
Filed: August 18, 2009	: **PETITION UNDER**
For: U.S. Patent No. 6,114,635	: **37 CFR 1.137(b)**

This is a decision on the June 8, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the June 8, 2010 patent owner petition to revive").

The June 8, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 8, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the March 15, 2010 Office action.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

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

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

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.550 provides, in pertinent part:

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

*

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the June 8, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the March 15, 2010 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The March 15, 2010 Office action set a two-month period for response. A proper response to the March 15, 2010 Office action was not filed until June 8, 2010, which was untimely. However, for the purpose of evaluating whether the June 8, 2010 patent owner petition to revive is a grantable petition, the submission of the June 8, 2010 Response To Office Action satisfies item (1).[2]

Accordingly, the June 8, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The June 8, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for treatment of the June 8, 2010 Response To Office Action.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Minh Nguyen, of CRU Art Unit 3992, at (571) 272-1748.

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 June 8, 2010 Response To Office Action as to each of the rejections set forth in the March 15, 2010 Office action; such is the examiner's province.

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Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

For Patent Owner

MAILED

JAN 29 2010

CENTRAL REEXAMINATION UNIT

Thomas H. Martin
Martin & Ferraro LLP
1557 Lake O'Pines St., NE
Hartville, OH 44632

For 3rd Party Requester
90/009,542

Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W., Suite 800
Washington, DC 20005

For 3rd Party Requester
90/010,655

Ex Parte Reexamination Proceeding
Control No. 90/009,542
Filed: July 24, 2009
For: U.S. Patent No. 6,936,071

Ex Parte Reexamination Proceeding
Control No. 90/010,655
Filed: August 24, 2009
For: U.S. Patent No. 6,936,071

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/009,542 and 90/010,655 are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/009,542 was ordered in a decision mailed September 4, 2009, granting reexamination of claims 1-16 and 19-30 of US Patent No. 6,936,071. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

Reexamination in application Control No. 90/010,655 was ordered in a decision mailed September 15, 2009, indicating that claims 1-16 and 19-30 of US patent No. 6,936,071 would be reexamined. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

As evidenced by the above facts, reexamination Control No. 90/009,542 and reexamination control No. 90/010,655 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely and the proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-16 and 19-30 are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper will be entered into each of the files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief fee, brief fee, etc.) only a single feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination control Nos. 90/009,542 and 90/010,655 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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For Patent Owner

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JUL 26 2010

CENTRAL REEXAMINATION UNIT

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1557 Lake O'Pines St., NE
Hartville, OH 44632

3d Party Requester
(90/009,542)

Joseph A. Hynds
Rothwell, Figg, Ernst & Manbeck, P.C.
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Washington, DC 20005

3rd Party Requester
(90/010,655)

Ex Parte Reexamination Proceeding
Control No. 90/009,542
Filed: July 24, 2009
For: U.S. Patent No. 6,936,071

Ex Parte Reexamination Proceeding
Control No. 90/010,655
Filed: August 24, 2009
For: U.S. Patent No. 6,936,071

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed June 4, 2010, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The petition is **DISMISSED**.

Petitioner requests that "the Protective Order Material submitted in a sealed envelop herewith be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability". The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the

information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

The information in question has been determined by the examiner in charge of the proceedings to not be material to the examination of the instant merged reexamination proceeding. However, the petition is deficient because it lacks items (A), (C), and (D) listed above. As to item (B), the petition does not indicate that the material in question has not been otherwise made public.

If patent owner still wishes to have the material in question expunged, a renewed petition must be promptly filed in view of the mailing of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate on July 14, 2010, for once the reexamination proceeding enters the reexamination certificate printing process, it may not be possible to address the renewed petition. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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.
90/010,663	09/02/2009	5775995	6620-82302-02	5809

20210 7590 03/12/2010

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,663	09/02/2009	5775995	6620-82302-02	5809

20210 7590 03/12/2010

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PORTLAND, OR 97204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2010

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(For Patent Owner)

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MAR 12 2010

CENTRAL REEXAMINATION UNIT

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD NH 03301

(For Third Party Requester)

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204

In re Okamoto Reexamination Proceeding Control No. 90/009,523 For: U.S. Patent No. 5,775,995	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Okamoto Reexamination Proceeding Control No. 90/010,663 For: U.S. Patent No. 5,775,995	: : : :

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,775,995 (hereinafter, the '995 patent), issued to Okamoto, on July 7, 1998.

2. On August 17, 2009, a corrected request for *ex parte* reexamination of the '995 patent was filed by Patent Owner. The reexamination proceeding was assigned Control Nos. 90/009,523 (hereinafter, the '9523 proceeding).

3. On October 1, 2009, the reexamination order granting the request in the '9523 proceeding was mailed indicating that claims 1 and 2 would be reexamined.

4. On September 2, 2009, a third party deposited a request for *ex parte* reexamination of the '995 patent. The reexamination proceeding was assigned Control No. 90/010,663 (hereinafter, the '10663 proceeding).

5. On November 27, 2009, the reexamination order granting the request in the '10663 proceeding was mailed indicating that claims 1 and 2 would be reexamined.

6. The time period for a patent owner statement has expired in both proceedings.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9523 and '10663 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/009,523 and 90/010,663 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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

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

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

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

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

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

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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,666	09/04/2009	6193520	6620-82302-03	8556

164 7590 03/12/2010

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,666	09/04/2009	6193520	6620-82302-03	8556

164 7590 03/12/2010

EXAMINER

Joseph T. Jakubek
KLARQUIST SPARKMAN, LLP, ONE WORLD TRADE CENTER
121 S.W. Salmon Street
Portland, OR 97204

ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2010

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

(For Patent Owner)

MAILED

MAR 12 2010

CENTRAL REEXAMINATION UNIT

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD NH 03301

(For Third Party Requester)

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204

In re Okamoto Reexamination Proceeding Control No. 90/009,524 For: U.S. Patent No. 6,139,520	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Okamoto Reexamination Proceeding Control No. 90/010,666 For: U.S. Patent No. 6,139,520	: : : :

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,139,520 (hereinafter, the '520 patent), issued to Okamoto, on July 7, 1998.

2. On August 17, 2009, a corrected request for *ex parte* reexamination of the '520 patent was filed by Patent Owner. The reexamination proceeding was assigned Control No. 90/009,524 (hereinafter, the '9524 proceeding).

3. On November 14, 2009, the reexamination order granting the request in the '9524 proceeding was mailed indicating that claims 1, 2, 4, 5, 7-9, 11, 12, 14, 15, 19, and 21 would be reexamined.

4. On September 4, 2009, a third party deposited a request for *ex parte* reexamination of the '520 patent. The reexamination proceeding was assigned Control No. 90/010,666 (hereinafter, the '10666 proceeding).

5. On December 3, 2009, the reexamination order granting the request in the '10666 proceeding was mailed indicating that claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 19, and 21 would be reexamined.

6. The time period for a patent owner statement has expired in both proceedings.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9524 and '10666 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/009,524 and 90/010,666 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
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
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Alexandria, VA 22314

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

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

Eric Keasel

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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MAR 25 2010

CENTRAL REEXAMINATION UNIT

MARTIN & FERRARO, LLP (For Patent Owner)
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HARTVILLE OH 44632

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(CERNER CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

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

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

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

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

BACKGROUND

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

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

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

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

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

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

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

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

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/009,196 & 90/010,670 *ex parte* reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

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

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

CONCLUSION

1. Reexamination Control Nos. 90/009,196 & 90/010,670 *ex parte* reexamination proceedings are hereby **merged**.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,674	10/02/2009	6177956	07597-112037	9178

93143 7590 04/16/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-4003

Date: MAILED

APR 16 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010674
PATENT NO. : 6177956
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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Abraham Hershkowitz Herskovitz & Associates, LLC 2845 Duke Street Alexandria VA 22314	: : : :	(For Patent Owner)

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APR 16 2010

CENTRAL REEXAMINATION UNIT

Steven T Snyder KING & SPALDING 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036-4003	: : : :	(For Third Party Requester)

In re: Anderson *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,674 Deposited on: 15 September 2009 For: US Patent No. 6,177,956	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 13 March 2010, "Petition for Extension of Time Under 37 CFR 1.550(c)" requesting the response period be extended by two (2) months for responding to the non-final Office action mailed 19 February 2010. The petition submitted 13 March 2010 was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response to be extended by two (2) months for responding to the non-final Office action mailed on 19 February 2010, which sets two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 13 March 2010, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The period for response is extended by one (1) month's time. The request is granted-in-part.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> *Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all

those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. The petitioner notes delay in receipt of the Office action, need for affidavit "swearing back" and/or an affidavit or declaration from an expert witness. The multiple responses are noted as well as the consideration of an interview. On balance there is "sufficient cause" for granting-in-part the extension of time. Requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

The petition request to extend the response time is hereby granted-in-part for a period one (1) month.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action mailed on 19 February 2010 is hereby **granted-in-part.**

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

3. The response is extended to **19 May 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
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401 Dulany Street
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By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 07 2010

CENTRAL REEXAMINATION UNIT

Commissioner for Patents
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(For Patent Owner)

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Third Party Requester)

KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-4003

(For Third Party Requester)

HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-7195

In re Kuo *et alia* Reexamination Proceeding Control No. 90/010,676 Corrected Request Deposited: October 2, 2009 For: U.S. Patent No. 6,400,471	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Kuo *et alia* Reexamination Proceeding Control No. 90/010,875 Corrected Request Deposited: March 4, 2010 For: U.S. Patent No. 6,400,471	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,400,471 (hereinafter, the '471 patent), issued to Kuo *et alia*, on June 4, 2002.

2. On October 2, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '471 patent. The reexamination proceeding was assigned Control No. 90/010,676 (hereinafter, the '10676 proceeding).

3. The Reexamination Order was granted in the '10676 proceeding on November 14, 2009 finding a substantial new question of patentability (SNQP) as to claims 1-8, 10, 11, 13-17, 19, 20, 22-24, 26, 28, and 29.

4. A non-final office action was mailed in the '10676 proceeding on March 17, 2010.

5. On April 19, 2010, Patent Owner responded to the office action in the '10676 proceeding and added new claims 31-60.

6. On March 4, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '471 patent. The reexamination proceeding was assigned Control No. 90/010,875 (hereinafter, the '10875 proceeding).

7. The Reexamination Order was granted in the '10875 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-9, 12-18, 21-27, and 30.

8. Patent Owner did not waive their right to a file a Patent Owner statement. The period for a Patent Owner statement has expired.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. <u>Merger of Proceedings.</u>

In accordance with 37 C.F.R. § 1.565(c), the '10676, and '10875 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims 31-60 have been added in the '10676 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/010,676 and 90/010,875 are MERGED.

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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,677	10/02/2009	6504575	07597-112037	9295

93143 7590 04/16/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,677	10/02/2009	6504575	07597-112037	9295

93143 7590 04/16/2010

KING & SPALDING
1185 Avenue of the Americas
New York, NY 10036-4003

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Abraham Hershkowitz Herskovitz & Associates, LLC 2845 Duke Street Alexandria VA 22314	: : : :	(For Patent Owner)

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APR 16 2010

CENTRAL REEXAMINATION UNIT

Steven T Snyder KING & SPALDING 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036-4003	: : : :	(For Third Party Requester)

In re: Ramirez *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/010,677 Deposited on: 15 September 2009 For: US Patent No. 6,504,575	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 13 March 2010, "Petition for Extension of Time Under 37 CFR 1.550(c)" requesting the response period be extended by two (2) months for responding to the non-final Office action mailed 2619 February 2010. The petition submitted 13 March 2010 was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response to be extended by two (2) months for responding to the non-final Office action mailed on 26 February 2010, which sets two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 13 March 2010, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The period for response is extended by one (1) month's time. The request is granted-in-part.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

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

MPEP 2265 (in-part)

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

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

those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. The petitioner notes delay in receipt of the Office action, need for affidavit "swearing back" and/or an affidavit or declaration from an expert witness. The multiple responses are noted as well as the consideration of an interview. On balance there is "sufficient cause" for granting-in-part the extension of time. Requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

The petition request to extend the response time is hereby granted-in-part for a period one (1) month.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action mailed on 26 February 2010 is hereby **granted-in-part.**

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

3. The response is extended to **26 May 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APR 13 2010

CENTRAL REEXAMINATION UNIT

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

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

(For Requester)

In re Anderson
Reexamination Proceeding
Control No. 90/010,681
For: U.S. Patent No. 6,249,316

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

This is a decision on the April 6, 2010 petition for extension of time requesting that the time to submit a response be extended an additional 2 months from the current due date of April 16, 2010.

The petition is before 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. The present petition for extension of time was timely filed on April 6, 2010 with the petition fee required by 37 CFR §1.550(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 ....

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 petition notes Patent Owner's consideration as to the submission of declaratory evidence in response to the office action as well as an apparent delay in mailing or uploading of the outstanding action in the office's Image File Wrapper. Reference is made to the petition for details of this and other issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a complete response. An extension of time of one month is considered sufficient.

Accordingly, the time for filing the response is extended for thirty days and therefor the response is due on or before May 17, 2010 (May 16th being a Sunday).

It should be noted that the petition references a desire to interview the present reexamination and potentially reschedule the interview to a later date. However, the desire to conduct an interview is unrelated to the sufficient cause necessary for the extension of time to respond to the office action because a response can be formulated based on the written record.

Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

CONCLUSION

1. Petitioner's request is **granted in part**. The period during which Patent Owner may file a response has been extended to May 17, 2010 (May 16th being a Sunday).

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

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

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

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

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

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

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

Eric Keasel
SPE, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,683	09/15/2009	5903309	R132590	1042

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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

Date:

MAILED

JUL 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010683
PATENT NO. : 5903309
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,693	02/22/2010	5903309	353990US91RX	4226

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, LLC
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date: **MAILED**

JUL 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009693
PATENT NO. : 5903309
ART UNIT : 3992

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

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JUL 07 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Third Party Requester)

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

(For Third Party Requester)

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

In re Anderson Reexamination Proceeding Control No. 90/010,683 Request Deposited: September 15, 2009 For: U.S. Patent No. 5,903,309	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Anderson Reexamination Proceeding Control No. 90/009,693 Request Deposited: February 22, 2010 For: U.S. Patent No. 5,903,309	

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,903,309 (hereinafter, the '309 patent), issued to Anderson, on May 11, 1999.

2. On September 15, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '309 patent. The reexamination proceeding was assigned Control No. 90/010,683 (hereinafter, the '10683 proceeding).

3. The Reexamination Order was granted in the '10683 proceeding on October 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1-13.

4. A non-final office action was mailed in the '10683 proceeding on February 19, 2010.

5. On April 19, 2010, Patent Owner responded to the office action in the '10683 proceeding and added new claims 14-36.

6. On February 22, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '309 patent. The reexamination proceeding was assigned Control No. 90/009,693 (hereinafter, the '9693 proceeding).

7. The Reexamination Order was granted in the '9693 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-13.

8. Patent Owner did not waive their right to a file a Patent Owner statement. The period for a Patent Owner statement has expired.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. <u>Merger of Proceedings.</u>

In accordance with 37 C.F.R. § 1.565(c), the '10683, and '9693 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims 14-36 have been added in the '10683 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/010,683 and 90/009,693 are MERGED.

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

Eric Keasel

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,684	09/15/2009	6278447	R132596-684	1075

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date:

MAILED

JUL 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010684
PATENT NO. : 6278447
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,833	02/17/2010	6,278,447	06082.0067.RXUS00	5541

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-7195

Date:
MAILED

JUL 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010833
PATENT NO. : 6278447
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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JUL 07 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Herskovitz & Associates, LLC
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(For Third Party Requester)

MORRISON & FOERSTER LLP
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FALLS CHURCH, VA 22042-7195

In re Anderson Reexamination Proceeding Control No. 90/010,684 Request Deposited: September 15, 2009 For: U.S. Patent No. 6,278,447	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Anderson Reexamination Proceeding Control No. 90/010,833 Corrected Request Deposited: February 17, 2010 For: U.S. Patent No. 6,278,447	

This is a decision on the June 15, 2010 paper entitled "PETITION UNDER 37 CFR § 1.181(a)(3) FOR MERGER OF COPENDING EX PARTE REEXAMINATIONS UNDER 37 CFR § 1.565(c)". No fee is required. The petition is before the Central Reexamination Unit for decision.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,278,447 (hereinafter, the '447 patent), issued to Anderson, on August 21, 2001.

2. On September 15, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '447 patent. The reexamination proceeding was assigned Control No. 90/010,684 (hereinafter, the '10684 proceeding).

3. The Reexamination Order was granted in the '10684 proceeding on October 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, 4-7, 9-12, 14-17, 19-22, 24, and 25.

4. A non-final office action was mailed in the '10684 proceeding on February 19, 2010.

5. On April 19, 2010, Patent Owner responded to the office action in the '10684 proceeding and added new claims 26-65.

6. On February 17, 2010, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '447 patent. The reexamination proceeding was assigned Control No. 90/010,833 (hereinafter, the '10833 proceeding).

7. The Reexamination Order was granted in the '10833 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-25.

8. Patent Owner did not waive their right to a file a Patent Owner statement. The period for a Patent Owner statement has expired.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '10684, and '10833 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims 26-65 have been added in the '10684 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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

CONCLUSION

1. Reexamination Control Nos. 90/010,684 and 90/010,833 are MERGED.

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

Eric Keasel
SPE, AU 3992

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.
90/010,687	10/13/2009	4827226	1171.004	4610

28168 7590 04/01/2010

DANIEL J. DENEUFBOURG
CTS CORPORATION
171 COVINGTON DRIVE
BLOOMINGDALE, IL 60108

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,687	10/13/2009	4827226	1171.004	4610

28168 7590 04/01/2010

EXAMINER

MENDELSOHN, DRUCKER & ASSOCIATES, PC
1500 JOHN F. KENNEDY BLVD.
SUITE 405
PHILADELPHIA, PA 19102

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DANIEL J. DENEUFBOURG
CTS CORPORATION
171 COVINGTON DRIVE
BLOOMINGDALE, IL 60108

MAILED

APR 01 2010

CENTRAL REEXAMINATION UNIT

(For Requester)

MENDELSOHN, DRUCKER & ASSOCIATES, PC
1500 JOHN F. KENNEDY BLVD.
SUITE 405
PHILADELPHIA, PA 19102

In re Connell	:
Reexamination Proceeding	: DECISION ON
Control No. 90/010,687	: PETITION UNDER
Filed: October 13, 2009	: 37 CFR 1.181
For: U.S. Patent No. 4,827,226	:

The paper filed by requester on January 19, 2010, styled as "Petition under 37 CFR 1.181," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order dated December 16, 2010 and which denied the Request for *Ex Parte* Reexamination. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists for claims 3 and 15 based upon the references cited pursuant to substantial new questions set forth in the request for reexamination.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 4,827,226 (hereinafter, the '226 patent) issued on May 2, 1989.

2. On November 19, 2007, a third party requester deposited a corrected request for *ex parte* reexamination for claims 1-21 of the '226 patent, and the resulting reexamination proceeding was assigned Control No. 90/008,841 (hereinafter, the '841 proceeding).

3. On January 14, 2008, an order granting reexamination of claims 1-21 was mailed in the '841 proceeding.

4. On August 30, 2008, an Office action was mailed in the '841 proceeding. The Office action indicated claims 3 and 15 allowable over the prior art of record. The '841 proceeding is still pending, and claims 1, 2, 4, 6-8, 11-13, 16, 20, and 21 are rejected as being anticipated by U.S. Patent No. 4,470,024 to Leuenberger.

5. On October 13, 2009, the same third party requester deposited a corrected request for *ex parte* reexamination for claims 3 and 15 of the '226 patent, and the resulting reexamination proceeding was assigned Control No. 90/010,687 (hereinafter, the '687 proceeding).

6. On December 16, 2010, an order denying the request for reexamination for claims 3 and 15 was issued. The order stated that the request for reexamination did not raise any SNQ for claims 3 and 15.

7. On January 19, 2010, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

<u>Petitioner's Grounds in Support of the Requested Relief</u>

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 because the cited combinations of references teach an integrated Colpitts oscillator, which is a new, noncumulative teaching. See pages 5-8 of the petition.
2. The examiner used an incorrect standard in making the determination that the cited references do not raise a substantial new question of patentability, and mischaracterized the teachings of the cited references. See pages 9-13 of the petition.
3. The request should be granted for the sake of equity. See pages 13-15 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 3 and 15 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 3 and 15 of the '226 patent. Likewise, this decision will not address every point raised by the petitioner if the director finds that the examiner's determination was in error. Consideration is limited to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 3 and 15 in the '226 patent. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition) 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.

In order to raise a SNQ for old art, that the old art must be presented/viewed in a <u>new light</u>, 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 <u>same</u> 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 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:

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[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

(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 for reexamination proposes obviousness rejections of claims 3 and 15 based on ten different combinations of references. See page 6 of the request. The request relies upon the teachings of the SSRE, Hongu et al., Gehrke, Pipitone, Embree et al., and Helfrick references to establish the substantial new question of patentability to support the above-mentioned proposed rejections (see, e.g., pages 6-12 of the request).

In the order, the examiner stated that the SSRE and Helfrick references teach a Colpitts oscillator but fail to teach integration of the same. See pages 8 and 13 of the order. The order stated that the teachings of Embree et al., Hongu, Gehrke, and Pipitone are deemed cumulative to the teachings already of record, and fail to teach an integrated variable capacitance means as required by claim 1 or the at least one integrated varactor, as required by claim 11. See pages 8-12 of the order. In the earlier-filed and still pending '841 proceeding, claims 3 and 15 were indicated as allowable because the prior art of record failed to teach a fully integrated oscillating means or fully integrated oscillator comprising a Colpitts oscillator circuit and a tuning network that includes at least one varactor as a shunt element. See page 31 of the first Office action dated August 30, 2008 in the '841 proceeding. The order in the '687 proceeding seems to indicate that more than a teaching of a Colpitts oscillator circuit and a tuning network that includes at least one varactor as a shunt element, the structure cited in claims 3 and 15, is required to raise a SNQ. See, e.g., pages 3-5 of the order.

The examiner's explanation seems to be indicating that the cited combinations of references do not teach all the limitations of claims 1 and 3 or claims 11 and 15, or that there is no reason to combine the teachings. These criteria or tests are required in performing an obviousness analysis under 35 U.S.C. 103(a). See, e.g., MPEP 2141.01(a) and 2143.02. Such criteria need not be met in order to establish a substantial new question of patentability. See MPEP 2242, which states,

"'a substantial new question of patentability' as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications."

Upon review of the request for reexamination, pages 7-8 of the request show that SSRE reference provides teachings relevant to the limitations of a Colpitts oscillator circuit and a tuning network that includes at least one varactor as a shunt element found in claims 3 and 15. Therefore, SSRE provides a new technological teaching that was not present in the prior examinations of the '226 patent, and that new technical teaching would have been important to a reasonable examiner in determining the patentability of at least one claim. Accordingly, the SSRE reference raises a substantial new question of patentability for claims 3 and 15 of the '226 patent.

Because it is agreed that the SSRE reference raises a SNQ with respect to claims 3 and 15 of the '226 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED. The SSRE reference raises a substantial new question of patentability for claims 3 and 15 of the '226 patent. Reexamination was not requested, and is not ordered, for claims 1, 2, 4-14, and 16-21 in this proceeding.

2. Reexamination is ordered for claims 3 and 15 of the '226 patent.

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

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

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

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,701	11/05/2009	7,379,900	case C reexam	2008

62250 7590 06/17/2010

STEPHEN WREN
6 Monarch Trace Court, #102
Chesterfield, MO 63017

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LAWRENCE A. AARONSON
12850 HIGHWAY 9
SUITE 600 PMB 338
ALPHARETTA, GA 30004

Date:
MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010701
PATENT NO. : 7379900
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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STEPHEN WREN 6 Monarch Trace Court, #102 Chesterfield MO 63017	: : :	(For Patent Owner)
LAWRENCE A. AARONSON, P.C. LAWRENCE A. AARONSON 12850 HIGHWAY 9 SUITE #600 PMB 338 ALPHARETTA, GA 30004	: : : : :	(For Third Party Requester)

MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

In re: Stephen Corey Wren *Ex Parte* Reexamination Proceeding Control No. 90/010,701 Deposited on: 05 November 2009 For: US Patent No. 7,379,900 B1	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 10 June 2010 petition titled, "Request for Extension of Time to Respond [37 CFR § 1.550(c)]" requesting the response period for response be extended by sixty (60) days for response to the non-final Office action dated 19 April 2010. The petition submitted 11 June 2010 was timely filed without certificate of service.

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

The petition is dismissed 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 19 April 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 11 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 dismissed.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual

accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR § 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

37 CFR § 1.550 (f). Conduct of *ex parte* reexamination proceedings.

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. <u>The document must reflect service or the document may be refused consideration by the Office</u>. (emphasis added)

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding <u>sixty (60) days</u> 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 notes that the petitioner has reviewed the patents and prosecution history and references cited. The Petitioner further notes the "number and length of cited references" and cites one other application which is not a part of the instant proceeding. The petitioner also notes an interview is planned.

The review of the action finds that only four references and four rejections are found in the Office action which are considered to be not particularly extensive. The other application is noted but since it is not directly a part of the instant proceeding is not germane to the issue at hand. Lastly, while an

interview may be planned there is no indication what if any effort was made to schedule the interview in the two month period for response.

MPEP § 2265 requires (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. Further, the petition lacks a statement that 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 clear why in spite of action taken thus far additional time is needed. There is no specific outline of the factual accounting and why again in spite of this action additional time is needed. On balance, there is not "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

Additionally, lacking certificate of service pursuant to 37 CFR § 1.550(f) is also cause for refusal of consideration of the instant petition.

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

CONCLUSION

1. The patent owner's petition for extension for sixty (60) days time in which to file a response to the non-final Office action dated 19 April 2010 is hereby **dismissed.**

2. The period ends two months from the mailing of the non-final Office action.

3. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 26 2010

CENTRAL REEXAMINATION UNIT

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For Patent Owner

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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

Ex Parte Reexamination Proceeding
Control No. 90/010,713
Filed: October, 9, 2009
For: U.S. Patent No. 7,013,284

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/010,201 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 feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents

and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,201 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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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Alexandria, VA 22313-1450
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MAY 26 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

STROOCK & STROOCK & LAVAN LLP
180 MAIDEN LANE
NEW YORK NY 10038

(For Third Party Requester)

FENWICK & WEST LLP
SILICON VALLEY CENTER
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MOUNTAIN VIEW, CA 94041

(For Third Party Requester)

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

In re Turock Reexamination Proceeding Control No. 90/010,716 Corrected Request Deposited: December 7, 2009 For: U.S. Patent No. 6,243,373	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Turock Reexamination Proceeding Control No. 90/009,637 Corrected Request Deposited: December 29, 2009 For: U.S. Patent No. 6,243,373	

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,243,373 (hereinafter, the '373 patent), issued to Turock, on June 5, 2001.

2. On December 7, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '373 patent. The reexamination proceeding was assigned Control No. 90/010,716 (hereinafter, the '10716 proceeding).

3. The Reexamination Order was granted in the '10716 proceeding on January 29, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-6 and 13-18.

4. On December 29, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '373 patent. The reexamination proceeding was assigned Control No. 90/009,637 (hereinafter, the '9637 proceeding).

5. The Reexamination Order was granted in the '9637 proceeding on January 29, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-24.

6. The period for a Patent Owner statement has expired.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '10716, and '9637 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

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

CONCLUSION

1. Reexamination Control Nos. 90/010,716 and 90/009,637 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an office action.

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

Eric Keasel

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,726	10/30/2009	RE35952	454032800900	1039

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison-Suite 4600
Chicago, IL 60602

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,400	02/09/2009	RE 35952		4219

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON - SUITE 4600
CHICAGO, IL 60602

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,456	05/27/2009	RE35952		7400

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago, IL 60602

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE
SUITE 2800
CHICAGO, IL 60606

Date: MAILED
MAY 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009400
PATENT NO. : RE35952
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1100 13th Street, N.W., Suite 1200
Washington, DC 20005-4051

Date:

MAILED
MAY 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009456
PATENT NO. : RE35952
ART UNIT : 3992

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Mehran Arjomand
MORRISON & FOERSTER LLP
555 West Fifth Street
Los Angeles, CA 90013

Date: MAILED
MAY 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010726
PATENT NO. : RE35952
ART UNIT : 3992

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

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

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MAY 04 2010

CENTRAL REEXAMINATION UNIT

NIRO, SCAVONE, HALLER & NIRO (For Patent Owner)
181 W. Madison
Suite 4600
Chicago IL 60602

SHUMAKER & SIEFFERT, P. A. (For Third Party Requester)
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CHICAGO, IL 60606

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WASHINGTON, DC 20005-4051

MORRISON & FOERSTER LLP (For Third Party Requester)
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

In re Beery
Reexamination Proceeding
Control No. 90/009,400
Request Deposited: February 9, 2009
For: Reissued U.S. Patent No. RE 35,952

In re Beery
Reexamination Proceeding
Control No. 90/009,456
Corrected Request Deposited: May 27, 2009
For: Reissued U.S. Patent No. RE 35,952

In re Beery
Reexamination Proceeding
Control No. 90/010,726
Corrected Request Deposited: October 30, 2009
For: Reissued U.S. Patent No. RE 35,952

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,045,947, issued to Beery, on September 3, 1991. Reissued U.S. Patent No. RE 35,952 (hereinafter, the '952 patent), issued to Beery, on November 10, 1998.

2. On February 9, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,400 (hereinafter, the '9400 proceeding).

3. The Reexamination Order was granted in the '9400 proceeding on April 22, 2009 finding a substantial new question of patentability (SNQP) as to claims 8, 9, 20, 29, 37, and 38.

4. On May 27, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,456 (hereinafter, the '9456 proceeding).

5. The Reexamination Order was granted in the '9456 proceeding on August 20, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, 5, 12, 13, 23, 24, 41, 48, 52, and 53.

6. Patent owner waived the right to file a patent owner statement on September 8, 2009.

7. On September 16, 2009, the '9400 and '9456 were merged.

8. On September 24, 2009, a non-final office action was mailed on the merged '9400 and '9456 proceedings. Claims 1, 2, 5, 8, 9, 12, 13, 20, 23, 24, 29, 37, 38, 41, 48, 52, and 53 were rejected. All other claims were not subject to reexamination. Patent owner responded on November 23, 2009.

9. On October 30, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/010,726 (hereinafter, the '10726 proceeding).

10. The Reexamination Order was granted in the '10726 proceeding on December 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, and 5-53.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9400, '9456, and '10726 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/009,400, 90/009,456, and 90/010,726 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an office action.

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

Eric Keasel

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,744	11/17/2009	7310736	5017.01REX	9609

321 7590 04/28/2010

SENNIGER POWERS LLP
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS, MO 63102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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
SKAAR ULBRICH MACARI, P.A.
601 CARLSON PARKWAY
SUITE 1050
MINNEAPOLIS, MN 55305

Date:

MAILED

APR 2 8 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010744
PATENT NO. : 7310736
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,745	11/24/2009	7310736	LMI-010	1376

321 7590 04/28/2010

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ST LOUIS, MO 63102

EXAMINER

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David H. Judson
LAW OFFICE OF DAVID H. JUDSON
15950 Dallas Parkway, Suite 225
Dallas, TX 75248

Date:
MAILED
APR 2 8 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010745
PATENT NO. : 7310736
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,744	11/17/2009	7310736	5017.01REX	9609

7590 04/28/2010

James N. Rothbarth
11880 Conway Road
St. Louis, MO 63131

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

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APR 28 2010

CENTRAL REEXAMINATION UNIT

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ST LOUIS MO 63102

(For Third Party Requester)

SKAAR ULBRICH MACARI, P.A.
601 CARLSON PARKWAY
SUITE 1050
MINNEAPOLIS, MN 55305

(For Third Party Requester)

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

(Courtesy Copy)

James N. Rothbarth
11880 Conway Road
St. Louis MO 63131

In re Rothbarth *et alia* Reexamination Proceeding Control No. 90/010,744 For: U.S. Patent No. 7,310,736	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Rothbarth *et alia* Reexamination Proceeding Control No. 90/010,745 For: U.S. Patent No. 7,310,736	: : : :

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,310,736 (hereinafter, the '736 patent), issued to Rothbarth *et alia*, on December 18, 2007.

2. On November 17, 2009, a request for *ex parte* reexamination of the '736 patent was filed. The reexamination proceeding was assigned Control No. 90/010,744 (hereinafter, the '10744 proceeding).

3. On November 17, 2009, a request for *ex parte* reexamination of the '736 patent was filed. The reexamination proceeding was assigned Control No. 90/010,745 (hereinafter, the '10745 proceeding).

4. On December 16, 2009, the reexamination order granting the request in the '10745 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-6, 8, and 9. The time to file a patent owner statement has expired.

5. On January 15, 2010, the reexamination order granting the request in the '10744 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-12. 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 '10744 and '10745 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements. Claims 1-12 are subject to reexamination.

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.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the '736 patent file is that of

SENNIGER POWERS LLP
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS MO 63102

As a courtesy, this decision is being mailed to the address of

James N. Rothbarth
11880 Conway Road
St. Louis MO 63131

in view of the January 6, 2010 Power of Attorney and Change of Address and the January 12, 2010 Notice of Acceptance of Power of Attorney and Notice Regarding Change of Power of Attorney present in the file of the '10744 reexamination proceeding.

The address of

SENNIGER POWERS LLP
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS MO 63102

, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '736 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. Reexamination Control Nos. 90/010,744 and 90/010,745 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

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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90/010,745	11/24/2009	7310736	LMI-010	1376

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EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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LAW OFFICE OF DAVID H. JUDSON
15950 Dallas Parkway, Suite 225
Dallas, TX 75248

Date:

MAILED

APR 2 8 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010745
PATENT NO. : 7310736
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,744	11/17/2009	7310736	5017.01REX	9609

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SUITE 1050
MINNEAPOLIS, MN 55305

Date:

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90/010,744	11/17/2009	7310736	5017.01REX	9609

7590 04/28/2010

EXAMINER

James N. Rothbarth
11880 Conway Road
St. Louis, MO 63131

ART UNIT	PAPER NUMBER

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APR 2 8 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

SENNIGER POWERS LLP
100 NORTH BROADWAY
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ST LOUIS MO 63102

(For Third Party Requester)

SKAAR ULBRICH MACARI, P.A.
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MINNEAPOLIS, MN 55305

(For Third Party Requester)

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

(Courtesy Copy)

James N. Rothbarth
11880 Conway Road
St. Louis MO 63131

In re Rothbarth *et alia*
Reexamination Proceeding
Control No. 90/010,744
For: U.S. Patent No. 7,310,736

In re Rothbarth *et alia*
Reexamination Proceeding
Control No. 90/010,745
For: U.S. Patent No. 7,310,736

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,310,736 (hereinafter, the '736 patent), issued to Rothbarth *et alia*, on December 18, 2007.

2. On November 17, 2009, a request for *ex parte* reexamination of the '736 patent was filed. The reexamination proceeding was assigned Control No. 90/010,744 (hereinafter, the '10744 proceeding).

3. On November 17, 2009, a request for *ex parte* reexamination of the '736 patent was filed. The reexamination proceeding was assigned Control No. 90/010,745 (hereinafter, the '10745 proceeding).

4. On December 16, 2009, the reexamination order granting the request in the '10745 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-6, 8, and 9. The time to file a patent owner statement has expired.

5. On January 15, 2010, the reexamination order granting the request in the '10744 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-12. 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 '10744 and '10745 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements. Claims 1-12 are subject to reexamination.

II. Requirements for Same Amendments in All Proceedings.

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

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PATENT OWNER'S CORRESPONDENCE ADDRESS

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SENNIGER POWERS LLP
100 NORTH BROADWAY
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ST LOUIS MO 63102

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The address of

SENNIGER POWERS LLP
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ST LOUIS MO 63102

, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '736 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. Reexamination Control Nos. 90/010,744 and 90/010,745 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**.

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

Eric Keasel

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,751	11/30/2009	7,542,878 B2	LWC-005RX	3683

42532 7590 06/04/2010

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ONE INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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www.uspto.gov

Gerald E. Worth
PROSKAUER ROSE LLP
One International Place
Boston, MA 02110

(For Patent Owner)

MAILED

JUN 04 2010

CENTRAL REEXAMINATION

Thomas W. Edman
HARRITY & HARRITY LLP
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(For *Ex parte* Requester)

Steven B. Maebius
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3000 K. St. N.W., Suite 600
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(Courtesy Copy
For *Inter partes* Requester)

In re Reissue Application of Nanikashvili
Application No. 12/706,541
Filed: Feb. 16, 2010
For: U.S. Patent No. 7,542,878

In re Nanikashvili
Ex parte Reexamination Proceeding
Control No. 90/010,751
Filed: Nov. 30, 2009
For: U.S. Patent No. 7,542,878

In re Nanikashvili
Inter partes Reexamination Proceeding
Control No. 95/001,312
Filed: March 16, 2010
For: U.S. Patent No. 7,542,878

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND *EX PARTE* REEXAMINATION PROCEEDINGS

The above-captioned reissue, *ex parte* reexamination proceeding, and *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. Patent No. 7,542,878 (the '878 patent) issued on June 2, 2009, with 30 claims.

2. A request for *ex parte* reexamination of claim 1 of the '878 patent was filed by a third party requester on Nov. 30, 2009, and was assigned control No. 90/010,751 (the '10751 proceeding).

3. *Ex parte* reexamination in the '10751 proceeding was ordered for claim 1 of the '878 patent on Jan. 15, 2010.

4. A patent owner's statement under 37 CFR 1.530 has not been received in the '10751 proceeding, and the time for filing same has expired.

5. A reissue application was filed on February 16, 2010 by patent owner to correct an error in inventorship and was assigned serial no. 12/706,541 (the '541 application).

6. The filing of the '541 application was announced in the *Official Gazette* on March 23, 2010.

7. A request for *inter partes* reexamination of claim 1-30 of the '878 patent was deposited on Feb. 16, 2010 by a third party requester, United Therapeutics Corp., and was assigned control no. 95/001,312 (the '1312 proceeding). The filing date requirements for the '1312 proceeding were satisfied on March 16, 2010.

8. *Inter partes* reexamination in the '1312 proceeding was ordered for claims 2-30 of the '878 patent on April 23, 2010. No substantial new question of patentability was found for claim 1 based on the request in the '1312 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

Under 37 CFR 1.991:

> "If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings."

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 rights of any third party requester of the ex parte reexamination shall be governed by §§ 1.510 through 1.560."

As evidenced by the above review of facts, reissue application No. 12/706,541, *ex parte* reexamination control no. 90/010,751, and *inter partes* reexamination control no. 95/001,312 are currently pending. The order to reexamine has been mailed in both reexamination proceedings, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d), 37 CFR 1.991, and 37 CFR 989(b) 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. The proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of the proceedings. In making a decision on whether or not to merge the proceedings, consideration is given to the status of each proceeding. See MPEP § 2285.

The Office has complete discretion regarding merger. A decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 and 314(c) to conduct reexamination proceedings with "special dispatch."

In this situation, *ex parte* reexamination has been ordered in the '10751 proceeding for claim 1, while *inter partes* reexamination has been ordered in the '1312 proceeding for claims 2-30. The reissue application has been filed to correct the inventorship. No amendments to the claims have been made in any of the proceedings.

In order to provide efficient and prompt handling of all of the proceedings, it is appropriate that the instant reissue application and the instant *ex parte* reexamination proceeding be merged and a joint examination be conducted. However, in view of the facts and circumstances of the reexamination proceedings and in compliance with the mandate for "special dispatch," the *ex parte* reexamination proceeding and the *inter partes* reexamination proceeding will not be merged and will proceed independently. Accordingly, **only** the examination of the reissue application and the *ex parte* reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted 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 *ex parte* reexamination proceeding as per 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND *EX PARTE* REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and *ex parte* reexamination proceeding are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements. The *inter partes* reexamination of claim 2-30 will proceed independently of the merged proceeding.

II. Conduct of the Merged Reissue Application Examination and *Ex Parte* Reexamination Proceeding

1. The examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that the claims in any proceeding are amended, concurrent amendments must be made in both the reissue and *ex parte* reexamination proceedings, to maintain identical text. Any claim that does not contain identical text in the merged proceedings will 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.[1]

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the *ex parte* reexamination proceeding. Each action will contain identifying data for all of the cases, i.e., the reissue application and the

[1] The merged proceeding and the *inter partes* proceeding may contain different claims, since the claims being addressed do not overlap. Claim consistency for the patent will be adjusted at the point where the later of the two proceedings is issued and published as a patent/certificate.

ex parte reexamination proceeding, and each action will be entered into the file history for both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285:
"Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

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

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

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See: MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the *ex parte* reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, any grounds of rejection that are not applicable under *ex parte* reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection that are applicable under *ex parte* 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 *ex parte* reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the *ex parte* reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 12/706,541 and *ex parte* reexamination control no. 90/010,751 **are merged** into a single proceeding. *Inter partes* reexamination control no. 95/001,312 will remain as a separate, non-merged proceeding and shall be conducted independently of the merged proceeding in accordance with the rules of *inter partes* reexamination. The patent owner shall ensure that the text of the claims of the '878 patent remains identical in the merged proceeding.

2. A copy of this decision shall be entered into all three proceeding files in the Image File Wrapper (IFW).

3. Periods for response in the merged proceeding 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. All further examination in the merged proceeding should be conducted in accordance with Part II of this decision.

5. **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 proceeding as per 37 CFR 1.550(d).

6. Jurisdiction over the merged reissue and *ex parte* reexamination proceeding is being transferred to Technology Center 2800, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '878 patent (e.g., by preparing/signing an action). See MPEP 2236.

7. Jurisdiction over the *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit.

8. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

June 2, 2010
Kentpetmerger/IP-reissue

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.
90/010,799	12/23/2009	6447027	29314-1	1545

28886 7590 03/23/2010

CLARK HILL, P.C.
500 WOODWARD AVENUE, SUITE 3500
DETROIT, MI 48226

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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
DICKINSON WRIGHT PLLC
38525 WOODWARD AVENUE
SUITE 2000
BLOOMFIELD HILLS, MI 48304-2970

Date:

MAILED

MAR 23 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010799
PATENT NO. : 6447027
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
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Alexandria, VA 22313-1450
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MAILED
MAR 23 2010
CENTRAL REEXAMINATION UNIT

Clark Hill, P.C.
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(For Patent Owner)

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(For Requester)

In re *Lilley et al.*
Reexamination Proceeding
Control No. 90/010,799
Filed: December 23, 2009
For: U.S. Patent No. 6,447,027

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on March 4, 2010, styled as "Petition for Reconsideration of Denial of Request for *Ex Parte* Reexamination," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated February 22, 2010. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,447,027 (hereinafter, the '027 patent) issued on September 10, 2002.

2. On July 27, 2006, a third party requester deposited a request for *ex parte* reexamination for claims 1-11 of the '027 patent, and the resulting reexamination

proceeding was assigned Control No. 90/008,129 (hereinafter, the '129 reexamination proceeding).

3. On August 18, 2006, an order granting reexamination of claims 1-11 based upon AWG Fire Fighting Equipment for Fire Fighting and Industrial Usage (hereinafter "AWG"), U.S. Patent No. 489,107 to Storz and 9 other references was mailed in the '129 reexamination proceeding. The order agreed with the requester that the references raised substantial new question of patentability.

4. On July 15, 2009, a Notice of Intent to Issue a Reexamination Certificate was mailed in the '129 reexamination proceeding. The Notice indicated that original claims 1-11, as amended, were patentable and newly presented claims 12-20 were patentable.

5. On October 6, 2009, the Reexamination Certificate for the '027 patent issued.

6. On December 23, 2009, the third party requester deposited a new request for *ex parte* reexamination for claims 1-20 of the '027 patent and the resulting reexamination proceeding was assigned Control No. 90/010,799 (hereinafter, the '799 proceeding).

7. On February 22, 2010, an order denying the request for reexamination for claims 1-20 of the '027 patent was mailed.

8. On March 4, 2010, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

Petitioner's Grounds in Support of the Requested Relief

The following is a list of the prior art cited by requester:

1. U.S. Patent No. 4,982,107 to Kreezko (hereinafter "Kreezko");
2. U.S. Patent No. 489,107 to Storz ("Storz", as above)'
3. U.S. Patent No. 5,301,985 to Terzini (hereinafter "Terzini");
4. AWG Fire Fighting Equipment for Fire Fighting and Industrial Usage (hereinafter "AWG");
5. Standardizing Hydrants (hereinafter "Standardizing Hydrants");
6. Harrington's Permanent Hydrant Adaptor (hereinafter "Harrington's");
7. NFPA Standards (hereinafter "NFPA");
8. VAG MBH (hereinafter "VAG");
9. Century B-50-B18 & B-50-B24 Hydrants, Installation, Operation and Maintenance Manual (hereinafter "Century Maintenance");
10. Century B-50-B18 & B-50-B24 Hydrants (hereinafter "Century Hydrants"); and

11. Harrington, Inc. "The Original Hardware for Large Diameter Hose Systems" (hereinafter "Harrington Hardware").

Petitioner (the third party requester) alleges that the examiner incorrectly denied the request for reexamination because the prior art, which was all previously considered in the '129 reexamination proceeding, shows the features that were indicated as allowable (patentable) in the previous '129 reexamination proceeding. Accordingly, petitioner argues that he has established a substantial new question of patentability by presenting the previously considered references in a new light by pointing out the seamless fluid passageway which was not previously considered. Petitioner also argues that the examiner in the '129 reexamination proceeding did not indicate that the AWG reference, NFPA standard and VAG publication were properly considered.

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 1-20 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 1-20 of the '027 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 1-20. 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, such as the Harrington declaration) 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 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-

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[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*

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

A. As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated December 23, 2009. 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 1-20.

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

All of the above listed references were the basis for an order granting reexamination of the '027 patent in the '129 reexamination proceeding. Moreover, Storz and Harrington's, in combination with admitted prior art from the '027 patent, were twice applied in a rejection of claims 1 and 5 of the '027 patent in the '129 proceeding.

The evidence and explanation, as set forth in the request dated December 23, 2009, simply does not support ordering a second request for reexamination. The request does not present sufficient evidence that any of the previously cited and considered references are presented 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. As pointed out by the examiner at page 3 of the order denying reexamination, "Requester does not discuss how these references are being viewed in a new light, but merely states that the proposed rejections show all of the claimed features. Merely disagreeing with the results of a previous reexamination is not grounds for a new reexamination over the same art." The examiner also correctly points out that the reasons for patentability provided by the examiner in the '129 reexamination proceeding states that the various features are not shown in *the prior art of record* and it is thus clear that all of the cited reference were properly considered. In addition, the prior art does not show what the previous examiner indicated to be the patentable feature, namely, the seamless path and its related structure. As noted by the examiner, there is no way to tell from the cited pictures/drawings that the path is seamless and there is nothing in the advertisements/descriptions that discuss this point. The noted "seamless" limitation is present in all of the claims.

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 2242, "substantial new question of patentability" is <u>not</u> raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '027 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination (which new request includes the missing information identified above). This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. The PETITION is DENIED.

2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

3. Telephone inquiries related to this decision should be directed Supervisory Patent Examiner Andres Kashnikow, 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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CENTRAL REEXAMINATION UNIT

BOYLE FREDRICKSON S.C.
840 NORTH PLANKINTON AVENUE
MILWAUKEE, WI 53203

In re Application of	:	
JORDAN, SCOTT E.	:	
Control No. 90/010,801 (US PAT RE40,613 E)	:	DECISION ON PETITION
Filed: January 29, 2010	:	TO WITHDRAW
Attorney Docket No. 21775/021276 (BF 456.018)	:	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 10, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Mathew E. Corr on behalf of all attorneys of record who are associated with customer No. 23598.

All attorneys/agents associated with the Customer Number 23598 have been withdrawn.

The correspondence address of record has been changed and the new correspondence address is the first copied address indicated below.

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

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: EPSTEIN & GERKEN
1901 RESEARCH BLVD., SUITE 340
ROCKVILLE, MD 20850-3164

cc: CHERYL H. AGRIS PH.D., ESQ (Third Party Requester)
P.O. BOX 8495
PELHAM MANOR, NY 10803

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on February 10, 2010. There is no indication it was served on the Third 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
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(For Patent Owner)

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APR 28 2010

CENTRAL REEXAMINATION UNIT

Beyer Law Group LLP
P.O. BOX 1687
Cupertino CA 95015-1687

(For Third Party Requester)

MICHAEL A DESANCTIS
HAMILTON DESANCTIS & CHA LLP
FINANCIAL PLAZA AT UNION SQUARE
225 UNION BOULEVARD, SUITE 305
LAKEWOOD, CO 80228

In re Chen *et alia*	: DECISION *SUA SPONTE*
Reexamination Proceeding	: MERGING
Control No. 90/010,817	: REEXAMINATION
For: U.S. Patent No. 5,951,698	: PROCEEDINGS
In re Chen *et alia*	:
Reexamination Proceeding	:
Control No. 90/010,842	:
For: U.S. Patent No. 5,951,698	:

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. 5,951,698 (hereinafter, the '698 patent), issued to Chen *et alia*, on September 14, 1999.

2. On January 11, 2010, a request for *ex parte* reexamination of the '698 patent was filed. The reexamination proceeding was assigned Control No. 90/010,817 (hereinafter, the '10817 proceeding).

3. On January 29, 2010, a request for *ex parte* reexamination of the '698 patent was filed. The reexamination proceeding was assigned Control No. 90/010,842 (hereinafter, the '10842 proceeding).

4. On February 18, 2010, the reexamination order granting the request in the '10817 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-25. The time to file a patent owner statement has expired.

5. On February 22, 2010, the reexamination order granting the request in the '10842 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-4, 8, 10-13, 16-19, and 22-24. 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 '10817 and '10842 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements. Claims 1-25 are subject to reexamination.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/010,817 and 90/010,842 are **merged**.

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

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

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

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

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

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

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

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,833	02/17/2010	6,278,447	06082.0067.RXUS00	5541

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-7195

Date: MAILED

JUL 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010833
PATENT NO. : 6278447
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.
90/010,684	09/15/2009	6278447	R132596-684	1075

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date:
MAILED

JUL 0 7 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010684
PATENT NO. : 6278447
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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JUL 07 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Third Party Requester)

MORRISON & FOERSTER LLP
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(For Third Party Requester)

HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-7195

In re Anderson Reexamination Proceeding Control No. 90/010,684 Request Deposited: September 15, 2009 For: U.S. Patent No. 6,278,447	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Anderson Reexamination Proceeding Control No. 90/010,833 Corrected Request Deposited: February 17, 2010 For: U.S. Patent No. 6,278,447	

This is a decision on the June 15, 2010 paper entitled "PETITION UNDER 37 CFR § 1.181(a)(3) FOR MERGER OF COPENDING EX PARTE REEXAMINATIONS UNDER 37 CFR § 1.565(c)". No fee is required. The petition is before the Central Reexamination Unit for decision.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,278,447 (hereinafter, the '447 patent), issued to Anderson, on August 21, 2001.

2. On September 15, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '447 patent. The reexamination proceeding was assigned Control No. 90/010,684 (hereinafter, the '10684 proceeding).

3. The Reexamination Order was granted in the '10684 proceeding on October 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, 4-7, 9-12, 14-17, 19-22, 24, and 25.

4. A non-final office action was mailed in the '10684 proceeding on February 19, 2010.

5. On April 19, 2010, Patent Owner responded to the office action in the '10684 proceeding and added new claims 26-65.

6. On February 17, 2010, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '447 patent. The reexamination proceeding was assigned Control No. 90/010,833 (hereinafter, the '10833 proceeding).

7. The Reexamination Order was granted in the '10833 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-25.

8. Patent Owner did not waive their right to a file a Patent Owner statement. The period for a Patent Owner statement has expired.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '10684, and '10833 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims 26-65 have been added in the '10684 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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

CONCLUSION

1. Reexamination Control Nos. 90/010,684 and 90/010,833 are MERGED.

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

Eric Keasel

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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APR 28 2010

CENTRAL REEXAMINATION UNIT

Beyer Law Group LLP
P.O. BOX 1687
Cupertino CA 95015-1687

(For Third Party Requester)

MICHAEL A DESANCTIS
HAMILTON DESANCTIS & CHA LLP
FINANCIAL PLAZA AT UNION SQUARE
225 UNION BOULEVARD, SUITE 305
LAKEWOOD, CO 80228

In re Chen *et alia* Reexamination Proceeding Control No. 90/010,817 For: U.S. Patent No. 5,951,698	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Chen *et alia* Reexamination Proceeding Control No. 90/010,842 For: U.S. Patent No. 5,951,698	: : : :

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. 5,951,698 (hereinafter, the '698 patent), issued to Chen *et alia*, on September 14, 1999.

2. On January 11, 2010, a request for *ex parte* reexamination of the '698 patent was filed. The reexamination proceeding was assigned Control No. 90/010,817 (hereinafter, the '10817 proceeding).

3. On January 29, 2010, a request for *ex parte* reexamination of the '698 patent was filed. The reexamination proceeding was assigned Control No. 90/010,842 (hereinafter, the '10842 proceeding).

4. On February 18, 2010, the reexamination order granting the request in the '10817 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-25. The time to file a patent owner statement has expired.

5. On February 22, 2010, the reexamination order granting the request in the '10842 proceeding was mailed. The order found that the request raised a raise a substantial new question of patentability as to claims 1-4, 8, 10-13, 16-19, and 22-24. 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 '10817 and '10842 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements. Claims 1-25 are subject to reexamination.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/010,817 and 90/010,842 are **merged**.

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

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

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

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

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

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

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

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUL 07 2010
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Third Party Requester)

KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-4003

(For Third Party Requester)

HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-7195

In re Kuo *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/010,676	: MERGING
Corrected Request Deposited: October 2, 2009	: REEXAMINATION
For: U.S. Patent No. 6,400,471	: PROCEEDINGS
In re Kuo *et alia*	:
Reexamination Proceeding	:
Control No. 90/010,875	:
Corrected Request Deposited: March 4, 2010	:
For: U.S. Patent No. 6,400,471	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,400,471 (hereinafter, the '471 patent), issued to Kuo *et alia*, on June 4, 2002.

2. On October 2, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '471 patent. The reexamination proceeding was assigned Control No. 90/010,676 (hereinafter, the '10676 proceeding).

3. The Reexamination Order was granted in the '10676 proceeding on November 14, 2009 finding a substantial new question of patentability (SNQP) as to claims 1-8, 10, 11, 13-17, 19, 20, 22-24, 26, 28, and 29.

4. A non-final office action was mailed in the '10676 proceeding on March 17, 2010.

5. On April 19, 2010, Patent Owner responded to the office action in the '10676 proceeding and added new claims 31-60.

6. On March 4, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '471 patent. The reexamination proceeding was assigned Control No. 90/010,875 (hereinafter, the '10875 proceeding).

7. The Reexamination Order was granted in the '10875 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-9, 12-18, 21-27, and 30.

8. Patent Owner did not waive their right to a file a Patent Owner statement. The period for a Patent Owner statement has expired.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '10676, and '10875 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims 31-60 have been added in the '10676 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/010,676 and 90/010,875 are MERGED.

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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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Haynes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

For Patent Owner

MAILED

APR 19 2010

CENTRAL REEXAMINATION UNIT

Procopio, Cory, Hargreaves & Savitch LLP
530 B Street
Suite 2100
San Diego, CA 92101

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,643
Filed: August 12, 2009
For: U.S. Patent No. 5,109,651

Ex Parte Reexamination Proceeding
Control No. 90/010,920
Filed: March 18, 2010
For: U.S. Patent No. 5,109,651

DECISION *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/010,643 was ordered in a decision mailed September 4, 2009. The decision granted reexamination for claims 1-3, and 5-32, the

claims for which reexamination was requested. Prosecution has progressed to a point where claims 1-3, 5, and 7-32 have been cancelled.[1]

Reexamination in application Control No. 90/010,920 was ordered in a decision mailed March 31, 2010. The decision indicating that claim 2, the only claim for which reexamination was requested, would be reexamined. On April 7, 2010, patent owner filed a waiver of his rights to file a Patent Owner Statement under 37 CFR 1.530. On April 8, 2010, patent owner filed an amendment cancelling claim 2, the claim for which reexamination was requested.

As evidenced by the above facts, reexamination Control No. 90/010,643 and reexamination control No. 90/010,920 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, above-captioned 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

In merged reexamination proceedings, patent owner is required to maintain identical claims, drawings, and specification in both files. As noted above, in reexamination control No. 90/010,643, claims 1-3, 5, and 7-32 have been cancelled leaving only 6 subject to reexamination.[2] In reexamination control No. 90/010,920, claim 2, the only claim for which reexamination was requested, has been cancelled.[3] It is assumed that no instructions have been given in reexamination control No. 90/010,920 to cancel claims 1, 3, 5 and 7-32 in view of the instructions to cancel these claims given in first reexamination proceeding control No. 90/010,643. In view of the above-noted assumption, both proceedings are deemed identical at this point and 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. Claim 6, the only remaining claim for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal

[1] Claims, 1, 3, 5, and 7-32 were cancelled per the amendment filed March 24, 2010. Claim 2 was cancelled per the amendment filed April 7, 2010.
[2] No reexamination for claim 4 was requested.
[3] No reexamination for claim 4 was requested.

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

Conclusion

Reexamination Control Nos. 90/010,643 and 90/010,920 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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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McGarry Bair PC
32 Market Ave., SW
Suite 500
Grand Rapids, MI 49503

(For Patent Owner)

MAILED

MAY 12 2009

CENTRAL REEXAMINATION UNIT

Larry S. Nixon
Nixon & Vanderhye P.C.
901 North Glebe Road, 11th Floor
Arlington, VA 22203

(For 3rd Party Requester)

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

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

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

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

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

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

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

Conduct of Proceedings

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

Conclusion

Reexamination Control Nos. 90/009,221 and 90/011,997 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files**. Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,999		6439107	R01019US (08395.72)	6871

22920 7590 09/29/2008

GARVEY SMITH NEHRBASS & NORTH, LLC
LAKEWAY 3, SUITE 3290
3838 NORTH CAUSEWAY BLVD.
METAIRIE, LA 70002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Seth M Nehrbass GARVEY, SMITH, NEHRBASS AND NORTH, LLC 3838 N. Causeway Blvd, Suite 3290 Metairie, LA 70002	: : : : :	(For Patent Owner)

MAILED
SEP 2 9 2008
CENTRAL REEXAMINATION UNIT

In re Bourgeois *Ex Parte* Reexamination Proceeding Control No. 90/011,999 Deposited: April 7, 2008 For: U.S. Patent No. 6,439,107	: : : : :	: DECISION ON PETITION UNDER 37 CFR 1.181

The paper filed by patent owner on July 31, 2008 entitled "Response to Decision Vacating *Ex Parte* Reexamination Filing Date" is not filed as a petition. It is, however, in actuality a petition requesting reconsideration, under 37 CFR 1.181 of the July 1, 2008 Decision *Sua Sponte* Vacating the *Ex Parte* Reexamination Filing Date, and thus, the paper is being treated as a petition. The paper is hereinafter referred to as "the Petition"

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

The Petition is granted to the extent that reconsideration has been given, but is otherwise dismissed.

REVIEW OF FACTS

1. Patent owner deposited a request for reexamination of U.S. Patent No. 6,439,107 on October 17, 2007.

2. A Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements was mailed on March 6, 2008, based on a failure of the request to provide a statement of the substantial new questions of patentability.

3. Patent owner filed a "replacement" statement of the substantial new questions of patentability on April 7, 2008.

4. A filing date for *Ex Parte* reexamination was granted on April 11, 2008.

5. A Decision *Sua Sponte* Vacating the *Ex Parte* Reexamination Filing Date was mailed on July 1, 2008.

6. The instant paper, taken as a reconsideration petition under 37 CFR 1.181, was filed on July 31, 2008.

DECISION

Petitioner's Grounds in Support of the Requested Relief

Petitioner argues:

1. 37 CFR 1.510(b) does not require that the statement and identification be made by the requester.

2. 37 CFR 1.510(b) does not prohibit requester patent owner from incorporating by reference statements and identifications made by others.

3. Requester is entitled to present the analysis of a third party without adopting the analysis as its own.

4. *Emerson Elec. Co. v. Davoil, Inc.*, 88 F.3d 1051, 39 USPQ2d 1474 (Fed. Cir. 1996) does not stand for the position that a patent owner cannot file papers of a third party in a reexamination proceeding.

5. 37 CFR 1.550(g) does not prevent submissions on behalf of third parties as no order for *ex parte* reexamination has yet been made.

6. Requiring the patent owner to reproduce the analysis of a third party would be a waste of time and money.

Analysis and Findings

The arguments raised by Petitioner are not persuasive.

The only papers submitted in the reexamination request in support of a substantial new question of patentability are copies of a third party's documents. In the request, petitioner emphasizes the fact it is filing the papers of a third party and makes no statements with respect to a substantial new question of patentability other than to refer the Office to the third party's documents. While a requester may present and use statements and identifications made by others (e.g., an affidavit) in a request for reexamination, the request itself must apply those statements and identifications to point out the substantial new question of patentability that is raised, and to apply the art to the claims. The present incorporation by reference of such others' statements and identifications fails in that respect.

Pursuant to MPEP 2214:

> The request must identify each substantial new question of patentability raised and proposed ground of rejection separately. The request must apply all of the cited prior art to the claims for which reexamination is requested. For each identified substantial new question of patentability and each identified proposed ground of rejection, the request must explain how the cited documents identified for that substantial new question of patentability/proposed ground of rejection are applied to meet or teach the patent claim limitations to thus establish the identified substantial new question of patentability or proposed ground of rejection.

Petitioner has not pointed out any specifics of how the incorporated third party papers do so.

Pursuant to MPEP 2216:

> The request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office....It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested.

Petitioner has not pointed out where this is addressed/found in the request papers.

In addition to the above considerations, since the patent owner has relied solely on the incorporated third party papers without applying them to the claims, the patent owner has *de facto* filed the request on behalf of the third party. With respect to the patent owner filing papers on behalf of a third party, 37 CFR 1.510(f) requires:

> If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.

Petitioner does not have a power of attorney from the third party as required by 37 CFR 1.510(f).

In view of the above, the request cannot be granted.

Jurisdiction over the request papers is being forwarded to the Central Reexamination Unit (CRU). As pointed out in the "REQUESTER'S RECOURSE" section Office's July 1, 2008 decision:

> The requester has one opportunity to make the request papers filing date compliant. If the response to this decision fails to cure the defect(s) identified in this decision or adds a new defect, then processing of the request papers will be terminated, and the request papers will either be discarded or treated as a prior art citation under 37 CFR 1.501, at the Office's option.

Accordingly, the CRU will determine whether any corrected request paper has been filed separately from this paper to address the deficiencies pointed out in the July 1, 2008 decision. If a corrected request has not been filed, the CRU will issue a notice of termination of preprocessing of the request papers. Of course, if such a notice would be issued, it is without prejudice as to patent owner's filing of another request for reexamination curing the noted deficiencies in the present request.

CONCLUSION

The Petition is granted to the extent that reconsideration has been given, but is otherwise dismissed.

Jurisdiction over the request papers is being forwarded to the Central Reexamination Unit.

Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or Lynne A Browne, at (571) 272-3670; or in their absence, to Legal Advisors Cynthia Nessler at (571) 272-7724, Stephen Marcus at (571) 272-7743, or Pinchus M. Laufer at (571) 272-7726.

Kenneth M. Schor

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration

August 22, 2008
C:\kiva\kenreex\file-date\decisions\11999-paper taken as FD recon petition under 1.181_dismissed

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 15

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C 20231
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Robert Nabinger (For Patent Owner)
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1300 19th Street, N.W., Suite 600
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MAILED

MAY 29 2002

REEXAM UNIT

Buono et al.
Reexamination Proceeding
Control No. 95/000,001
Filed: July 27, 2001
For: U.S. Patent No. 6,232,427

DECISION ON
ENTRY OF PAPERS

The present proceeding (reexamination Control. No. 95/000,001) is before the Office of Patent Legal Administration for *sua sponte* consideration of the entry of papers filed after the Office action of October 17, 2001.

REVIEW OF RELEVANT INFORMATION

1. The request for *inter partes* reexamination (of patent number 6,232,427) was filed July 27, 2001, by the third party requester.

2. An order granting reexamination and a first action were issued on October 17, 2001. The October 17, 2001, Office action set a two month period for response.

3. The patent owner's response to the Office action was received February 6, 2002. It was accompanied by a submission under 37 CFR 1.8(b), and it was accepted as having been timely filed on December 17, 2001.

4. The Certificate of Service attached to patent owner's response was dated December 17, 2001.

5. On January 17, 2002, third party requester comments on patent owner's response were received in the Office. This was one day too late, i.e., after the 30 day period mandated by statute (because January has 31 days). [1]

6. On March 6, 2002, a Notice of Defective Paper was sent to patent owner informing patent owner that claims 40-60, newly added in the response, should have been underlined. Patent owner was given time to correct this informality. The precise language was:

> "Patent owner is given a time period of 30-days or one month from the date of this letter (whichever is longer) to correct this informality, or the amendment will not be entered, although the argument in the December 17, 2001, response will be considered as it applies to the proceeding without the amendment."

7. On April 11, 2002, patent owner filed a "Corrected Response" in response to the Notice. The "Corrected Response" re-presented new claims 40-60 in underlined format, and completely re-presented the "Remarks" section of the previously submitted informal response. [An Information Disclosure Statement (IDS) was also filed on April 11th; the IDS is unrelated to and does not enter into the present discussion.]

8. The Certificate of Service attached to the April 11th "Corrected Response" was dated April 2, 2001 (the same date as the Certificate of Mailing on the paper).

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[1] Pursuant to 35 U.S.C. 314(b)(3), the third party requester may once file written comments "within 30 days after the date of service of the patent owner's response." Accordingly, requester's comments must have been received by the Office on or before January 16, 2002.

9. On May 1, 2002, the third party requester filed "Supplemental Comments" on patent owner's Corrected Response. These "Comments" are timely (because April only has 30 days).

10. The entirety of the May 1st "Comments" was:

> "Requester has no additional comments regarding the Corrected Response."

DISCUSSION

As pointed out above, new claims 40-60 were improperly presented in the first patent owner response and, as such, were not entered. Thus, claims 40-60 did not yet exist in the proceeding for the third party requester to comment on. Likewise, the argument that was directed to such claims was not ripe for requester comment. Stated another way, the patent owner's submission of argument was mooted by the non-entry of the claims.

After the patent owner corrected the informality by way of the April 11, 2002, "Corrected Response," claims 40-60 existed in the proceeding, and the argument ("Remarks") re-presented by owner in the "Corrected Response" became viable and relevant. At this point, requester had a right to provide comments in response to the patent owner's re-presented argument.

The third party requester's "Supplemental Comments" of May 1, 2002, stated that requester has no <u>additional</u> comments on the owner's response. Thus, requester was stating that the initially submitted comments did apply. This, in-effect, republished the third party requester comments of January 17, 2002, by way of the timely requester "Supplemental Comments" of May 1. The requester comments of January 17 are thus timely, as they were submitted prior to the patent owner's corrected response, and were republished as the requester comments of May 1.

CONCLUSION

1. It is directed that Patent Owner's "Corrected Response" filed April 11, 2002, and third party requester's comments of January 17, 2002, and "Supplemental Comments" of May 1, 2002, be entered.

2. The papers will be entered, and the file will be forwarded in due course to the examiner in charge of the proceeding for action on the merits not inconsistent with this decision.

3. Any comments concerning this decision must be submitted within 30 days of this decision and must be referred to Kenneth Schor, Senior Legal Advisor, Office of Patent Legal Administration.

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

May 28, 2002
C:\KIVA\KENPET3\95-0001A.WPD

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Paper No. 13

Z. Peter Sawicki
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(For Requester)

MAILED

JAN 30 2003

REEXAM UNIT

In re Dahlstrom et al.
Inter partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Ex parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged under 37 C.F.R. § 1.989 at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526, issued to Dahlstrom et al. on November 20, 2001.

2. A request for *inter partes* reexamination pursuant to 37 C.F.R. § 1.915 was filed on January 8, 2002, by third party requester John W. Behringer, for Leprino Foods Company, and was assigned Control No. 95/000,003.

3. Reexamination was ordered pursuant to 37 C.F.R. § 1.931 in the '003 proceeding on April 4, 2002, and a nonfinal Office action was mailed on the same date pursuant to 37 C.F.R. § 1.935.

4. On June 3, 2002, patent owner's response to the nonfinal Office action pursuant to 37 C.F.R. § 1.945 was received in the '003 proceeding, which included an amendment that was not in compliance with 37 C.F.R. § 1.530(d)-(j). A Notice re: Defective Paper was mailed on June 10, 2002, which provided a time period of one month for patent owner to correct the informality.

5. On July 3, 2002, third party requester's comments pursuant to 37 C.F.R. § 1.947 were received in the '003 proceeding.

6. A request for *ex parte* reexamination pursuant to 37 C.F.R. § 1.510, was also filed on July 3, 2002, by the same third party requester John W. Behringer, for Leprino Foods Company, and was assigned Control No. 90/006,317. The third party requester requests merger of the '6317 proceeding with the '003 proceeding.

7. An amendment was filed by patent owner in the '003 proceeding on July 9, 2002, in response to the Notice re: Defective Paper, which is in compliance with 37 C.F.R. § 1.530(d)-(j).

8. Reexamination was ordered pursuant to 37 C.F.R. § 1.525 in the '6317 proceeding on August 20, 2002.

9. On October 2, 2002, a patent owner statement pursuant to 37 C.F.R. § 1.530 was received in the '6317 proceeding, which included an amendment.

10. On November 27, 2002, a requester's reply pursuant to 37 C.F.R. § 1.535 was received in the '6317 proceeding, in which the request for merger of this proceeding with the '003 proceeding is reiterated.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 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, the *inter partes* reexamination proceeding and the *ex parte* reexamination proceeding are currently pending. Since reexamination has been ordered in both proceedings, and the time periods for filing the appropriate subsequent patent owner and requester papers have expired, a decision under 37 C.F.R. § 1.989(a) is timely.

The general policy of the Office is that examination of *inter partes* reexamination and *ex parte* reexamination proceedings will <u>not</u> be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding.

A review of the prosecution history of the '003 *inter partes* reexamination proceeding reveals that the original specification, drawings and patent claims 1-14, 16-25, 27-35, 37-51, 53-88 and 90-113 are presently in the reexamination file, claims 26, 36, 52 and 89 have been amended, new claims 114-163 have been added, and claim 15 has been cancelled. A nonfinal Office action was mailed along with the order on April 4, 2002, pursuant to 37 C.F.R. § 1.935. A patent owner's response pursuant to 37 C.F.R. § 1.945 and written comments by third party requester pursuant to 37 C.F.R. § 1.947 have been received. The *inter partes* reexamination proceeding is ready for the examiner's consideration of such papers and preparation of the next Office action on the merits.

A review of the prosecution history of the '6317 *ex parte* reexamination proceeding reveals that the original specification,

drawings and patent claims 1-25, 27-35, 37-51, 53-88 and 90-113 are presently in the reexamination file, and claims 26, 36, 52 and 89 have been amended. An owner's statement pursuant to 37 C.F.R. § 1.530 and a third party requester's reply pursuant to 37 C.F.R. § 1.535 have been received. The *ex parte* reexamination proceeding is ready for the examiner's consideration of such papers and preparation of a first Office action on the merits.

Accordingly, the claims are not identical in both proceedings. In order to provide efficient, consistent and prompt handling of both proceedings, it is appropriate that the *inter partes* reexamination proceeding and the *ex parte* reexamination proceeding be merged and a joint examination be conducted. Therefore, the examination of the merged *inter partes* reexamination and *ex parte* reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION

I. Merger of Proceedings

In accordance with 37 C.F.R. § 1.989 (a), the above-identified *inter partes* reexamination and *ex parte* reexamination proceedings are **merged**. A joint examination of both proceedings will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

As noted above with regard to the amendments submitted, the claims are NOT the same in both files. Patent owner is required to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files. The paper should be strictly limited to the bare presentation of the amendments. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files and a signature, and should be filed in duplicate for entry into each reexamination file. Any discussion of the merits or issues of the proceeding would be improper and would result in the return of the paper as an improper submission under 37 C.F.R. § 1.939.

It should be noted that submission of such an appropriate housekeeping amendment will not create a reply right for third party requester. Any comments filed by the requester in response to any such housekeeping amendment would be improper and result

in the return of the paper as an improper submission under 37 C.F.R. § 1.939.

III. Conduct of Merged Proceeding

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding. Pursuant to 37 C.F.R. § 1.989 (b), the merged proceeding is governed by 37 C.F.R. § 1.902 through § 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 C.F.R. § 1.510 through § 1.560. In the instant proceedings, as noted above in the review of facts, the third party requester is the same for both proceedings.

B. Papers mailed/filed:

Normally, a requirement is made in merged reexamination proceedings for duplicate papers (*e.g.*, Office actions, patent owner responses, requester replies, *etc.*) for placement of papers in both files. Since the third party requester is the same in both of the instant reexamination proceedings, there does not appear to be a benefit in maintaining two separate files with duplicate papers. Therefore, the requirement for duplicate papers will not be made in this merged proceeding[1].

Instead, the *ex parte* reexamination file will become and remain physically dormant after receipt of the "housekeeping amendment," in that no further papers that are mailed/filed will be physically entered into this file[2]. All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requester will contain the identifying data for both files and will be physically entered in the *inter partes* reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, bearing a signature and including identifying data for both files, for entry into the *inter partes* reexamination file.

---

[1]with the exception of the above-noted "housekeeping amendment," which should be filed in duplicate

[2]with the exception of *e.g.*, a PTO-892 form, as explained in part E. below

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

by Mail to: Attn: "Box *Inter Partes* Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
Washington, D.C. 20231

by FAX to: (703) 305-1013
Central Reexamination Unit

by hand: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 C.F.R. § 1.903. All papers should be addressed to the Central Reexamination Unit as indicated above, and should **not** be sent to the Technology Center.

C. Amendments:

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

Pursuant to 37 C.F.R. § 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. In other words, for all amendments, any words not appearing in the patent must be underlined, and only words being deleted from the patent must appear in brackets.

D. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee is required to be paid. For example, only one fee is required to be paid for patent owner's appellant brief (or that of the *inter partes* requester), even though the brief relates to merged multiple proceedings.

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. If the examiner identifies any discrepancies as to such citations, the examiner will cite such documents on a PTO-892 form as part of the next Office action in order to make the same references of record in both files.

F. Reexamination Certificate:

At the conclusion of the examination of the merged reexamination proceeding, copies of any papers (e.g., amendments) needed for publishing the reexamination certificate will be placed in the *ex parte* reexamination file. Both files will be forwarded to the Office of Publications for issuance of a single certificate setting forth the results of the merged proceeding pursuant to 37 C.F.R. § 1.997.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,003 and *ex parte* Reexamination Control No. 90/006,317 are merged

into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination files are being stored in the Central Reexamination Unit to await receipt of the housekeeping amendment in accordance with Part II., *supra*.

3. Once the housekeeping amendment is received, or the time for filing such has expired, the merged reexamination files will be forwarded via the Technology Center 1700 Group Director to the examiner for the preparation of an Office action in the merged proceeding.

4. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

5. Any questions concerning this communication should be directed to the undersigned, at (703)308-0255.

Lynn M. Kryza

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

January 28, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

SEP 23 2005

REEXAM UNIT

In re Dahlstrom et al.
Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION DISMISSING PETITION

This is a decision on the July 18, 2005, patent owner PETITION UNDER 37 C.F.R. § 1.137(a), for the entry of belated papers based upon unavoidable delay.

The petition fee of $500.00 pursuant to 37 C.F.R. § 1.17(l) for the petition under 37 C.F.R. § 1.137(a) was paid by credit card.

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

The PETITION UNDER 37 C.F.R. § 1.137(a), for the entry of the late response is **dismissed as moot** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. Reexamination was ordered and a non-final Office action was mailed in the '003 proceeding on April 4, 2002.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 C.F.R. § 1.945, including an amendment, in the '003 proceeding.

5. A Notification of Defective paper was mailed on June 10, 2002, indicating that the amendment of April 4, 2002, was not in compliance with 37 C.F.R. § 1.530(d)-(j), and setting a one month response period for the patent owner to file a corrected amendment.

6. On July 3, 2002, third party requester filed comments to patent owner's response, pursuant to 37 C.F.R. § 1.947.

7. Also on July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the same third party requester, which proceeding was assigned control no. 90/006,317.

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 C.F.R. § 1.530(d)-(j), in the '003 proceeding.

9. Reexamination was ordered in the '6317 proceeding on August 20, 2002.

10. The '003 and '6317 proceedings were merged on January 30, 2003.

11. A housekeeping amendment was filed for the merged proceedings on February 28, 2003.

12. A nonfinal Office action was mailed on February 16, 2005 in the merged proceedings.

13. Patent owner filed a response to the nonfinal Office action on April 27, 2005.

14. On May 24, 2005, the third party requester filed comments pursuant to 37 C.F.R. 1.947, in reply to the patent owner response.

15. On June 3, 2005, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed, notifying the patent owner that the amendment of April 27, 2005 was not in compliance with 37 C.F.R. 1.530, and setting a 30 day or 1 month time period for response.

16. Patent owner filed the instant petition on July 18, 2005, accompanied by declarations, and a proposed reply to the "Notice Re Defective Paper in *Inter Partes* Reexamination."

DECISION

The PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of terminated reexamination proceedings based upon unavoidable delay filed by patent owner on July 18, 2005, has been fully considered, but is deemed immaterial to the issue of the late response. It should be noted that the failure to respond to the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005, did **not** cause a lapse in pendency, **nor** result in termination of the instant merged reexamination proceedings. As stated on the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069) a failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, although the argument will be considered as it applies to the proceeding without the amendment. Therefore, the PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of proceedings based upon unavoidable delay is **dismissed as moot**.

Petitioner asserts that patent owner never received the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed June 3, 2005. Petitioner states that they were not aware of this Office communication until July 13, 2005, when the third party requester contacted them to inquire as to the status of the patent owner's response to the outstanding Notice of June 3, 2005. Petitioner purports that the entire delay in filing the required reply was unavoidable due to non-receipt of the advisory action.

MPEP 711.03(c)(I.)(A.)states:

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

The petition of July 18, 2005, was accompanied by, *inter alia*, declarations of Mr. Sawicki and Ms. Kosloski, a copy of a mail log of June 2005, and a response including a proposed amendment in response to the "Notice Re Defective Paper in *Inter Partes* Reexamination". With regard to the extent that petitioner has attempted to demonstrate the non-receipt of the "Notice Re Defective Paper in *Inter Partes* Reexamination," it should be noted that the requirements set forth in MPEP 711.03(c)(I.)(A.), *i.e.*, the required statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, nor the copy of the docket record where the non-received Office communication would have been entered, were **not** included in the evidence of non-receipt that was filed with the instant petition.

A review of the proposed amendment included with the instant petition reveals that this amendment is also **no**t in compliance with 37 C.F.R. 1.530(4)(f). Specifically, amended claims 26, 36, 52, 62 and 89 do **not** show all changes made (with the appropriate

bracketing and underlining) with respect to the original patent text of the claims, and the new claims 114-163 are not completely underlined, as required. Therefore, the late-filed amendment is **not** effective to overcome the deficiencies of the originally filed amendment of April 27, 2005, set forth in the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005.

Accordingly, even if the delay in filing the response were to be excused, there is no meaningful relief that may be provided to petitioner, because, irrespective of the fact that the response is late, the amendment of July 18, 2005, is also defective for the reasons set forth above. There is no point in excusing the delay in filing the response, because it is no more dispositive of the issue than the former amendment of April 27, 2005. As stated on the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), the failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, although the argument will be considered as it applies to the proceeding without the amendment. Since the response to the notice of June 3, 2005, did **not** correct the defects, the submission of July 18, 2005, will **not** be entered (See MPEP 2666.60). Therefore, the petition for the entry of the late response of July 18, 2005, has been fully considered, but is **dismissed as moot**.

CONCLUSION

1. The petition for the entry of the late response of July 18, 2005, is **dismissed as moot**, and the proposed amendment accompanying the petition is **not entered**.

2. Since the patent owner response of July 18, 2005, is **not** entered, no further comments from the third party requester are permitted.

3. The patent owner amendment of April 27, 2005, is **not** entered, although the argument will be considered as it applies to the proceeding without the amendment.

4. Similarly, the third party comments of May 24, 2005, will also be considered as they apply to the proceeding without the patent owner's amendment of April 27, 2005.

5. The instant *inter partes* reexamination proceeding will be forwarded to the Technology Center 1700 examiner to prepare the next appropriate Office action.

6. Any future correspondence with respect to this *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

7. Any telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

September 23, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAILED

OCT 27 2006

CENTRAL REEXAMINATION UNIT

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In re Dahlstrom et al. Reexamination Proceeding Control No. 95/000,003 Filed: January 8, 2002 For: U.S. Patent No. 6,319,526	:	**DECISION DISMISSING PETITION and *SUA SPONTE* GRANTING RELIEF**
In re Dahlstrom et al. Reexamination Proceeding Control No. 90/006,317 Filed: July 3, 2002 For: U.S. Patent No. 6,319,526	:	

This is a decision on the September 19, 2006, patent owner PETITION UNDER 37 C.F.R. § 1.182, taken as a petition requesting the withdrawal of the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006, which canceled claims 1-14 and 16-163, and requesting entry and consideration of patent owner's late response and amendment accompanying the instant petition.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.182 was paid by credit card.

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

The PETITION UNDER 37 C.F.R. § 1.182 is **dismissed**, but relief is *sua sponte* **granted** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. Reexamination was ordered and a non-final Office action was mailed in the '003 proceeding on April 4, 2002.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 C.F.R. § 1.945, including an amendment, in the '003 proceeding.

5. A Notification of Defective paper was mailed on June 10, 2002, indicating that the amendment of April 4, 2002, was not in compliance with 37 C.F.R. § 1.530(d)-(j), and setting a one month response period for the patent owner to file a corrected amendment.

6. On July 3, 2002, third party requester filed comments to patent owner's response, pursuant to 37 C.F.R. § 1.947.

7. Also on July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the same third party requester, which proceeding was assigned control no. 90/006,317.

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 C.F.R. § 1.530(d)-(j), in the '003 proceeding.

9. Reexamination was ordered in the '6317 proceeding on August 20, 2002.

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10. The '003 and '6317 proceedings were merged on January 30, 2003.

11. A housekeeping amendment was filed for the merged proceedings on February 28, 2003.

12. A nonfinal Office action was mailed on February 16, 2005, in the merged proceedings.

13. Patent owner filed a response to the nonfinal Office action on April 27, 2005.

14. On May 24, 2005, the third party requester filed comments pursuant to 37 C.F.R. § 1.947, in reply to the patent owner response.

15. On June 3, 2005, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed, notifying the patent owner that the amendment of April 27, 2005, was not in compliance with 37 C.F.R. § 1.530, and setting a 30 day or 1 month time period for response. No patent owner response was received.

16. On July 18, 2005, patent owner filed a PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of terminated reexamination proceedings based upon unavoidable delay, accompanied by declarations, and a proposed late response (including an amendment) to the "Notice Re Defective Paper in *Inter Partes* Reexamination."

17. A decision dismissing the PETITION UNDER 37 C.F.R. § 1.137(a) was mailed on September 23, 2005, which decision noted that the late-filed amendment was NOT in compliance with 37 C.F.R. § 1.530.

18. A Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on August 28, 2006, cancelling claims 1-14 and 16-163.

19. Patent owner filed a PETITION UNDER 37 C.F.R. § 1.182, requesting the withdrawal of cancellation of claims 1-14 and 16-163, and requesting entry and consideration of patent owner's late response and amendment accompanying the instant petition.

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DECISION

The present PETITION UNDER 37 C.F.R. § 1.182, taken as a petition requesting the withdrawal of the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006, which canceled claims 1-14 and 16-163, and requesting entry and consideration of patent owner's response and amendment accompanying the instant petition, has been fully considered. Petitioner requests that the claims be considered on their merits and not summarily dismissed due to procedural/formatting irregularities. Petitioner contends that since the previously filed petition of July 18, 2005, was dismissed, the previously submitted amendments were not entered for procedural reasons, and patent owner was left with no recourse in having the claims considered on their merits. The petitioner points out that claims 1-14 and 16-163 were canceled by the Examiner's Amendment accompanying the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006.

Petitioner's contentions are **NOT** persuasive. A review of the reexamination record reveals that patent owner has had ample time and opportunity to provide an amendment in conformance with the reexamination rules of practice, specifically, 37 C.F.R. § 1.530, but has repeatedly failed to do so. It is noted that the necessary compliance with 37 C.F.R. § 1.530, was first brought to patent owner's attention on June 10, 2002. On July 9, 2002, patent owner did manage to file a proper amendment (and the housekeeping amendment of February 28, 2003, is a duplicate of this amendment). However, it was then necessary on June 3, 2005, to again require patent owner to comply with the reexamination amendment rules of practice, and ever since that time, patent owner has NOT ONCE managed to provide an amendment in compliance with 37 C.F.R. § 1.530. It is also noted that although the previous petition was dismissed more than one (1) year ago, during this time patent owner has apparently never attempted to provide a proper amendment for consideration. It is notable that out of four (4) amendments presented by patent owner in this reexamination proceeding, only one (1) has been found to be in compliance with the rules for reexamination amendment practice. This recurring pattern of providing reexamination amendments which are not in compliance with the rules has resulted in unnecessary delays which are contrary to the statutory requirement for the reexamination proceedings to be conducted

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with "special dispatch" pursuant to 35 U.S.C. 305[1]. Petitioner's arguments have been fully considered, but none of these arguments are persuasive.

I. Withdrawal of the NIRC:

Based on a general review by the undersigned, it was noted that the patent owner's failure to respond to the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005, did **not** cause a lapse in pendency, **nor** should it have resulted in termination of the instant merged reexamination proceedings. As stated in the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), a failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, **although the argument will be considered as it applies to the proceeding without the amendment** (emphasis added).
The PETITION UNDER 37 C.F.R. § 1.137(a) of July 18, 2005, for the revival of proceedings based upon unavoidable delay was **dismissed** in the decision mailed September 23, 2005, for the reason that the merged reexamination proceeding had not been terminated. It was noted that the proposed late amendment was also **not** in compliance with 37 C.F.R. § 1.530(4)(f), and consequently no more dispositive of the issue than the former amendment of April 27, 2005. The decision dismissing this petition again reiterated that, as stated in the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), the failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, **although the argument will be considered as it applies to the proceeding without the amendment** (emphasis added).

A review of the NIRC of August 28, 2006, reveals that the examiner states:

> "Claims 1-14 and 16-163 (all live claims in the proceedings) were subject to rejection in the last Office action mailed 16 February 2005. The patent owner failed to file a timely respond to that Office action. Accordingly, claims 1-14 and 16-163 have been canceled. See 37 CFR 1.5979b) and MPEP 2666.10." (*sic*)

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[1]See also 37 C.F.R. § 10.18(b)(2)(i)

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Therefore, although petitioner has failed to rely upon this argument, from the record it is clear that the Office has failed to follow its' own procedures set forth in the "Notice Re Defective Paper in *Inter Partes* Reexamination" of June 3, 2005, and again reiterated in the Decision Dismissing the Petition of September 23, 2005. Specifically, the NIRC canceling the claims for failure to respond should NOT have been mailed in the instant merged reexamination proceeding. Instead, an Office action should have been prepared based on the claims in existence in the merged reexamination proceeding prior to the improper amendment of April 27, 2005, *i.e.*, the claims in the housekeeping amendment of February 28, 2003. Such Office action should have treated the patent owner's response of April 27, 2005, and the third party requester's comments of May 31, 2005, inasmuch as the respective arguments and comments applied to the claims pending in the merged reexamination proceeding as of February 28, 2003.

Accordingly, although petitioner's arguments are not persuasive, the requested relief of the withdrawal of the cancellation of claims 1-14 and 16-163, has been *sua sponte* **granted** in view of the Office's failure to follow its' own procedures. The NIRC of August 28, 2006, is **withdrawn** as of the mailing of this petition decision, and claims 1-14 and 16-163 are restored to a pending status. An appropriate Office action will be prepared in accordance with the above-mentioned procedures, and will be mailed in due course.

II. Entry and consideration of late response and amendment:

Petitioner's assertion that since the previously filed petition of July 18, 2005, was dismissed, the previously submitted amendments were not entered for procedural reasons, and patent owner was left with no recourse in having the claims considered on their merits, has been considered, but is not well-founded and definitely not persuasive. A review of the record reveals that although the previous petition was dismissed over one (1) year ago, during this time patent owner has apparently never attempted to provide a proper amendment for consideration. The petitioner points out that claims 1-14 and 16-163 were canceled by the Examiner's Amendment accompanying the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006.

A review of the proposed late amendment included with the instant petition reveals that this amendment is also **not** in compliance with 37 C.F.R. 1.530(4)(f). Specifically, amended patent claim

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36 is missing patent text, amended patent claim 52 contains a typographical error, and the new claims 114-163 are completely underlined, but some new claims also include bracketing, which is improper (*e.g.*, claims 124, 146, 155, 160). Therefore, the late-filed amendment of September 19, 2006, is **not** effective to overcome the deficiencies of the originally filed amendment of April 27, 2005, set forth in the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005.

Accordingly, even if the delay in filing the response were to be excused, there is no meaningful relief that may be provided to petitioner, because, irrespective of the fact that the response is late, the amendment of September 19, 2006, is also defective for the reasons set forth above. There is no point in excusing the delay in filing the response, because it is no more dispositive of the issue than the former amendments of April 27, 2005, or July 18, 2005. As stated in the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), the failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, although the argument will be considered as it applies to the proceeding without the amendment. Since the late response to the notice of June 3, 2005, still did **not** correct the defects, the submission of September 19, 2006, will **not** be entered (See MPEP 2666.60). Therefore, the petition for the entry of the late response of September 19, 2006, has been fully considered, but is **dismissed**.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. § 1.182 is **dismissed**.

2. The requested relief of the withdrawal of the cancellation of claims 1-14 and 16-163, has been ***sua sponte* granted**.

3. The NIRC of August 28, 2006, is **withdrawn**, and claims 1-14 and 16-163 are restored to a pending status.

4. The petition requesting entry of the late response of September 19, 2006, is **dismissed**, and the proposed late amendment accompanying the petition is **not entered**.

5. Since the patent owner response of September 19, 2006, is **not** entered, no further comments from the third party requester are permitted.

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6. The patent owner amendment of April 27, 2005, is **not** entered, although the argument will be considered as it applies to the proceeding without the amendment.

7. Similarly, the third party comments of May 24, 2005, will also be considered as they apply to the proceeding without the patent owner's amendment of April 27, 2005.

8. The merged *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit 3991 examiner to prepare an appropriate Office action in accordance with the above-mentioned procedures, which will be mailed in due course.

9. Any future correspondence with respect to this merged *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

10. Any telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

October 27, 2006

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CENTRAL REEXAMINATION UNIT

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900 Second Avenue South
Minneapolis, MN 55402-3319

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In re Dahlstrom et al.
Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION DISMISSING PETITION

This is a decision on the July 26, 2007, patent owner PETITION UNDER 37 C.F.R. § 1.183, requesting waiver of 37 C.F.R. § 1.951 as to patent owner's one opportunity to file comments. The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.183 was paid by credit card. The petition is before the Office of Patent Legal Administration for decision.

The PETITION UNDER 37 C.F.R. § 1.182 is **dismissed** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. Reexamination was ordered and a non-final Office action was mailed in the '003 proceeding on April 4, 2002.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 C.F.R. § 1.945, including an amendment, in the '003 proceeding.

5. A Notification of Defective paper was mailed on June 10, 2002, indicating that the amendment of April 4, 2002, was not in compliance with 37 C.F.R. § 1.530(d)-(j), and setting a one month response period for the patent owner to file a corrected amendment.

6. On July 3, 2002, third party requester filed comments to patent owner's response, pursuant to 37 C.F.R. § 1.947.

7. Also on July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the same third party requester, which proceeding was assigned control no. 90/006,317.

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 C.F.R. § 1.530(d)-(j), in the '003 proceeding.

9. Reexamination was ordered in the '6317 proceeding on August 20, 2002.

10. The '003 and '6317 proceedings were merged on January 30, 2003.

11. A housekeeping amendment was filed for the merged proceedings on February 28, 2003.

12. A nonfinal Office action was mailed on February 16, 2005, in the merged proceedings.

13. Patent owner filed a response to the nonfinal Office action on April 27, 2005, which included an amendment.

14. On May 24, 2005, the third party requester filed comments pursuant to 37 C.F.R. § 1.947, in reply to the patent owner response.

15. On June 3, 2005, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed, notifying the patent owner that the amendment of April 27, 2005, was not in compliance with 37 C.F.R. § 1.530, and setting a 30 day or 1 month time period for response. No patent owner response was received.

16. On July 18, 2005, patent owner filed a PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of terminated reexamination proceedings based upon unavoidable delay, accompanied by declarations, and a proposed late response (including an amendment) to the "Notice Re Defective Paper in *Inter Partes* Reexamination."

17. A decision dismissing the PETITION UNDER 37 C.F.R. § 1.137(a) was mailed on September 23, 2005, which decision noted that the late-filed amendment was NOT in compliance with 37 C.F.R. § 1.530.

18. A Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on August 28, 2006, cancelling claims 1-14 and 16-163.

19. On September 19, 2006, Patent owner filed a PETITION UNDER 37 C.F.R. § 1.182, requesting the withdrawal of cancellation of claims 1-14 and 16-163, and requesting entry and consideration of patent owner's late response and amendment accompanying the instant petition.

20. A decision dismissing the petition was mailed on October 27, 2006, and granting *sua sponte* relief in the form of withdrawing the NIRC in the merged reexamination proceedings. The proposed amendment accompanying the petition was NOT in compliance with 37 C.F.R. § 1.530.

21. On June 23, 2007, an Action Closing Prosecution was mailed.

22. On July 26, 2007, patent owner filed comments after action closing prosecution, accompanied by a proposed amendment.

23. Also on July 26, 2007, patent owner filed a PETITION UNDER 37 C.F.R. § 1.183, requesting waiver of 37 C.F.R. § 1.951 as to patent owner's one opportunity to file comments.

24. Third party requester filed a change of correspondence address on August 1, 2007.

25. On August 24, 2007, third party requester filed comments after Action Closing Prosecution pursuant to 37 C.F.R. § 1.951(b).

DECISION

The present PETITION UNDER 37 C.F.R. § 1.183, requesting waiver of 37 C.F.R. § 1.951 as to patent owner's one opportunity to file comments, has been fully considered. Petitioner asserts that this case includes an extraordinary situation where deleted matter in new claims was bracketed resulting in the amendment of April 27, 2005, not being in compliance with the rules, and therefore not being entered and considered. Petitioner contends that justice requires that a patent owner's amendments and arguments be considered prior to the issuance of the ACP, which could potentially take away patent owner's rights. Petitioner asserts that whether a patent owner's rights are taken away should not be decided on issues of format, but rather on the merits of the case.

Additionally, petitioner contends that the result of the present ACP is contrary to the purpose provided in MPEP 2671.02, which states that before an ACP is in order, a clear issue should be developed. Petitioner purports that in this case the issues being developed include whether a process without vacuum is patentable over the prior art. Petitioner postures that due to formatting errors caused by vagueness in the MPEP, this claim element was not considered, therefore, the issue of whether a process as claimed in the present reexamination proceeding without vacuum is patentable has not been developed. Petitioner further argues that the examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to

which the patent owner is entitled, per MPEP 2671.02. Petitioner purports that it is clear that the patent owner is seeking to define the process claimed in the patent to be without vacuum and/or without vacuum and in a dry environment, and asserts that each of these elements distinguishes the claimed invention over the prior art. Petitioner states that the patent owner believes that the claims containing the amended claim language entitle the patent owner to such protection.

37 C.F.R. § 1.183 states in 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.

37 C.F.R. § 1.951 states in part:

> (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

Petitioner's arguments have been fully considered, but such contentions are **NOT** persuasive. Petitioner's assertion that "this case includes an extraordinary situation where deleted matter in new claims was bracketed resulting in the amendment of April 27, 2005, not being in compliance with the rules, and therefore not being entered and considered" is incorrect, and mis-characterizes the situation at hand. A review of the reexamination record reveals that patent owner has had ample time and opportunity to provide an amendment in conformance with the reexamination rules of practice, specifically, 37 C.F.R. § 1.530, but has **repeatedly failed to do so.** It is noted that the necessary compliance with 37 C.F.R. § 1.530, was first brought to patent owner's attention on June 10, 2002. On July 9, 2002, patent owner filed a proper amendment (and the housekeeping

amendment of February 28, 2003, is a duplicate of this amendment). However, it was then necessary on June 3, 2005, to again require patent owner to comply with the reexamination amendment rules of practice, and since that time, patent owner has not provided an amendment in compliance with 37 C.F.R. § 1.530. In summary, on June 3, 2002, a first improper amendment was filed; on April 27, 2005, a second improper amendment was filed; on July 18, 2005, a third improper amendment was filed; and on September 19, 2006, a fourth improper amendment was filed. It is noted that out of five (5) amendments presented by patent owner in this reexamination proceeding, only one (1) amendment has been found to be in compliance with the rules for reexamination amendment practice. It is further noted that although the previous petition was dismissed in October 2006, during the time subsequent to the dismissal, patent owner has not provided a proper amendment for consideration. Such prosecution evidences a **recurring pattern** of patent owner providing reexamination amendments which are **not** in compliance with the rules. This recurring pattern has resulted in unnecessary delays which are contrary to the statutory requirement for the reexamination proceedings to be conducted with "special dispatch" pursuant to 35 U.S.C. 305[1]. Therefore, petitioner's assertions of an "extraordinary situation" are not well-founded.

Fortunately, contrary to Petitioner's assertions, patent owner has not yet lost any rights, as an ACP is not a final Office action (MPEP 2671.02). Patent owner does have an opportunity to provide an amendment in reply to the ACP of June 26, 2007, as noted in the action:

> "(1) Pursuant to 37 C.F.R. 1.951(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 C.F.R. 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 C.F.R. 1.951(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester."

---

[1]See also 37 C.F.R. § 10.18(b)(2)(i)

It is noted that on July 26, 2007, patent owner did submit a response, including a proposed amendment, that was accompanied by the instant petition. To purport that patent owner may have lost certain rights is unfounded, as well as premature, as patent owner has availed itself of the optional reply right to the ACP. Since patent owner has taken advantage of the one opportunity to file a response accompanied by a proposed amendment in reply to the ACP, but patent owner has not yet received the Office's determination on such proposed amendment as to whether it shall be entered and considered pursuant to the provisions of 37 C.F.R. 1.116, the instant petition requesting waiver of 37 C.F.R. § 1.951, as to patent owner's one opportunity to file comments is **dismissed as premature**.

Note that with regard to any potential non-entry of patent owner's amendment filed in reply to the ACP, MPEP 2673.02 states in part:

> In the event that an amendment submitted by the patent owner after the ACP has not been entered because the amendment does not comply with the requirements of 37 CFR 1.116 (see 37 CFR 1.951(a)), the patent owner may file a petition under 37 CFR 1.181 requesting entry of the amendment. The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal or cross appeal, if appropriate (see 37 CFR 1.953(c)). Note that the filing of a petition under 37 CFR 1.181 does **not** toll the time period for filing a notice of appeal or cross appeal, if appropriate. Thus, in addition to the petition under 37 CFR 1.181, the patent owner is encouraged to file (1) a petition under 37 CFR 1.183 requesting waiver of the prohibition of an extension of time for filing an appeal brief (37 CFR 41.66(a)), and (2) a request for an extension of the period to file the appeal brief until after a decision on the petition under 37 CFR 1.181. The third party requester may once file comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester. When rendering a decision on the petition under 37 CFR 1.181, the deciding official should be mindful that a patent owner in an *inter partes* reexamination proceeding may not be able to proceed effectively if the amendment submitted after the ACP is not entered since the patent owner in an *inter partes* reexamination proceeding does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an *inter partes* reexamination.

With regard to what justice requires, due to the recurring pattern of providing amendments that are NOT in compliance with 37 C.F.R. § 1.530, the Office's ability to proceed with "special dispatch" in the instant merged reexamination proceeding has been frustrated. In the event critical rights are lost for failure to timely provide an amendment in compliance with 37 C.F.R. § 1.530, it is to be noted that the Office and third party requester have countervailing interests of "special dispatch" which must be weighed in deciding the instant petition under 37 C.F.R. § 1.183. The petitioner's assertion that justice requires granting of this petition is not well-taken, as the repeated failure of patent owner to comply with the amendment rules for reexamination has resulted in prolonged prosecution within the Office.

Concerning petitioner's contentions that the result of the present ACP is contrary to the purpose provided in the MPEP 2671.02, which states that before an ACP is in order, a clear issue should be developed, such argument is not well-founded. A clear issue has been developed, it is based on the one proper amendment that patent owner has provided to the Office. Petitioner postures that the issue of whether a process as claimed in the present reexamination proceeding without vacuum is patentable has not been developed. While this may be unfortunate, the Office is not responsible for patent owner's failure to provide a timely and proper amendment directed to these claim limitations. Petitioner further argues that the examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to which the patent owner is entitled, per MPEP 2671.02. However, it should be noted that patent owner was cautioned in the first Office action mailed on April 4, 2002, (i.e., more than 5 years ago) that:

> "In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patent ability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an action closing prosecution (ACP), will be governed by the requirements of 37 C.F.R. 1.116, which will be strictly enforced."

Therefore, to contend that the ACP of June 26, 2007, is premature is without merit. Petitioner purports that it is clear that the patent owner is seeking to define the process claimed in the patent to be without vacuum and/or without vacuum and in a dry environment, and asserts that each of these elements

distinguishes the claimed invention over the prior art. Petitioner states that the patent owner believes that the claims containing the amended claim language entitle the patent owner to such protection. However, since a proposed amendment did accompany patent owner's response to the ACP, if the proposed amendment complies with 37 C.F.R. § 1.530, and is found by the examiner to be enter-able based on the criteria of 37 C.F.R. § 1.116, then it shall be entered and considered.

The PETITION UNDER 37 C.F.R. § 1.183 has been fully considered, but is **dismissed as premature**.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. § 1.183 is **dismissed**.

2. The merged *inter partes* reexamination proceeding has been forwarded to the examiner for consideration of the patent owner's and requester's comments in response to the ACP per MPEP 2672, and preparation of the next Office action pursuant to MPEP 2673.

3. Any future correspondence with respect to this merged *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

4. Any telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

September 27, 2007

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.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 09/03/2008

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3244

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/03/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:
MAILED
SEP 03 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317 + 95000003
PATENT NO. : 6319526
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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WESTMAN CHAMPLIN & KELLY, P.A. (For Patent Owner)
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MINNEAPOLIS MN 55402-3244

Townsend, Townsend & Crew LLP (For Third Party Requester)
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

MAILED

SEP 03 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Dahlstrom et al. :
Control No. 95/000,003 :
Filed: January 8, 2002 :
U.S. Patent No. 6,319,526 : **DECISION GRANTING**
: **PETITION**

In re Reexamination Proceeding :
Dahlstrom et al. :
Control No. 90/006,317 :
Filed: July 3, 2002 :
U.S. Patent No. 6,319,526 :

This is a decision on the July 23, 2008 patent owner petition under 37 CFR 1.137(b), entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)." The petition is being treated as a petition under 37 CFR 1.958(b) to revive *inter partes* reexamination prosecution, and under 37 CFR 1.137(b) to accept an appellant brief as having been unintentionally delayed.

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

DECISION

37 CFR 1.958(b) incorporates the requirements of 37 CFR 1.137(b) for revival of an *inter partes* reexamination prosecution that was terminated (or limited) due to an unintentionally delayed response by patent owner. 37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or

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

The present petition under 37 CFR 1.137(b) includes, *inter alia*:

1) The requisite response (an appellant brief with authorization to charge the $510.00 brief fee) to satisfy item 1;

2) The $1,540.00 petition fee under 37 CFR 1.17(m) (an authorization to charge counsel's credit card for the $1,540.00 petition fee under 37 CFR 1.17(m)) to satisfy item 2; and

3) The requisite statement regarding the delay to satisfy item 3; and

4) A Certificate of Service upon Third Party Requester to satisfy 37 CFR 1.903.

Accordingly, the July 23, 2008 appellant brief is accepted as having been unintentionally delayed.

ADDITIONAL DISCUSSION

37 CFR 41.66 (b) states:

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

37 CFR 41.68 states (in part):

> (a) (1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

As the petition to revive includes a paper (appellant brief) that triggers a third party requester right to respond, the requester is being provided an opportunity to file a respondent's brief. The appellant brief is not considered "properly filed" in the proceeding until the prosecution is revived; thus, third party requester's time period to file a respondent's brief begins to run from the date of the petition granting revival. Accordingly, any third party requester respondent's brief addressing patent owner's July 23, 2008 appellant brief must be filed **within one month from the issue date of the instant decision to revive the instant proceeding.**

CONCLUSION

1. The petition under 37 CFR 1.958(b) and 37 CFR 1.137(b) is granted.

2. A fee in the amount of $2050.00 (1540.00 + $510.00) has been charged in accordance with petitioner's EFS web submission containing the present petition.

3. A time period for third party requester to file a respondent brief in accordance with 37 CFR 41.68 is set to expire **one (1) month from the issue date of this decision.**

4. Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) for processing of papers received, and to await receipt of respondent's brief or the expiration of the time for filing same, after which jurisdiction will be returned to CRU Art Unit 3991 for consideration.

5. Any further communications as to the reexamination proceeding should be directed to the supervisor Deborah Jones of CRU Art Unit 3991, who can be reached at 571-272-1535.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss at 571-272-7759.

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

09-2-08
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 10/15/2008

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3244

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/15/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:
MAILED

OCT 15 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 10/15/2008

WESTMAN CHAMPLIN & KELLY, P.A.
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900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3244

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/15/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

OCT 15 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
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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OCT 15 2008

CENTRAL REEXAMINATION UNIT

WESTMAN CHAMPLIN & KELLY, P.A.
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(For Patent Owner)

Townsend, Townsend & Crew LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

(For Third Party Requester)

In re Reexamination Proceeding Dahlstrom et al. Control No. 95/000,003 Filed: January 8, 2002 U.S. Patent No. 6,319,526	DECISION ON PETITION TO CONTINUE *INTER PARTES* REEXAMINATION PROCEEDINGS AND AS A REQUEST FOR ENTRY OF AN AMENDMENT AFTER FILING FOR APPEAL
In re Reexamination Proceeding Dahlstrom et al. Control No. 90/006,317 Filed: July 3, 2002 U.S. Patent No. 6,319,526	

This is a decision on patent owner's July 23, 2008 "PETITION UNDER 37 CFR 1.183," requesting waiver of 37 CFR 1.953(c) and 37 CFR 41.33 to reopen prosecution in the instant reexamination proceeding for entry of a "STATEMENT OF PATENT OWNER AND AMENDMENT," filed with the petition. The July 23, 2008 petition is being treated as a petition Requesting Continued Reexamination under 37 CFR 1.182 and also as a petition requesting waiver of 37 CFR 41.63(c) under 37 CFR 1.183.

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 1.183 was charged to petitioner's credit card on July 23, 2008.

For the reasons set forth below, the petition under 37 CFR 1.183 is dismissed.

REVIEW OF THE FACTS

1. U.S Patent number 6,319,526 (the '526 patent) issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed in the Office by a first third party requester. The request was assigned reexamination proceeding control number 95/000,003 (the '003 reexamination proceeding).

3. On April 4, 2002, the Office issued an order, in the '003 reexamination proceeding, granting inter partes reexamination of the '526 patent. Concurrently with the order the Office issued a non-final Office action.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 CFR 1.945, including an amendment, in the '003 reexamination proceeding.

5. On June 10, 2002, the Office issued a Notice of Defective paper stating that the June 3, 2002 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one month time period for patent owner to file a proper amendment.

6. On July 3, 2002, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's June 3, 2002 response.

7. Also on July 3, 2002, a request for *ex parte* reexamination for the '526 patent was filed in the Office by a second third party requester. The request was assigned reexamination proceeding control number 90/006,317 (the '6317 reexamination proceeding).

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 CFR 1.530 (d) – (j) in the '003 reexamination proceeding.

9. On August 20, 2002, the Office issued an order, in the '6317 reexamination proceeding, granting *ex parte* reexamination of the '526 patent.

10. On January 30, 2003, the Office issued a decision merging the '003 *inter partes* reexamination proceeding and the '6317 *ex parte* reexamination proceeding (the merged reexamination proceeding).

11. On February 28, 2003, patent owner filed a housekeeping amendment in the merged reexamination proceeding.

12. On February 16, 2005, the Office issued a non-final Office action for the merged reexamination proceeding.

13. On April 27, 2005, the patent owner filed a response to the Office action, including an amendment, in the merged reexamination proceeding.

14. On May 24, 2005, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's April 27, 2005 response.

15. On June 3, 2005, the Office issued a Notice of Defective paper stating that the April 27, 2005 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one

month time period for patent owner to file a proper amendment. A patent owner response to the notice was not received.

16. On July 18, 2005, patent owner filed a petition under 37 CFR 1.137(a), for the revival of a terminated reexamination proceeding based upon unavoidable delay, accompanied by declarations and a proposed late response (including an amendment) to the Notice of Defective paper issued by the Office on June 3, 2005.

17. On September 23, 2005, the Office issued a decision dismissing as moot patent owner's July 18, 2005 petition noting that prosecution of the proceeding had not in fact terminated. The Office also noted that the late filed amendment was NOT in compliance with 37 CFR 1.530.

18. On August 28, 2006, the Office inadvertently issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) canceling claims 1-14 and 16-163.

19. On September 16, 2006, patent owner filed a petition under 37 CFR 1.182, requesting withdrawal of the cancellation of claims 1-14 and 16-163 and requesting entry and consideration of patent owner's response (to include an amendment) concurrently filed with the petition.

20. On October 27, 2006, the Office issued a decision *sua sponte* withdrawing the August 28, 2006 NIRC and reinstating claims 1-14 and 16-163 to a pending status. The decision dismissed patent owner's request for consideration and entry of the amendment to the claims made in the September 16, 2006 petition, because the accompanying amendment did not comply with 37 CFR 1.530. The Office transferred jurisdiction to the Central Reexamination Unit (CRU) for further consideration.

21. On June 23, 2007, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

22. On July 26, 2007, patent owner filed a response to the ACP that included an amendment and a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.951 requesting entry and consideration of the concurrently filed amendment.

23. On August 24, 2007, third party requester filed comments after ACP pursuant to 37 CFR 1.951(b).

24. On September 27, 2007, the Office issued a decision dismissing patent owner's July 26, 2007 petition noting that such petition was premature, as 37 CFR 1.951(a)[1] provide for patent owner to present an amendment in response to an ACP.

25. On January 29, 2008, patent owner filed a reissue application of the '526 patent. The Office assigned the application U.S. Application Serial number 12/011,746.

---

[1] However subject to the criteria of § 1.116 as to whether or not it shall be admitted.

26. On April 1, 2008, the Office issued a Right of Appeal Notice (RAN) in the merged proceeding. The RAN noted that patent owner's amendment submitted after ACP was not entered due to a failure to comply with the amendment entry criteria set forth in 37 CFR 1.952 and 1.116.

27. On April 30, 2008, patent owner filed a Notice of Appeal.

28. On July 23, 2008, patent owner filed a petition for petition under 37 CFR 1.137(b), for entry of late papers (an Appeal Brief) based upon unintentional delay. The petition was accompanied by an appeal brief, a certificate of service and payment of fees.

29. Also on July 23, 2008, patent owner submitted a petition under 37 CFR 1.183 requesting entry of an amendment attached to and concurrently filed with the petition.

30. On September 3, 2008 the Office issued a decision granting the revival of the merged reexamination proceeding.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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 1.953(c) provides:

> The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the inter partes reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

37 CFR 41.33(c) provides (for *ex parte* appeals):

> (c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

37 CFR 41.63 provides (for *inter partes* reexamination appeals):

> (a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.
>
> (b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).
>
> (c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

MPEP 2672 (VI) ACTION CLOSING PROSECUTION - PREMATURE states:

> If the patent owner is of the opinion that the Office action closing prosecution in the inter partes reexamination proceeding is premature, the patent owner may, in addition to the comments submitted under 37 CFR 1.951(a), file a petition under 37 CFR 1.181 within the time period for filing the comments under 37 CFR 1.951(a). The third party requester may then once file, as a paper separate from any submission under 37 CFR 1.951(b), comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester.

MPEP 2673.02 states (in part):

> In the event that an amendment submitted by the patent owner after the ACP has not been entered because the amendment does not comply with the requirements of 37 CFR 1.116 (see 37 CFR 1.951(a)), the patent owner may file a petition under 37 CFR 1.181 requesting entry of the amendment. The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal or cross appeal, if appropriate (see 37 CFR 1.953(c)). Note that the filing of a petition under 37 CFR 1.181 does not toll the time period for filing a notice of appeal or cross appeal, if appropriate. Thus, in addition to the petition under 37 CFR 1.181, the patent owner is encouraged to file (1) a petition under 37 CFR 1.183 requesting waiver of the prohibition of an extension of time for filing an appeal brief (37 CFR 41.66(a)), and (2) a request for an extension of the period to file the appeal brief until after a decision on the petition under 37 CFR 1.181. The third party requester may once file comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester. When rendering a decision on the petition under 37 CFR 1.181, the deciding official should be mindful that a patent owner in an inter partes reexamination proceeding may not be able to proceed effectively if the amendment submitted after the ACP is not entered since the patent owner in an inter partes reexamination proceeding does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an inter partes reexamination.

MPEP 2674 states (in part):

> It should be noted that under 37 CFR 41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under 37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1).

DECISION

Petitioner patent owner requests that the Office suspend 37 CFR 1.953(c) and 37 CFR 41.33(c) and reopen prosecution in the merged proceeding to provide consideration of the amendment that was filed on July 23, 2008, after the filing of a notice of appeal and submission of an appeal brief. Patent owner's July 23, 2008 petition will be treated as both a petition under 37 CFR 1.182 as a Request to Continue Reexamination (RCR) and as a petition under 37 CFR 1.183 to suspend 37 CFR 41.63(c).

CONTINUATION OF PROSECUTION UNDER 37 CFR 1.182

In March of 2005, the Office issued a Notice entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[2] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

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

Based on the facts and circumstances of the present case, Petitioner patent owner's response in the form of an amendment and remarks/arguments directed towards continued reexamination of additional issues of patentability is not 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 presents two arguments to justify the granting of the extraordinary relief of request for continued reexamination: (1) An allegation the claims, as amended in the amendment concurrently submitted with the petition for continued reexamination, are patently distinct over the prior art of record; and (2) The denial of entry of previous versions of the amendment concurrently submitted during reexamination in the merged reexamination proceeding due to formal matters should not preclude consideration of the substantive content of the amendment.

Petitioner's first argument that continued reexamination should be granted because the amendments to the claims render the claims patentable is not persuasive. Specifically, petitioner states on page 2 of the instant petition at the beginning of the second full paragraph of the page that, "It is clear that the patent owner is seeking to define the process claimed in the patent to be without vacuum and/or without vacuum and in a dry environment." The presentation of this amendment is not in response to the issue asserted as being raised for the first time in a final Office action. Furthermore, a review of the amendments made indicate that not all the claims contain the negative limitation of "without vacuum." Claims 114-136, 155-161, and 163 set forth the negative limitation "without vacuum." If such a limitation clearly defines over the prior art of record to place the claim in *prima facia* condition for allowance,why is the limitation not in all the claims? Furthermore, petitioner's remarks do not point to express support for the negative limitation of "without vacuum" to resolve any issues of patentability that may arise under 35 USC 112, first paragraph. Instead petitioner makes speculative conclusions as to absence of a vacuum in various examples set forth in the written description, which are unsupported by evidence or legal analysis as to how petitioner arrived at such speculative conclusions. Finally, petitioner also amends all the claims to include a limitation regarding adding emulsifying salts, dairy ingredients, non-dairy ingredients or other generally recognized as safe ingredients to the curd and then a subsequent limitation that requires these same ingredients to not be added, thus creating another issue of patentability (indefiniteness) under 35 USC 112, second paragraph. Therefore, petitioner's amendment actually injects several new issues of patentability that could only be resolved by further prolonging the reexamination proceeding, and not reducing issues in the proceeding. The presentation of new limitations into some of the claims, while alleging the limitation renders all the claims patently distinct, and simultaneously not decisively establishing proper support for the new limitations and creating issues of indefiniteness only adds to the issues of patentability that must be resolved. The current proceeding is a REEXAMINATION PROCEEDING with a statutory mandate of SPECIAL DISPATCH and its current procedural posture is AFTER A FINAL OFFICE ACTION and on APPEAL. The creation of new issues of patentability in the accompanying response is inappropriate, as the limitations only complicate and delay reexamination. Thus the response runs contrary to the statutory mandate of "special

dispatch." Accordingly, continued reexamination is not appropriate here, due to petitioner's creation of issues that are not even prompted by the presentation of information raised for the first time in a final Office action.

Petitioner's second argument that the denial of entry of previous versions of the amendment concurrently submitted during reexamination in the merged reexamination proceeding due to formal matters should not preclude consideration of the substantive content of the amendment is not persuasive. Specifically, petitioner states on page 2 of the instant petition that the issues of patentability regarding the addition of the "without vacuum and/or without vacuum and in a dry environment" limitations have been thwarted by the Office's denial of their entry during prosecution. The Office's basis for denying entry of petitioner's amendments containing the "without vacuum and/or without vacuum and in a dry environment" limitations were based upon a failure of petitioner to comply with 37 CFR 1.530. Petitioner has characterized the requirement of 37 CFR 1.530 as matters of form which should not get in the way of determining the important matters of patent rights to an important invention. The presentation of this amendment is not in response to an issue or information being raised for the first time in a final Office action. Instead, the amendment is presented for the fifth time in response to a rule, of which petitioner should be aware, that governs the foundational manner in which reexamination proceedings are conducted. As noted above in regards to petitioner's assertion as to developing the patentability of the claims with the proposed limitations of "without vacuum and/or without vacuum and in a dry environment," such cannot be dispositive of the case because petitioner has not placed the limitations in all the claims and has not properly proven the existence of the legally necessary support for the limitations to avoid a rejection under 35 USC 112, first paragraph. Further, the record reflects that, in addition to the current submission, petitioner has submitted essentially the same amendment on four different occasions during prosecution of the present proceeding (April 27, 2005, July 18, 2005, September 19, 2006 and July 26, 2007). In response to all of petitioner's submissions, the Office either rejected or noted that the amendments failed to comply with 37 CFR 1.530. Petitioner is essentially arguing that, because the rule is one of "form" petitioner should not be required to comply, or that the statutory requirement of special dispatch should be dispensed with to accommodate patent owner's lack of attentiveness to the rule. The concurrently submitted version continues this non-compliance,[3] Which would further delay special dispatch in spite of the fact that the Office has given petitioner multiple opportunities to comply with 37 CFR 1.530. 37 CFR 1.530 supports special dispatch by allowing the Office to readily examine the merits of the amendment without having to continually revisit previously presented amendments to discern what issues are being further developed. Petitioner has had multiple opportunities to insure their rights are optimally preserved, but has not done so. Accordingly, an continued reexamination is no appropriate.

SUSPENSION OF THE RULES UNDER 37 CFR 1.183

Patent owner's arguments for suspending rule 37 CFR 41.63(c) and enter amendment filed on July 23, 2008 are not persuasive and hence is not be granted. MPEP section 2673.02 of the Manual of Patent Examining Procedure (MPEP) states, "[a]n amendment filed after the RAN will not be entered at all, in the absence of a grantable petition under 37 CFR 1.183, because 37

[3] The concurrent filed amendment, *inter alia*, does not use bracketing to designate deleted text from claim 124.

CFR 1.953(c) prohibits an amendment after the RAN in an *inter partes* reexamination." The provisions of 37 CFR 1.953(c) may be waived under 37 CFR 1.183 where a petitioner demonstrates an extraordinary situation in which justice requires suspension of the rule. However, MPEP section 2674 states, "[a]s to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under 37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1)." A notice of appeal was filed on April 30, 2008 and petitioner filed an appeal brief on July 23, 2008. Therefore, the July 23, 2008 amendment has been filed after the date of filing an appeal, and 37 CFR 41.63 now governs the merged proceeding regarding entry of amendments.

In light of the analysis of petitioner's arguments in the previous section regarding continued reexamination relief, even if the petition and amendment were timely filed, patent owner's arguments do not demonstrate an extraordinary situation in which justice requires suspension of the rule prohibiting the filing of an amendment after the date of filing for an appeal in an *inter partes* reexamination. The entry of an amendment after the date of filing for an appeal for the purpose of presenting amended claims so as to merely raise additional new issues of patentability and prolong the reexamination proceeding and not for the purposes of advancing prosecution toward appeal (e.g., by reducing the issues on appeal) is not a situation where justice requires suspension of the rule.

On July 26, 2007, petitioner submitted a response to ACP that included a proposed amendment and a petition under 37 CFR 1.183 requesting suspension of rule 37 CFR 1.951 and entry of the amendment. On September 27, 2007 the Office dismissed petitioner's request for a wavier of 37 CFR 1.951 as being premature because the rule actually gives discretion for entry of amendments after ACP. The September 27, 2007 decision noted that if entry of the amendment after ACP was denied then, in accordance with MPEP 2673.02, patent owner had legal recourse to seek review of the denial of entry. The decision replicated the relevant portion of MPEP 2673.02 and highlighted the fact that patent owner would need to file a petition under 37 CFR 1.181 seeking supervisory review of the denial of entry and, while the filing of a notice of appeal could not be extended, patent owner could simultaneously file a petition under 37 CFR 1.183 seeking an extension of time to file an appeal brief until a decision issued on the 37 CFR 1.181 request for supervisory review of the denial of entry. Petitioner opted not to pursue this alternative legal recourse and instead filed a notice of appeal and subsequently an appeal brief. Accordingly, as petitioner opted to pursue the appeal and declined to pursue the proper legal course of action that did not require a suspension of the rules, the instant petition for entry suspension of 37 CFR 41.63 is not persuasive.

As a final point, the repeated failure to comply with the reexamination amendment rules does not provide an extraordinary situation.

For the reasons set forth above, petitioner's arguments for waiver of 37 CFR 41.63(c) is not persuasive. Petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 41.63(c) for entry of the July 23, 2008 amendment

filed after the date of filing for an appeal. Furthermore, as noted above petitioner opted not to avail themselves of the appropriate alternative legal recourse that would have mooted the need to request suspension of 37 CFR 41.63(c).

In view of the above and the fact situation presented by the record, the petition is dismissed, and jurisdiction of the proceeding is returned to the Central Reexamination Unit (CRU) for appeal.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The petition under 37 CFR 1.183 is dismissed.

3. Prosecution is not being reopened by this decision, and patent owner's amendment will not be entered.

4. The merged reexamination proceeding will continued its current appeal process.

5. Jurisdiction for the merged reexamination proceeding is returned to the Central Reexamination Unit for appeal.

6. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 11/04/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Eugene J. Bernard
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Date: MAILED
NOV 04 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317 + 95/000003
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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NOV 04 2009

CENTRAL REEXAMINATION UNIT

In re Dahlstrom et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,003
Filing Date: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Ex parte Reexamination Proceeding
Control No.: 90/006,317
Filing Date: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION GRANTING PETITION UNDER 37 CFR 1.183

This is a decision on patent owner's August 31, 2009 "PETITION UNDER 37 C.F.R. § 1.183," requesting waiver of 37 CFR §§ 41.63(c) and 41.66(e) to permit entry of a concurrently filed declaration under 37 CFR 1.131, accompanied by attached Exhibits A-P.

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 1.183 was charged to petitioner's credit card on September 8, 2009.

For the reasons set forth below, the petition under 37 CFR 1.183 is granted.

Accordingly, the August 31, 2009 declaration under 37 CFR 1.131 and attached Exhibits A-P, will be entered for consideration by the examiner. The third party requester is given a period of fifteen (15) days from the mailing date of the present decision to submit a response solely limited to addressing the Garaoutte declaration and attached Exhibits A-P.

REVIEW OF THE FACTS

1. U.S Patent number 6,319,526 (the '526 patent) issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,003 (the '003 reexamination proceeding).

3. On April 4, 2002, the Office issued an order in the '003 reexamination proceeding granting *inter partes* reexamination of the '526 patent. Concurrently with the order, the Office issued a non-final Office action.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 CFR 1.945, including an amendment, in the '003 reexamination proceeding.

5. On June 10, 2002, the Office issued a Notice of Defective paper stating that the June 3, 2002 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one month time period for patent owner to file a proper amendment.

6. On July 3, 2002, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's June 3, 2002 response.

7. Also on July 3, 2002, a request for *ex parte* reexamination for the '526 patent was filed in the Office by the same third party requester that filed the *inter partes* reexamination request. This request was assigned reexamination proceeding control number 90/006,317 (the '6317 reexamination proceeding).

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 CFR 1.530 (d) - (j) in the '003 reexamination proceeding.

9. On August 20, 2002, the Office issued an order in the '6317 reexamination proceeding granting *ex parte* reexamination of the '526 patent.

10. On January 30, 2003, the Office issued a decision merging the '003 *inter partes* reexamination proceeding and the '6317 *ex parte* reexamination proceeding (the merged reexamination proceeding).

11. On February 28, 2003, patent owner filed a housekeeping amendment in the merged reexamination proceeding.

12. On February 16, 2005, the Office issued a non-final Office action for the merged reexamination proceeding.

13. On April 27, 2005, the patent owner filed a response to the Office action, including an amendment, in the merged reexamination proceeding.

14. On May 24, 2005, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's April 27, 2005 response.

15. On June 3, 2005, the Office issued a Notice of Defective paper stating that the April 27, 2005 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one month time period for patent owner to file a proper amendment. A patent owner response to the notice was not received.

16. On July 18, 2005, patent owner filed a petition under 37 CFR 1.137(a), for the revival of a terminated reexamination proceeding based upon unavoidable delay, accompanied by declarations and a proposed late response (including an amendment) to the Notice of Defective paper issued by the Office on June 3, 2005.

17. On September 23, 2005, the Office issued a decision dismissing as moot patent owner's July 18, 2005 petition noting that prosecution of the proceeding had not in fact terminated. The Office also noted that the late filed amendment was NOT in compliance with 37 CFR 1.530.

18. On August 28, 2006, the Office inadvertently issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) canceling claims 1 - 14 and 16-163.

19. On September 19, 2006, patent owner filed a petition under 37 CFR 1.182, requesting withdrawal of the cancellation of claims 1-14 and 16-163 and requesting entry and consideration of patent owner's response (to include an amendment) concurrently filed with the petition.

20. On October 27, 2006, the Office issued a decision *sua sponte* withdrawing the August 28, 2006 NIRC and reinstating claims 1-14 and 16-163 to a pending status. The decision dismissed patent owner's request for consideration and entry of the amendment to the claims made in the September 16, 2006 petition, because the accompanying amendment did not comply with 37 CFR 1.530.

21. On June 26, 2007, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

22. On July 26, 2007, patent owner filed a response to the ACP that included an amendment and a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.951 and entry and consideration of the concurrently filed amendment.

23. On August 24, 2007, third party requester filed comments after ACP pursuant to 37 CFR 1.951(b).

24. On September 27, 2007, the Office issued a decision dismissing patent owner's July 26, 2007 petition noting that such petition was premature, as 37 CFR 1.951(a)[1] provided for patent owner to present an amendment in response to an ACP.

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[1] However subject to the criteria of § 1.116 as to whether or not it shall be admitted.

25. On January 29, 2008, patent owner filed a reissue application of the '526 patent. The Office assigned the application U.S. Application Serial number 12/011,746.

26. On April 1, 2008, the Office issued a Right of Appeal Notice (RAN) in the merged proceeding. The RAN noted that patent owner's amendment submitted after ACP was not entered due to a failure to comply with the amendment entry criteria set forth in 37 CFR 1.953 and 1.116.

27. On April 30, 2008, patent owner filed a Notice of Appeal.

28. On July 23, 2008, patent owner filed a petition under 37 CFR 1.137(b), for entry of late papers (an appellant brief) based upon unintentional delay. The petition was accompanied by an appeal brief, a certificate of service and payment of fees.

29. Also on July 23, 2008, patent owner submitted a petition under 37 CFR 1.183 requesting entry of an amendment attached to and concurrently filed with the petition.

30. On September 3, 2008 the Office issued a decision granting the revival of the merged reexamination proceeding.

31. On October 3, 2008, third party requester filed a respondent brief.

32. On October 15, 2008, the Office issued a decision dismissing patent owner's July 23, 2008 petition.

33. On February 23, 2009, the Office issued an Examiner's Answer.

34. On March 23, 2009, patent owner filed a rebuttal brief in response to the Examiner's Answer.

35. On April 8, 2009, the Office issued a Notice of Defective paper stating that the July 23, 2008 appellant brief was improper because it was 33 pages in length, with no word count provided. The Notice also stated that the October 3, 2008 respondent's brief was in response to the improper appellant brief, and thus the requester's respondent brief was moot and would not be considered.

36. On April 22, 2009, patent owner resubmitted appellant brief.

37. On May 12, 2009, third party requester resubmitted respondent brief.

38. On July 8, 2009, the Office issued a Notice of Defective paper stating that the April 22, 2009 appellant brief was defective because appellant failed to argue the rejections of all of the pending claims 1-14 and 16-163, which contradicted the appellant's statement under "Status of Claims" in the brief that pending claims 1-14 and 16-163 were rejected and were on appeal.

39. On August 6, 2009, patent owner resubmitted appellant brief.

40. On August 10, 2009, patent owner filed an amendment after an appeal pursuant to 37 CFR 41.63(a) to cancel claims 104-113, 124, and 137-163.

41. On August 20, 2009, third party requester resubmitted a respondent brief.

42. On August 31, 2009, patent owner filed the present petition under 37 CFR 1.183 to request waiver of 37 CFR §§ 41.63(c) and 41.66(e) to permit entry of a concurrently filed declaration under 37 CFR 1.131.

43. On September 28, 2009, the Office issued an Examiner's Answer in response to the August 6, 2009 resubmitted appellant brief and the August 20, 2009 resubmitted respondent brief.

44. On October 13, 2009, patent owner filed a rebuttal brief.

45. On October 29, 2009, the Office issued a Notice of Defective rebuttal brief.

RELEVANT REGULATIONS AND EXAMINING PROCEDURE

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 41.63(c) provides (for *inter partes* reexamination appeals):

> Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

37 CFR 41.66(e) provides (for *inter partes* reexamination appeals):

> No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

MPEP 2674 states (in part):

> It should be noted that under 37 CFR 41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to <u>all other amendments filed after the date of filing an appeal</u>, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent

owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under 37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1).

DECISION

In the present petition under 37 CFR 1.183, petitioner patent owner requests that the Office waive 37 CFR §§ 41.63(c) and 41.66(e) and permit entry of the concurrently filed declaration of Garaoutte under 37 CFR 1.131 (hereinafter "the Garaoutte declaration"), accompanied by attached Exhibits A-P. The patent owner alleges that the Garaoutte declaration provides evidence of prior invention with respect to U.S. Patent No. 6,120,809 to Rhodes ("Rhodes '809). Patent owner asserts that he did not discover the existence of the documentary evidence until after the Action Closing Prosecution was issued, and therefore was procedurally prevented from submitting the evidence of prior invention that would eliminate Rhodes '809 as prior art during the present reexamination proceeding. Patent owner explains that he has spent a significant amount of time and effort locating the evidence of prior invention, that each of the three inventors listed in the patent that is the subject of the present reexamination proceeding had ceased employment with patent owner prior to the institution of the instant present proceeding, and that the existence and location of these documents were unknown to the patent owner until after the Action Closing Prosecution was mailed.[2] Patent owner asserts that the evidence submitted conclusively proves actual reduction to practice of the claimed methods prior to the filing date of Rhodes '809.[3] With the submission of the Garaoutte declaration, patent owner argues that it has traversed each and every prior art rejection of the claims.[4] Patent owner states that if the present petition is not granted, patent owner may lose all patent rights to an important invention.[5] The examiner and the examiner's supervisor have been consulted, and they have agreed to enter the Garaoutte declaration and accompanied exhibits.

Based on the facts and circumstances of the present case, the petition under 37 CFR 1.183 is granted, and the Garaoutte declaration and accompanied exhibits will be entered for consideration by the examiner, in the interest of resolving the issues of the present proceeding with special dispatch, pursuant to the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

THIRD PARTY REQUESTER OPTION

In order to address the equities of the present situation, the requirements of 37 CFR 41.66(e) and 37 CFR 41.63(c) are *sua sponte* waived to the extent that third party requester is provided with one opportunity to file a response to the newly entered evidence – the Garaoutte declaration and accompanied exhibits - which is granted entry by the present petition. Any such requester response must be filed within fifteen (15) days from the mailing date of the present decision. If a

[2] Petition at page 2.
[3] Petition at page 2.
[4] Petition at page 2.
[5] Petition at page 3.

response to the Garaoutte declaration and accompanied exhibits is filed and it goes beyond this limitation, the response will be returned, or expunged if entered before discovery of such defect.

CONCLUSION

1. The present petition under 37 CFR 1.183 is granted. Accordingly, the August 31, 2009 Garaoutte declaration and attached Exhibits A-P are entered.

2. The third party requester is given a period of fifteen (15) days from the mailing date of the present decision to submit a response solely limited to addressing the Garaoutte declaration and attached Exhibits A-P .

3. Jurisdiction over the proceeding is returned to the Central Reexamination Unit, to await the filing of a response to the Garaoutte declaration and accompanied exhibits or the expiration of time for same, after which the examiner will take appropriate action.

4. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711, or, in her absence, to the undersigned at 571-272-7711.

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.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 03/25/2010

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:
MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 03/25/2010

WESTMAN CHAMPLIN & KELLY, P.A.
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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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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San Francisco, CA 94111

Date:
MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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United States Patent and Trademark Office
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MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

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Eugene J. Bernard (For Requester)
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Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

In re Dahlstrom et al.	:	
Merged *Inter Partes* Reexamination	:	
Proceeding 95/000,003 &	:	**DECISION**
Ex Parte Reexamination	:	**DISMISSING**
Proceeding 90/006,317	:	**PETITION**
Filed: January 8, 2002 & July 3, 2002	:	
For: U.S. Patent No. 6,319,526	:	

This is a decision on the patent owner petition, filed January 12, 2010, denominated "Petition Under 37 CFR § 1.183" requesting waiver of the signature of an unwilling inventor on a declaration under 37 CFR 1.131.

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

The petition fee required under 37 CFR 1.17(f) has been received, but is being refunded for the reasons explained below.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 (the '526 patent) issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003 (the '003 proceeding).

3. On April 4, 2002, reexamination was ordered and a non-final Office action was mailed in the '003 proceeding.

4. On July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the *inter partes* third party requester, which proceeding was assigned control no. 90/006,317 (the '6317 proceeding).

5. On August 20, 2002 reexamination was ordered in the '6317 proceeding, granting *ex parte* reexamination of the '526 patent.

6. On January 30, 2003, the '003 and '6317 proceedings were merged.

7. The merged proceeding progressed to the point of appeal, with the patent owner filing a Notice of Appeal on April 30, 2008.

8. Following filings of the patent owner's appeal brief, respondent's brief, examiner's answer, and rebuttal brief, patent owner petitioned on August 31, 2009 for the opportunity to file arguments after the issuance of the Right of Appeal Notice and filing the Appeal in order to submit evidence of prior invention in the form of a declaration under 37 CFR 1.131(a).

9. Patent owner's August 31, 2009 petition was granted on November 4, 2009 to permit entry of the declaration under 37 CFR 1.131 and attached Exhibits A-P for consideration by the examiner.

10. On December 17, 2009, a second Action Closing the Prosecution (ACP) was mailed stating that reexamination was reopened solely for the purpose of entering the declaration under 37 CFR 1.131 and that the rejections set forth in the ACP dated June 26, 2007 and the Right of Appeal Notice dated April 1, 2008 are maintained. The declaration filed under 37 CFR 1.131 was found by the examiner to fail to demonstrate that any of the inventors of the '526 patent reduced the claimed invention to practice. The second ACP also stated that the patent owner failed to follow the procedure of MPEP 715.04, Part I, by failing to file a petition to request a waiver to permit entry of a declaration without all of the inventors' signatures.

11. After requesting and receiving an extension of time, patent owner filed comments to the second ACP on January 29, 2010 along with a second declaration under 37 CFR 1.131 executed by two of the three inventors and a petition under 37 CFR 1.183 requesting that the requirement that all the inventors sign the declaration be waived. The petition is the subject of this decision.

12. The third party requester filed comments following patent owners comments to the second ACP on February 25, 2010.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

37 CFR 1.183 provides, in pertinent part:

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

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

> The following parties may make an affidavit or declaration under 37 CFR 1.131:
>
> (A) All the inventors of the subject matter claimed.
>
> (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
>
> (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
>
> (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).
>
> Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

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

> (a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.
> (b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:
>
> (i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the

documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or

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

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

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

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

(c) For patent matters only:

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

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

ANALYSIS AND FINDINGS

Patent owner requests that the requirement for the signature of one of the inventors, William Aimutis, be waived for a declaration under 37 CFR 1.131, which has been submitted with signatures of the other two inventors, James Wiegand and Donald Dahlstrom. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination. . .* may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. In this case, the inventors, rather than the patent owner, have attempted to submit a declaration under 37 CFR 1.131. However, waiver of the rule is not required, since the patent owner (assignee) can sign the declaration.

It is acknowledged that the second Action Closing Prosecution incorrectly stated that the patent owner failed to follow the proper procedure for making a Rule 131 declaration by not petitioning to request waiver. However, the owner of a patent under reexamination has the ability to make the declaration under 37 CFR 1.131(a) without a petition. Due to this inadvertent error that may have led the patent owner to file the subject petition, the petition fee is being refunded to patent owner.

Patent owner is reminded that, in order to file a declaration under 37 CFR 1.131(a), the right of the assignee to take action must be established in the reexamination proceeding by filing a proper statement under 37 CFR 3.73(b). To date, no such paper has been filed establishing the authority of the assignee to act in this proceeding.

In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief. Patent owner has an available remedy in which (1) the right to act in this proceeding may be established and then (2) a declaration under 37 CFR 1.131 signed by patent owner may be filed. For that reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

CONCLUSION

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

2. The $400.00 petition fee paid under 37 CFR 1.17(f) is being refunded.

3. This decision does not address the merits of the patent owner's response or the substance of the declaration, which are determinations within the jurisdiction of the examiner of record.

4. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for any further examination as appropriate.

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

/Kenneth M. Schor/

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

March 24, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 06/02/2010

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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SAN FRANCISCO, CA 94111

Date:
MAILED

JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 06/02/2010

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

Eugene J. Bernard (For Requester)
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San Francisco, CA 94111

In re Dahlstrom et al.	:	
Merged *Inter Partes* Reexamination	:	
Proceeding 95/000,003 &	:	**DECISION**
Ex Parte Reexamination	:	**DISMISSING**
Proceeding 90/006,317	:	**PETITION**
Filed: January 8, 2002 & July 3, 2002	:	
For: U.S. Patent No. 6,319,526	:	

This is a decision on the patent owner petition, filed May 24, 2010, denominated "Request for Reconsideration of Denial of Petition Under 37 CFR § 1.183," requesting reconsideration of the March 25, 2010 decision dismissing patent owner's petition under 37 CFR 1.183 to waive the requirement that all inventors sign a declaration under 37 CFR 1.131.

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

The petition under 37 CFR 1.183 for reconsideration is **dismissed** as premature. Petitioner has not shown that this is an extraordinary situation such that relief under the rules has been exhausted and is not available. 37 CFR 1.183 provides (in pertinent part) that:

> 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).

Extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, the patent owner has pursued alternative relief via a 37 CFR 1.181 petition to request entry of the declaration. If the relief requested in the petition under 37 CFR 1.181 is granted, the relief requested in the present petition would be rendered moot. Since the entry of the declaration is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.183 would be

premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.183, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183.

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

It is additionally noted that a declaration under 37 CFR 1.131 signed by **the patent owner** has not been submitted in this proceeding; thus, there does not appear to be a properly signed 37 CFR 1.131 declaration of record for consideration of entry.

Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for any further examination as appropriate.

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

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

June 1, 2010
Kenaffidavit/waiver

#9
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UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 13 2002
REEXAM UNIT

In re Tarbox et al
Ex parte Reexamination Proceeding
Control No. 90/006,330
Filed: July 16, 2002
For: U.S. Patent No. 6,328,260

In re Tarbox et al
Inter partes Reexamination Proceeding
Control No. 95/000,005
Filed: July 15, 2002
For: U.S. Patent No. 6,328,260

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,328,260, issued December 11, 2001, is the subject of both *inter partes* Reexamination Control Number 95/000,005 and *ex parte* Reexamination Control Number 90/006,330.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,005 ('005), was filed July 15, 2002, by third party requester Harry Shannon.

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/006,330 ('330), was filed July 16, 2002, by third party requester Aircraft Owners and Pilots Association.

4. An order granting reexamination was mailed for both proceedings on September 13, 2002.

5. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '330 *ex parte* reexamination expired after November 13, 2002.[1]

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.

In accordance with 37 CFR 1.989 (a), the 95/000,005 and 90/006,330 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

---

[1] There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from parties.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

by Mail to: Attn: "Box *Inter Partes* Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
Washington, D.C. 20231

by FAX to: (703) 305-1013
Central Reexamination Unit

By hand: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA

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.

C. Amendments:

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

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

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., petition fee, 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* requester), 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. 95/000,005 and *ex parte* Reexamination Control No. 90/006,330 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination files are being forwarded via the Technology Center Group Director 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 the undersigned, at (703)308-6710.

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

December 13, 2002
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Paper No. 16

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AUG 1 3 2004

REEXAM UNIT

In re Tarbox et al
Ex parte Reexamination Proceeding
Control No. 90/006,330
Filed: July 16, 2002
For: U.S. Patent No. 6,328,260

In re Tarbox et al
Inter Partes Reexamination Proceeding
Control No. 95/000,005
Filed: July 15, 2002
For: U.S. Patent No. 6,328,260

DECISION AS TO
LATE REQUESTER
COMMENTS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration regarding the April 23, 2004, *inter partes* reexamination requester comments filed after the patent owner's supplemental response to the Office action of January 16, 2004.

For the reasons set forth below, the April 23, 2004, *inter partes* reexamination requester comments are not timely filed, and, as such, the comments will be refused consideration. 37 CFR 1.957(a).

REVIEW OF FACTS

1. United States Patent Number 6,328,260, issued December 11, 2001, is the subject of both *inter partes* Reexamination Control Number 95/000,005 and *ex parte* Reexamination Control Number 90/006,330.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,005 ('005), was filed July 15, 2002, by third party requester Harry Shannon (hereinafter, "the *inter partes* requester").

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/006,330 ('330), was filed July 16, 2002, by third party requester Aircraft Owners and Pilots Association (hereinafter, "the *ex parte* requester").

4. An order granting reexamination was mailed for both proceedings on September 13, 2002.

5. On December 13, 2002, the '005 and '330 reexamination proceedings were merged into a single proceeding, by a decision of the Senior Legal Advisor of the Office of Patent Legal Administration.

6. On January 16, 2004, the examiner issued a first Office action on the merits for the merged proceeding.

7. The patent owner filed a response to the first Office action on March 17, 2004, and then supplemented that response of March 22, 2004. The Certificate of Service for the March 17, 2004, response states a date of service upon the requesters (pursuant to 37 CFR 1.248) of March 11, 2004. The Certificate of Service for the March 22, 2004, supplemental response states a date of service upon the requesters of March 15, 2004. The service is stated to be made at the correct addresses of record for the two requesters.

8. On April 23, 2004, the *inter partes* requester filed comments "in response to" the patent owner's responses. The Certificate of Service for requester's comments states a date of service upon the patent owner and *ex parte* requester (pursuant to 37 CFR 1.248) of April 16, 2004.

DECISION

The requester comments of April 23, 2004, were not timely filed.

Pursuant to 35 U.S.C. 314(b)(3):

> "Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, **if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.**" [Emphasis added]

In the present instance, (1) the Certificate of Service for the March 22, 2004, supplemental patent owner response states a date of service upon the *inter partes* requester of March 15, 2004, (2) the service is stated to be made at the correct *inter partes* requester address of record. Thus, the last possible date [1] for timely requester comments under 35 U.S.C. 314(b) was April 14, 2004. The present requester comments were filed on April 23, 2004, and as such were not timely.

It is noted that 37 CFR 1.947 provides:

> "For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8."

In the present instance, however, the requester comments have not been found to include a certificate under 37 CFR 1.8. There is a Certificate of Service on the other parties to the merged proceeding stating a date of service upon the patent owner and *ex parte* requester of April 16, 2004. However, a Certificate of Service on parties is not a certificate under 37 CFR 1.8. Further, the April 16, 2004, date of the Certificate of Service is still after the April 14, 2004, due date for the comments.

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[1] The Certificate of Service for the March 17, 2004, original patent owner response states a date of service upon the requester of March 11, 2004. Based on that Certificate, the requester comments were due by April 10, 2004. In the last sentence of MPEP 2666.40, however, it is stated (for a patent owenr response curing a defect in an original response) that "if the patent owner's response is not limited to the bare submission of the fee, i.e., if the response also includes argument, then the third party can comment since the patent owner has addressed the merits of the case." Even if the correction of the District Court citation which is the entirety of the supplemental response could be considered as being "addressed the merits of the case," the requester comments were due by April 14, 2004.

In view of the above, the requester comments of April 23, 2004, are not timely filed.

Under 37 CFR 1.957(a), "[i]f the third party requester files an untimely or inappropriate comment... in an *inter partes* reexamination, the paper will be refused consideration." In addition, pursuant to MPEP 2667, part II.B.3:

> "Any third party requester submission following a patent owner's submission, where the third party requester submission is filed subsequent to the permitted time from the date of service of the patent owner's submission, will be retained in the file, but will not be considered."

Since the *inter partes* requester comments were not timely filed, they will not be considered, but will be retained in the file of the merged proceeding.

CONCLUSION

1. For the reasons set forth below, the April 23, 2004, requester comments are not timely filed, and will be refused consideration. The comments will, however, be retained in the file.

2. The merged reexamination file is being forwarded via the Technology Center 3600 Group Director to the examiner for the preparation of an Office action, to be issued in due course. The examiner's action will address the patent owner response of March 17, 2004, and supplemental response of March 22, 2004, but will not address the April 23, 2004, requester comments.

3. Any questions concerning this communication should be directed to the undersigned, at (703)308-6710.

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

August 11, 2004
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CENTRAL REEXAMINATION UNIT

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In re Sembonmatsu et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,006	:	FOR ENTERING
Filed: December 4, 2002	:	AMENDMENT
For: U.S. Patent No.: 6,357,595	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on November 17, 2008. The petition is entitled "PETITION TO ENTER AMENDMENT 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 under 37 CFR 41.77(b)(1). The third party requester filed comments in response to the petition on December 2, 2008.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated November 17, 2008 is denied with respect to entering the amendment filed under 37 CFR 41.50(b)(1) in the prosecution of the *Inter Partes* reexamination proceeding 95/000,006.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,357,595 (hereinafter, the '595 patent) issued on March 2, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/000,006, was filed by a third party requester on December 4, 2002.

3. *Inter partes* reexamination was ordered for the '006 reexamination proceeding on February 6, 2003. On the same day, a non-final Office action was mailed in the '006 reexamination proceeding. The Office action rejected all the claims based upon U.S. Patent No. 5,791,486 to Brahmbhatt (hereinafter "Brahmbhatt").

4. The patent owner filed a response to the non-final Office action on April 7, 2003. The response included proposed amendments to claim 1, cancelled claims 12-15, and added a new independent claim 16.

5. The third party filed comments on May 7, 2003 to the patent owner's response, and introduced an additional ground of rejection based on the embodiment shown in Figure 17 of Brahmbhatt.

6. On October 7, 2003, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP continued to adopt the same grounds of rejections, as set forth in the February 6, 2003 Office action, for the pending claims and included new claim 16 in rejection of claims 1, 2 and 5-11 as being anticipated by Brahmbhatt. The Office action did not adopt the newly proposed rejection of claims 1 and 16 based on the embodiment shown in Figure 17 of Brahmbhatt.

7. On November 7, 2003, patent owner submitted remarks but did not make any further proposed claim amendments.

8. On December 10, 2003, the third party requester submitted comments.

9. On March 2, 2004, the Office issued a Right of Appeal Notice (RAN), which maintained the same rejections as set forth in the ACP.

10. On March 30, 2004, the patent owner filed a Notice of Appeal.

11. On May 28, 2004, the patent owner filed an Appeal Brief

12. On June 28, 2004, the third party requester filed a respondent brief.

13. On December 9, 2004, the Office mailed the Examiner's Answer.

14. On January 10, 2005, the patent owner filed a rebuttal brief to the Examiner's Answer.

15. On March 26, 2007, the Board of Appeals and Interferences (BPAI) issued a decision, which affirmed-in-part the examiner's ground of rejection and issued a new ground of rejection of claims 1, 2, 5-11 and 16 based upon the embodiment shown in Figure 17 of Brahmbhatt.

16. On April 25, 2007, the patent owner elected to reopen prosecution before the examiner by filing a proposed amendment to claims 1, 4, 6, 8-11, and 16 and added new claims 17-29.

17. On May 25, 2007, the third party requester filed comments.

18. On May 19, 2008, the Office issued a notification that the amendment of April 25, 2007 is not entered because it is not compliant with 37 CFR 41.77(b)(1) and also indicated that the third party comments of May 25, 2007 is not entered. The notification set a time period of 15 days to refile the amendment in compliance with 37 CFR 41.77(b)(1).

19. On June 3, 2008, the patent owner filed an amendment, which cancelled claims 1-11 and 16 and added new claims 17-40.[1]

20. On July 2, 2008, the third party requester filed comments.

21. On September 15, 2008, the Office issued a notification that the amendment of June 3, 2008 was not entered because it was not compliant with 37 CFR 41.77(b)(1) and also indicated that the third party comments of July 2, 2008 were not entered. The notification also stated that pursuant to 37 CFR 41.77(f), jurisdiction of the reexamination proceeding was being returned to the BPAI.

22. On November 17, 2008, the patent owner filed the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that amendment of April 25, 2007 or the amendment of June 3, 2008 be entered.

23. On December 2, 2008, the third party requester filed comments in response to the petition.

---

[1] It is noted that two claims were numbered as "39."

24. On December 15, 2008, the BPAI returned the reexamination proceeding to the Central Reexamination Unit to address minor informalities pertaining to the signing of information disclosure statements and to address the petition.

DECISION

The patent owner (petitioner) states that the examiner erred in not entering either the amendment of April 25, 2007 or June 3, 2008 and requests one of the following actions:

1. Entry of the amendment dated April 25, 2007.
2. Entry of the amendment dated June 3, 2008.
3. Entry *in part* of either the amendment of April 25, 2007 or June 3, 2008.

Patent Owner argues that the new claims (claims 17-29 in the amendment dated April 25, 2007 and claims 29-40 in the amendment dated June 3, 2008) are directed to the same subject matter as the claims rejected in the new grounds of rejection. See pages 9-14 of the petition. Because of this, petitioner requests that one of the amendments be entered.

In their comments of December 2, 2008, the third party requester argues that the amendments of April 25, 2007 and June 3, 2008 were correctly not entered by the examiner because the amendments were not compliant with 37 CFR 41.77(b). In support, the third party requester states that prosecution in this reexamination proceeding as been ongoing since December 2002, and that all rejections have consistently been based on the same reference to Brahmbhatt. Third Party requester points out that patent owner had many opportunities to add new claims to vary the scope of coverage but chose not to do so. Given these facts, the third party requester argues that the reopening of prosecution authorized by 37 CFR 41.77 should be strictly limited to the address the new ground of rejection in the interest of special dispatch.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the addition of the new claims (claims 17-29 in the amendment dated April 25, 2007 and claims 29-40 in the amendment dated June 3, 2008) exceeds the limited reopening of prosecution permitted by 37 CFR 41.77(b)(1).

As pointed out by the examiner in the notifications of May 19, 2008 and September 15, 2008, the amendments were not entered because the new claims did not comply with the guidance set forth in MPEP 2682, subsection II.B., which states that:

> "When the patent owner submits a response pursuant to 37 CFR 41.77(b)(1), prosecution and examination will then be carried out under 37 CFR 41.77(c) through 37 CFR 41.77(f). Under 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims, *Ex parte*

> *Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). ... The new ground of rejection raised by the Board does not "reopen the prosecution" (under 37 CFR 41.77(b)(1) and 37 CFR 41.77(c) through 37 CFR 41.77(f) *except as to that subject matter to which the new rejection was applied.* Accordingly, any amendment or showing of facts **not** directed to that subject matter to which the new rejection was applied will be refused entry and will not be considered."

As pointed out by both the examiner and the third party requester, the patent owner made no showing in the amendment papers as to why the new claims (claims 17-29 in the amendment dated April 25, 2007 and claims 29-40 in the amendment dated June 3, 2008) were necessary and how the claims were patentable over Brahmbhatt. Patent owner provided no explanation in either the April 25, 2007 amendment or the June 3, 2008 amendment that the new claims are directed to the subject matter of the new grounds of rejection. For example, the remarks in the amendment of April 25, 2007 identify support for the new claims on pages 9-10 and state that new claims 17-29 are patentable over the prior art because of their dependencies on either claim 1 or 16. Specifically, page 17 of the remarks state:

> "New claims 17-29 to obtain more varied protection for the invention. Claims 17-29 are deemed patentable over the art at least by virtue of their respective dependencies upon claims 1 and 16 in addition to their individual recitations which will be self evident upon their consideration."

The remarks of April 25, 2007 are clear that the arguments as to the patentability of the claims only rely on the added subject matter to claims 1 and 16. See pages 11-15 of the remarks. The remarks of the June 3, 2008 amendment are similar. Again, patent owner made no showing on how the new claims are patentable over Brahmbhatt, except for their dependencies on claim 17 (which is the same as amended claim 1 in the April 25, 2007 amendment) or claim 28 (which is the same as amended claim 16 in the April 25, 2007 amendment). Patent owner did make a conclusion that "... new claims 29-40 recite additional structures that are not addressed in Brahmbhatt," but failed to provide any explanation or showing to support that conclusion. The petition also has presented no arguments as to why the new claims themselves are patentable over Brahmbhatt. Accordingly, even with three separate submissions (the two amendments and the petition), the patent owner has failed to clearly point out the patentable novelty which he or she thinks the new claims present in view of the state of the art disclosed by the references cited as required by 37 CFR 1.111(b).

Therefore, patent owner's argument, introduced for the first time in the petition, that the new claims are limited to the subject matter of the new grounds of rejection is unpersuasive. Accordingly, the examiner appropriately denied entry of the amendment of April 25, 2007 and June 3, 2008 in the interest of "special dispatch" in accordance with Office rules and procedures.

It is further noted that the amendment of June 3, 2008 is not compliant with 37 CFR 1.26, which requires:

37 CFR 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

The June 3, 2008 amendment fails to begin the claim numbering with the next number following the highest numbered claim previously presented because it started with claim 17 instead of claim 30, which is the next highest claim number following the claims previously presented in the April 25, 2007 amendment. In addition, the June 3, 2008 amendment contained two claims numbered "39." For this additional reason, the June 3, 2008 amendment is not compliant with the Office's rules and procedures.

Regarding the patent owner's request to enter the amendment in part, this request is not consistent with current Office policy. See MPEP 714.16(e) which clearly states that, except for amendments submitted under 37 CFR 1.312, amendments are not entered in part. Accordingly, the amendments of April 25, 2007 and June 3, 2008 will not be entered in part.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the amendments of April 25, 2007 and June 3, 2008.

Accordingly, the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for entry, in whole or in part, of the amendment of either April 25, 2007 or June 3, 2008 in the prosecution of the '006 reexamination proceeding is denied.

2. Patent owner is advised that a petition under 37 CFR 1.181 requesting review of this decision or a petition under 37 CFR 1.183 requesting waiver or suspension of the rules must be filed within 30 days or 1 month, whichever is longer, from the mailing date of this petition. Patent owner may file petitions under 37 CFR 1.181 and 1.183 in this time period, but each petition must be a separate paper. Jurisdiction of the reexamination proceeding will be retained by the Central Reexamination Unit until the expiration of the time period for filing a petition under 37 CFR 1.181 and/or 1.183.

3. If no further petition is filed, jurisdiction of the reexamination proceeding will be returned to the BPAI, in accordance with 37 CFR 41.77(f), in due course.

4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or Jeanne Clark at (571) 272-7714, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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In re Sembonmatsu et al.	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No.: 95/000,006	: **DISMISSING**
Filed: December 4, 2002	: **PETITION**
For: U.S. Patent No.: 6,357,595	:

This is a decision on the patent owner's petition entitled "Petition Under 37 C.F.R. § 1.183 Requesting Waiver Or Suspension Of Rules" filed February 23, 2009.

The petition is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 filed February 23, 2009, is dismissed as premature.

RELEVANT BACKGROUND

1. U.S Patent number 6,357,595 (the '595 patent) issued on March 19, 2002.
2. On December 4, 2002, a request for *inter partes* reexamination of the '595 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,006 (the '006 reexamination proceeding).
3. On February 6, 2003, the Office issued an order, in the '006 reexamination proceeding, granting *inter partes* reexamination of the '595 patent. An Office action accompanied the order.
4. The proceeding progressed to the point where, on March 26, 2007, the Board of Patent Appeals and Interferences (BPAI) issued a decision, which affirmed-in-part the examiner's grounds of rejection and entered new grounds of rejection.

5. On April 25, 2007, patent owner filed a response under 37 CFR 41.77(b)(1) requesting reopening of prosecution before the examiner. The response included an amendment.

6. On May 25, 2007, the third party requester filed comments pursuant to 37 CFR 41.77(c).

7. On May 19, 2008, a "Notice of Informal Amendment Under 37 CFR 41.77(b)" was mailed by the Office. The notice indicated that the amendment filed April 25, 2007 would not be entered because it did not comply with 37 CFR 41.77(b), and further indicated that the third party comments of May 25, 2007 would also not be entered. The notice set a 15 day time period for patent owner to file a replacement amendment in compliance with 37 CFR 41.77(b).

8. On June 3, 2008, patent owner filed a replacement amendment under 37 CFR 41.77(b)(1).

9. On July 2, 2008, the third party requester filed comments pursuant to 37 CFR 41.77(c).

10. On September 15, 2008, a "Notice of Non-entry of Amendment and Return of Jurisdiction to the Board of Patent Appeals and Interferences" was mailed by the Office. The notice indicated that the replacement amendment filed June 3, 2008, did not comply with 37 CFR 41.77(b)(1) and that the amendment, and third party requester's comments filed July 2, 2008, would not be entered. The notice further indicated that jurisdiction was being returned to the Board pursuant to 37 CFR 41.77(f).

11. On November 17, 2008, patent owner filed a petition under 37 CFR 1.181 requesting entry of the amendment filed April 25, 2007, or, alternatively, the amendment filed June 3, 2008.

12. On December 2, 2008, third party requester filed an opposition to the petition.

13. On December 15, 2008, an "Order Returning Undocketed Appeal" was mailed in which the BPAI returned the reexamination proceeding to the Central Reexamination Unit to address an issue regarding three information disclosure statements and to address the petition under 37 CFR 1.181.

14. On January 22, 2009, a decision denying the patent owner's November 17, 2008 petition was mailed.

15. On February 23, 2009, patent owner filed a petition requesting review of the decision on petition under 37 CFR 1.181 mailed January 22, 2009. Patent owner also filed the instant petition under 37 CFR 1.183 requesting waiver or suspension of the rules, in the event that the petition requesting review under 37 CFR 1.181 is not granted.

16. On March 10, 2009, the third party requester filed a paper opposing patent owner's February 23, 2009 petitions, which is being addressed by a separate decision being mailed concurrently with this decision.

17. On April 14, 2009, an Office communication was mailed in which three forms 1449 bearing the examiner's initials/signature were attached, per the BPAI's Order mailed December 15, 2008.

RELEVANT REGULATORY PROVISION

37 CFR 1.183 states:

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

DECISION

The petition under 37 CFR 1.183 was filed concurrently with a petition under 37 CFR 1.181 requesting review of the petition decision mailed January 22, 2009. The petition under 37 CFR 1.183 states that it is being filed in the event that the petition under 37 CFR 1.181 requesting review of the prior petition decision is not granted. The petition under 37 CFR 1.181 has not yet been decided. Until there is an adverse decision on the petition under 37 CFR 1.181, any petition under 37 CFR 1.183 is premature.[1] In addition, the relief requested in the petition under 37 CFR 1.183 would be moot, should relief be granted under 37 CFR 1.181, since no waiver or suspension of the rules would be needed.

It is noted that the patent owner has not specified in the petition under 37 CFR 1.183 which requirement of the rules patent owner is requesting to be waived or suspended. In the event that patent owner timely files a renewed petition under 37 CFR 1.183 after an adverse decision on the petition under 37 CFR 1.181 which patent owner does not further contest, patent owner must specify which requirement of the rules that patent owner is requesting to be waived or suspended, as well as show why this situation is an extraordinary situation where justices requires waiver or suspension of that requirement of the rules.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.183 is <u>dismissed as premature</u>.

2. Pursuant to 37 CFR 1.181(f), any renewed petition under 37 CFR 1.183 must be filed within TWO months of any decision dismissing the petition under 37 CFR 1.181, if applicant does not seek further consideration of the petition under 37 CFR 1.181, or, alternatively, within TWO months of any final agency action denying the petition under 37 CFR 1.181.

---

[1] The petition decision mailed January 22, 2009, stated that the patent owner "may file petitions under 37 CFR 1.181 and 1.183 in this time period, but each petition must be a separate paper." It is noted, however, that a petition under 37 CFR 1.183 is not appropriately filed while a petition under 37 CFR 1.181 regarding the same issue is still pending.

3. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

May 18, 2009
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,006	12/04/2002	6357595	2267.661US01	6073

7590 06/24/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2010

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

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000006
PATENT NO. : 6357595
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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CENTRAL REEXAMINATION UNIT

(For Requester)

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In re Sembonmatsu et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,006	:	REQUESTING REVIEW
Filed: December 4, 2002	:	OF DECISION
For: U.S. Patent No.: 6,357,595	:	UNDER 37 CFR 1.181

This is a decision on a petition filed February 23, 2009 by the patent owner requesting reconsideration of a January 22, 2009 decision by the Director of the Central Reexamination Unit. The petition is titled "PETITION REQUESTING REVIEW OF DECISION ON PETITION FOR ENTERING AMENDMENT UNDER 37 CFR 1.181."

The petition is before the Director of Technology Center 1600 for supervisory review.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director is denied with respect to entering the amendment filed under 37 CFR 41.77(b)(1) in the prosecution of the *Inter Partes* reexamination proceeding 95/000,006.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,357,595 (hereinafter, the '595 patent) issued on March 19, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/000,006, was filed by a third party requester on December 4, 2002.

3. *Inter partes* reexamination was ordered for the '006 reexamination proceeding on February 6, 2003. On the same day, a non-final Office action was mailed in the '006 reexamination proceeding. The Office action rejected all the claims based upon U.S. Patent No. 5,791,486 to Brahmbhatt (hereinafter "Brahmbhatt").

4. The patent owner filed a response to the non-final Office action on April 7, 2003. The response included proposed amendments to claim 1, cancelled claims 12-15, and added a new independent claim 16.

5. The third party filed comments on May 7, 2003 to the patent owner's response, and introduced an additional ground of rejection based on the embodiment shown in Figure 17 of Brahmbhatt.

6. On October 7, 2003, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP continued to adopt the same grounds of rejections, as set forth in the February 6, 2003 Office action, for the pending claims and included new claim 16 in rejection of claims 1, 2 and 5-11 as being anticipated by Brahmbhatt. The Office action did not adopt the newly proposed rejection of claims 1 and 16 based on the embodiment shown in Figure 17 of Brahmbhatt.

7. On November 7, 2003, patent owner submitted remarks but did not make any further proposed claim amendments.

8. On December 10, 2003, the third party requester submitted comments.

9. On March 2, 2004, the Office issued a Right of Appeal Notice (RAN), which maintained the same rejections as set forth in the ACP.

10. On March 30, 2004, the patent owner filed a Notice of Appeal.

11. On May 28, 2004, the patent owner filed an Appeal Brief

12. On June 28, 2004, the third party requester filed a respondent brief.

13. On December 9, 2004, the Office mailed the Examiner's Answer.

14. On January 10, 2005, the patent owner filed a rebuttal brief to the Examiner's Answer.

15. On March 26, 2007, the Board of Appeals and Interferences (BPAI) issued a decision, which affirmed-in-part the examiner's ground of rejection and issued a new ground of rejection of claims 1, 2, 5-11 and 16 based upon the embodiment shown in Figure 17 of Brahmbhatt.

16. On April 25, 2007, the patent owner elected to reopen prosecution before the examiner by filing a proposed amendment to claims 1, 4, 6, 8-11, and 16 and added new claims 17-29.

17. On May 25, 2007, the third party requester filed comments.

18. On May 19, 2008, the Office issued a notification that the amendment of April 25, 2007 is not entered because it is not compliant with 37 CFR 41.77(b)(1) and also indicated that the third party comments of May 25, 2007 is not entered. The notification set a time period of 15 days to refile the amendment in compliance with 37 CFR 41.77(b)(1).

19. On June 3, 2008, the patent owner filed an amendment, which cancelled claims 1-11 and 16 and added new claims 17-40.[1]

20. On July 2, 2008, the third party requester filed comments.

21. On September 15, 2008, the Office issued a notification that the amendment of June 3, 2008 was not entered because it was not compliant with 37 CFR 41.77(b)(1) and also indicated that the third party comments of July 2, 2008 were not entered. The notification also stated that pursuant to 37 CFR 41.77(f), jurisdiction of the reexamination proceeding was being returned to the BPAI.

22. On November 17, 2008, the patent owner filed the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the amendment of April 25, 2007 or the amendment of June 3, 2008 be entered.

23. On December 2, 2008, the third party requester filed comments in response to the petition.

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[1] It is noted that two claims were numbered as "39."

24. On December 15, 2008, the BPAI returned the reexamination proceeding to the Central Reexamination Unit to address minor informalities pertaining to the signing of information disclosure statements and to address the petition.

25. On January 22, 2009, the petition under 37 CFR 1.181 to enter the amendment after decision of the BPAI was denied.

26. On February 23, 2009, two petitions addressing the entry of amendments after decision of the BPAI were filed, including the present petition and a petition under 37 CFR 1.183.

27. On May 19, 2009, the petition under 37 CFR 1.183 was dismissed.

DECISION

The patent owner (petitioner) states that the examiner erred in not entering either the amendment of April 25, 2007 or June 3, 2008, and that the denial of the November 17, 2008 petition was in error, and requests one of the following actions at pages 18-20 of the present petition:

1. Entry of the amendment dated April 25, 2007.
2. Entry of the amendment dated June 3, 2008.
3. Entry *in part* of either the amendment of April 25, 2007 or June 3, 2008.

Patent Owner argues that the new claims (claims 17-29 in the amendment dated April 25, 2007 and claims 29-40 in the amendment dated June 3, 2008) are directed to the same subject matter as the claims rejected in the new grounds of rejection. See pages 9-14 of the petition of November 17, 2008 and pages 6-18 of the present petition. Because of this, petitioner requests that one of the amendments be entered.

In considering this petition under 37 CFR 1.181, the decision made by the examiner will be reviewed for its correctness based on the record as it appeared at the time of the decision; this decision will not address arguments in favor of the patentability of the claims that are presented for the first time in petitions for review.

As pointed out by the examiner in the notifications of May 19, 2008 and September 15, 2008, the amendments were not entered because the new claims did not comply with the guidance set forth in MPEP 2682, subsection II.B., which states that:

> "When the patent owner submits a response pursuant to 37 CFR 41.77(b)(1), prosecution and examination will then be carried out under 37 CFR 41.77(c) through 37 CFR 41.77(f). Under 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims, *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). ... The new ground of

> rejection raised by the Board does not "reopen the prosecution" (under 37 CFR 41.77(b)(1) and 37 CFR 41.77(c) through 37 CFR 41.77(f) *except as to that subject matter to which the new rejection was applied.* Accordingly, any amendment or showing of facts **not** directed to that subject matter to which the new rejection was applied will be refused entry and will not be considered."

As pointed out by both the examiner and the third party requester, the patent owner made no showing in the amendment papers as to why the new claims (claims 17-29 in the amendment dated April 25, 2007 and claims 29-40 in the amendment dated June 3, 2008) were necessary and how the claims were patentable over Brahmbhatt. Patent owner provided no explanation in either the April 25, 2007 amendment or the June 3, 2008 amendment that the new claims are directed to the subject matter of the new grounds of rejection. For example, the remarks in the amendment of April 25, 2007 identify support for the new claims on pages 9-10 and state that new claims 17-29 are patentable over the prior art because of their dependencies on either claim 1 or 16. Specifically, page 17 of the remarks state:

> "New claims 17-29 to obtain more varied protection for the invention. Claims 17-29 are deemed patentable over the art at least by virtue of their respective dependencies upon claims 1 and 16 in addition to their individual recitations which will be self evident upon their consideration."

The remarks of April 25, 2007 are clear that the arguments as to the patentability of the claims only rely on the added subject matter to claims 1 and 16. See pages 11-15 of the remarks. The remarks of the June 3, 2008 amendment are similar. Again, patent owner made no showing on how the new claims are patentable over Brahmbhatt, except for their dependencies on claim 17 (which is the same as amended claim 1 in the April 25, 2007 amendment) or claim 28 (which is the same as amended claim 16 in the April 25, 2007 amendment). Patent owner did make a conclusion that "... new claims 29-40 recite additional structures that are not addressed in Brahmbhatt," but failed to provide any explanation or showing to support that conclusion. Accordingly, the patent owner has failed to clearly point out the patentable novelty which he or she thinks the new claims present in view of the state of the art disclosed by the references cited as required by 37 CFR 1.111(b).

Regarding the patent owner's argument (page 18 of the present petition) for review of the decision of the examiner not to enter the amendment in part, a review of the record shows that the decision of the examiner was consistent with current Office policy. See MPEP 714.16(e) which clearly states that, except for amendments submitted under 37 CFR 1.312, amendments are not entered in part. Patent owner points to MPEP 714.20 as giving the examiner some discretion in entering an amendment in part. The present situation is not addressed, but it is not likely that the present situation was specifically considered in drafting this section of the MPEP. The situations identified generically separate amendments to the claims from formal matters (substitute spec vs. claim amendments; formal matters in an *Ex parte Quayle* response from new claims) and do not ask the examiner to enter some substantive claim amendments and not enter

others. A review of the record does not suggest that the examiner violated USPTO policy as embodied in MPEP 714.16(e) and 714.20 by refusing to enter the amendment in part.

For the reasons set forth above, since the examiner followed Office rules and procedures in deciding to not enter the amendments of April 25, 2007 and June 3, 2008, the decision of the examiner not to enter the amendments and the denial of the petition under 37 CFR 1.181 were proper.

Accordingly, the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for review of the decision of January 22, 2009 is granted only to the extent that a review has been made. The petition is denied as to the underlying relief requested since the decision of the examiner not to enter the amendments was not in violation of USPTO rules and procedures.

2. Jurisdiction of the reexamination proceeding is being returned to the BPAI, in accordance with 37 CFR 41.77(f). As no compliant reply under 41.77(b)(1)[2] has been filed, it appears that the matter should be considered by the BPAI as one in which time has expired.

4. Telephone inquiries related to this decision should be directed to Greg Morse at (571) 272-3838 or, in his absence, to the undersigned at (571) 272-0700.

Irem Yucel
Director, Technology Center 1600

[2] See the paper of 9/15/2008 for a full explanation.

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Paper No. 16

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(For Patent Owner)

MAILED
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(For Requester)

95000007 122203

In re Allan, et al. Reissue Application No.: 10/430,713 Filed: May 5, 2003 For: U.S. Patent No. 6,339,455	**: DECISION DISMISSING : PETITION : : AND :**
In re Allan, et al. *Inter Partes* Reexamination Proceeding Control No. 95/000,007 Filed: December 16, 2002 For: U.S. Patent No. 6,339,455	**: DECISION MERGING : *INTER PARTES* REEXAMINATION : AND REISSUE PROCEEDINGS :**

This is a decision on the May 6, 2003, patent owner PETITION UNDER 37 CFR 1.182, requesting that (1) the reissue application **not** be merged with the *inter partes* reexamination proceeding, and (2) the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application. The patent owner PETITION UNDER 37 CFR 1.182

alternatively requests that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. Accordingly, the reissue application and *inter partes* reexamination proceeding are also before the Office of Patent Legal Administration for a decision on petition as to whether the proceedings should either be merged, or one proceeding stayed, pursuant to 37 CFR 1.991 at this time. The petition fee of $130.00 pursuant to 37 CFR 1.17(h), has been charged to petitioner's deposit account No. 11-1410, as per petitioner's instructions on page 1 of the instant petition.

The petition under 37 CFR 1.182 is **dismissed**.

The above-identified reissue application and *inter partes* reexamination proceeding are **merged**.

REVIEW OF FACTS

1. U.S. Patent No. 6,339,455 issued to Allan et al., on January 15, 2002.

2. A request for *inter partes* reexamination of the '455 patent was filed by a third party requester (Audiovox Corporation is the Real Party in Interest) on December 16, 2002, and the resulting reexamination proceeding was assigned Control No. 95/000,007.

3. Notice of the filing of the *inter partes* reexamination was published in the *Official Gazette* on January 14, 2003.

4. On March 12, 2003, reexamination was ordered and a non-final Office action was mailed in the '007 *inter partes* reexamination proceeding.

5. Patent owner filed a broadening reissue application based on the '455 patent, on May 5, 2003, which was assigned Application No. 10/430,713. Claims 23-41 were added in the broadening '713 reissue application.

6. On May 6, 2003, patent owner filed the present petition under 37 CFR 1.182 in the '007 *inter partes* reexamination proceeding.

7. Patent owner filed a response to the non-final Office action pursuant to 37 CFR 1.945 on May 19, 2003, in the '007 *inter partes* reexamination proceeding.

8. On June 6, 2003, the third party requester filed comments in opposition to the patent owner petition in the '007 *inter partes* reexamination proceeding.

9. On June 13, 2003, the third party requester filed comments pursuant to 37 CFR 1.947 to patent owner's response in the '007 *inter partes* reexamination proceeding.

10. On June 20, 2003, patent owner filed a reply to the third party requester's comments in opposition to the petition, in the '007 *inter partes* reexamination proceeding.

11. Notice of the filing of the '713 reissue application was published in the *Official Gazette* on August 12, 2003.

I. DECISION ON PETITION

The patent owner PETITION UNDER 37 CFR 1.182, of May 6, 2003, requests that (1) the reissue application **not** be merged with the *inter partes* reexamination proceeding, and (2) the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application. The patent owner PETITION UNDER 37 CFR 1.182, alternatively requests that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding.

Petitioner asserts that merger of the reissue application and *inter partes* reexamination proceeding would deprive patent owner of statutory rights, specifically, to seek broader claims through reissue within two years of the issuance of the patent. Petitioner notes that 37 CFR 1.991 does not explicitly prohibit the patent owner from seeking broader claims in a merged proceeding, but points out that this rule states that the same claims must be maintained in both the reissue application and in the *inter partes* reexamination proceeding. Petitioner refers to 37 CFR 1.906(b) which sets forth that claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent. The petitioner then concludes that the effect of 37 CFR 1.991 is that broader claims cannot be included in a reissue application which has been merged with an *inter partes* reexamination proceeding.

However, petitioner's conclusion does not follow, since the requirement for the "same claims" to be presented in the *inter partes* reexamination and the reissue application for the merged proceeding can, in fact, be the broadened claims referred to by petitioner. When an *inter partes* reexamination proceeding is merged with a reissue application, because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 314 relating to the conduct of *inter partes* 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. Therefore, broadening of claims permitted in a reissue application filed within two years of the patent date will continue to be permitted in the reissue application, even if it has been merged with an *inter partes* reexamination proceeding. Accordingly, petitioner's argument is not persuasive, as contrary to petitioner's assertions, patent owner would **NOT** be deprived of the statutory right to seek broader claims through reissue within two years of the issuance of the patent as a consequence of a merger of the two proceedings.

Petitioner also asserts that merger of the two proceedings will deprive patent owner of their statutory right to *ex parte* prosecution of its reissue application.

It should be noted, however, that 37 CFR 1.991 states (in part):

> ... In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

Therefore, when an *inter partes* reexamination proceeding is merged with a reissue application, the third party requester participation will be limited to issues within the scope of *inter partes* reexamination as provided under §§ 1.902 to 1.997. Accordingly, petitioner's argument is not persuasive as contrary to petitioner's contentions, merger will **NOT** deprive patent owner of their statutory right to *ex parte* prosecution of their reissue application, as the third party requester does not gain any rights to participate in the merged proceeding that they do not already have in the *inter partes* reexamination. The third party requester does not gain any rights to participate with respect to issues that are not within the scope of *inter partes* reexamination. Specifically, with regard to petitioner's example of the issue of broadening the claims, note that the addition of broadened claims is not permitted in *inter partes* reexamination. Therefore, broadening issues would not be an issue within the scope of *inter partes* reexamination, and the third party requester would not be permitted to raise these issues in the merged proceeding. In other words, third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings. However, third party requester would NOT have the right to address broadening issues, *e.g.*, the 2 yr. time limit, recapture, declaration, assignee consent, *etc.*, as these would not be patentability issues within the scope of *inter partes* reexamination.

Petitioner asserts that merger would violate patent owner's constitutional right to due process. Patent owner contends that "The Fifth Amendment of the U.S. Constitution provides that no person shall 'be deprived of . . . property without due process of law.' *U.S. Const. Amend. V.* Like tangible property, patents are a cognizable property right protected by the due process clause. See *Hughes Aircraft Company v. U.S.*, 86 F.3d 1566, 1571 (Fed. Cir. 1986) (finding a patented invention to be property subject to analysis under the Takings Clause)." Petitioner argues that the patent owner's right to due process includes a right to know what procedures will be followed in proceedings that ultimately could interfere with its rights in connection with the '455 patent. Petitioner further contends that their right to due process includes a right to have such proceedings governed by reasonably clear procedures. Petitioner asserts that currently there are no procedures for conducting a merged reissue application and *inter partes* reexamination proceeding under § 1.991, and no new material has been added to the MPEP addressing merger of multiple proceedings including an *inter partes* reexamination proceeding under any rule.

Petitioner further asserts that merger of the reissue application and *inter partes* reexamination proceeding would plunge both proceedings into unknown procedures, thus merging these proceedings now without any established procedures would violate due process.

Contrary to petitioner's assertion, clear procedures are in place governing merged proceedings. The policy and procedure for merging a reissue application and a reexamination proceeding are clearly set forth in 37 CFR 1.991 and 1.995. In addition, the decision ordering merger would further set forth the practice and procedure to be followed. Petitioner argues that § 1.991 is unclear as it suggests that in a merged proceeding different rules apply to the patent owner (reissue rules) and the third party requester (*inter partes* reexamination rules). However, note that an important concern in the merger of a reissue application and an *inter partes* reexamination proceeding is in preserving the rights that each party is entitled to prior to the merger. As stated earlier, merger will **NOT** deprive patent owner of their statutory right to *ex parte* prosecution of their reissue application, as the third party requester does not gain any rights to participate in the merged proceeding that they do not already have in the *inter partes* reexamination. The third party requester participation will be limited to issues within the scope of *inter partes* reexamination as provided under §§ 1.902 to 1.997. The third party requester does not gain any rights to raise issues that are not within the scope of *inter partes* reexamination. This is why in a merged proceeding, different rules apply to the patent owner (reissue rules) and the third party requester (*inter partes* reexamination rules).

Petitioner contends that deliberative rulemaking or MPEP revision is needed to illuminate procedures for conducting merged proceedings, and the Office should not engage in *ad hoc* rule making, but should include substantial deliberation and an opportunity for the public to comment in order to form fair, clear and sound procedures that comply with due process. It should be noted that these processes of deliberation and provision of an opportunity for public comment have already taken place. The proposed rules for governing *inter partes* reexamination, including 37 CFR 1.991 and 1.995 were published, along with an invitation for public comment[1]. The comments received were considered and addressed in the publication of the final rules governing *inter partes* reexamination[2].

Petitioner asserts that the decision in *In re Onda*, 229 USPQ 235 (Comm'r of Patents and Trademarks, 1985) compels non-merger and suspension of the *inter partes* reexamination. Petitioner notes that in *In re Onda* the Commissioner opted not to merge the reexamination with

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[1] *Notice of Proposed Rule making to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000), 1234 *Off. Gaz. Pat. Office* 93 (May 23, 2000) (proposed rule).

[2] *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76756 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule), effective Feb. 5, 2001.

the reissue, but to suspend the reexamination as it had passed the appeal stage. As petitioner notes, in *In re Onda*, the decision to suspend the reexamination included the fact that the reexamination had passed the appeal stage. This fact situation differs greatly from the instant proceedings, in which prosecution has only just begun. To date, in the *inter partes* reexamination only one non-final Office action has been mailed, and in the reissue application no Office action has yet been mailed. Petitioner also indicates that like *Onda*, patent owner had no practical choice as to the timing of the filing of the reissue application, as 35 U.S.C. § 251 allows broadening of claims only within two years of the issuance of a patent. Petitioner asserts that unless the Commissioner acts to prevent merger, patent owner will lose rights under 35 U.S.C. § 251, including the right to seek broader claims, to enjoy *ex parte* procedures, and to know the procedures that will be applied. Patent owner further asserts that as in *Onda*, the Patent Office must act to preserve the right of patent owner to seek a broadening reissue, as provided in 35 U.S.C. § 251, to protect patent owner's rights to due process. However, as stated earlier, broadening of claims permitted in a reissue application filed within two years of the patent date will continue to be permitted in the reissue application, even if it has been merged with an *inter partes* reexamination proceeding; merger will **NOT** deprive patent owner of their statutory right to *ex parte* prosecution of their reissue application; and clear procedures governing the merged proceedings are provided by the rules as well as the decision ordering merger. Accordingly, the assertion that the decision in *In re Onda* compels non-merger and suspension of the *inter partes* reexamination is not persuasive.

Petitioner states that patent owner will be unable to interview the examiner which will create substantial barriers to communications in the reissue not faced by other reissue applicants. It is noted that the decision to merge the reissue application and the *inter partes* reexamination set forth below clearly sets forth that no interviews may be conducted in the merged proceeding. However, this would not "create substantial barriers to communications" as argued by petitioner, as the rules provide that the examination be conducted on the written record. In fact, the intent of the *inter partes* reexamination statute in not permitting interviews is to establish and maintain a level playing field between the requester and the patent owner. Note that the right to an interview in a reissue application is not a statutory right. In the instant circumstances, carrying out the legislative intent for equal participation in the merged proceeding is of paramount importance. Should patent owner be of the opinion that an interview is necessary to supplement the written record to provide information that could otherwise not be provided in an adequate manner, patent owner may file a petition under 37 CFR 1.182 in the merged proceeding requesting an interview on an *ad hoc* basis, and provide a showing as to why the interview should be granted based upon the particular fact situation. If the petition is granted, the petition decision would set forth the guidelines of the *ad hoc* interview.

Petitioner requests that the *inter partes* reexamination be suspended, and asserts that such suspension would better serve the two USPTO policies of preventing inconsistent amendments from being entered in two concurrent proceedings involving a patent and expediting the prosecution of all proceedings. Petitioner argues that merger under 37 CFR 1.991 would create a

complicated procedural morass that would not arise if the *inter partes* reexamination were suspended. Petitioner contends that merger of the proceedings would cause unnecessary delay and take away statutory rights, as argued above. Petitioner further asserts that suspension of the *inter partes* reexamination will expedite the proceedings, as compared to merger, because suspension will lead to less complex procedures which are already known.

Note that 37 CFR 1.937 states (in part):

> (A) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Commissioner makes a determination that there is good cause for suspending the reexamination proceeding.

This requirement for "special dispatch" is based upon the statutory requirement set forth in 35 U.S.C. § 314. Therefore, suspension of the present *inter partes* reexamination would be contrary to § 314 of the statute.

With regard to petitioner's assertion that suspension would prevent inconsistent amendments from being entered in two concurrent proceedings involving a patent, this assertion is not well-founded. It is merger, not suspension, that would prevent inconsistent amendments from being entered into two concurrent proceedings involving a patent, because the merger decision would include a requirement that the patent owner maintain the same claims in both proceedings. Petitioner's assertion that suspension would expedite the prosecution of all proceedings because suspension will lead to less complex procedures which are already known, is also not persuasive. It is also merger, not suspension, that would expedite the prosecution of all proceedings, because the same claims would be maintained in both proceedings and a joint examination of those claims would be conducted, which would serve to simultaneously expedite the prosecution of both proceedings.

With regard to petitioner's arguments that merger under 37 CFR 1.991 would create a complicated procedural morass that would not arise if the *inter partes* reexamination were suspended, this argument is not persuasive. It should be noted that when an *inter partes* reexamination proceeding is merged with a reissue application, because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 314 relating to the conduct of *inter partes* 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, except where it is not practical (see discussion of this below in the decision merging the proceedings). Therefore, this actually serves to simplify, as opposed to complicate, the examination of the merged proceedings.

With regard to petitioner's arguments that merger of the proceedings would cause unnecessary delay and take away statutory rights, this argument is not persuasive. As addressed above, the merger of the proceedings would NOT cause unnecessary delay and take away statutory rights, as argued by petitioner. Broadening of claims permitted in a reissue application filed within two years of the patent date will continue to be permitted in the reissue application, even if it has been merged with an *inter partes* reexamination proceeding. Therefore, merger actually serves to expedite the examination of the merged proceedings.

With regard to petitioner's arguments that suspension of the *inter partes* reexamination will expedite the proceedings, as compared to merger, because suspension will lead to less complex procedures which are already known, this argument is not persuasive. Petitioner asserts that suspension of the *inter partes* reexamination will expedite the proceedings, as by examining the reissue application first, the broadest possible scope of patent claims can be determined. However, note that in a merger of proceedings, the same benefit of determining the broadest possible scope of patent claims is attained, with the additional benefit of addressing third party requester's concerns <u>at the same time</u>. On the other hand, a suspension of the *inter partes* reexamination until the conclusion of the reissue proceeding will lead to a significant delay in the subsequent examination of the claims in the *inter partes* reexamination proceeding.

Petitioner alternatively requests that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. Suspension of the reissue proceeding would be inappropriate as it would significantly delay addressing the issue of broadened claims in the reissue application; and would lead to the possibility of the third party requester having to file a subsequent *inter partes* reexamination request in order to participate in the subsequent examination of the broadened claims (as per patentability of the broadened claims over prior art patents and printed publications) in the reissue application. Accordingly, it would not only be much more time-effective and cost-effective to merge the proceedings, but merger would also benefit both patent owner and requester in providing a much earlier resolution of any uncertainty with regard to the patentability of the patent claims, as well as the broader claims added via the reissue application.

Petitioner acknowledges on page 3 of the petition that "A decision to merge may be made where the statutory rights of the patent owner will not be extinguished." As discussed above, it is clear that the statutory rights of patent owner will not be extinguished by merger of the proceedings. In fact, merger of proceedings is desirable as the requirement for placing the same claims in both proceedings will prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Also, a joint examination would expedite the prosecution of both of the proceedings. Petitioner's arguments have been fully considered, but are not effective in showing good cause for suspending either the *inter partes* reexamination proceeding or the reissue application.

Accordingly, the petition is **dismissed**, as to the request that the reissue application **not** be merged with the *inter partes* reexamination proceeding and that the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application.

The petition is also **dismissed**, as to the alternative request that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding, for the same reasons.

With regard to the comments in opposition to the petition filed on June 6, 2003, by third party requester, note that as such comments have already been addressed above in this petition decision, no further discussion is deemed necessary.

With regard to the patent owner reply to the third party comments on opposition filed on June 20, 2003, note that as such reply has already been addressed above in this petition decision for the reasons indicated *supra* with regard to broadening claims, no further discussion is deemed necessary.

II. DISCUSSION REGARDING MERGER

Under 37 CFR 1.991:

> If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings... .

As evidenced by the above review of facts, the reissue application and the *inter partes* reexamination proceeding are currently pending. Since reexamination has been ordered pursuant to § 1.931 in the '007 reexamination proceeding, and the time periods for filing the appropriate subsequent patent owner and requester papers have expired, a decision under § 1.991 is timely.

The general policy of the Office is that examination of reissue and *inter partes* reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding.

A review of the prosecution history of the '007 *inter partes* reexamination file shows that no amendments were made in the *inter partes* reexamination proceeding.

A review of the '713 reissue application prosecution history shows that the notice of the filing of the reissue application was published in the *Official Gazette* on August 12, 2003. In the reissue application, patent owner has added new claims 23-41.

Accordingly, the claims are **not** identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the *inter partes* reexamination proceedings be merged and a joint examination be conducted. Therefore, the examination of the merged reissue application and the *inter partes* reexamination proceeding will be conducted in accordance with the decision set forth below.

III. DECISION MERGING THE REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDINGS

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the above-identified reissue and *inter partes* reexamination proceedings are **merged**. A joint examination of both proceedings will be conducted in accordance with the guidelines and requirements which follow.

B. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the *inter partes* reexamination file 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 1.991.

2. As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/430,713, and Control Number 95/000,007. The response to the requirement must be strictly limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the *inter partes* reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue application file and the *inter partes* reexamination files. The housekeeping amendment must be in compliance with

37 CFR 1.121(h) and 1.173; see MPEP 1453.[3] Any discussion of the merits or issues of either proceeding would be improper and would result in the return of the paper as an improper submission under 37 CFR 1.939.

3. In the event that the required housekeeping amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings 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.

4. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) will not create a comment right for third party requester. Any comments filed by third party requester in response to any such housekeeping amendment would be improper and would result in the return of the paper as an improper submission under 37 CFR 1.939. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 314 relating to the conduct of *inter partes* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, where it is practical to do so. The third party requester may participate to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding except as noted in paragraph 12 below with respect to the scope of the third party *inter partes* reexamination requester's rights to participate.

2. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the *inter partes* reexamination proceeding. Each action will contain identifying data *for both of the cases*, *i.e*, the reissue application and the *inter partes* reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

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[3]Note that a "clean copy" of the amendment is **not** required by this rule.

3. Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the *inter partes* reexamination proceeding Control No.). All amendments submitted during the prosecution of the merged proceeding should be submitted in accordance with the reissue practice under 37 CFR 1.121(h) and 37 CFR 1.173; see MPEP 1453.

4. Any comments by the third party requester must consist of a single paper, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the *inter partes* reexamination proceeding Control No.).

5. There will be no interviews in the merged proceeding, as the rules provide that the examination will be conducted on the written record.[4]

6. If the reissue application ultimately matures into a reissue patent, the *inter partes* reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.997. See 37 CFR 1.991 & 1.997(e).

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the *inter partes* reexamination proceeding, if it is appropriate to terminate the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal route has been exhausted. See 37 CFR 1.957(c).

8. 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 *inter partes* reexamination proceeding. If it is appropriate to terminate the reexamination proceeding (there are no patentable claims), a NIRC will be issued, and the Director will proceed to issue a

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[4]As pointed out *supra*, a level playing field between the patent owner and the requester will be established and maintained in the merged proceeding by not permitting interviews, which is the intent of the *inter partes* reexamination statute. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of paramount importance. A petition may be submitted to request an interview in the rare circumstances that an interview is indispensable, as discussed above.

reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal route has been exhausted. See 37 CFR 1.957(c).

9. Where the merged proceeding is dissolved based on abandonment of the reissue application and the *inter partes* reexamination proceeding continues, 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 *inter partes* 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 *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant to 37 CFR 1.906(c).

10. Where the merged proceeding is dissolved based on abandonment of the reissue application and the *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application will be merged with the reexamination proceeding (the continuation reissue application might be stayed pending termination of the *inter partes* reexamination).

11. If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

12. Scope of *inter partes* reexamination practice and procedure in the merged proceeding:

The third party requester's right to participate in the *inter partes* reexamination as to issues within the scope of reexamination is statutory, and as such, that right must be preserved in the merged proceeding. The following provides for preservation of that right.

a. Copies of all Office actions must be provided by the Office to the third party requester. Further, any paper filed by the patent owner/applicant in the merged reissue/reexamination proceeding must be served on the third party requester. Third party requester will be given an opportunity to comment on all patent owner replies (responses) to Office actions (including amendments after final rejection). Requester comments must, however, be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no comments can be advanced on issues appropriate for reissue and not appropriate for reexamination). Third party requester participation in the merged proceeding will be strictly limited to issues within the scope of *inter partes* reexamination. Thus, for example, where a question of "public use" is raised in the merged proceeding due to the presence of the reissue, the third party requester's responsive papers <u>cannot</u>

comment on that question. Where such comment is made, the examiner will note that "the comment is outside the scope of the third party requester's participation in the merged proceeding," and the comment will not be otherwise addressed.

b. In the same manner that patent owner/applicant in the merged proceeding must serve the third party requester with correspondence filed in the Office, the third party requester must serve the patent owner/applicant with correspondence that requester files in the Office.

c. Prior to the issuance of a Notice of Allowability (Form PTOL-37), the procedure for issuing Office actions and the forms used therefor, and response by the patent owner, and requester comments, will be governed by the provisions of 37 CFR 1.943 through 37 CFR 1.956. Likewise, the appeal provisions of 37 CFR 1.959 through 37 CFR 1.983 will control appeal by the patent owner and requester to the Board, and to the Court of Appeals for the Federal Circuit. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to advise parties of same, and inform patent owner of the steps that must be taken (e.g., payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out in part 6 (of this section of the decision) above, the present *inter partes* reexamination proceeding would be terminated by the grant of such a reissue patent, and the reissue patent would serve as the certificate under 37 CFR 1.997.

d. Inherent in the rules set forth in the immediately above paragraph is that the patent owner may not appeal to the Board of Patent Appeals and Interferences (Board), until a final Office action is issued, in the form of a right of appeal notice (final action) under 37 CFR 1.953.

e. Requester's comments and appeal papers must be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no challenge can be advanced on issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed above).

f. In view of the provisions 37 CFR 1.953(c), the filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to the right of appeal notice (final action) under 37 CFR 1.953.

13. Clerical processing for the merged reexamination, including entry of amendments, will be carried out in the Central Reexamination Unit (CRU) to the extent it is carried out for an *inter partes* reexamination.

14. The examiner will consult with OPLA (i.e., the legal advisor assigned to the *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner as he/she would consult in a normal (not merged) *inter partes* reexamination.

IV. CONCLUSION

1. The patent owner's petition under 37 CFR 1.182 is **dismissed**.

2. The above-identified reissue application and *inter partes* reexamination proceeding **are merged** into a single consolidated proceeding.

3. A copy of this decision will be placed in the *inter partes* reexamination proceeding and reissue application files.

4. The reissue application file and the *inter partes* reexamination file are being stored in the Central Reexamination Unit (CRU) to await the housekeeping amendment, in accordance with Part III.B., *supra*.

5. Once the housekeeping amendment is received, or the time for filing such housekeeping amendment has expired, the merged reissue and *inter partes* reexamination proceeding will be forwarded via the Technology Center 2600 Group Director to the examiner for the preparation of an Office action in the merged proceeding. All further examination should be conducted in accordance with Parts III.B. and III.C. of this decision.

6. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

7. Telephone inquiries related to this decision and procedural matters should be directed to Lynn M. Kryza, the OPLA Reexamination Legal Advisor assigned to this proceeding, at (703) 308-0255. If attempts to contact Ms. Kryza are unsuccessful, the undersigned may be contacted at (703) 308-5107.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

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Paper No. 20

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MAILED
APR 2 6 2004
REEXAM UNIT

In re Allan, et al.
Reissue Application No.: 10/430,713
Filed: May 5, 2003
For: U.S. Patent No. 6,339,455

In re Allan, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,007
Filed: December 16, 2002
For: U.S. Patent No. 6,339,455

DECISION
GRANTING REQUEST
FOR RECONSIDERATION,
VACATING MERGER, AND
STAYING REISSUE

This is a decision on the patent owner's January 22, 2004, "REQUEST FOR RECONSIDERATION OF THE DECISION DISMISSING PETITION AND DECISION MERGING *INTER PARTES* REEXAMINATION AND REISSUE PROCEEDINGS" that requests reconsideration of the December 22, 2003, decision which (a) dismissed the patent owner's May 6, 2003, petition under 37 CFR 1.182, and (b) merged the above-identified reissue and *inter partes* reexamination proceedings.

A third party requester paper was filed February 17, 2004, in opposition to the patent owner's request for reconsideration, and that opposition paper has been considered in this decision.

Also considered in this decision is the January 30, 2004, patent owner amendment paper titled "HOUSEKEEPING AMENDMENT FOR REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING AND REQUEST TO DELAY ENTRY OF AMENDMENT PENDING DECISION ON REQUEST FOR RECONSIDERATION."

The request for reconsideration, the opposition to that request, and the amendment paper are before the Director of the Office of Patent Legal Administration.

SUMMARY

A. The patent owner's request for reconsideration is granted.

B. The merger ordered on the Office of Patent Legal Administration decision of December 22, 2003 is hereby vacated.

C. The January 30, 2004, amendment paper will not be entered as requested by the patent owner.

D. The prosecution of patent owner's reissue application number 10/430,713 is hereby stayed pending the completion of the 95/000,007 reexamination proceeding by the issuance of the reexamination certificate.

REVIEW OF FACTS

1. U.S. Patent No. 6,339,455 (the '455 patent) issued to Allan et al, on January 15, 2002.

2. A request for ***inter partes*** reexamination of the '455 patent was filed by a third party requester [1] on December 16, 2002, and the resulting reexamination proceeding was assigned Control Number 95/000,007.

3. Notice of the filing of the *inter partes* reexamination was published in the *Official Gazette* on January 14, 2003.

4. On March 12, 2003, an order granting the reexamination request was mailed for the '007 proceeding. The order was accompanied by a non-final Office action.

5. On May 5, 2003, the patent owner filed a "broadening" reissue application based on the '455 patent, which was assigned Application Number 10/430,713. New claims 23-41 [2] are provided in the reissue application.

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[1] Audiovox Corporation is identified as the real party in interest.

[2] Not present in the '455 patent.

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6. On May 6, 2003, the patent owner filed a petition under 37 CFR 1.182, requesting (a) that the reissue application **not** be merged with the *inter partes* reexamination proceeding, and (b) that the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application. The petition alternatively requested [3] that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. [4]

7. The patent owner filed, on May 19, 2003, a response (pursuant to 37 CFR 1.945) to the non-final Office action that was issued in the '007 proceeding.

8. On June 6, 2003, the third party requester filed a paper in opposition to the patent owner's petition under 37 CFR 1.182.

9. In addition, the third party requester filed, on June 13, 2003, comments (pursuant to 37 CFR 1.947) to patent owner's response made in the '007 proceeding.

10. On June 20, 2003, the patent owner filed a reply to the third party requester's opposition paper.

11. Notice of the filing of the reissue application was published in the *Official Gazette* on August 12, 2003.

12. On December 22, 2003, the Office of Patent Legal Administration issued a decision dismissing the patent owner petition under 37 CFR 1.182 and merging the above identified reissue and *inter partes* reexamination proceedings.

13. The patent owner then filed, on January 22, 2004, the present request for reconsideration of the December 22, 2003, decision. The third party requester responded on February 17, 2004, with a paper in opposition to the patent owner's request for reconsideration, and in support of the Office's December 22, 2003, decision.

14. On January 30, 2004, the patent owner filed a "Housekeeping Amendment for Reissue Application and *Inter partes* Reexamination Proceeding and Request to Delay Entry of Amendment Pending Decision on Request for Reconsideration." This paper would, if entered, add new claims 23-41 of the reissue application to the reexamination proceeding. As is clear from the title of the paper, the patent owner desires that this amendment not be entered.

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[3] This request for relief is an alternative to the (b) relief requested, should the (a) request for relief be granted.

[4] See petition of May 6, 2003, at page 1.

DECISION

I. Reconsideration of Petitioner's Request Not to Merge:

Petitioner (the patent owner) requests reconsideration of the December 22, 2003, decision (a) dismissing its petition of May 6, 2003, and (b) merging the above-identified reissue and *inter partes* reexamination proceedings. The request for reconsideration asserts that the December 22, 2003, decision promulgates an interpretation of the patent regulations that violates federal statute, and as such, cannot be maintained.

More particularly, petitioner points out that when Congress legislated the *inter partes* reexamination statute, Congress provided, in 35 U.S.C. 314(b), the following unambiguous limitation:

> "In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, **except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.**" [Emphasis added]

Petitioner asserts that the December 22, 2003, decision orders a merger that creates an *inter partes* reexamination of pending claims which are broader than the claims of the issued patent. Petitioner refers to the statement in the December 22nd decision found at page 3, lines 22-24, - "the requirement for the 'same claims' to be presented in the *inter partes* reexamination and the reissue application for the merged proceeding can, in fact, be the broadened claims...". Petitioner contends that this inconsistency cannot be excused as merely a matter of form over substance. Petitioner notes the provision in the decision that the "third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings;" [5] petitioner points out that this fundamentally changes the nature of what would otherwise be an *ex parte* reissue proceeding, i.e., what would otherwise be an *ex parte* proceeding as to the broadened claims. [6]

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[5] See December 22, 2003, decision, at p. 4, lines 21-22.

[6] Petitioner asserts that because the December 22nd decision presents a position inconsistent with the Congressional mandate of the reexamination statute as set forth above, it must be rejected. Petitioner refers to *Federal Election Comm'n v. Democratic Senatorial Campaign Comm'n*, 454 U.S. 27, 32 (1981) (administrative constructions of statutes must be rejected "that are inconsistent with the statutory mandate or that frustrate the policy that Congress sought to implement"). Petitioner also refers to *Public Employees Retirement System v. Betts*, 492 U.S. 158, 171 (1989) ("[N]o deference is due to an agency interpretation at odds with the plain language of the statute itself.")

This argument by the petitioner has been found to be persuasive. The merger ordered by the December 22, 2003, decision would permit a third party (the requester)to comment on broadened claims, and participate in the appeal process as to such claims, while the reissue and reexamination statutes do not provide such a right of third party comment.

The opposition paper urges that the merger is proper since it limits the third party requester input to issues within the scope of *inter partes* reexamination; thus, issues such as recapture, the reissue declaration, and assignee consent could not be considered. However, the main (focal) point is that the consideration of the broadened claims *per se* is not within the scope of *inter partes* reexamination, since the *inter partes* reexamination statute explicitly precludes same. Combining the *inter partes* reexamination with the broadening reissue proceeding would provide for such consideration, and thus be in violation of the statute.

In view of the above, the instant request for reconsideration is granted.

Accordingly, the reissue proceeding and the *inter partes* reexamination proceeding will be conducted based on the following analysis and guidance:

In the present instance, the *inter partes* reexamination is the first filed proceeding. The later-filed reissue application was filed prior to the expiration of the statutory period for broadening the patent claims, i.e., two years from the patent grant. The original petition points out (at page 7) that the reissue application was filed in order to preserve the patent owner's right to broaden the claims, which right would expire during the reexamination proceeding. [7] It is argued that the patent owner was thus prevented from delaying the filing of the reissue application after the conclusion of the *inter partes* reexamination, in an effort to keep the broadened reissue claims beyond the reach of the third party requester's comments via a potential merger. Relief from this situation is provided via the patent owner's request for alternative relief found at page 1 of the original petition, which best addresses this scenario. The alternative request is that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. A suspension of the reissue application preserves the patent owner's right to have the broadened claims considered by the Office, while keeping the broadened claims beyond the reach of the third party requester's comments.

The reexamination proceeding will not be stayed. It must proceed at this time, since there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceedings (see 35 U.S.C. 314), and it would not be equitable to permit a reissue proceeding filed after a reexamination request to delay

[7] The two year date from patent grant is stated in the petition to be January 15, 2004, a date that has already expired.

the conduct of the reexamination proceeding by suspending the reexamination. [8]

Finally, it is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '455 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. In the present instance, it is further to be noted that, if the examination of the reissue and reexamination proceedings were conducted separately, the patent owner could place all of its responsive comments (even those directed to the non-broadened claims) in the reissue application and not in the reexamination proceeding. The third party requester would then be barred from responding in the *inter partes* reexamination proceeding, while the Office would have the benefit of the patent owner's input as to the claims by way of the reissue application. This runs contrary to the intent of the *inter partes* reexamination statute.

In view of the above reasons, it is appropriate that the reexamination proceeding continue with special dispatch (as required by 35 U.S.C. 314) to its conclusion and issuance of a reexamination certificate, and it is appropriate to stay the reissue proceeding. Thus, the prosecution of reissue application number 10/430,713 is stayed pending the completion of the reexamination proceeding, control number 95/000,007, by the issuance of a reexamination certificate.

NON-ENTRY OF HOUSEKEEPING AMENDMENT

The Office of Patent Legal Administration decision of December 22, 2003, required "an appropriate housekeeping amendment" to place "the same amendments in both cases, specifically, Application No. 10/430,713, and Control Number 95/000,007." Accordingly, the patent owner filed, on January 30, 2004, a "Housekeeping Amendment for Reissue Application and *Inter partes* Reexamination Proceeding and Request to Delay Entry of Amendment Pending Decision on Request for Reconsideration." This paper, if entered, would add new claims 23-41 of the reissue to the reexamination proceeding. As is clear from the title of the paper, the patent owner desires that this amendment not be entered. At the last page of the paper, the patent owner specifically requests "that this Amendment not be entered, **at least** until a decision is made on the Request for Reconsideration." [Emphasis added]

The patent owner's request for non-entry of this January 30, 2004, amendment paper is granted.

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[8] The patent owner could delay the reexamination proceeding indefinitely via repeated filing of requests for continued examination (RCEs) pursuant to 37 CFR 1.114, with the broadened claims being retained.

The proffered claims 23-41 of the reissue will not be entered in the '007 reexamination proceeding. Thus, the requester of the '007 reexamination proceeding has no right of comment on any of claims 23-41 of the January 30, 2004, amendment paper. **Any paper filed by the requester that contains such comment will be returned as a non-statutory comments paper.**

As a clerical matter, it is to be noted that any new claims which are added in the reexamination proceeding will be numbered beginning with claim 23, since claims 23-41 of the January 30, 2004, amendment paper have never been entered.

CONCLUSION

1. The patent owner's request for reconsideration is granted.

2. The merger ordered by the Office decision of December 22, 2003 is vacated.

3. The prosecution of reissue application number 10/430,713 is stayed pending the completion of the 95/000,007 reexamination proceeding by the issuance of the reexamination certificate.

4. The patent owner's request for non-entry of the January 30, 2004, amendment paper is granted.

5. Any paper filed by the third party requester that contains a comment as to claims 23-41 in the reissue application will be returned to the requester as a non-statutory comment paper.

6. A copy of this decision will be placed in both the 10/430,713 reissue file and the 95/000,007 reexamination file.

7. The reexamination file is being forwarded to the Central Reexamination Unit (of the Office of Patent Legal Administration) for processing, after which it will be forwarded via the Group Director of Technology Center 3600 to the examiner for the issuance of an Office action. [9]

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[9] The Office action will address patent owner's May 19, 2003, response and requester's June 13, 2003, comments to patent owner's response

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8. The reissue file is being forwarded via the Group Director of Technology Center 3600 to the Technology Center Special Program Examiner for storage pending the issuance of the reexamination certificate for the '007 reexamination proceeding, after which an Office action will be issued for the reissue application.

9. The patent owner is advised to, at the time that a reexamination certificate is issued for the '007 reexamination, call the issuance of the certificate to the attention of the Office, and request a resumption of examination of the reissue application.

9. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

Robert J. Spar, Director
Office of Patent Legal Administration
Office of Patent Examination Policy

April 21, 2003
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Paper No. 16

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(For Patent Owner)

MAILED
DEC 22 2003
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In re Allan, et al. Reissue Application No.: 10/430,713 Filed: May 5, 2003 For: U.S. Patent No. 6,339,455	**: DECISION DISMISSING : PETITION : : AND :**
In re Allan, et al. *Inter Partes* Reexamination Proceeding Control No. 95/000,007 Filed: December 16, 2002 For: U.S. Patent No. 6,339,455	**: DECISION MERGING : *INTER PARTES* REEXAMINATION : AND REISSUE PROCEEDINGS :**

This is a decision on the May 6, 2003, patent owner PETITION UNDER 37 CFR 1.182, requesting that (1) the reissue application **not** be merged with the *inter partes* reexamination proceeding, and (2) the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application. The patent owner PETITION UNDER 37 CFR 1.182

alternatively requests that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. Accordingly, the reissue application and *inter partes* reexamination proceeding are also before the Office of Patent Legal Administration for a decision on petition as to whether the proceedings should either be merged, or one proceeding stayed, pursuant to 37 CFR 1.991 at this time. The petition fee of $130.00 pursuant to 37 CFR 1.17(h), has been charged to petitioner's deposit account No. 11-1410, as per petitioner's instructions on page 1 of the instant petition.

The petition under 37 CFR 1.182 is **dismissed**.

The above-identified reissue application and *inter partes* reexamination proceeding are **merged**.

REVIEW OF FACTS

1. U.S. Patent No. 6,339,455 issued to Allan et al., on January 15, 2002.

2. A request for *inter partes* reexamination of the '455 patent was filed by a third party requester (Audiovox Corporation is the Real Party in Interest) on December 16, 2002, and the resulting reexamination proceeding was assigned Control No. 95/000,007.

3. Notice of the filing of the *inter partes* reexamination was published in the *Official Gazette* on January 14, 2003.

4. On March 12, 2003, reexamination was ordered and a non-final Office action was mailed in the '007 *inter partes* reexamination proceeding.

5. Patent owner filed a broadening reissue application based on the '455 patent, on May 5, 2003, which was assigned Application No. 10/430,713. Claims 23-41 were added in the broadening '713 reissue application.

6. On May 6, 2003, patent owner filed the present petition under 37 CFR 1.182 in the '007 *inter partes* reexamination proceeding.

7. Patent owner filed a response to the non-final Office action pursuant to 37 CFR 1.945 on May 19, 2003, in the '007 *inter partes* reexamination proceeding.

8. On June 6, 2003, the third party requester filed comments in opposition to the patent owner petition in the '007 *inter partes* reexamination proceeding.

9. On June 13, 2003, the third party requester filed comments pursuant to 37 CFR 1.947 to patent owner's response in the '007 *inter partes* reexamination proceeding.

10. On June 20, 2003, patent owner filed a reply to the third party requester's comments in opposition to the petition, in the '007 *inter partes* reexamination proceeding.

11. Notice of the filing of the '713 reissue application was published in the *Official Gazette* on August 12, 2003.

I. DECISION ON PETITION

The patent owner PETITION UNDER 37 CFR 1.182, of May 6, 2003, requests that (1) the reissue application **not** be merged with the *inter partes* reexamination proceeding, and (2) the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application. The patent owner PETITION UNDER 37 CFR 1.182, alternatively requests that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding.

Petitioner asserts that merger of the reissue application and *inter partes* reexamination proceeding would deprive patent owner of statutory rights, specifically, to seek broader claims through reissue within two years of the issuance of the patent. Petitioner notes that 37 CFR 1.991 does not explicitly prohibit the patent owner from seeking broader claims in a merged proceeding, but points out that this rule states that the same claims must be maintained in both the reissue application and in the *inter partes* reexamination proceeding. Petitioner refers to 37 CFR 1.906(b) which sets forth that claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent. The petitioner then concludes that the effect of 37 CFR 1.991 is that broader claims cannot be included in a reissue application which has been merged with an *inter partes* reexamination proceeding.

However, petitioner's conclusion does not follow, since the requirement for the "same claims" to be presented in the *inter partes* reexamination and the reissue application for the merged proceeding can, in fact, be the broadened claims referred to by petitioner. When an *inter partes* reexamination proceeding is merged with a reissue application, because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 314 relating to the conduct of *inter partes* 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. Therefore, broadening of claims permitted in a reissue application filed within two years of the patent date will continue to be permitted in the reissue application, even if it has been merged with an *inter partes* reexamination proceeding. Accordingly, petitioner's argument is not persuasive, as contrary to petitioner's assertions, patent owner would **NOT** be deprived of the statutory right to seek broader claims through reissue within two years of the issuance of the patent as a consequence of a merger of the two proceedings.

Petitioner also asserts that merger of the two proceedings will deprive patent owner of their statutory right to *ex parte* prosecution of its reissue application.

It should be noted, however, that 37 CFR 1.991 states (in part):

> ... In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

Therefore, when an *inter partes* reexamination proceeding is merged with a reissue application, the third party requester participation will be limited to issues within the scope of *inter partes* reexamination as provided under §§ 1.902 to 1.997. Accordingly, petitioner's argument is not persuasive as contrary to petitioner's contentions, merger will **NOT** deprive patent owner of their statutory right to *ex parte* prosecution of their reissue application, as the third party requester does not gain any rights to participate in the merged proceeding that they do not already have in the *inter partes* reexamination. The third party requester does not gain any rights to participate with respect to issues that are not within the scope of *inter partes* reexamination. Specifically, with regard to petitioner's example of the issue of broadening the claims, note that the addition of broadened claims is not permitted in *inter partes* reexamination. Therefore, broadening issues would not be an issue within the scope of *inter partes* reexamination, and the third party requester would not be permitted to raise these issues in the merged proceeding. In other words, third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings. However, third party requester would NOT have the right to address broadening issues, *e.g.*, the 2 yr. time limit, recapture, declaration, assignee consent, *etc.*, as these would not be patentability issues within the scope of *inter partes* reexamination.

Petitioner asserts that merger would violate patent owner's constitutional right to due process. Patent owner contends that "The Fifth Amendment of the U.S. Constitution provides that no person shall 'be deprived of . . . property without due process of law.' *U.S. Const. Amend. V.* Like tangible property, patents are a cognizable property right protected by the due process clause. See *Hughes Aircraft Company v. U.S.*, 86 F.3d 1566, 1571 (Fed. Cir. 1986) (finding a patented invention to be property subject to analysis under the Takings Clause)." Petitioner argues that the patent owner's right to due process includes a right to know what procedures will be followed in proceedings that ultimately could interfere with its rights in connection with the '455 patent. Petitioner further contends that their right to due process includes a right to have such proceedings governed by reasonably clear procedures. Petitioner asserts that currently there are no procedures for conducting a merged reissue application and *inter partes* reexamination proceeding under § 1.991, and no new material has been added to the MPEP addressing merger of multiple proceedings including an *inter partes* reexamination proceeding under any rule.

Petitioner further asserts that merger of the reissue application and *inter partes* reexamination proceeding would plunge both proceedings into unknown procedures, thus merging these proceedings now without any established procedures would violate due process.

Contrary to petitioner's assertion, clear procedures are in place governing merged proceedings. The policy and procedure for merging a reissue application and a reexamination proceeding are clearly set forth in 37 CFR 1.991 and 1.995. In addition, the decision ordering merger would further set forth the practice and procedure to be followed. Petitioner argues that § 1.991 is unclear as it suggests that in a merged proceeding different rules apply to the patent owner (reissue rules) and the third party requester (*inter partes* reexamination rules). However, note that an important concern in the merger of a reissue application and an *inter partes* reexamination proceeding is in preserving the rights that each party is entitled to prior to the merger. As stated earlier, merger will **NOT** deprive patent owner of their statutory right to *ex parte* prosecution of their reissue application, as the third party requester does not gain any rights to participate in the merged proceeding that they do not already have in the *inter partes* reexamination. The third party requester participation will be limited to issues within the scope of *inter partes* reexamination as provided under §§ 1.902 to 1.997. The third party requester does not gain any rights to raise issues that are not within the scope of *inter partes* reexamination. This is why in a merged proceeding, different rules apply to the patent owner (reissue rules) and the third party requester (*inter partes* reexamination rules).

Petitioner contends that deliberative rulemaking or MPEP revision is needed to illuminate procedures for conducting merged proceedings, and the Office should not engage in *ad hoc* rule making, but should include substantial deliberation and an opportunity for the public to comment in order to form fair, clear and sound procedures that comply with due process. It should be noted that these processes of deliberation and provision of an opportunity for public comment have already taken place. The proposed rules for governing *inter partes* reexamination, including 37 CFR 1.991 and 1.995 were published, along with an invitation for public comment[1]. The comments received were considered and addressed in the publication of the final rules governing *inter partes* reexamination[2].

Petitioner asserts that the decision in *In re Onda*, 229 USPQ 235 (Comm'r of Patents and Trademarks, 1985) compels non-merger and suspension of the *inter partes* reexamination. Petitioner notes that in *In re Onda* the Commissioner opted not to merge the reexamination with

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[1] *Notice of Proposed Rule making to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000), 1234 *Off. Gaz. Pat. Office* 93 (May 23, 2000) (proposed rule).

[2] *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76756 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule), effective Feb. 5, 2001.

the reissue, but to suspend the reexamination as it had passed the appeal stage. As petitioner notes, in *In re Onda*, the decision to suspend the reexamination included the fact that the reexamination had passed the appeal stage. This fact situation differs greatly from the instant proceedings, in which prosecution has only just begun. To date, in the *inter partes* reexamination only one non-final Office action has been mailed, and in the reissue application no Office action has yet been mailed. Petitioner also indicates that like *Onda*, patent owner had no practical choice as to the timing of the filing of the reissue application, as 35 U.S.C. § 251 allows broadening of claims only within two years of the issuance of a patent. Petitioner asserts that unless the Commissioner acts to prevent merger, patent owner will lose rights under 35 U.S.C. § 251, including the right to seek broader claims, to enjoy *ex parte* procedures, and to know the procedures that will be applied. Patent owner further asserts that as in *Onda*, the Patent Office must act to preserve the right of patent owner to seek a broadening reissue, as provided in 35 U.S.C. § 251, to protect patent owner's rights to due process. However, as stated earlier, broadening of claims permitted in a reissue application filed within two years of the patent date will continue to be permitted in the reissue application, even if it has been merged with an *inter partes* reexamination proceeding; merger will **NOT** deprive patent owner of their statutory right to *ex parte* prosecution of their reissue application; and clear procedures governing the merged proceedings are provided by the rules as well as the decision ordering merger. Accordingly, the assertion that the decision in *In re Onda* compels non-merger and suspension of the *inter partes* reexamination is not persuasive.

Petitioner states that patent owner will be unable to interview the examiner which will create substantial barriers to communications in the reissue not faced by other reissue applicants. It is noted that the decision to merge the reissue application and the *inter partes* reexamination set forth below clearly sets forth that no interviews may be conducted in the merged proceeding. However, this would not "create substantial barriers to communications" as argued by petitioner, as the rules provide that the examination be conducted on the written record. In fact, the intent of the *inter partes* reexamination statute in not permitting interviews is to establish and maintain a level playing field between the requester and the patent owner. Note that the right to an interview in a reissue application is not a statutory right. In the instant circumstances, carrying out the legislative intent for equal participation in the merged proceeding is of paramount importance. Should patent owner be of the opinion that an interview is necessary to supplement the written record to provide information that could otherwise not be provided in an adequate manner, patent owner may file a petition under 37 CFR 1.182 in the merged proceeding requesting an interview on an *ad hoc* basis, and provide a showing as to why the interview should be granted based upon the particular fact situation. If the petition is granted, the petition decision would set forth the guidelines of the *ad hoc* interview.

Petitioner requests that the *inter partes* reexamination be suspended, and asserts that such suspension would better serve the two USPTO policies of preventing inconsistent amendments from being entered in two concurrent proceedings involving a patent and expediting the prosecution of all proceedings. Petitioner argues that merger under 37 CFR 1.991 would create a

complicated procedural morass that would not arise if the *inter partes* reexamination were suspended. Petitioner contends that merger of the proceedings would cause unnecessary delay and take away statutory rights, as argued above. Petitioner further asserts that suspension of the *inter partes* reexamination will expedite the proceedings, as compared to merger, because suspension will lead to less complex procedures which are already known.

Note that 37 CFR 1.937 states (in part):

> (A) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Commissioner makes a determination that there is good cause for suspending the reexamination proceeding.

This requirement for "special dispatch" is based upon the statutory requirement set forth in 35 U.S.C. § 314. Therefore, suspension of the present *inter partes* reexamination would be contrary to § 314 of the statute.

With regard to petitioner's assertion that suspension would prevent inconsistent amendments from being entered in two concurrent proceedings involving a patent, this assertion is not well-founded. It is merger, not suspension, that would prevent inconsistent amendments from being entered into two concurrent proceedings involving a patent, because the merger decision would include a requirement that the patent owner maintain the same claims in both proceedings. Petitioner's assertion that suspension would expedite the prosecution of all proceedings because suspension will lead to less complex procedures which are already known, is also not persuasive. It is also merger, not suspension, that would expedite the prosecution of all proceedings, because the same claims would be maintained in both proceedings and a joint examination of those claims would be conducted, which would serve to simultaneously expedite the prosecution of both proceedings.

With regard to petitioner's arguments that merger under 37 CFR 1.991 would create a complicated procedural morass that would not arise if the *inter partes* reexamination were suspended, this argument is not persuasive. It should be noted that when an *inter partes* reexamination proceeding is merged with a reissue application, because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 314 relating to the conduct of *inter partes* 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, except where it is not practical (see discussion of this below in the decision merging the proceedings). Therefore, this actually serves to simplify, as opposed to complicate, the examination of the merged proceedings.

With regard to petitioner's arguments that merger of the proceedings would cause unnecessary delay and take away statutory rights, this argument is not persuasive. As addressed above, the merger of the proceedings would NOT cause unnecessary delay and take away statutory rights, as argued by petitioner. Broadening of claims permitted in a reissue application filed within two years of the patent date will continue to be permitted in the reissue application, even if it has been merged with an *inter partes* reexamination proceeding. Therefore, merger actually serves to expedite the examination of the merged proceedings.

With regard to petitioner's arguments that suspension of the *inter partes* reexamination will expedite the proceedings, as compared to merger, because suspension will lead to less complex procedures which are already known, this argument is not persuasive. Petitioner asserts that suspension of the *inter partes* reexamination will expedite the proceedings, as by examining the reissue application first, the broadest possible scope of patent claims can be determined. However, note that in a merger of proceedings, the same benefit of determining the broadest possible scope of patent claims is attained, with the additional benefit of addressing third party requester's concerns <u>at the same time</u>. On the other hand, a suspension of the *inter partes* reexamination until the conclusion of the reissue proceeding will lead to a significant delay in the subsequent examination of the claims in the *inter partes* reexamination proceeding.

Petitioner alternatively requests that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. Suspension of the reissue proceeding would be inappropriate as it would significantly delay addressing the issue of broadened claims in the reissue application; and would lead to the possibility of the third party requester having to file a subsequent *inter partes* reexamination request in order to participate in the subsequent examination of the broadened claims (as per patentability of the broadened claims over prior art patents and printed publications) in the reissue application. Accordingly, it would not only be much more time-effective and cost-effective to merge the proceedings, but merger would also benefit both patent owner and requester in providing a much earlier resolution of any uncertainty with regard to the patentability of the patent claims, as well as the broader claims added via the reissue application.

Petitioner acknowledges on page 3 of the petition that "A decision to merge may be made where the statutory rights of the patent owner will not be extinguished." As discussed above, it is clear that the statutory rights of patent owner will not be extinguished by merger of the proceedings. In fact, merger of proceedings is desirable as the requirement for placing the same claims in both proceedings will prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Also, a joint examination would expedite the prosecution of both of the proceedings. Petitioner's arguments have been fully considered, but are not effective in showing good cause for suspending either the *inter partes* reexamination proceeding or the reissue application.

Accordingly, the petition is **dismissed**, as to the request that the reissue application **not** be merged with the *inter partes* reexamination proceeding and that the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application.

The petition is also **dismissed**, as to the alternative request that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding, for the same reasons.

With regard to the comments in opposition to the petition filed on June 6, 2003, by third party requester, note that as such comments have already been addressed above in this petition decision, no further discussion is deemed necessary.

With regard to the patent owner reply to the third party comments on opposition filed on June 20, 2003, note that as such reply has already been addressed above in this petition decision for the reasons indicated *supra* with regard to broadening claims, no further discussion is deemed necessary.

II. DISCUSSION REGARDING MERGER

Under 37 CFR 1.991:

> If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings... .

As evidenced by the above review of facts, the reissue application and the *inter partes* reexamination proceeding are currently pending. Since reexamination has been ordered pursuant to § 1.931 in the '007 reexamination proceeding, and the time periods for filing the appropriate subsequent patent owner and requester papers have expired, a decision under § 1.991 is timely.

The general policy of the Office is that examination of reissue and *inter partes* reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding.

A review of the prosecution history of the '007 *inter partes* reexamination file shows that no amendments were made in the *inter partes* reexamination proceeding.

A review of the '713 reissue application prosecution history shows that the notice of the filing of the reissue application was published in the *Official Gazette* on August 12, 2003. In the reissue application, patent owner has added new claims 23-41.

Accordingly, the claims are **not** identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the *inter partes* reexamination proceedings be merged and a joint examination be conducted. Therefore, the examination of the merged reissue application and the *inter partes* reexamination proceeding will be conducted in accordance with the decision set forth below.

III. DECISION MERGING THE REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDINGS

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the above-identified reissue and *inter partes* reexamination proceedings are **merged**. A joint examination of both proceedings will be conducted in accordance with the guidelines and requirements which follow.

B. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the *inter partes* reexamination file 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 1.991.

2. As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/430,713, and Control Number 95/000,007. The response to the requirement must be strictly limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the *inter partes* reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue application file and the *inter partes* reexamination files. The housekeeping amendment must be in compliance with

37 CFR 1.121(h) and 1.173; see MPEP 1453.[3] Any discussion of the merits or issues of either proceeding would be improper and would result in the return of the paper as an improper submission under 37 CFR 1.939.

3. In the event that the required housekeeping amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings 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.

4. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) will not create a comment right for third party requester. Any comments filed by third party requester in response to any such housekeeping amendment would be improper and would result in the return of the paper as an improper submission under 37 CFR 1.939. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 314 relating to the conduct of *inter partes* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, where it is practical to do so. The third party requester may participate to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding except as noted in paragraph 12 below with respect to the scope of the third party *inter partes* reexamination requester's rights to participate.

2. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the *inter partes* reexamination proceeding. Each action will contain identifying data *for both of the cases*, *i.e*, the reissue application and the *inter partes* reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

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[3]Note that a "clean copy" of the amendment is **not** required by this rule.

3. Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the *inter partes* reexamination proceeding Control No.). All amendments submitted during the prosecution of the merged proceeding should be submitted in accordance with the reissue practice under 37 CFR 1.121(h) and 37 CFR 1.173; see MPEP 1453.

4. Any comments by the third party requester must consist of a single paper, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the *inter partes* reexamination proceeding Control No.).

5. There will be no interviews in the merged proceeding, as the rules provide that the examination will be conducted on the written record.[4]

6. If the reissue application ultimately matures into a reissue patent, the *inter partes* reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.997. See 37 CFR 1.991 & 1.997(e).

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the *inter partes* reexamination proceeding, if it is appropriate to terminate the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal route has been exhausted. See 37 CFR 1.957(c).

8. 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 *inter partes* reexamination proceeding. If it is appropriate to terminate the reexamination proceeding (there are no patentable claims), a NIRC will be issued, and the Director will proceed to issue a

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[4]As pointed out *supra*, a level playing field between the patent owner and the requester will be established and maintained in the merged proceeding by not permitting interviews, which is the intent of the *inter partes* reexamination statute. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of paramount importance. A petition may be submitted to request an interview in the rare circumstances that an interview is indispensable, as discussed above.

reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal route has been exhausted. See 37 CFR 1.957(c).

9. Where the merged proceeding is dissolved based on abandonment of the reissue application and the *inter partes* reexamination proceeding continues, 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 *inter partes* 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 *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant to 37 CFR 1.906(c).

10. Where the merged proceeding is dissolved based on abandonment of the reissue application and the *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application will be merged with the reexamination proceeding (the continuation reissue application might be stayed pending termination of the *inter partes* reexamination).

11. If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

12. Scope of *inter partes* reexamination practice and procedure in the merged proceeding:

The third party requester's right to participate in the *inter partes* reexamination as to issues within the scope of reexamination is statutory, and as such, that right must be preserved in the merged proceeding. The following provides for preservation of that right.

a. Copies of all Office actions must be provided by the Office to the third party requester. Further, any paper filed by the patent owner/applicant in the merged reissue/reexamination proceeding must be served on the third party requester. Third party requester will be given an opportunity to comment on all patent owner replies (responses) to Office actions (including amendments after final rejection). Requester comments must, however, be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no comments can be advanced on issues appropriate for reissue and not appropriate for reexamination). Third party requester participation in the merged proceeding will be strictly limited to issues within the scope of *inter partes* reexamination. Thus, for example, where a question of "public use" is raised in the merged proceeding due to the presence of the reissue, the third party requester's responsive papers <u>cannot</u>

comment on that question. Where such comment is made, the examiner will note that "the comment is outside the scope of the third party requester's participation in the merged proceeding," and the comment will not be otherwise addressed.

b. In the same manner that patent owner/applicant in the merged proceeding must serve the third party requester with correspondence filed in the Office, the third party requester must serve the patent owner/applicant with correspondence that requester files in the Office.

c. Prior to the issuance of a Notice of Allowability (Form PTOL-37), the procedure for issuing Office actions and the forms used therefor, and response by the patent owner, and requester comments, will be governed by the provisions of 37 CFR 1.943 through 37 CFR 1.956. Likewise, the appeal provisions of 37 CFR 1.959 through 37 CFR 1.983 will control appeal by the patent owner and requester to the Board, and to the Court of Appeals for the Federal Circuit. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to advise parties of same, and inform patent owner of the steps that must be taken (e.g., payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out in part 6 (of this section of the decision) above, the present *inter partes* reexamination proceeding would be terminated by the grant of such a reissue patent, and the reissue patent would serve as the certificate under 37 CFR 1.997.

d. Inherent in the rules set forth in the immediately above paragraph is that the patent owner may not appeal to the Board of Patent Appeals and Interferences (Board), until a final Office action is issued, in the form of a right of appeal notice (final action) under 37 CFR 1.953.

e. Requester's comments and appeal papers must be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no challenge can be advanced on issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed above).

f. In view of the provisions 37 CFR 1.953(c), the filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to the right of appeal notice (final action) under 37 CFR 1.953.

13. Clerical processing for the merged reexamination, including entry of amendments, will be carried out in the Central Reexamination Unit (CRU) to the extent it is carried out for an *inter partes* reexamination.

14. The examiner will consult with OPLA (i.e., the legal advisor assigned to the *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner as he/she would consult in a normal (not merged) *inter partes* reexamination.

IV. CONCLUSION

1. The patent owner's petition under 37 CFR 1.182 is **dismissed**.

2. The above-identified reissue application and *inter partes* reexamination proceeding **are merged** into a single consolidated proceeding.

3. A copy of this decision will be placed in the *inter partes* reexamination proceeding and reissue application files.

4. The reissue application file and the *inter partes* reexamination file are being stored in the Central Reexamination Unit (CRU) to await the housekeeping amendment, in accordance with Part III.B., *supra*.

5. Once the housekeeping amendment is received, or the time for filing such housekeeping amendment has expired, the merged reissue and *inter partes* reexamination proceeding will be forwarded via the Technology Center 2600 Group Director to the examiner for the preparation of an Office action in the merged proceeding. All further examination should be conducted in accordance with Parts III.B. and III.C. of this decision.

6. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

7. Telephone inquiries related to this decision and procedural matters should be directed to Lynn M. Kryza, the OPLA Reexamination Legal Advisor assigned to this proceeding, at (703) 308-0255. If attempts to contact Ms. Kryza are unsuccessful, the undersigned may be contacted at (703) 308-5107.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

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Paper No. 20

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REEXAM UNIT

In re Allan, et al.
Reissue Application No.: 10/430,713
Filed: May 5, 2003
For: U.S. Patent No. 6,339,455

In re Allan, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,007
Filed: December 16, 2002
For: U.S. Patent No. 6,339,455

DECISION
GRANTING REQUEST
FOR RECONSIDERATION,
VACATING MERGER, AND
STAYING REISSUE

This is a decision on the patent owner's January 22, 2004, "REQUEST FOR RECONSIDERATION OF THE DECISION DISMISSING PETITION AND DECISION MERGING *INTER PARTES* REEXAMINATION AND REISSUE PROCEEDINGS" that requests reconsideration of the December 22, 2003, decision which (a) dismissed the patent owner's May 6, 2003, petition under 37 CFR 1.182, and (b) merged the above-identified reissue and *inter partes* reexamination proceedings.

A third party requester paper was filed February 17, 2004, in opposition to the patent owner's request for reconsideration, and that opposition paper has been considered in this decision.

Also considered in this decision is the January 30, 2004, patent owner amendment paper titled "HOUSEKEEPING AMENDMENT FOR REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING AND REQUEST TO DELAY ENTRY OF AMENDMENT PENDING DECISION ON REQUEST FOR RECONSIDERATION."

The request for reconsideration, the opposition to that request, and the amendment paper are before the Director of the Office of Patent Legal Administration.

SUMMARY

A. The patent owner's request for reconsideration is granted.

B. The merger ordered on the Office of Patent Legal Administration decision of December 22, 2003 is hereby vacated.

C. The January 30, 2004, amendment paper will not be entered as requested by the patent owner.

D. The prosecution of patent owner's reissue application number 10/430,713 is hereby stayed pending the completion of the 95/000,007 reexamination proceeding by the issuance of the reexamination certificate.

REVIEW OF FACTS

1. U.S. Patent No. 6,339,455 (the '455 patent) issued to Allan et al, on January 15, 2002.

2. A request for ***inter partes*** reexamination of the '455 patent was filed by a third party requester [1] on December 16, 2002, and the resulting reexamination proceeding was assigned Control Number 95/000,007.

3. Notice of the filing of the *inter partes* reexamination was published in the *Official Gazette* on January 14, 2003.

4. On March 12, 2003, an order granting the reexamination request was mailed for the '007 proceeding. The order was accompanied by a non-final Office action.

5. On May 5, 2003, the patent owner filed a "broadening" reissue application based on the '455 patent, which was assigned Application Number 10/430,713. New claims 23-41 [2] are provided in the reissue application.

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[1] Audiovox Corporation is identified as the real party in interest.

[2] Not present in the '455 patent.

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6. On May 6, 2003, the patent owner filed a petition under 37 CFR 1.182, requesting (a) that the reissue application **not** be merged with the *inter partes* reexamination proceeding, and (b) that the *inter partes* reexamination proceeding be suspended pending completion of the broadening reissue application. The petition alternatively requested [3] that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. [4]

7. The patent owner filed, on May 19, 2003, a response (pursuant to 37 CFR 1.945) to the non-final Office action that was issued in the '007 proceeding.

8. On June 6, 2003, the third party requester filed a paper in opposition to the patent owner's petition under 37 CFR 1.182.

9. In addition, the third party requester filed, on June 13, 2003, comments (pursuant to 37 CFR 1.947) to patent owner's response made in the '007 proceeding.

10. On June 20, 2003, the patent owner filed a reply to the third party requester's opposition paper.

11. Notice of the filing of the reissue application was published in the *Official Gazette* on August 12, 2003.

12. On December 22, 2003, the Office of Patent Legal Administration issued a decision dismissing the patent owner petition under 37 CFR 1.182 and merging the above identified reissue and *inter partes* reexamination proceedings.

13. The patent owner then filed, on January 22, 2004, the present request for reconsideration of the December 22, 2003, decision. The third party requester responded on February 17, 2004, with a paper in opposition to the patent owner's request for reconsideration, and in support of the Office's December 22, 2003, decision.

14. On January 30, 2004, the patent owner filed a "Housekeeping Amendment for Reissue Application and *Inter partes* Reexamination Proceeding and Request to Delay Entry of Amendment Pending Decision on Request for Reconsideration." This paper would, if entered, add new claims 23-41 of the reissue application to the reexamination proceeding. As is clear from the title of the paper, the patent owner desires that this amendment not be entered.

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[3] This request for relief is an alternative to the (b) relief requested, should the (a) request for relief be granted.

[4] See petition of May 6, 2003, at page 1.

DECISION

I. Reconsideration of Petitioner's Request Not to Merge:

Petitioner (the patent owner) requests reconsideration of the December 22, 2003, decision (a) dismissing its petition of May 6, 2003, and (b) merging the above-identified reissue and *inter partes* reexamination proceedings. The request for reconsideration asserts that the December 22, 2003, decision promulgates an interpretation of the patent regulations that violates federal statute, and as such, cannot be maintained.

More particularly, petitioner points out that when Congress legislated the *inter partes* reexamination statute, Congress provided, in 35 U.S.C. 314(b), the following unambiguous limitation:

> "In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, **except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.**" [Emphasis added]

Petitioner asserts that the December 22, 2003, decision orders a merger that creates an *inter partes* reexamination of pending claims which are broader than the claims of the issued patent. Petitioner refers to the statement in the December 22nd decision found at page 3, lines 22-24, - "the requirement for the 'same claims' to be presented in the *inter partes* reexamination and the reissue application for the merged proceeding can, in fact, be the broadened claims...". Petitioner contends that this inconsistency cannot be excused as merely a matter of form over substance. Petitioner notes the provision in the decision that the "third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings;" [5] petitioner points out that this fundamentally changes the nature of what would otherwise be an *ex parte* reissue proceeding, i.e., what would otherwise be an *ex parte* proceeding as to the broadened claims. [6]

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[5] See December 22, 2003, decision, at p. 4, lines 21-22.

[6] Petitioner asserts that because the December 22nd decision presents a position inconsistent with the Congressional mandate of the reexamination statute as set forth above, it must be rejected. Petitioner refers to *Federal Election Comm'n v. Democratic Senatorial Campaign Comm'n*, 454 U.S. 27, 32 (1981) (administrative constructions of statutes must be rejected "that are inconsistent with the statutory mandate or that frustrate the policy that Congress sought to implement"). Petitioner also refers to *Public Employees Retirement System v. Betts*, 492 U.S. 158, 171 (1989) ("[N]o deference is due to an agency interpretation at odds with the plain language of the statute itself.")

This argument by the petitioner has been found to be persuasive. The merger ordered by the December 22, 2003, decision would permit a third party (the requester)to comment on broadened claims, and participate in the appeal process as to such claims, while the reissue and reexamination statutes do not provide such a right of third party comment.

The opposition paper urges that the merger is proper since it limits the third party requester input to issues within the scope of *inter partes* reexamination; thus, issues such as recapture, the reissue declaration, and assignee consent could not be considered. However, the main (focal) point is that the consideration of the broadened claims *per se* is not within the scope of *inter partes* reexamination, since the *inter partes* reexamination statute explicitly precludes same. Combining the *inter partes* reexamination with the broadening reissue proceeding would provide for such consideration, and thus be in violation of the statute.

In view of the above, the instant request for reconsideration is granted.

Accordingly, the reissue proceeding and the *inter partes* reexamination proceeding will be conducted based on the following analysis and guidance:

In the present instance, the *inter partes* reexamination is the first filed proceeding. The later-filed reissue application was filed prior to the expiration of the statutory period for broadening the patent claims, i.e., two years from the patent grant. The original petition points out (at page 7) that the reissue application was filed in order to preserve the patent owner's right to broaden the claims, which right would expire during the reexamination proceeding. [7] It is argued that the patent owner was thus prevented from delaying the filing of the reissue application after the conclusion of the *inter partes* reexamination, in an effort to keep the broadened reissue claims beyond the reach of the third party requester's comments via a potential merger. Relief from this situation is provided via the patent owner's request for alternative relief found at page 1 of the original petition, which best addresses this scenario. The alternative request is that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding. A suspension of the reissue application preserves the patent owner's right to have the broadened claims considered by the Office, while keeping the broadened claims beyond the reach of the third party requester's comments.

The reexamination proceeding will not be stayed. It must proceed at this time, since there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceedings (see 35 U.S.C. 314), and it would not be equitable to permit a reissue proceeding filed after a reexamination request to delay

[7] The two year date from patent grant is stated in the petition to be January 15, 2004, a date that has already expired.

the conduct of the reexamination proceeding by suspending the reexamination. [8]

Finally, it is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '455 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. In the present instance, it is further to be noted that, if the examination of the reissue and reexamination proceedings were conducted separately, the patent owner could place all of its responsive comments (even those directed to the non-broadened claims) in the reissue application and not in the reexamination proceeding. The third party requester would then be barred from responding in the *inter partes* reexamination proceeding, while the Office would have the benefit of the patent owner's input as to the claims by way of the reissue application. This runs contrary to the intent of the *inter partes* reexamination statute.

In view of the above reasons, it is appropriate that the reexamination proceeding continue with special dispatch (as required by 35 U.S.C. 314) to its conclusion and issuance of a reexamination certificate, and it is appropriate to stay the reissue proceeding. Thus, the prosecution of reissue application number 10/430,713 is stayed pending the completion of the reexamination proceeding, control number 95/000,007, by the issuance of a reexamination certificate.

NON-ENTRY OF HOUSEKEEPING AMENDMENT

The Office of Patent Legal Administration decision of December 22, 2003, required "an appropriate housekeeping amendment" to place "the same amendments in both cases, specifically, Application No. 10/430,713, and Control Number 95/000,007." Accordingly, the patent owner filed, on January 30, 2004, a "Housekeeping Amendment for Reissue Application and *Inter partes* Reexamination Proceeding and Request to Delay Entry of Amendment Pending Decision on Request for Reconsideration." This paper, if entered, would add new claims 23-41 of the reissue to the reexamination proceeding. As is clear from the title of the paper, the patent owner desires that this amendment not be entered. At the last page of the paper, the patent owner specifically requests "that this Amendment not be entered, **at least** until a decision is made on the Request for Reconsideration." [Emphasis added]

The patent owner's request for non-entry of this January 30, 2004, amendment paper is granted.

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[8] The patent owner could delay the reexamination proceeding indefinitely via repeated filing of requests for continued examination (RCEs) pursuant to 37 CFR 1.114, with the broadened claims being retained.

The proffered claims 23-41 of the reissue will not be entered in the '007 reexamination proceeding. Thus, the requester of the '007 reexamination proceeding has no right of comment on any of claims 23-41 of the January 30, 2004, amendment paper. **Any paper filed by the requester that contains such comment will be returned as a non-statutory comments paper.**

As a clerical matter, it is to be noted that any new claims which are added in the reexamination proceeding will be numbered beginning with claim 23, since claims 23-41 of the January 30, 2004, amendment paper have never been entered.

CONCLUSION

1. The patent owner's request for reconsideration is granted.

2. The merger ordered by the Office decision of December 22, 2003 is vacated.

3. The prosecution of reissue application number 10/430,713 is stayed pending the completion of the 95/000,007 reexamination proceeding by the issuance of the reexamination certificate.

4. The patent owner's request for non-entry of the January 30, 2004, amendment paper is granted.

5. Any paper filed by the third party requester that contains a comment as to claims 23-41 in the reissue application will be returned to the requester as a non-statutory comment paper.

6. A copy of this decision will be placed in both the 10/430,713 reissue file and the 95/000,007 reexamination file.

7. The reexamination file is being forwarded to the Central Reexamination Unit (of the Office of Patent Legal Administration) for processing, after which it will be forwarded via the Group Director of Technology Center 3600 to the examiner for the issuance of an Office action. [9]

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[9] The Office action will address patent owner's May 19, 2003, response and requester's June 13, 2003, comments to patent owner's response

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8. The reissue file is being forwarded via the Group Director of Technology Center 3600 to the Technology Center Special Program Examiner for storage pending the issuance of the reexamination certificate for the '007 reexamination proceeding, after which an Office action will be issued for the reissue application.

9. The patent owner is advised to, at the time that a reexamination certificate is issued for the '007 reexamination, call the issuance of the certificate to the attention of the Office, and request a resumption of examination of the reissue application.

9. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

Robert J. Spar, Director
Office of Patent Legal Administration
Office of Patent Examination Policy

April 21, 2003
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,007	12/16/2002	6339455	JHNSF.015A	8480

20995 7590 06/30/2008

KNOBBE MARTENS OLSON & BEAR LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Frank Chau
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130 Woodbury Road
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MAILED

JUN 30 2008

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,007*.

PATENT NUMBER *6,339,455*.

TECHNOLOGY CENTER *3900*.

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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In re Allan et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,007
Filed: December 16, 2002
For: U.S. Patent No.: 6,339,455

DECISION ON PETITION

This is a decision on the May 19, 2008 patent owner petition entitled REQUEST FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.183.

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

The petition for extension of time filed May 19, 2008, is granted.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee has been charged to petitioner's Deposit Account No. 11-1410 as authorized in the May 19, 2008 petition.

DECISION

37 CFR 1.183 states:

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

The petition was filed before the day on which action by patent owner was due (July 19, 2008), and petitioner provides a factual showing of diligence on the record as to prosecuting the reexamination proceeding. In this instance a notice of appeal has been filed by patent owner. And, 37 CFR 41.66 (a) provides that [t]he time for filing an appellant's brief or an amended appellant's brief may not be extended." However, based on the unique facts and circumstances of this proceeding, it is appropriate to waive that provision to the extent that a one month extension of time is granted.

ADDITIONAL DISCUSSION

37 CFR 1.4(c) states:

> (c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The May 19, 2008 submission of a petition under 37 CFR 1.182 Requesting Continued Reexamination or Entry of Amendment after Action Closing Prosecution is an improper submission as it runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters. A petition requesting entry of an amendment after ACP is properly presented under 37 CFR 1.181, and not 37 CFR 1.182.[1] These petitions would be addressed by different areas of the Office, and require different showings. Therefore, the May 19, 2008 submission from petitioner is an improper paper under 37 CFR 1.4(c). Patent owner may file separate petitions (1) requesting entry of an amendment after ACP under 37 CFR 1.181 and/or (2) requesting continued reexamination under 37 CFR 1.182,

Note that any petition under 37 CFR 1.181 must show what procedural error was made by the Office that resulted in the refusal to enter the amendment in question. If petitioner cannot show a procedural error, then petitioner may file a separate petition under 37 CFR 1.182 requesting continued reexamination.[2]

The grant of the May 19, 2008 petition for an extension of time is not to be construed to provide any indication of whether any petition requesting entry of an amendment after ACP under 37 CFR 1.181 or a petition requesting continued reexamination under 37 CFR 1.182, once properly submitted in terms of form, would have merit. The Office will decide whether or not any such resubmitted petition(s) are grantable upon proper presentment.

CONCLUSION

1. The patent owner petition for extension of time filed May 19, 2008 is **granted** to extend the period for filing an Appellant Brief by one month.

---

[1] *See the Notice of Changes in Requirements for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination while an Earlier Filed Reexamination is Pending,* 1292 Off. Gaz. Pat. Office 20, March 1, 2005

[2] *Id.* at subsection D, second paragraph, note the use of the "either . . . or" language when outlining the procedure.

2. Petitioner has until August 19, 2008 (one month from July 19, 2008 original due date of the Appellant Brief) to submit an Appellant Brief, to keep the proceeding pending.

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

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

June 24, 2008
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20995 7590 08/15/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/15/2008

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000007	12/16/02	6339455	JHNSF.015A

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EXAMINER
NGUYEN, LINH

ART UNIT	PAPER
3992	

DATE MAILED:

08/15/08

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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 this communication.

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MAILED

AUG 15 2008

CENTRAL REEXAMINATION UNIT

In re Allan et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,007
Filed: December 16, 2002
For: U.S. Patent No.: 6,339,455

: DECISION ON PETITION
: TO CONTINUE
: *INTER PARTES*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the July 10, 2008 patent owner petition, denominated "AMENDED PETITION UNDER 37 CFR 1.182 REQUESTING 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 was charged to Deposit account No. 11-1410 on May 20, 2008.

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

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,339,455 (the '455 patent) issued on January 15, 2002.

2. On December 16, 2002 a request for *inter partes* reexamination of the '455 patent was filed by a third party requester and assigned control number 95/000,007 (the '007 reexamination proceeding).

3. On March 12, 2003 the Office issued an Order granting reexamination in the '007 reexamination proceeding. The order was accompanied by a first Office action on the merits of the reexamination proceeding. The Office action set a two-month shortened statutory period for filing a response thereto.

4. On May 19, 2003, patent owner filed a response traversing the Office action, in which no claims were amended.

5. On June 13, 2003, third party requester filed comments in response to patent owner's May 19, 2003 traversal of the Office action.

6. On August 13, 2003, the Office issued a second Office action non-final.

7. On October 18, 2004, patent owner filed a response which amended the issued patent claims and added new claims, and further traversed the rejections of record.

8. On October 28, 2004, the Office issued a notice of defective paper in an *inter partes* reexamination noting informalities in patent owner's October 18, 2004 submission.

9. On November 14, 2004, third party requester filed comments in response to patent owner's response to the August 13, 2004 Office action.

10. On March 3, 2005 patent owner re-filed the October 18, 2004 response correcting the defects noted by the Office.

11. On July 7, 2005, third party requester re-filed its comments in response to patent owner's response to the August 13, 2004 Office action with a post card receipt date stamped by the Office reflecting an original comments filing date of November 14, 2004.

12. On September 30, 2005, the Office issued an Action Closing Prosecution (ACP). The examiner in the ACP indicated that a new limitation in newly added claim 28, was not shown or suggested by one of the prior art combinations used against claim 1 under 35 U.S.C. 103.

13. On November 2, 2005, patent owner filed an amendment after ACP under 37 CFR 1.951(a).

14. On December 2, 2005, third party requester filed comments under 37 CFR 1.951(b) in response to patent owner's November 2, 2005 amendment after ACP.

15. On March 27, 2006, the Office issued a notice of defective paper in an *inter partes* reexamination noting informalities in patent owner's November 2, 2005 submission.

16. On April 24, 2006, patent owner re-filed the November 2, 2005 response, correcting the defects noted by the Office.

17. On April 17, 2008, the Office issued a Right of Appeal Notice (RAN). The RAN stated that the amendment after ACP were denied entry because *inter alia* the amended claims did not avoid the prior art.

18. On May 19, 2008 patent owner filed a notice of appeal.

19. Concurrently on May 19, 2008, patent owner filed a request for a one-month extension of the time for filing an appeal brief and a petition under 37 CFR 1.182, requesting continued reexamination of the proceeding, or in the alternative, entry of an amendment after action closing prosecution in the '007 reexamination proceeding.

20. On June 30, 2008 the Office issued a decision granting patent owner's request for an extension of time and informing patent owner that the concurrently filed petition under 37 CFR 1.182 was an improper paper.

21. On July 10, 2008 patent owner resubmitted the petition under 37 CFR 1.182 with only a request for continued reexamination of the '007 reexamination proceeding.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the Amendment After ACP received in the Office on April 24, 2006.[1]

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[2] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

At page 70 of the September 30, 2005 ACP, the examiner addressed claim 28, an independent claim that included the limitations of originally issued independent claim 1, plus a limitation drawn to an "open bay." The examiner stated the prior art combination of Wong in view Boesch et al. and Alioshin et al. did not teach or suggest the "open bay" limitation. Focusing on independent claim 1 as amended during reexamination and on newly presented claim 28, the ACP utilized obviousness rejections based upon the prior art combinations of: Wong in view Boesch et al. and Alioshin et al. against claim 1; Scribner in view of Wong and Boesch against claims 1 and 28; Rosen in view of Schiffman and Scribner against claims 1 and 28; and Vitito in

[1] Item numbers 13 and 16 in the Review of Salient Facts.
[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

view of Pala against claim 28. The post ACP amendment submitted by patent owner cancelled claims 25-29, and in reliance upon the examiner's statements regarding the "open bay" limitation, attempted to reduce issues for appeal by further amending claim 1 to include the "open bay" limitation. This further amending of claim 1 was submitted presumably for the purpose of obviating the rejection based upon Wong in view Boesch et al. and Alioshin et al. leaving only two obviousness rejections for consideration on appeal.[3] The RAN of April 17, 2008 denied entry of the after ACP amendment stating *inter alia* that Rosen and Scribner disclose an "open bay," Rosen and Scribner being references that are currently of record and as noted previously were applied against both claim 1 as amended during the reexamination and newly added claim 28.

Accordingly, based upon the facts and circumstances of the present case, the post ACP amendment presented by Petitioner/patent owner, consistent with and limited by patent owner in reliance upon statements made on the record by the examiner in the ACP, is deemed a *bona fide* attempt to advance the prosecution by reducing issues for appeal, and toward the issuance of a reexamination certificate. As such, the granting of the present petition is consistent with the requirements of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the Amendment After ACP received April 24, 2006. The amendment paper will be entered in the reexamination proceeding, and the proceeding will be forwarded to the CRU to await submission of any third party comments under 37 CFR 1.947 after the April 24, 2006 patent owner Amendment.[4] Following the submission of third party requester comments or the lapse of the time period for third party comment, the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the April 24, 2006 Amendment, any third party comments, and all papers submitted as part of the appeal process. The Examiner will then issue an Office action treating the patent owner papers as a response and comments received **after** a first Office action.

CONCLUSION

1. The petition under 37 CFR 1.182 is **granted**.

2. The prosecution of the present '007 *inter-partes* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a showing of **extraordinary** circumstances.

3. The closing of prosecution rendered via the Office action mailed September 30, 2005 is withdrawn, and prosecution of the proceeding is reopened. The amendment will be treated as a response by patent owner received **after** a first Office action.

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[3] The rejections based upon the reference combinations of Scribner in view of Wong and Boesch; and Rosen in view of Schiffman and Scribner.

[4] The record reflects third party requester submitted comments under 37 CFR 1.951(b), however by reopening prosecution and treating patent owner's Amendment After ACP as a response received after a first Office action, third party's comment rights are now defined by 37 CFR 1.947 and not 37 CFR 1.951(b).

4. Third party requester has thirty (30) days from the date of mailing of this decision to submit comments pursuant to 37 CFR 1.947.

5. The Amendment After ACP received April 24, 2006 will be entered [5] by the Central Examination Unit, await submission of third party comments and then be forwarded to the examiner for consideration of both the amendment and any third party comments.

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

7. 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

July 12, 2008
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[5] This decision takes no position on the propriety of the amendment or whether it introduces new matter. Any issues raised by the amendment will be addressed by the Examiner in the next Office action.

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Paper No. 13

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MAILED
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REEXAM UNIT

In re MacQueen et al.	:	
Inter Partes Reexamination	:	**DECISION DISMISSING**
Proceeding	:	**PETITION AND *SUA SPONTE***
Control Number 95/000,009	:	**WAIVING THE RULES**
Filed: January 8, 2003	:	
For: U.S. Patent No. 6,399,670	:	

This is a decision on the November 20, 2003, patent owner "REQUEST TO STRIKE AND DISREGARD THE DECLARATION UNDER 37 C.F.R. § 1.132 OF IAN QUARMBY AND PORTIONS OF APPELLANT'S APPEAL BRIEF RELATED THERETO." In view of the relief requested, the November 20, 2003, patent owner paper is taken as a petition under 37 CFR 1.59(b) to expunge the Quarmby Declaration submitted with the Appellant Brief and to redact the Appellant Brief to remove reference to the declaration.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.59(b). The required petition fee of $130.00 has been charged to Pennie & Edmonds **LLP** Deposit Account No. 16-1150 for the present petition under 37 CFR 1.59(b), as authorized in the second paragraph of the petition.

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

SUMMARY

The petition under 37 CFR 1.59(b) is dismissed for the reasons set forth below. The Quarmby Declaration will remain of record.

Pursuant to 37 CFR 1.183, the provision of 37 CFR 1.967(a) is *sua sponte* waived to the extent that the patent owner may submit a Supplemental Respondent Brief directed solely to providing evidence and argument challenging the Quarmby Declaration. The patent owner is hereby granted a period of two months from the date of this decision for that purpose.

REVIEW OF FACTS

1. U.S. patent No. 6,399,670 issued on June 4, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/000,009, was filed by a third party requester [1] on January 8, 2003.

3. Reexamination was ordered for the '009 reexamination proceeding on April 7, 2003. The order was accompanied by an Action Closing Prosecution pursuant to 37 CFR 1.949.

4. There was no response to the Action Closing Prosecution, and, on July 31, 2003, a Right of Appeal Notice was issued pursuant to 37 CFR 1.953.

5. On August 27, 2003, the third party requester filed a Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences under 37 CFR 1.953.

6. The third party requester then filed its Appellant Brief on October 22, 2003, and included a Declaration under 37 CFR 1.132 of Ian Quarmby having attachments.

7. On November 20, 2003, the patent owner filed its Respondent Brief Pursuant to 37 C.F.R. § 1.967.

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[1] Lord Corporation is identified as the real party in interest.

8. Also on November 20, 2003, the patent owner filed the present request titled "REQUEST TO STRIKE AND DISREGARD THE DECLARATION UNDER 37 C.F.R. § 1.132 OF IAN QUARMBY AND PORTIONS OF APPELLANT'S APPEAL BRIEF RELATED THERETO." As pointed out above, the patent owner request is being taken as a petition under 37 CFR 1.59(b) to expunge the Quarmby Declaration and redact the Appellant Brief to remove reference to the declaration.

DECISION ON PETITION

It is requested by petitioner that "the Quarmby Declaration, and those portions of Appellant's Appeal Brief related thereto, be stricken from the record, be disregarded, and be unavailable for use in this appeal or any subsequent proceeding." [2]

The basis for petitioner's request is threefold:

> "The Quarmby Declaration does not comply with the type of information that can be considered in an *inter partes* reexamination.
>
> "The Quarmby Declaration was presented for the first time on appeal without the requisite showing of good and sufficient reasons why it was not presented earlier.
>
> "The veracity and accuracy of the Quarmby Declaration cannot be challenged, and, therefore, it cannot be used as a basis for denying Respondent's patent rights." [3]

These bases will now be addressed.

1. The timeliness of presenting the Quarmby Declaration:

Pursuant to 37 CFR 1.975:

> "Affidavits, declarations, or exhibits submitted after the *inter partes* reexamination has been appealed will not be admitted without **a showing of good and sufficient reasons why they were not earlier presented.**" [Emphasis added]

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[2] Petition at page 8.

[3] Again, Petition at page 8.

At page 7 of the Appellant Brief, the third party requester points out that "Requester had earlier pointed out that an initiator was present in all commercially sold UV-curable resins. The appended Declaration of Dr. Ian Quarmby is presented in response to the Examiner's statement that the requester has failed to show adequately the preformulation of the resin with initiator... and it is presented to explain or confirm that the UV-curable resins U312 and U337 used by Chen were commercially sold with the initiator preformulated in them." The Quarmby Declaration contains attachments, including product ingredient listings, production records, printed web site content and a trade brochure, which are provided with the purpose of showing that certain formulations in the Chen patent do teach the initiator claimed in the present '670 patent.

At page 9 of the Appellant Brief, the third party requester points out that "to demonstrate that the viscosity range obtained in some of the [Chen] illustrative examples falls in the range stated in the '670 claims...appended hereto is a Table attached to the declaration of Ian Quarmby." The Quarmby tests are submitted in an attempt to show that certain formulations in the Chen patent do teach the viscosity range claimed in the '670 patent.

This requester evidence was presented for the first time on appeal, and petitioner's position is that there is no showing of good and sufficient reasons why it was not presented earlier.

With respect to petitioner's position, it is to first be noted that the requester did not have an opportunity, until the appeal stage, to present the Quarmby Declaration evidence that addresses the examiner's comments on the rejection of the claims proposed in the request for reexamination.

The patent owner did not respond to any of the Office actions issued for the present proceeding; thus, there was no procedural opportunity for the third party requester to submit the Quarmby Declaration and its attachments (hereinafter, the the declaration package will simply be refereed to as the Quarmby Declaration) until the point in the prosecution at which the Appellant Brief was filed. It is only at that point, that the statute provides for third party requester participation, where the patent owner does not respond to an Office action. Thus, requester is deemed to have timely submitted the declaration.

Further, by way of the statements at pages 7 and 9 of the Appellant Brief, the Quarmby Declaration has been shown by the third party requester to be submitted in response to the comments made in the Office actions issued for the present proceeding. At page 5 of the petition, it is argued that the requester evidence was not submitted in response to the examiner's comments, but rather seeks to raise new points not directed to examiner's comments. The petition states:

> "Appellant in making its anticipation argument did not cite to any particular portion of the Chen patent as teaching the claimed initiator and instead simply stated that the claimed initiator was known in the art. [Footnote omitted] In essence, Appellant admitted that the Chen patent did not teach the claimed initiator. Further, Appellant's argument that certain formulations in the Chen patent had the claimed viscosity was also rejected. [Footnote omitted] Appellant now, for the first time, submits on appeal a biased declaration that attempts to rectify their problem."

In response, a requester's foresight/recognition of what an examiner will or will not accept, and how a position will be viewed cannot be pinpoint and precise. In this instance, it is reasonable that requester could initially believe that the examiner would accept requester's statement that "the claimed initiator was known in the art" would thus "place" that initiator inherently within the Chen reference. Now that the requester is aware that the examiner will not accept the statement, the requester is entitled to use another way to "place" the initiator inherently within the Chen reference. Further, it is reasonable that the requester would not know, at filing of the request, that its argument that certain formulations in the Chen patent had the claimed viscosity would be rejected by the examiner. Once again, requester has provided a response to what requester could not be expected to know would come about.

Petitioner argues, at page 7 of the petition, that:

> "Basically, Appellant has made the *inter partes* reexamination appeal into a mini-litigation by **slipping in** improper and biased information through a cooperative employee's declaration **very late in the process**. The submission of the Quarmby Declaration under these circumstances **undermines the efficiency of the PTO by expending precious time and resources** in evaluating the veracity and accuracy of the declaration." [Emphasis added]

Petitioner points out at page 4 of the petition that "Congress did not enact *inter partes* reexamination as "a license to abuse patentees and waste the life of a patent...."

In response, it could not have been the intent of the statute to provide the requester with a right of appeal, yet prevent the requester from responding with supporting evidence to an unanticipated position taken by the examiner in the Office actions of the proceeding. It would only be equitable to prevent a requester response with evidence where it is clear that the requester could have anticipated the position taken by the examiner in the Office actions and addressed it in the request. In the present instance, the Quarmby Declaration addresses the inherency of the initiator and the viscosity range of the art falling within that of the claims, both of which the examiner did not accept. It is deemed reasonable that the requester did not anticipate that the examiner would refuse to acquiesce to its position set forth in the request. To find otherwise would be to engage in speculation based on hindsight.

Since the declaration (1) is responsive to the Office actions issued for the present proceeding and (2) was presented at the earliest point at which the third party requester was permitted to present it, good and sufficient reasons are present to satisfy 37 CFR 1.975.

2. The propriety of providing the Quarmby Declaration in the present reexamination proceeding:

Petitioner argues that the Quarmby Declaration "does not comply with the type of information that can be considered in an *inter partes* reexamination," [4] and thus, the reexamination statute should dictate non-entry of the Quarmby Declaration.

This argument is not persuasive. As acknowledged by petitioner, [5] MPEP 2205, "which discusses the content of the prior art cited in an *ex parte* reexamination[,]... explains that 'affidavits or declarations relating to the prior art

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[4] Petition at page 8.

[5] See paragraph bridging pages 3 and 4 of the petition.

documents submitted may accompany the citation to explain the contents or pertinent dates.'" In addition, MPEP 2617 states that:

> "Affidavits or declarations which explain the contents or pertinent dates of prior patents or printed publications in more detail **may be considered in any reexamination.**" [Emphasis added]

As pointed out above, the Quarmby Declaration addresses the inherency of the initiator in the art, and the viscosity range of the art falling within that of the claims, both of which the examiner did not accept. As admitted in the petition,[6] the Quarmby tests "were apparently performed ... in an attempt to show that certain formulations in the Chen patent did teach the viscosity range claimed in the '670 patent. In addition, the Quarmby Declaration contains a number of attachments, including product ingredient listings, production records, recently printed web site content and a trade brochure, which were provided in an attempt to show, among other things, that certain formulations in the Chen patent did teach the initiator claimed in the '670 patent." Thus, the Quarmby Declaration does explain the contents of the prior art.

At page 5 of the petition, it is argued as to the requester's presentation of declaration evidence that "[h]aving the PTO involved in litigation-like aspects also runs contrary to statutory language and Congressional intent for reexaminations by having the PTO go beyond its powers of reexamining patents against patents and publications."

This argument is not persuasive. As pointed out in the decision of *In re Chambers*, 20 USPQ2d 1470 (Comr. Pats. 1991), the reexamination statute provides for evidentiary affidavits and declarations to help define the scope and content of the prior art.

> "After reexamination has been ordered, the examination on the merits is dictated by §305. Section 305 specifically provides that 'reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.' *See also In re Etter,* 756 F.2d 852, 856, 225 USPQ 1,4 (Fed. Cir.)(*en banc), cert. denied,* 474 U.S. 828 (1985).
>
> 'Section 132 provides:

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[6] Petition at page 3.

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together ***with such information*** and references as may be useful in judging of the propriety of continuing the prosecution of his application .... (emphasis added).'

> A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. It would be contrary to §§ 305 and 132 to preclude consideration of other 'information' (e.g., affidavits, declarations and transcripts) to help define the scope and content of the prior art, or to establish that a claimed invention is not anticipated under 35 U.S.C. § 102 or unpatentable under 35 U.S.C. § 103 based on obviousness."

The Federal Circuit's decision of *In re Baxter Travenol Labs*, 952 F.2d 388, 21 USPQ2d 1281(Fed. Cir. 1992) applied the *Chambers* principle that affidavits and declarations are proper to help define the scope and content of the prior art, as follows:

> "Baxter argues that these depositions, declarations, and admissions are extrinsic evidence, which may not be considered when determining the anticipatory teaching of a reference. This is incorrect. Baxter acknowledges, as it must, that extrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576-77, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Here, the depositions and declarations of skilled workers and Baxter's admissions **were used to identify what materials Baxter's commercial bags contained at the time of the Becker document,** thereby explaining what the phrase "[Baxter] Travenol's commercial, two blood bag container" would have meant to one skilled in the art. This evidence clearly shows that those skilled in the art, reading the Becker document, would have known that Becker's primary bag was plasticized with DEHP." [21 USPQ2d at 1284][Emphasis added]

At page 7 of the petition, the potential for bias in the declaration evidence is discussed. Petitioner contends that:

> "[T}he statements, conclusions, and test results presented in the Quarmby Declaration are likely biased because the declarant is an employee of the Appellant, in particular, a higher level employee, namely, a Program Manager for Coatings. [Footnote omitted] Given that the declarant has enjoyed success at Appellant's

> organization, he would be naturally inclined to produce statements, conclusions, and test results that are favorable to Appellant, in order to stay in good standing with Appellant for future promotions. Basically, Appellant has made the *inter partes* reexamination appeal into a mini-litigation by slipping in improper and biased information through a cooperative employee's declaration very late in the process..."by submitting the Quarmby Declaration, it is forcing the PTO to act as judges of an evidentiary determination, which is outside of its expertise and legal scope. Even if the PTO tries to assess the Quarmby Declaration for veracity and accuracy, it will find it problematic because it cannot observe the declarant's demeanor or hear his testimony first hand."

In response, the patent laws provide for the use of evidentiary affidavits and declarations, which may be submitted by various parties including an assignee/owner of the patent or an inventor. As pointed out above, the use of evidentiary affidavits and declarations in a reexamination proceeding (for the purposes stated above) is provided for by statute. Since evidentiary affidavits and declarations are explicitly permitted, the possibility that an interested party might has a bias toward the issue cannot prevent the use of such evidence in patent procedure (in both applications and reexamination proceedings). Rather, the potential for bias is a factor that is taken into account in evaluating the evidence and challenging the proffered evidence as may be appropriate. In the present instance, the patent owner is free, as pointed out above, to challenge the evidence presented by the third party requester, and the totality of the evidence will be evaluated.

In connection with the above, petitioner is referred to *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817 (Fed. Cir. 1994) which addresses the use of "hearsay evidence" in patent proceedings. The Federal Circuit pointed out that:

> "The general rule is that **administrative agencies like the PTO are not bound by the rules of evidence that govern judicial proceedings**. See 2 Am. Jur. 2d Administrative Law Section 345, at 350 (1994); Ernest H. Schopler, Annotation, Comment Note.--Hearsay Evidence in Proceedings Before Federal Administrative Agencies, 6 A.L.R. Fed. 76 (1971); see also Fed. R. Evid. 1101 (omitting administrative proceedings as coming within the applicability of the Federal Rules of Evidence)... **The inapplicability of hearsay evidence rules in *ex parte* PTO examination is appropriate in light of the purpose and reason for the hearsay rule**. As has been articulated by Professor Wigmore, " [t]he theory of the hearsay

rule...is that the many possible sources of inaccuracy and untrustworthiness which may lie underneath the bare untested assertion of a witness can best be brought to light and exposed, if they exist, by the test of cross-examination." [Cite omitted] **During *ex parte* PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under** 37 C.F.R. Section 1.132 (1993)." [7] [Emphasis added]

In the same way that an applicant can rebut the evidence used by an examiner in an *ex parte* application examination, the patent owner, in this instance, can rebut the Quarmby Declaration evidence provided by the requester. Where one party to a reexamination presents an affidavit/declaration that defines the scope and content of the prior art most favorable to that party, the other party to the reexamination is free to present an affidavit/declaration that rebuts the first affidavit/declaration, or otherwise defines the scope and content of the prior art most favorable to that other party. Both parties can "have their say" in the matter. This method of using competing affidavits/declarations to help define the scope and content of the prior art is sanctioned by the reexamination statute, and it no more deprives the patent owner of its rights than does the absence of a jury trial in the Office's administrative review of a patent being reexamined. [8]

3. The opportunity for patent owner to challenge the Quarmby Declaration:

Petitioner has argued that the veracity and accuracy of the Quarmby Declaration cannot be challenged in this instance by the patent owner; thus, the declaration cannot be used as a basis for denying the patent owner's patent rights. In the first complete paragraph of page 8 of the petition, it is stated that:

"Respondent has not had, nor will ever have, an opportunity to challenge the veracity and accuracy of any of the test

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[7] See *Epstein*, 31 USPQ2d at 1821.

[8] See *Patlex Corporation et al. v. Mossinghoff et al.*, 758 F.2d 594, 225 USPQ 243 (Fed. Cir. 1985), where the Federal Circuit addressed and dismissed a challenge that, via reexamination, the patent owner was being deprived of it right to a jury review of its patent and review by an Article III court.

results, statements, opinions or conclusions made in the Quarmby Declaration. Respondent should be afforded such an opportunity before its property rights are taken."

In response, the patent owner could have challenged the Quarmby Declaration via the Respondent Brief with argument pursuant to 37 CFR 1.967(b)(7). Further, evidence could have been submitted, with an explanation (to satisfy the 37 CFR 1.975 showing of cause) that the evidence was for the purpose of challenging/rebutting the Quarmby Declaration, and could not have been submitted earlier since the Quarmby declaration was not submitted until the Appellant Brief stage of the proceeding. In the event that a reasonable amount of additional time was needed to prepare the patent owner's evidence, a petition under 37 CFR 1.183 [9] could have been submitted to waive the the 37 CFR 1.963(b) prohibition on extending the time for filing a Respondent Brief.

At this point, however, 37 CFR 1.967 would bar the patent owner from submitting a challenge to the Quarmby Declaration. Pursuant to 37 CFR 1.967(a):

"Respondent(s) in an *inter partes* reexamination appeal may **once**, within the time limit for filing set forth in § 1.963, file a respondent brief in triplicate and serve the brief on all parties in accordance with § 1.903." [Emphasis added]

Thus, by rule, the patent owner is limited to one Respondent Brief. In the interest of fairness and equity, however, justice requires in this instance that the rule be waived *sua sponte* to permit the patent owner to file a Supplemental Respondent Brief incorporating evidence and/or argument directed to challenging the Quarmby Declaration. Accordingly,

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[9] As provided in 37 CFR 1.183:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner'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(h)."

pursuant to 37 CFR 1.183, [10] the provision of 37 CFR 1.967(a) is hereby waived to the extent that the patent owner may submit a Supplemental Respondent Brief directed solely to providing evidence and/or argument challenging the Quarmby Declaration. The patent owner is granted a period of two months from the date of this decision to submit such a Supplemental Respondent Brief.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.59(b) is **dismissed**.

2. Pursuant to 37 CFR 1.183, the provision of 37 CFR 1.967(a) ***is sua sponte waived*** to the extent that the patent owner is granted leave to submit a Supplemental Respondent Brief directed solely to evidence and/or argument challenging the Quarmby Declaration. The patent owner is hereby granted a period of **Two (2) Months** from the date of this decision to submit such a Supplemental Respondent Brief.

3. If such a Supplemental Respondent Brief is not received within said two (2) month period, the record will be forwarded to the primary examiner to address the Appellant Brief and Respondent Brief presently of record.

4. The reexamination file is being forwarded to the Central Reexamination Unit (CRU) to await the filing of a Supplemental Respondent Brief directed solely to evidence and argument challenging the Quarmby Declaration, or the expiration of the time for such a filing.

5. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

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

March 27, 2003
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[10] See previous footnote.

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Paper No. 13

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(For Patent Owner)

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(For Requester)

MAILED
MAY 0 6 2004
REEXAM UNIT

In re MacQueen et al.	:	
Inter Partes Reexamination	:	**DECISION DISMISSING**
Proceeding	:	**PETITION AND *SUA SPONTE***
Control Number 95/000,009	:	**WAIVING THE RULES**
Filed: January 8, 2003	:	
For: U.S. Patent No. 6,399,670	:	

This is a decision on the November 20, 2003, patent owner "REQUEST TO STRIKE AND DISREGARD THE DECLARATION UNDER 37 C.F.R. § 1.132 OF IAN QUARMBY AND PORTIONS OF APPELLANT'S APPEAL BRIEF RELATED THERETO." In view of the relief requested, the November 20, 2003, patent owner paper is taken as a petition under 37 CFR 1.59(b) to expunge the Quarmby Declaration submitted with the Appellant Brief and to redact the Appellant Brief to remove reference to the declaration.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.59(b). The required petition fee of $130.00 has been charged to Pennie & Edmonds **LLP** Deposit Account No. 16-1150 for the present petition under 37 CFR 1.59(b), as authorized in the second paragraph of the petition.

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

SUMMARY

The petition under 37 CFR 1.59(b) is dismissed for the reasons set forth below. The Quarmby Declaration will remain of record.

Pursuant to 37 CFR 1.183, the provision of 37 CFR 1.967(a) is *sua sponte* waived to the extent that the patent owner may submit a Supplemental Respondent Brief directed solely to providing evidence and argument challenging the Quarmby Declaration. The patent owner is hereby granted a period of two months from the date of this decision for that purpose.

REVIEW OF FACTS

1. U.S. patent No. 6,399,670 issued on June 4, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/000,009, was filed by a third party requester [1] on January 8, 2003.

3. Reexamination was ordered for the '009 reexamination proceeding on April 7, 2003. The order was accompanied by an Action Closing Prosecution pursuant to 37 CFR 1.949.

4. There was no response to the Action Closing Prosecution, and, on July 31, 2003, a Right of Appeal Notice was issued pursuant to 37 CFR 1.953.

5. On August 27, 2003, the third party requester filed a Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences under 37 CFR 1.953.

6. The third party requester then filed its Appellant Brief on October 22, 2003, and included a Declaration under 37 CFR 1.132 of Ian Quarmby having attachments.

7. On November 20, 2003, the patent owner filed its Respondent Brief Pursuant to 37 C.F.R. § 1.967.

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[1] Lord Corporation is identified as the real party in interest.

8. Also on November 20, 2003, the patent owner filed the present request titled "REQUEST TO STRIKE AND DISREGARD THE DECLARATION UNDER 37 C.F.R. § 1.132 OF IAN QUARMBY AND PORTIONS OF APPELLANT'S APPEAL BRIEF RELATED THERETO." As pointed out above, the patent owner request is being taken as a petition under 37 CFR 1.59(b) to expunge the Quarmby Declaration and redact the Appellant Brief to remove reference to the declaration.

DECISION ON PETITION

It is requested by petitioner that "the Quarmby Declaration, and those portions of Appellant's Appeal Brief related thereto, be stricken from the record, be disregarded, and be unavailable for use in this appeal or any subsequent proceeding." [2]

The basis for petitioner's request is threefold:

> "The Quarmby Declaration does not comply with the type of information that can be considered in an *inter partes* reexamination.
>
> "The Quarmby Declaration was presented for the first time on appeal without the requisite showing of good and sufficient reasons why it was not presented earlier.
>
> "The veracity and accuracy of the Quarmby Declaration cannot be challenged, and, therefore, it cannot be used as a basis for denying Respondent's patent rights." [3]

These bases will now be addressed.

1. The timeliness of presenting the Quarmby Declaration:

Pursuant to 37 CFR 1.975:

> "Affidavits, declarations, or exhibits submitted after the *inter partes* reexamination has been appealed will not be admitted without **a showing of good and sufficient reasons why they were not earlier presented.**" [Emphasis added]

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[2] Petition at page 8.

[3] Again, Petition at page 8.

At page 7 of the Appellant Brief, the third party requester points out that "Requester had earlier pointed out that an initiator was present in all commercially sold UV-curable resins. The appended Declaration of Dr. Ian Quarmby is presented in response to the Examiner's statement that the requester has failed to show adequately the preformulation of the resin with initiator... and it is presented to explain or confirm that the UV-curable resins U312 and U337 used by Chen were commercially sold with the initiator preformulated in them." The Quarmby Declaration contains attachments, including product ingredient listings, production records, printed web site content and a trade brochure, which are provided with the purpose of showing that certain formulations in the Chen patent do teach the initiator claimed in the present '670 patent.

At page 9 of the Appellant Brief, the third party requester points out that "to demonstrate that the viscosity range obtained in some of the [Chen] illustrative examples falls in the range stated in the '670 claims...appended hereto is a Table attached to the declaration of Ian Quarmby." The Quarmby tests are submitted in an attempt to show that certain formulations in the Chen patent do teach the viscosity range claimed in the '670 patent.

This requester evidence was presented for the first time on appeal, and petitioner's position is that there is no showing of good and sufficient reasons why it was not presented earlier.

With respect to petitioner's position, it is to first be noted that the requester did not have an opportunity, until the appeal stage, to present the Quarmby Declaration evidence that addresses the examiner's comments on the rejection of the claims proposed in the request for reexamination.

The patent owner did not respond to any of the Office actions issued for the present proceeding; thus, there was no procedural opportunity for the third party requester to submit the Quarmby Declaration and its attachments (hereinafter, the the declaration package will simply be refereed to as the Quarmby Declaration) until the point in the prosecution at which the Appellant Brief was filed. It is only at that point, that the statute provides for third party requester participation, where the patent owner does not respond to an Office action. Thus, requester is deemed to have timely submitted the declaration.

Further, by way of the statements at pages 7 and 9 of the Appellant Brief, the Quarmby Declaration has been shown by the third party requester to be submitted in response to the comments made in the Office actions issued for the present proceeding. At page 5 of the petition, it is argued that the requester evidence was not submitted in response to the examiner's comments, but rather seeks to raise new points not directed to examiner's comments. The petition states:

> "Appellant in making its anticipation argument did not cite to any particular portion of the Chen patent as teaching the claimed initiator and instead simply stated that the claimed initiator was known in the art. [Footnote omitted] In essence, Appellant admitted that the Chen patent did not teach the claimed initiator. Further, Appellant's argument that certain formulations in the Chen patent had the claimed viscosity was also rejected. [Footnote omitted] Appellant now, for the first time, submits on appeal a biased declaration that attempts to rectify their problem."

In response, a requester's foresight/recognition of what an examiner will or will not accept, and how a position will be viewed cannot be pinpoint and precise. In this instance, it is reasonable that requester could initially believe that the examiner would accept requester's statement that "the claimed initiator was known in the art" would thus "place" that initiator inherently within the Chen reference. Now that the requester is aware that the examiner will not accept the statement, the requester is entitled to use another way to "place" the initiator inherently within the Chen reference. Further, it is reasonable that the requester would not know, at filing of the request, that its argument that certain formulations in the Chen patent had the claimed viscosity would be rejected by the examiner. Once again, requester has provided a response to what requester could not be expected to know would come about.

Petitioner argues, at page 7 of the petition, that:

> "Basically, Appellant has made the *inter partes* reexamination appeal into a mini-litigation by **slipping in** improper and biased information through a cooperative employee's declaration **very late in the process**. The submission of the Quarmby Declaration under these circumstances **undermines the efficiency of the PTO by expending precious time and resources** in evaluating the veracity and accuracy of the declaration." [Emphasis added]

Petitioner points out at page 4 of the petition that "Congress did not enact *inter partes* reexamination as "a license to abuse patentees and waste the life of a patent...."

In response, it could not have been the intent of the statute to provide the requester with a right of appeal, yet prevent the requester from responding with supporting evidence to an unanticipated position taken by the examiner in the Office actions of the proceeding. It would only be equitable to prevent a requester response with evidence where it is clear that the requester could have anticipated the position taken by the examiner in the Office actions and addressed it in the request. In the present instance, the Quarmby Declaration addresses the inherency of the initiator and the viscosity range of the art falling within that of the claims, both of which the examiner did not accept. It is deemed reasonable that the requester did not anticipate that the examiner would refuse to acquiesce to its position set forth in the request. To find otherwise would be to engage in speculation based on hindsight.

Since the declaration (1) is responsive to the Office actions issued for the present proceeding and (2) was presented at the earliest point at which the third party requester was permitted to present it, good and sufficient reasons are present to satisfy 37 CFR 1.975.

2. The propriety of providing the Quarmby Declaration in the present reexamination proceeding:

Petitioner argues that the Quarmby Declaration "does not comply with the type of information that can be considered in an *inter partes* reexamination," [4] and thus, the reexamination statute should dictate non-entry of the Quarmby Declaration.

This argument is not persuasive. As acknowledged by petitioner, [5] MPEP 2205, "which discusses the content of the prior art cited in an *ex parte* reexamination[,]... explains that 'affidavits or declarations relating to the prior art

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[4] Petition at page 8.

[5] See paragraph bridging pages 3 and 4 of the petition.

documents submitted may accompany the citation to explain the contents or pertinent dates.'" In addition, MPEP 2617 states that:

> "Affidavits or declarations which explain the contents or pertinent dates of prior patents or printed publications in more detail **may be considered in any reexamination.**" [Emphasis added]

As pointed out above, the Quarmby Declaration addresses the inherency of the initiator in the art, and the viscosity range of the art falling within that of the claims, both of which the examiner did not accept. As admitted in the petition,[6] the Quarmby tests "were apparently performed ... in an attempt to show that certain formulations in the Chen patent did teach the viscosity range claimed in the '670 patent. In addition, the Quarmby Declaration contains a number of attachments, including product ingredient listings, production records, recently printed web site content and a trade brochure, which were provided in an attempt to show, among other things, that certain formulations in the Chen patent did teach the initiator claimed in the '670 patent." Thus, the Quarmby Declaration does explain the contents of the prior art.

At page 5 of the petition, it is argued as to the requester's presentation of declaration evidence that "[h]aving the PTO involved in litigation-like aspects also runs contrary to statutory language and Congressional intent for reexaminations by having the PTO go beyond its powers of reexamining patents against patents and publications."

This argument is not persuasive. As pointed out in the decision of *In re Chambers*, 20 USPQ2d 1470 (Comr. Pats. 1991), the reexamination statute provides for evidentiary affidavits and declarations to help define the scope and content of the prior art.

> "After reexamination has been ordered, the examination on the merits is dictated by §305. Section 305 specifically provides that 'reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.' *See also In re Etter,* 756 F.2d 852, 856, 225 USPQ 1,4 (Fed. Cir.)(*en banc), cert. denied,* 474 U.S. 828 (1985).
>
> 'Section 132 provides:

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[6] Petition at page 3.

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together ***with such information*** and references as may be useful in judging of the propriety of continuing the prosecution of his application .... (emphasis added).'

> A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. It would be contrary to §§ 305 and 132 to preclude consideration of other 'information' (e.g., affidavits, declarations and transcripts) to help define the scope and content of the prior art, or to establish that a claimed invention is not anticipated under 35 U.S.C. § 102 or unpatentable under 35 U.S.C. § 103 based on obviousness."

The Federal Circuit's decision of *In re Baxter Travenol Labs*, 952 F.2d 388, 21 USPQ2d 1281(Fed. Cir. 1992) applied the *Chambers* principle that affidavits and declarations are proper to help define the scope and content of the prior art, as follows:

> "Baxter argues that these depositions, declarations, and admissions are extrinsic evidence, which may not be considered when determining the anticipatory teaching of a reference. This is incorrect. Baxter acknowledges, as it must, that extrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576-77, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Here, the depositions and declarations of skilled workers and Baxter's admissions **were used to identify what materials Baxter's commercial bags contained at the time of the Becker document,** thereby explaining what the phrase "[Baxter] Travenol's commercial, two blood bag container" would have meant to one skilled in the art. This evidence clearly shows that those skilled in the art, reading the Becker document, would have known that Becker's primary bag was plasticized with DEHP." [21 USPQ2d at 1284][Emphasis added]

At page 7 of the petition, the potential for bias in the declaration evidence is discussed. Petitioner contends that:

> "[T}he statements, conclusions, and test results presented in the Quarmby Declaration are likely biased because the declarant is an employee of the Appellant, in particular, a higher level employee, namely, a Program Manager for Coatings. [Footnote omitted] Given that the declarant has enjoyed success at Appellant's

> organization, he would be naturally inclined to produce statements, conclusions, and test results that are favorable to Appellant, in order to stay in good standing with Appellant for future promotions. Basically, Appellant has made the *inter partes* reexamination appeal into a mini-litigation by slipping in improper and biased information through a cooperative employee's declaration very late in the process..."by submitting the Quarmby Declaration, it is forcing the PTO to act as judges of an evidentiary determination, which is outside of its expertise and legal scope. Even if the PTO tries to assess the Quarmby Declaration for veracity and accuracy, it will find it problematic because it cannot observe the declarant's demeanor or hear his testimony first hand."

In response, the patent laws provide for the use of evidentiary affidavits and declarations, which may be submitted by various parties including an assignee/owner of the patent or an inventor. As pointed out above, the use of evidentiary affidavits and declarations in a reexamination proceeding (for the purposes stated above) is provided for by statute. Since evidentiary affidavits and declarations are explicitly permitted, the possibility that an interested party might has a bias toward the issue cannot prevent the use of such evidence in patent procedure (in both applications and reexamination proceedings). Rather, the potential for bias is a factor that is taken into account in evaluating the evidence and challenging the proffered evidence as may be appropriate. In the present instance, the patent owner is free, as pointed out above, to challenge the evidence presented by the third party requester, and the totality of the evidence will be evaluated.

In connection with the above, petitioner is referred to *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817 (Fed. Cir. 1994) which addresses the use of "hearsay evidence" in patent proceedings. The Federal Circuit pointed out that:

> "The general rule is that **administrative agencies like the PTO are not bound by the rules of evidence that govern judicial proceedings**. See 2 Am. Jur. 2d Administrative Law Section 345, at 350 (1994); Ernest H. Schopler, Annotation, Comment Note.--Hearsay Evidence in Proceedings Before Federal Administrative Agencies, 6 A.L.R. Fed. 76 (1971); see also Fed. R. Evid. 1101 (omitting administrative proceedings as coming within the applicability of the Federal Rules of Evidence)... **The inapplicability of hearsay evidence rules in *ex parte* PTO examination is appropriate in light of the purpose and reason for the hearsay rule**. As has been articulated by Professor Wigmore, " [t]he theory of the hearsay

rule...is that the many possible sources of inaccuracy and untrustworthiness which may lie underneath the bare untested assertion of a witness can best be brought to light and exposed, if they exist, by the test of cross-examination." [Cite omitted] **During *ex parte* PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under** 37 C.F.R. Section 1.132 (1993)." [7] [Emphasis added]

In the same way that an applicant can rebut the evidence used by an examiner in an *ex parte* application examination, the patent owner, in this instance, can rebut the Quarmby Declaration evidence provided by the requester. Where one party to a reexamination presents an affidavit/declaration that defines the scope and content of the prior art most favorable to that party, the other party to the reexamination is free to present an affidavit/declaration that rebuts the first affidavit/declaration, or otherwise defines the scope and content of the prior art most favorable to that other party. Both parties can "have their say" in the matter. This method of using competing affidavits/declarations to help define the scope and content of the prior art is sanctioned by the reexamination statute, and it no more deprives the patent owner of its rights than does the absence of a jury trial in the Office's administrative review of a patent being reexamined. [8]

3. The opportunity for patent owner to challenge the Quarmby Declaration:

Petitioner has argued that the veracity and accuracy of the Quarmby Declaration cannot be challenged in this instance by the patent owner; thus, the declaration cannot be used as a basis for denying the patent owner's patent rights. In the first complete paragraph of page 8 of the petition, it is stated that:

"Respondent has not had, nor will ever have, an opportunity to challenge the veracity and accuracy of any of the test

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[7] See *Epstein*, 31 USPQ2d at 1821.

[8] See *Patlex Corporation et al. v. Mossinghoff et al.*, 758 F.2d 594, 225 USPQ 243 (Fed. Cir. 1985), where the Federal Circuit addressed and dismissed a challenge that, via reexamination, the patent owner was being deprived of it right to a jury review of its patent and review by an Article III court.

results, statements, opinions or conclusions made in the Quarmby Declaration. Respondent should be afforded such an opportunity before its property rights are taken."

In response, the patent owner could have challenged the Quarmby Declaration via the Respondent Brief with argument pursuant to 37 CFR 1.967(b)(7). Further, evidence could have been submitted, with an explanation (to satisfy the 37 CFR 1.975 showing of cause) that the evidence was for the purpose of challenging/rebutting the Quarmby Declaration, and could not have been submitted earlier since the Quarmby declaration was not submitted until the Appellant Brief stage of the proceeding. In the event that a reasonable amount of additional time was needed to prepare the patent owner's evidence, a petition under 37 CFR 1.183 [9] could have been submitted to waive the the 37 CFR 1.963(b) prohibition on extending the time for filing a Respondent Brief.

At this point, however, 37 CFR 1.967 would bar the patent owner from submitting a challenge to the Quarmby Declaration. Pursuant to 37 CFR 1.967(a):

"Respondent(s) in an *inter partes* reexamination appeal may **once**, within the time limit for filing set forth in § 1.963, file a respondent brief in triplicate and serve the brief on all parties in accordance with § 1.903." [Emphasis added]

Thus, by rule, the patent owner is limited to one Respondent Brief. In the interest of fairness and equity, however, justice requires in this instance that the rule be waived *sua sponte* to permit the patent owner to file a Supplemental Respondent Brief incorporating evidence and/or argument directed to challenging the Quarmby Declaration. Accordingly,

---

[9] As provided in 37 CFR 1.183:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner'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(h)."

pursuant to 37 CFR 1.183, [10] the provision of 37 CFR 1.967(a) is hereby waived to the extent that the patent owner may submit a Supplemental Respondent Brief directed solely to providing evidence and/or argument challenging the Quarmby Declaration. The patent owner is granted a period of two months from the date of this decision to submit such a Supplemental Respondent Brief.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.59(b) is **dismissed**.

2. Pursuant to 37 CFR 1.183, the provision of 37 CFR 1.967(a) ***is sua sponte waived*** to the extent that the patent owner is granted leave to submit a Supplemental Respondent Brief directed solely to evidence and/or argument challenging the Quarmby Declaration. The patent owner is hereby granted a period of **Two (2) Months** from the date of this decision to submit such a Supplemental Respondent Brief.

3. If such a Supplemental Respondent Brief is not received within said two (2) month period, the record will be forwarded to the primary examiner to address the Appellant Brief and Respondent Brief presently of record.

4. The reexamination file is being forwarded to the Central Reexamination Unit (CRU) to await the filing of a Supplemental Respondent Brief directed solely to evidence and argument challenging the Quarmby Declaration, or the expiration of the time for such a filing.

5. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

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

March 27, 2003
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[10] See previous footnote.

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Commissioner for Patents
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,009	01/08/203	6,399,670	60848-080-US

EXAMINER
Nathan Nutter

ART UNIT	PAPER
1711	

MORGAN LEWIS & BOCKIUS LLP
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PALO ALTO, CA 94306

DATE MAILED:

09/30/2005

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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 this communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

ALFRED D. LOBO
LOBO & CO., LPA
526 Superior Avenue, E.
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Cleveland, OH 44114-1401

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

REEXAMINATION CONTROL NUMBER *95/000,009*.

PATENT NUMBER *6,399,670*.

TECHNOLOGY CENTER *1700*.

ART UNIT *1711*.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re MacQueen et al.	:
Inter Partes Reexamination	: **DECISION**
Proceeding	: **GRANTING**
Control Number 95/000,009	: **PETITION**
Filed: January 8, 2003	:
For: U.S. Patent No. 6,399,670	:

This is a decision on the July 29, 2005 patent owner paper titled "REQUEST TO CORRECT THE RECORD AND IN THE ALTERNATIVE PETITION UNDER 37 C.F.R. 1.182." In view of the relief requested, the July 29, 2005 patent owner paper is taken as a petition under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

The petition under 37 CFR 1.181 is before the Group Director of Technology Center 1700 for decision.

No petition fee is required for the petition, and the petition is granted.

REVIEW OF FACTS

1. U.S. patent No. 6,399,670 issued on June 4, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/000,009, was filed by a third party requester [1] on January 8, 2003.

3. Reexamination was ordered for the '009 reexamination proceeding on April 7, 2003. The order was accompanied by an Action Closing Prosecution pursuant to 37 CFR 1.949.

4. There was no response to the Action Closing Prosecution, and, on July 31, 2003, a Right of Appeal Notice was issued pursuant to 37 CFR 1.953.

5. On August 27, 2003, the third party requester filed a Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences under 37 CFR 1.953.

6. The third party requester then filed its Appellant Brief under 37 CFR 1.965, and the patent owner filed its Respondent Brief Pursuant to 37 CFR 1.967, and an Examiner's Answer was mailed on June 29, 2005.

9. On July 29, 2005, the patent owner filed a paper requesting correction of the record as to the June 29, 2005 Examiner's Answer, or, alternatively petitioning under 37 CFR 1.182. This patent owner paper is taken as a petition under 37 CFR 1.181.

DECISION ON PETITION

At pages 1-2 of the petition, it is stated:

> "In the Examiner's Answer, the Exnminer cited to 37 C.F.R. 1.965(c)(7) as requiring the Respondent's Brief to contain a section regarding the 'grouping of claims.' However, this rule describes the requirements for the Appellant's Brief, not the Respondent's Brief. The rule for the Respondent's Brief, at the time of filing, was 37 C.F.R. 1.967, which did require a "grouping of claims" section.
>
> This mistake should be corrected because the Examiner relies upon this rule pertaining to the Appellant's Brief to conclude that the Respondent/patent owner has conceded that the proposed rejection of claims 1-17 stand or fall together, simply because the Respondent's Brief does not contain a statement regarding the grouping of claims. As noted, the rule did not require such a statement in the Respondent's Brief. Therefore, Respondent/patent owner has made no such concession, and the Examiner's conclusion should be stricken from the record." [Footnotes omitted].

Petitioner's position is addressed as follows:

A review of the Examiner's Answer shows that, on page 6, it is stated:

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[1] Lord Corporation is identified as the real party in interest.

"(7) Grouping of Claims.
Patent owner concedes that the proposed rejection of claims 1-17 stand or fall together, since the patent owner's appellant brief does not include a statement that this grouping of claims does not stand or fall together, accompanied by reasons in support thereof. See 37 CFR 1.965(c)(7)."

The 37 CFR 1.965 citation in the above paragraph is in fact directed to an appellant's brief in *inter partes* reexamination, and not to a respondent's brief. Although this portion of the Examiner's Answer refers to the patent owner paper filed in the appeal as "patent owner's appellant brief," the paper is clearly a respondent's brief. Thus, indeed, the examiner did not apply the correct rule to patent owner's Respondent's Brief, and the Respondent's Brief was inappropriately reviewed based on 37 CFR 1.965(c)(7).

Accordingly, the examiner is directed to issue a corrected Examiner's Answer pointing out that 37 CFR 1.967, the rule governing respondent's briefs, at the time the patent owner's Respondent's Brief was filed, does not require a statement as to grouping of claims not standing or falling together, accompanied by reasons in support thereof; and thus, no inference on the matter can be drawn from Respondent's Brief. This point should be the only change made by the corrected Examiner's Answer.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.181 is **granted**.

2. The reexamination file is being forwarded to the examiner. The examiner is directed to issue a corrected Examiner's Answer limited to the matter set forth in this decision.

3. Any questions regarding this decision should be directed to Kenneth M. Schor Senior Legal Advisor (Office of Patent Legal Administration) at (571) 272-7710.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re MacQueen et al

Appeal No. 2007-0196
Reexamination Control No. 95/000,009

MAILED
DEC 15 2006
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

DECISION ON PETITION

This is a decision on the Request for Filing Date Pursuant to 37 C.F.R. § 1.10(e) ("Petition"), filed by the Patent Owner on October 6, 2005, seeking a filing date of August 12, 2005 for the Request for Oral Hearing filed by the Patent Owner.

REVIEW OF FACTS

1. The Petition filed October 6, 2005, contained the following items:
    a. A Request for Filing Date Pursuant to 37 C.F.R. § 1.10(e);
    b. A copy of the August 12, 2005 Express Mail receipt;
    c. A copy of the August 12, 2005 Patent Log;
    d. A copy of the original Request for Oral Hearing with Express Mail number;
    e. A copy of the OIPE stamped returned postcard receipt.
2. Each item listed above is in compliance with 37 C.F.R. § 1.10(e) and is consistent with an Express Mail date of August 12, 2005.

DECISION

As set forth in the Petition and attachments thereto, the Patent Owner has complied with all of the evidence requirements of 37 C.F.R. § 1.10(e). Accordingly, the Petition is **GRANTED.** The Request for Oral Hearing has been accorded a filing date of August 12, 2005.

Michael R. Fleming
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences

David R. Owens
Moran, Lewis & Bockius LLP
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3000 El Camino Real
Palo Alto, CA 94304

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,010	03/12/2003	6375169	L&P-1299RE	4307

7590 12/01/2004

Kennedy Covington Lobdell & Hickman LLP
214 N. Tryon Street, 47th Floor
Hearst Tower
Charlotte, NC 28202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/01/2004

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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Paper No. 12

Kennedy Covington Lobdell & Hickman LLP
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(For Patent Owner)

J. Dwight Poffenberger, Jr.,
Wood Herron & Evans, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202

(For Third Party Requester)

McCraw et al.	:
Reexamination Proceeding	: DECISION REMANDING
Control No. 95/000,010	: PROCEEDING TO EXAMINER
Filed: March 12, 2003	: AND DISMISSING
For: U.S. Patent No. 6,375,169	: PETITION AS MOOT

This is a decision on the April 6, 2004, patent owner paper titled PETITION TO REOPEN PROSECUTION IN RESPONSE TO ACTION CLOSING PROSECUTION. It is also a decision remanding the present reexamination proceeding Control No. 95/000,010 (the '010 proceeding)to the examiner.

The patent owner petition and the proceeding are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The '010 proceeding is remanded to the examiner, and the patent owner petition is dismissed as moot, for the reasons set forth below.

REVIEW OF FACTS

1. U.S. patent No. 6,375,169 issued on April 23, 2002.

2. A first request for reexamination, assigned control No. 95/000,010, was filed by a third party requester, J. Dwight Poffenberger, Jr., on March 12, 2003.

3. Reexamination was ordered for the '010 reexamination proceeding on June 11, 2003.

4. Prosecution of the '010 reexamination proceeding advanced to the point where (a) patent claims 1-21 have been rejected by the examiner (paper no. 6, mailed June 11, 2003) and (b) patent owner filed a paper on August 5, 2003, titled "AMENDMENT AND RESPONSE TO OFFICE ACTION IN INTER PARTES REEXAMINATION." In patent owner's paper, Figure 2 has been amended.

5. On August 20, 2003, the requester then filed comments in response to the patent owner's paper of August 5, 2003.

6. On February 25, 2004, an Action Closing Prosecution (ACP) was mailed by the Office. The ACP maintained the rejection of patent claims 1-21 and did not accept amended drawing figure 2, indicating that the proposed amendment was considered to constitute new matter.

7. The time for response to the ACP expired after March 25, 2004.

8. On April 6, 2004, following a courtesy call from Ms. Marsha Twitty of the Central Reexamination Unit (CRU), the patent owner filed, by facsimile, the present paper requesting that the action on the merits of the '010 proceeding be reopened because: (1) the patent owner had filed a "PATENT OWNER'S SUPPLEMENTAL RESPONSE TO OFFICE ACTION IN INTER PARTES REEXAMINATION" via facsimile on August 26, 2003 and same was never associated with the '010 proceeding nor considered by the examiner, and (2) the patent owner never received the ACP, and thus, never had an opportunity to respond thereto. The patent owner was provided on this same date, April 6, 2004, with a facsimile copy of the ACP by Ms. Twitty.

DECISION

A. Remand of the proceeding to the examiner:

Under 37 CFR 1.949:

> Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.
>
> [Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

As provided for under 37 CFR 1.949, the examiner issued an ACP in the '010 proceeding on February 25, 2004. However, due to the Office's use of an incorrect, old address, the patent owner did not receive an official mailing of the ACP. It is noted that the patent owner had, prior to the mailing of the ACP, appropriately supplied a Customer Number Data Change Request, changing the address associated with customer number, No. 21878, which was associated with Reexamination No. 95/000,010. (See Exhibit B of the present patent owner paper.) The patent owner was unaware of the ACP until the patent owner received a courtesy call from Ms. Marsha Twitty of the CRU. Through their conversation, it became apparent that the patent owner had not received the originally mailed copy of the ACP due to the Office's use of the incorrect correspondence address for the patent owner. While Ms. Twitty provided patent owner with a facsimile copy of the ACP, such facsimile copy does not constitute an official mailing of the ACP. Thus, the ACP has not yet been officially issued by the Office. As a result, the period for response to the ACP has not yet begun to run, nor has it been tolled. Submission of the patent owner's *Supplemental Response to the Office Action in Inter Partes Reexamination* accordingly has been made prior to the issuance of the ACP, and the paper must be considered by the examiner.

In view of the above, the present reexamination proceeding is remanded to the examiner for (a) consideration of the August 26, 2003, supplemental response, (resubmitted via the facsimile of April 6, 2004), and (b) issuing a new Office action which includes the addressing of the patent owner supplemental response.

It is noted that there is no record of the third party requester having submitted comments responsive to the August 26, 2003, *Supplemental Response to Office Action in Inter Partes Reexamination*. Thus, there are no requester comments responsive to the *Supplemental Response to Office Action in Inter Partes Reexamination* for the examiner to consider.

B. Decision Dismissing Petition as Moot:

The patent owner petition requesting reopening of the prosecution is dismissed as moot.

An ACP has not been officially issued such that there would be a need for reopening of prosecution. In addition, the relief requested by the patent owner will be obtained by virtue of the present remand of the '010 proceeding to the examiner.

C. FAX number for response:

A proper facsimile number for response was set forth in the Office action of June 11, 2003. The patent owner, however, asserts that the examiner, when queried, supplied the patent owner with a different facsimile number for transmission of the August 26, 2003, supplemental response. While it is acknowledged that patent owner asserts that patent owner's counsel experienced problems in using the facsimile number given for the CRU and in response to such problems then used the facsimile number provided by the examiner, *the patent owner is reminded that* all *inter partes* reexamination correspondence ***must*** be filed by mail, by fax, or by hand to the addresses and/or facsimile numbers provided in the official correspondence mailed by the Office. In the event that any difficulty is experienced when using an address or facsimile number provided in the official correspondence mailed by the Office, the CRU is to be telephoned at 571-272-7705

CONCLUSION

1. The patent owner's petition to reopen prosecution of the '010 proceeding is **dismissed** as moot.

2. The present reexamination proceeding is **remanded** to the examiner for (a) consideration of the August 26, 2003, supplemental response, (resubmitted via the facsimile of April 6, 2004), and (b) issuance of a new Office action which includes the addressing of the patent owner supplemental response.

3. The reexamination file is being forwarded to the CRU for entry of the August 26, 2003, patent owner paper titled *Supplemental Response to Office Action in Inter Partes Reexamination*.

4. The reexamination file will then be forwarded to Technology Center 3600, for the examiner's consideration of the patent owner's supplemental response to the Office action of June 11, 2003 and preparation of a new Office action.

5. Any questions regarding this decision should be directed to either the undersigned at (571) 272-7710 or Senior Legal Advisor Elizabeth L. Dougherty at (571) 272-7733.

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

Kenpet5\IP\95_010 remand-OA to wrong address.wpd
11-1-04

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Paper No. 6

ANTONELLI TERRY STOUT & KRAUS (For Patent Owner)
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Arlington, VA 22209

Enclosure: copy of requester response of May 12, 2003

David L. Stewart (For Requester)
ALLEN DYER DOPPELT MILBRATH
& GILCHRIST, P.A.
Suite 1401
Orlando, FL 32802

MAILED
MAY 22 2003
REEXAM UNIT

In re Campana, Jr., et al. : MODIFIED
Reexamination Proceeding : DECISION VACATING
Control No. 95/000,011 : *INTER PARTES*
Filed: April 17, 2003 : REEXAMINATION
For: U.S. Patent No. 6,317,592 : PROCEEDING

This is a modified decision as to the issue of vacating the above-captioned *inter partes* reexamination proceeding. The matter is before the Director of the Office of Patent Legal Administration for consideration of whether or not to vacate the proceeding for failure to comply with the provisions of 37 CFR 1.915.

For the reasons set forth below, *inter partes* reexamination proceeding Control No. 95/000,011 is vacated, and the reexamination filing fee submitted with the proceeding will be refunded. The present modified decision is supplemental to the Decision Vacating Reexamination Proceeding which was issued May 29, 2003 by the Director of the Office of Patent Legal Administration.

REVIEW OF FACTS

1. U.S. Patent No. 6,317,592 (hereinafter, the '592 patent), issued to Campana, Jr. et al., on November 13, 2001, from an application filed on December 6, 1999.

2. The Director of the USPTO initiated reexamination of the '592 patent pursuant to 37 CFR 1.520, by way of an order mailed December 26, 2002. The reexamination proceeding was assigned Control No. 90/006,495 (hereinafter, the '6495 proceeding).

3. On February 26, 2003, a patent owner's statement pursuant to 37 CFR 1.530 was filed in the '6495 proceeding.

4. On April 17, 2003, a request for *inter partes* reexamination was filed by a third party requester, and this reexamination proceeding was assigned Control No. 95/000,011 (hereinafter, the '0011 proceeding).

5. On April 28, 2003, a "Notice of Incomplete Request for *Inter Partes* Reexamination" was mailed for the '011 proceeding. The notice identified numerous items that are required by 37 CFR 1.915 and were missing from the request. The notice provided a 15 day time period for requester to complete the request.

6. A response to the "Notice of Incomplete Request for *Inter Partes* Reexamination" was received from the requester on May 12, 2003.

7. After receipt of requester's May 12, 2003, response, a "Decision Vacating Reexamination Proceeding" was issued May 29, 2003, by the Director of the Office of Patent Legal Administration. The present modified decision is supplemental to the May 29, 2003, decision.

DECISION

I. The Notice of Incomplete Request for *Inter Partes* Reexamination:

The "Notice of Incomplete Request for *Inter Partes* Reexamination" mailed on April 28, 2003, identified the following items required by 37 CFR 1.915 and missing from the request:

- The request does not comply with 37 CFR 1.915 (b) (2) as it does not include a citation of the patents and printed publications which are presented to provide a substantial new question of patentability.

- The request does not comply with 37 CFR 1.915 (b) (3) as it does not include a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

- The request does not comply with 37 CFR 1.915 (b) (7) as it does not include a certification by the third party requester that the estoppel provisions of 37 CFR 1.907 do not prohibit the *inter partes* reexamination.

- The request does not comply with 37 CFR 1.915 (b) (8) as it does not include a statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

- The request does not comply with 37 CFR 1.915 (c) as it does not include a power of attorney from the third party requester, nor does the request include the attorney's registration number along with his signature, pursuant to 37 CFR 1.34(a).

An attachment to the "Notice of Incomplete Request ..." explained the deficiencies in the request in more detail, and also set forth the required response to rectify each deficiency, with specific examples:

- Proper citation of all patents and printed publications included in the request papers, <u>listed on a form PTO-1449, or its equivalent</u>, is required in response to this notice.

- Proper citation of all patents and printed publications included in the box labeled "Information Disclosure Statement," <u>listed on a form PTO-1449, or its equivalent</u>, is required in response to this notice.

- A statement pointing out each substantial new question of patentability based on the cited patents and printed publications is required in response to this notice. An example of such a statement is as follows:

  > "A substantial new question of patentability is raised with regard to claims 1-3 of the Key patent in view of Smith taken with Jones. The teaching as to spring-supporting the extruder as taught by Smith was not present in the prosecution of the application which became the Key patent."

- A detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested is required in response to this notice. An example of such a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested is as follows:

  > "Smith teaches using an extruder supported on springs at a 30 degree angle to the horizontal but does not teach the specific polymer of claims 1-3 which is extruded. The teaching as to spring-supporting the extruder at 30 degrees was not present in the prosecution of the application which became the Key patent. Jones teaches the specific polymer recited in claims 1-3. Claims 1-3 of the Key patent are unpatentable under 35 USC 103 as being obvious in view of Smith taken with Jones, as it would have been obvious to one having ordinary skill in the art to use the polymer of Jones in the spring-supported extruder of Smith, to gain the benefit of the enhanced extrusion properties attendant therewith."

- A certification by the third party requester that the estoppel provisions of 37 CFR 1.907 do not prohibit the *inter partes* reexamination is required in response to this notice.

- A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy is required in response to this notice.

- In order to show that David L. Stewart is authorized to represent the third party requester, either his registration number should be provided along with his signature (pursuant to 37 CFR 1.34(a)), or a power of attorney from the third party requester should be provided, in response to this notice.

The "Notice" provided a 15 day time period to respond and concluded with:

"Note that 37 C.F.R § 1.915 (d) states:

> "If the *inter partes* request does not meet all the requirements of subsection 1.915(b), the person identified as requesting *inter partes* reexamination may be so notified and given an opportunity to complete the formal requirements of the request within a specified time. <u>Failure to comply with the notice may result in the *inter* partes reexamination proceeding being vacated</u>." (Emphasis added.)

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

As pointed out above, a response from the requester to the "Notice of Incomplete Request for *Inter Partes* Reexamination" was received on May 12, 2003. The response has been reviewed, but it is **not** sufficient to complete the *inter partes* reexamination request pursuant to 37 CFR 1.915. It should be noted that the response is partly responsive to the "Notice" in that the missing items pursuant to 37 CFR 1.915 (b) (7), (b) (8), and (c) have been provided. The remaining deficiencies are as follows:

- With regard to 37 CFR 1.915 (b) (2), a PTO-1449 form has been provided, but not all of the references itemized in the "Table of Contents" of the request are cited on it (specifically, references H6-H1O are not listed); therefore, this requirement has only been completed-in-part.

- With regard to 37 CFR 1.915(b) (3), requester's response asserts that this sub-section of the rule has been complied with by the series of claim charts provided in the request; however, such series of claim charts are insufficient, therefore the request remains incomplete.

As explained in detail in the attachment to the "Notice of Incomplete Request ...," the *inter partes* reexamination request does not point out each substantial new question of patentability based on the cited patents and printed publications, nor does it include a detailed explanation of the pertinency and manner of applying the patents and publications to every claim for which reexamination is requested. The series of claim charts included in the request merely align certain limitations of the patent claims with certain portions of the reference(s). The request does not go so far as to set forth each substantial new question of patentability, as required, nor does it provide any proposed manner of applying the references, as required. The information, as compiled, merely invites the examiner to consider the claim charts and determine *ab initio* whether any of the references (alone or in combination) raise a substantial new question of patentability. Such an invitation is not in compliance with 37 CFR 1.915(b) (3), which specifically requires the third party requester to identify all of the grounds on which the third party requester is relying as raising a substantial new question of patentability for consideration by the examiner. The request has been clearly indicated to be insufficient to comply with 37 CFR 1.915(b) (3). Since the response to the "Notice" merely refers to the series of claim charts provided with the original request (in spite of the detailed instructions with examples as to how to complete the request), such response lends nothing to rectify these deficiencies of the original request.

In addition, there is no Certificate of Service included with the response. 37 CFR 1.903 states:

> "... 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."

Accordingly, the requester's response to the "Notice" is also deficient for failure to reflect service of the response on the patent owner in accordance with 37 CFR 1.903.

III. The proceeding is vacated:

In the present instance, the requester has been notified that the *inter partes* reexamination request does **not** meet all the requirements of subsection 1.915(b) and has been given an opportunity to complete the formal requirements of the request within a specified time. Requester has **failed to complete the requirements** for an *inter partes* reexamination request pursuant to 37 CFR 1.915. Accordingly, *inter partes* reexamination proceeding Control No. 95/000,011 is hereby **vacated** in accordance with 37 CFR 1.915(d).

THIRD PARTY REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *inter partes* reexamination of the '592 patent, requester may wish to consider filing a new and complete request for *inter partes* reexamination, (which new request includes the missing information identified above).

REFUND OF REEXAMINATION FILING FEE

The present reexamination proceeding is vacated for failure to file a complete request for reexamination under 37 CFR 1.915. Because the reexamination proceeding has been vacated under 37 CFR 1.915, a refund of the entire reexamination filing fee will be made to requester in due course.

It is noted that, pursuant to 37 CFR 1.925 and 37 CFR 1.26(c), where an *inter partes* reexamination is *denied*, the entire reexamination filing fee is not refunded. In that situation, a determination under 37 CFR 1.923 has been made as to whether or not a substantial new question of patentability has been presented, and pursuant to such determination, reexamination has been denied. Hence, the entire filing fee is not refunded. In the "Discussion of Specific Rules and Response to Comments" of *Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule*, Notice, 65 Fed. Reg. 76756, 76760 (December 7, 2000), it is pointed out with respect to 37 CFR 1.26(c) that where reexamination is denied, "$830 of the filing fee will be retained, which amount reflects the estimated average cost of the reexamination proceeding through the denial of the reexamination request." [Emphasis Added] Where a reexamination proceeding is being *vacated as not complying with 37 CFR 1.915(b)*, however, there is no determination made nor a denial of the reexamination request. The vacating of the proceeding under 37 CFR 1.915(d) (where no determination under 37 CFR 1.923 has been made) is tantamount to an annulment of the reexamination proceeding, that is, it has been deprived of

all force and operation, and in effect never existed. [1] Because the rules do not provide for a partial refund when a reexamination proceeding is vacated under 37 CFR 1.915(d), the entire reexamination filing fee is refunded.

CONCLUSION

1. *Inter partes* reexamination proceeding Control No. 95/000,011 is **vacated**.

2. A refund of the $8,800 reexamination filing fee will be made to requester in due course.

3. A copy of the requester response of May 12, 2003, is being sent to the patent owner, along with this decision

4. The vacated *inter partes* reexamination proceeding will be processed to terminate it, including making the refund of the reexamination filing fee, after which the file will be forwarded to the Files Repository Unit.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza, Patent Special Projects Advisor, at (703) 308-0255, or to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

May 21, 2003
C:\KIVA\KENPET4\ip0011'.wpd

[1] *Black's Law Dictionary, Sixth Edition*, pp. 90, 1548: **Vacate**. "To annul." **Annul**. "To annul a judgement or judicial proceeding is to deprive it of all force and operation, either *ab initio* or prospectively as to future transactions."

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter Partes Reexamination Proceeding
Cooper Cameron Corporation
v.
Safoco, Inc.

Appeal No. 2008-0988
Reexamination Control No. 95/000,015
Patent No. 6,450,477

Decided: August 1, 2008

DECISION ON PETITION

This is a decision on the "Petition to Stay Reexamination Pursuant to 35 U.S.C. § 314(c)," filed July 25, 2008 ("Petition") by Patent Owner, Safoco, Inc. The Petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b), as there is an appeal pending before the Board of Patent Appeals and Interferences ("Board"). *See* MPEP 1002.02(f)(4).

FINDINGS

1. The Request for Reexamination was filed by Third Party Requestor, Cooper Cameron Corporation, on May 20, 2003.

2. Patent Owner represents that Patent No. 6,250,605 (which is the parent of Patent No. 6,450,477 involved in the present reexamination proceeding) is involved in litigation in *Safoco, Inc. v. Cooper Cameron Corp.*, No. H-05-0739 (S.D. Tex., filed Mar. 7, 2005). Petition, p. 1-2. Patent Owner does not indicate the present status of this litigation or the issues being litigated that may have relevance to the disposition of the present reexamination proceeding.

3. Patent Owner correctly notes that pursuant to 35 U.S.C. § 314(c), the USPTO is to conduct inter parties reexamination proceedings with special dispatch, but that for good cause the Director may stay such a proceeding, citing *Sony Computer Entertainment America Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006). Petition, p. 2.

4. Patent Owner also represents that in the matter of *Cooper Technologies Co. v. Dudas*, 85 USPQ2d 1465 (E.D. Va. 2007) an issue common to the present reexamination proceeding has been presented for judicial resolution, namely whether an inter partes reexamination is permitted for patents having a priority date earlier than the effective date of the American Inventors Protection Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501, namely November 29, 1999. Further, Patent Owner represents that the District Court decision in *Cooper Technologies* has been appealed to the Court of Appeals for the Federal Circuit ("CAFC"), Appeal No. 2008-1130, and that oral argument was presented to the CAFC on July 11, 2008. Petition, p. 2-3.

5. The District Court in *Cooper Technologies* held that a patent, the application for which is designated as "an original application" as opposed

to "a reissue application" and that is actually filed on or after November 29, 1999, properly may be the subject of an inter partes reexamination proceeding irrespective of its status as a continuing patent having an earlier effective filing date. *Cooper Technologies*, 85 USPQ2d at 1468-70.

6. Patent Owner also contends that any decision in this appeal by the Board in the near future may be negatively impacted by a court ruling on the Constitutionality of the appointment of one or more of the Administrative Patent Judges ("APJs") comprising the merits panel for the appeal. Petition, p. 3.

DISCUSSION

As the Patent Owner has not shown sufficient reason to stay the reexamination, the petition is DENIED for the following reasons.

1. *Sony Computer* is factually distinguishable

The USPTO record in this reexamination proceeding and the facts presented in the Petition make it apparent that this proceeding was initiated in 2003 and that the litigation in the Texas court was initiated in 2005. Thus, the facts here are inapposite to those in *Sony Computer* where the litigation was initiated in 2002 and the reexamination proceeding was initiated in 2005, after a verdict had been rendered in the litigation. *Sony Computer*, 85 USPQ2d at 1596.

Furthermore, the Petition has not identified specific common issues in the Texas litigation and this proceeding.

Accordingly, no persuasive reason has been presented for staying the reexamination proceeding.

2. It is conjecture to assume *Cooper Technologies* will be reversed

In respect to the appeal in *Cooper Technologies,* the Petition seeks a stay based upon the possibility that the decision of the District Court will be reversed. The mere possibility of a reversal of a decision finding a standing USPTO practice proper is not a persuasive reason for staying this proceeding.

3. The Administrative Patent Judge appointment issue is speculative

The question of the Constitutionality of the appointment of APJs has not been developed on this record. It also represents only a remote possibility that any Board decision rendered in this proceeding would be set aside.

The Patent Owner has, therefore, not put forth sufficient persuasive evidence or argument constituting good cause for staying this proceeding.

DECISION

In view of the foregoing, the Petition is DENIED.

Michael R. Fleming/
Chief Administrative Patent Judge

Keith M. Tackett
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3040 Post Oak Blvd., Suite 1500
Houston, TX 77056-6582

Attorney for Patent Owner

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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.
95/000,015	05/20/2003	6450477	SAFO/0004	9976

7590 09/18/2008
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EXAMINER
KEASEL, ERIC S

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
09/18/2008	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter Partes Reexamination Proceeding
Cooper Cameron Corporation
v.
Safoco, Inc.

Appeal No. 2008-0988
Reexamination Control No. 95/000,015
Patent No. 6,450,477

Decided: September 12, 2008

DECISION ON PETITION

This is a decision on the "Petition Under 37 C.F.R. § 1.181 To Terminate Reexamination," filed August 12, 2008 ("Petition") by Patent Owner, Safoco, Inc. The Petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b), as there is an appeal pending in this *inter partes* reexamination before the Board of Patent Appeals and Interferences. *See* MPEP 1002.02(f)(4). The Petition seeks termination of the instant reexamination proceeding. Third Party Requester, Cooper Cameron Corporation, filed "Third Party Requester Opposition To Patentee's Petition Under 37 C.F.R. § 1.181" on August 27, 2008.

FINDINGS

1. The Request for *Inter Partes* Reexamination of U.S. Patent No. 6,450,477 was filed by the Third Party Requester on May 20, 2003, and reexamination was ordered on July 29, 2003.

2. U.S. Patent No. 6,450,477 involved in this reexamination proceeding was granted from an application filed on June 23, 2001, and is the fourth application in a chain of continuation applications dating from the first-filed application in the chain filed on March 4, 1994.

3. The American Inventors Protection Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501 ("AIPA"), provides that *inter partes* reexamination proceedings are available for all patents granted from an "original application" filed in the United States on or after the date of enactment of the Act, namely November 29, 1999.

4. Patent Owner contends that the application from which the '477 patent was granted is not an "original application" under the AIPA because it was the fourth application in a chain of continuation applications and only the first-filed application in the chain is an "original application." Patent Owner further contends that since the first-filed application, the purported "original application," was filed before November 29, 1999, the present *inter partes* reexamination proceeding was improperly commenced and should be terminated.

5. In *Cooper Industries Co. v. Dudas*, 536 F.3d 1330, 1343 (Fed. Cir. 2008), decided August 19, 2008, the Federal Circuit held that under the

AIPA, an "original application" is any application, including a continuation application, other than a reissue application.

DISCUSSION

Since Patent No. 6,450,477 involved in this *inter partes* reexamination proceeding was granted from an "original application" under the AIPA that was filed after November 29, 1999, the patent is eligible for *inter partes* reexamination pursuant to 37 CFR 1.913.

DECISION

In view of the foregoing, the Petition is DENIED.

Michael R. Fleming
Chief Administrative Patent Judge

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Paper No. 14

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(For Patent Owner)

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REEXAM UNIT

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(For Requester)

In re Better et al.	:	
Inter Partes Reexamination Proceeding	:	DECISION
Control No. 95/000,016	:	DISMISSING
Filed: May 21, 2003	:	PETITION
For: U.S. Patent No. 6,376,217	:	

This is a decision on the patent owner paper of January 16, 2004, requesting that the Comments filed by third party requester on December 10, 2003, be returned to the requester under 37 CFR 1.939, which paper is being treated as a petition under 37 CFR 1.182. The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office (USPTO). The petition fee of $130 pursuant to 37 CFR 1.17(h) for a petition under 37 CFR 1.182, has been charged to patent owner's deposit account, as directed on page 2 of the instant petition.

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

REVIEW OF FACTS

1. On August 8, 2003, the examiner issued an Office action.

2. The patent owner filed a response to the Office action on November 10, 2003.

3. On December 12, 2003, the third party requester filed papers in reply to patent owner's response comprising:

   a. a 37-page Requester's Comments Pursuant to 37 CFR 1.947; and,

   b. a 21-page Declaration of Michael G. Rosenblum (with Exhibits 1-17).

4. Patent owner filed a petition on January 16, 2004, asserting that the papers filed by the requester exceeded the 50-page limit established by 37 CFR 1.943(b) and accordingly urged that the papers should be returned to the requester under 37 CFR 1.939.

DECISION

37 CFR 1.943(b) provides:

> "(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference material such as prior art references."

Patent owner argues that the requester's Comments of December 10, 2003, include a 36 page comment paper plus a 21-page declaration, for a total of 57 pages, which petitioner asserts exceeds the 50 page limit established by 37 CFR 1.943(b). Patent owner states: "These page totals do not include amendments, appendices of claims, or reference materials such as prior art references." Patent owner therefore urges that such Comments should be returned to the requester under 37 CFR 1.939. It is noted, for the record, that the Comment paper includes a signature page 37 and is thus a 37 page document, not a 36 page paper. Because this one page discrepancy does not alter the decision below, this petition decision will address the Comment paper as a "36 page" document as set forth and argued by patent owner.

Although not directly stated, patent owner is apparently arguing that the 21 page declaration does not fall under the exclusions set forth in §1.943(b) (i.e., amendments, appendices of claims, and reference material such as prior art references), and accordingly, when these 21 pages are added to the 36 page comment paper, a total of 57 pages are present which would exceed the 50 page limit. The sole issue is whether the declaration submitted by requester falls under the listed exclusions: "amendments, appendices of claims, and reference material such as prior art

references." It goes without argument that the submitted declaration is not an "amendment" or an "appendices of claims." A determination must be made as to whether or not the submitted declaration is encompassed by the exclusion "reference material such as prior art references." (Emphasis added.)

Petitioner's argument that the declaration is not part of "reference material such as prior art references" has been fully considered but is not persuasive. The declaration constitutes extrinsic evidence and it is well-settled that extrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference. See *In re Baxter Travenol Labs*, 21 USPQ2d 1281, 1284 (Fed. Cir. 1991). Also, as stated in *In re Chambers*, 20 USPQ2d 1470, 1474 (Comm'r Pats. 1991):

> "A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. It would be contrary to §§305 and 132 to preclude consideration of other 'information' (e.g., affidavits, declarations and transcripts) to define the scope and content of the prior art, or to establish that a claimed invention is not anticipated under 35 U.S.C. §102 or unpatentable under 35 U.S.C. §103 based on obviousness."

Further, as stated in *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991):

> "It is sometimes appropriate to consider extrinsic evidence to explain the disclosure of a reference. . . . The role [of] extrinsic evidence is to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention, not to fill gaps in the reference."

The propriety of including declarations in a reexamination proceeding was also addressed in *Heinl v. Godici*, 143 F. Supp.2d 593, 604 (E.D. Va 2001) where the court held that a request for reexamination must set forth "the pertinency and manner of applying the prior art." The court further noted that MPEP 2205 (which discusses the scope and content of prior art references) provides:

> "Affidavits or declarations relating to the prior art documents submitted may accompany the citation to explain the content or pertinent dates in more detail."

Accordingly, the court held that because the affidavits and declarations were submitted to establish the date of the printed publications, the examiner properly accepted these documents as explanations of "the pertinency and manner of applying such prior art." The court, however, set forth guidelines for the use of declarations and affidavits in a reexamination. The court states in footnote 22:

> "A different result might be obtained if the documents did not relate to an explanation of the printed publications but rather to other issues of validity and enforceability. For example, in *Stewart Systems Inc. v. Commissioner of Patents and Trademarks*, 1 U.S.P.Q.2d 1879 (E.D. Va 1986), the plaintiff filed a request for reexamination which included an alleged breach of the duty of candor. The court stated that this issue could not be considered in the scope of a reexamination because reexaminations are limited to a review of patents and printed publications. ... Accordingly, any affidavits or declarations that were submitted to support the breach of candor claim, as opposed to materials submitted to explain the pertinency of the patents and printed publications, must be excluded. Thus pursuant to 35 U.S.C. §§ 301, 302, the patent examiner in this case properly considered the declarations and affidavits submitted because they help the examiner establish the date of publication of the four catalogs submitted." (Emphasis added.)

In view of the above, it is clear that the term "reference material such as prior art references" in 37 CFR 1.943(b) includes affidavits and declarations which further define the scope and content of the prior art references and as such, would not count against the 50-page limitation of the requester's comments. However, it is also equally clear that any affidavit or declaration (or a clearly-identified portion thereof) that is not directed to further defining the scope and content of a prior art reference would not be "reference material such as prior art references" and would count against the 50 page limit of requester's comments.

The Rosenblum Declaration submitted with requester's comments includes 35 numbered paragraphs covering 21 pages. Paragraph 35 (pages 20-21) relates to declarant's signature. Paragraphs 1-30 (pages 1-18) address and comment on the scope and teachings of the cited prior art references; and address the Carroll declaration submitted by patent owner in explaining what certain terms would have meant to one skilled in the art at the time the invention was made. Clearly these paragraphs are directed to further defining the scope and content of the prior art references and therefore constitute "reference material such as prior art references" under 37 CFR 1.943(b).

Paragraphs 31-34 (pages 18-20), however, are directed to the teachings of the references, but also contain arguments (directed to specifically named claims of patent owner's patent) that the combination of the teachings of the references would motivate one skilled in the art to prepare the claimed invention. It is held that although paragraphs 31-34 contain descriptions of the prior art references, the additional argument clearly relating to the application of the prior art to specific claims of the patent under reexamination "crosses the line." Such arguments therefore constitute and are deemed to be part of the comments submitted by requester. Therefore pages 18-20 (three pages) are added to the 36 pages of the Comment paper for a total of 39 pages. This new total of 39 pages, however, is less than the 50 page limit.

Accordingly, requester's Comments of December 10, 2003, (including the Rosenblum Declaration) is considered an appropriate submission under 37 CFR 1.947 and has been entered into the reexamination file and will be considered by the examiner.

CONCLUSION

1. The patent owner petition is **dismissed**.

2. A copy of this decision will be placed in the present *inter partes* reexamination file.

3. The *inter partes* reexamination file will be returned to the examiner for consideration of patent owner's Response of November 10, 2003, to the non-final Office action of August 8, 2003, and requester's Comments of December 10, 2003, (including the Rosenblum Declaration).

4. Telephone inquiries with regard to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 18

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MAILED
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REEXAM UNIT

In re Young
Reexamination Proceeding
Control No. 95/000,017
Filed: May 20, 2003
For: U.S. Patent No.6,250,605

DECISION GRANTING PETITION UNDER § 1.137 AND CLARIFYING ENTRY OF REQUESTER COMMENTS

This is a decision on the October 23, 2003, patent owner PETITION UNDER 37 CFR 1.137(b) TO REVIVE UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING, requesting revival of the present proceeding under the "unintentional" standard. This is also a decision on the status of the WRITTEN COMMENTS ON OFFICE ACTION DATED JULY 29, 2003 AND PATENT OWNER'S RESPONSE TO OFFICE ACTION MAILED OCTOBER 21, 2003 filed by the third party requester on November 24, 2003 (hereinafter, the Requester Comment Paper).

The petition under 37 CFR 1.137(b) and Requester Comment Paper are before the Office of Patent Legal Administration.

The petition fee of $665 set forth in 37 CFR 1.17(m) for the petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 20-0782/SAFO/0003/BTP, in accordance with petitioner's authorization in the third from last paragraph of the instant petition.

The petition under 37 CFR 1.137(b) is granted.

The Requester Comment Paper filed November 24, 2003, is found to be timely filed, and will be entered for consideration.

I. REVIEW OF FACTS

1. United States Patent Number 6,250,605, issued on June 26, 2001.

2. A request for *inter partes* reexamination was filed on May 20,2003, by third party requester David A. Rose (hereinafter, the *inter partes* requester, or simply the requester). The request was assigned Reexamination Control No. 95/000,017 ('017).

3. An order granting reexamination was mailed for the '017 proceeding on July 29, 2003.

4. On July 29, 2003, the examiner issued a first Office action on the merits for the *inter partes* proceeding. The Office action set a two month response period.

5. The patent owner neither filed a response to the first Office action within the two month response period set in the Office action, nor requested an extension of time under 37 CFR 1.956.

6. On October 23, 2003, the patent owner filed the present petition under 37 CFR 1.137(b) to revive an "unintentionally terminated" reexamination proceeding. The petition was accompanied by a response to the July 29, 2003, first Office action on the merits. The Certificate of Service accompanying the October 23, 2003, response states a date of service upon the requesters (pursuant to 37 CFR 1.248) of October 21, 2003. The service is stated to be made at the address of record for the requester.

7. On November 24, 2003, the *inter partes* requester filed comments "in response to" the patent owner's response. The Certificate of Service for requester's comments states a date of service upon the patent owner (pursuant to 37 CFR 1.248) of November 20, 2003.

I. DECISION ON PETITION UNDER 37 CFR 1.137(b)

The instant patent owner petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3). In addition, the *Response to Office Action* was filed with the petition, thereby providing the "reply required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee is being charged to petitioner's deposit account as authorized in the 37 CFR 1.137(b) petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2).

Accordingly, the petition under 37 CFR 1.137(b) is granted.

III. DECISION TIMELINESS OF REQUESTER COMMENT PAPER

The requester paper titled WRITTEN COMMENTS ON OFFICE ACTION DATED JULY 29, 2003 AND PATENT OWNER'S RESPONSE TO OFFICE ACTION MAILED OCTOBER 21, 2003 ("the Requester Comment Paper") is deemed to have been timely filed.

Pursuant to 35 U.S.C. 314(b)(3):

> "Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, **if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.**" [Emphasis added]

The patent owner's response of October 23, 2003 (responding to the Office action of July 29, 2003), contains a Certificate of Service, as it is require to, under 37 CFR 1.903. The Certificate of Service sets forth a date of service upon the *inter partes* requester of October 21, 2003. Thus, based on the Certificate of Service, the last possible date for timely requester comments under 35 U.S.C. 314(b) would ordinarily have been November 20, 2003, while the Requester Comment Paper was filed on November 24, 2003. Thus, ordinarily, the comments would not have been timely.

In the present instance, however, it is the date of the acceptance (under 37 CFR 1.137(b)) of the late patent owner response (to the Office action) that triggers the thirty day period for the requester to respond. Until that date, the requester has nothing to comment on.

Accordingly, the requester comments, which have already been filed on November 24, 2003, are found to be timely filed.

CONCLUSION

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

2. The November 24, 2003, requester comments are found to be **timely filed**, and the comments will be entered and considered.

3. The reexamination file is being forwarded to the Central Reexamination Unit (CRU) of the Office of Patent Legal Administration for entry into the record of:

   The papers filed by the patent owner on October 23, 2003, i.e., the *Petition under 37 CFR 1.137(b)*, *Response to Office Action*, *Terminal Disclaimer*; and *Declaration of C. James Bushman & Accompanying Exhibits*.

   The third party requester's "Written Comments on Office Action Dated July 29, 2003 and Patent Owner's Response to Office Action Mailed October 21, 2003" filed on November 24, 2003.

4. Following entry of the above-identified patent owner papers, the reexamination file will be forwarded via the Technology Center 3700 Group Director to the examiner for the preparation of an Office action, to be issued in due course. The examiner's Office action will address the patent owner's response papers of October 23, 2003, and the November 23, 2003, requester comments.

5. Telephone inquiries related to this decision should be directed to the undersigned at (571)272-7710 or Elizabeth Dougherty, Senior Legal Advisor, at (571)272-7733.

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter Partes Reexamination Proceeding
Cooper Cameron Corporation
v.
Safoco, Inc.

Appeal No. 2008-0750
Reexamination Control No. 95/000,017
Patent No. 6,250,605

Decided: August 1, 2008

DECISION ON PETITION

This is a decision on the "Petition to Stay Reexamination Pursuant to 35 U.S.C. § 314(c)," filed July 25, 2008 ("Petition") by Patent Owner, Safoco, Inc. The Petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b), as there is an appeal pending before the Board of Patent Appeals and Interferences ("Board"). *See* MPEP 1002.02(f)(4).

FINDINGS

1. The Request for Reexamination was filed by Third Party Requestor, Cooper Cameron Corporation, on May 20, 2003.

2. Patent Owner represents that claim 3 of Patent No. 6,250,605 ("the '605 patent") involved in the present reexamination proceeding also is involved in litigation in *Safoco, Inc. v. Cooper Cameron Corp.*, No. H-05-0739 (S.D. Tex., filed Mar. 7, 2005). Petition, p. 2. Patent Owner does not indicate the present status of this litigation or what additional claims, if any, of the '605 patent are involved in the litigation.

3. Patent Owner correctly notes that pursuant to 35 U.S.C. § 314(c), the USPTO is to conduct inter parties reexamination proceedings with special dispatch, but that for good cause the Director may stay such a proceeding, citing *Sony Computer Entertainment America Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006). Petition, p. 2.

4. Patent Owner also represents that in the matter of *Cooper Technologies Co. v. Dudas*, 85 USPQ2d 1465 (E.D. Va. 2007) an issue common to the present reexamination proceeding has been presented for judicial resolution, namely whether an inter partes reexamination is permitted for patents having a priority date earlier than the effective date of the American Inventors Protection Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501, namely November 29, 1999. Further, Patent Owner represents that the District Court decision in *Cooper Technologies* has been appealed to the Court of Appeals for the Federal Circuit ("CAFC"), Appeal No. 2008-1130, and that oral argument was presented to the CAFC on July 11, 2008. Petition, p. 2-3.

5. The District Court in *Cooper Technologies* held that a patent, the application for which is designated as "an original application" as opposed to "a reissue application" and that is actually filed on or after November 29,

1999, properly may be the subject of an inter partes reexamination proceeding irrespective of its status as a continuing patent having an earlier effective filing date. *Cooper Technologies*, 85 USPQ2d at 1468-70.

6. Patent Owner also contends that any decision in this appeal by the Board in the near future may be negatively impacted by a court ruling on the Constitutionality of the appointment of one or more of the Administrative Patent Judges ("APJs") comprising the merits panel for the appeal. Petition, p. 3.

DISCUSSION

As the Patent Owner has not shown sufficient reason to stay the reexamination, the petition is DENIED for the following reasons.

1. *Sony Computer* is factually distinguishable

The USPTO record in this reexamination proceeding and the facts presented in the Petition make it apparent that this proceeding was initiated in 2003 and that the litigation in the Texas court was initiated in 2005. Thus, the facts here are inapposite to those in *Sony Computer* where the litigation was initiated in 2002 and the reexamination proceeding was initiated in 2005, after a verdict had been rendered in the litigation. *Sony Computer*, 85 USPQ2d at 1596.

Furthermore, other than claim 3, the Petition has not identified specific common issues in the Texas litigation and this proceeding, which also involves claims 1 and 2.

Accordingly, no persuasive reason has been presented for staying the reexamination proceeding.

2. It is conjecture to assume *Cooper Technologies* will be reversed

In respect to the appeal in *Cooper Technologies,* the Petition seeks a stay based upon the possibility that the decision of the District Court will be reversed. The mere possibility of a reversal of a decision finding a standing USPTO practice proper is not a persuasive reason for staying this proceeding.

3. The Administrative Patent Judge appointment issue is speculative

The question of the Constitutionality of the appointment of APJs has not been developed on this record. It also represents only a remote possibility that any Board decision rendered in this proceeding would be set aside.

The Patent Owner has, therefore, not put forth sufficient persuasive evidence or argument constituting good cause for staying this proceeding.

DECISION

In view of the foregoing, the Petition is DENIED.

Michael R. Fleming
Chief Administrative Patent Judge

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Attorney for Third Party Requestor

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter Partes Reexamination Proceeding
Cooper Cameron Corporation
v.
Safoco, Inc.

Appeal No. 2008-0750
Reexamination Control No. 95/000,017
Patent No. 6,250,605

Decided: September 12, 2008

DECISION ON PETITION

This is a decision on the "Petition Under 37 C.F.R. § 1.181 To Terminate Reexamination," filed August 12, 2008 ("Petition") by Patent Owner, Safoco, Inc. The Petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b), as there is an appeal pending in this *inter partes* reexamination before the Board of Patent Appeals and Interferences. *See* MPEP 1002.02(f)(4). The Petition seeks termination of the instant reexamination proceeding. Third Party Requester, Cooper Cameron Corporation, filed a "Third Party Requester Opposition To Patentee's Petition Under 37 C.F.R. § 1.181" on August 27, 2008.

FINDINGS

1. The Request for *Inter Partes* Reexamination of U.S. Patent No. 6,250,605 was filed by the Third Party Requester on May 20, 2003, and reexamination was ordered on July 29, 2003.

2. U.S. Patent No. 6,250,605 involved in this reexamination proceeding was granted from an application filed on March 30, 2000, and is the third application in a chain of continuation applications dating from the first-filed application in the chain filed on March 4, 1994.

3. The American Inventors Protection Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501 ("AIPA"), provides that *inter partes* reexamination proceedings are available for all patents granted from an "original application" filed in the United States on or after the date of enactment of the Act, namely November 29, 1999.

4. Patent Owner contends that the application from which the '605 patent was granted is not an "original application" under the AIPA because it was the third application in a chain of continuation applications and only the first-filed application in the chain is an "original application." Patent Owner further contends that since the first-filed application, the purported "original application," was filed before November 29, 1999, the present *inter partes* reexamination proceeding was improperly commenced and should be terminated.

5. In *Cooper Industries Co. v. Dudas*, 536 F.3d 1330, 1343 (Fed. Cir. 2008), decided August 19, 2008, the Federal Circuit held that under the

AIPA, an "original application" is any application, including a continuation application, other than a reissue application.

DISCUSSION

Since Patent No. 6,250,605 involved in this *inter partes* reexamination proceeding was granted from an "original application" under the AIPA that was filed after November 29, 1999, the patent is eligible for *inter partes* reexamination pursuant to 37 CFR 1.913.

DECISION

In view of the foregoing, the Petition is DENIED.

Michael R. Fleming
Chief Administrative Patent Judge

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