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MAILED

JUN 02 2004

REEXAM UNIT

In re Campana, Jr. et al.
inter partes Reexamination Proceeding
Control Number 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DISMISSING PETITION

This is a decision on the October 10, 2003, patent owner petition under 37 CFR 1.181, requesting that 1) the present *inter partes* reexamination proceeding be dismissed; and 2) if the first petitioned request for dismissal of the present *inter partes* reexamination proceeding is not granted, that the present *inter partes* reexamination proceeding be suspended pending immediate judicial review of the decision not granting the first request. The petition is before the Director of the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

For reasons set forth below, the petition for dismissal of the present *inter partes* reexamination proceeding is dismissed; and the petition for suspension of present *inter partes* reexamination proceeding is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,317,592 (hereinafter, the '592 patent), issued to Campana et al., on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office. The Office's control number for the Director Ordered Reexamination of the '592 patent is 90/006,495.

3. On May 29, 2003, the present 95/000,020 request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in the instant proceeding The real party in interest requesting the reexamination is Research In Motion, Inc (RIM).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985, advising the Office of a decision dated August 5, 2003, appealable within 30 days under Federal Rules of Appellate Procedure Rules 3 and 4, issued by the U.S. District Court for the Eastern District of Virginia, which holds that the defendant (the requester RIM) has not sustained its burden of proving the invalidity of any patent claim in the '592 patent. The notice informed the Office of an order issued in *NTP, Inc. v. Research In Motion*, C.A. # 3:01CV767 (E.D.Va., August 5, 2003), and provided a copy of the order and its accompanying memoranda and other orders issued. In the order, the defendant, Research In Motion (RIM), was found to have infringed certain of plaintiff NTP's patent claims in the '592 patent. RIM is the third party reexamination requester (real party in interest) of the present '020 *inter partes* reexamination proceeding, as pointed out in the preceding paragraph. A copy of the Court's order is attached to the notice of concurrent proceeding

5. On August 26, 2003, the Office mailed an order for *inter partes* reexamination of the '592 patent to the patent owner and the third party requester. The August 26th order notified the parties to the reexamination that a decision in the litigation referred to in the Notice of Litigation, mentioned in the preceding paragraph, relating to the '592 patent was received from the patent owner on August 12, 2003, and that such decision might be grounds for termination of the instant proceeding.

6. On October 10, 2003, patent owner filed the present petition under 37 CFR 1.181, requesting that the *inter partes* reexamination proceeding be dismissed, i.e., terminated. Patent owner argues that the Court's holding and decision in *NTP, Inc. v. Research In Motion, supra.* is a "final decision" within the meaning of 35 U S.C 317(b), and accordingly, the instant *inter partes* reexamination proceeding, filed by the requester who is the defendant in that litigation, may not (after the court's order) be maintained by the Office.

7. The District Court decision is currently, at this time, on appeal to the United States Court of Appeals for the Federal Circuit

DECISION

I. Decision Dismissing the Petition to Dismiss the Present *inter partes* Reexamination Proceeding.

The record shows that the present '020 *inter partes* reexamination request was filed on May 29, 2003, on behalf of RIM (the real party in interest). Reexamination is requested of all of the patent claims. A determination that the cited prior art raises a substantial new question of patentability has been made, and it was communicated to the parties to the proceeding in an order mailed August 26, 2003.

The record further shows that RIM is the defendant in a civil action in the U.S. District Court for the Eastern District of Virginia. On August 5, 2003, the Court issued a JUDGEMENT IN A CIVIL CASE and a FINAL ORDER. In its Judgment, the Court found and/or ordered monetary and injunctive relief for NTP, however, enforcement was stayed, pending appeal.

Petitioner therefore requests that the Office dismiss the present *inter partes* reexamination proceedings according to the requirements of Section 317(b) of Title 35

II Applicable Statutory Provision

Section 317(b) of Title 35 provides:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings. [emphasis added]

The legislative history of this section includes the following, which identifies that its effect occurs after appeals and that its effect does not extend to issues concerning prior art that was unavailable.

> Sec. 4604. Optional *inter partes* Reexamination Procedure
> *****
> Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for *inter partes* reexamination has been issued, neither a third-party requester nor the patent owner may file

a subsequent request for *inter partes* reexamination until an *inter partes* reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO. [emphasis added] 106 Cong Rec. S14720, (Nov. 17, 1999).

III. Analysis

Petitioner lays out two major prongs of his argument

(I) RIM is stuck with its tactical decision to litigate rather than seek reexamination, because 35 U.S.C. 317 precludes both avenues following final decision; and

(II) the "final decision" provision of 35 U.S.C. 317 is satisfied by the "final decision" that was entered by the U.S. District Court; the provision does not require appeal exhaustion.

The first prong, predicated on the background of the dispute, sets forth seven events related to the litigation of validity issues in U.S. District Court and sixteen events related to an alleged post-trial campaign of harassment against NTP. The thesis of this prong is that:

> "The chronology of events ... clearly demonstrates RIM's tactical choice to litigate the issues and its subsequent harassment of NTP, abuse of PTO procedures and lack of candor before the PTO RIM's relentless post-trial activities .. constitute precisely the type of 'harassment' that Congress intended to protect against. ... Once RIM made the choice to litigate, harassment using *inter partes* requests is forbidden as per Congressional mandate." [Petition at pp. 3 and 5]

Petitioner portrays the allegation of harassment in the litigation and the Office reexamination request history as evidence of the harassment Congress addressed in formulating the language of 35 U.S.C. 317, leading to the second prong of Petitioner's argument, [1] the preclusion of *inter partes* availability resulting from 35 U.S.C. 317. Petitioner also implicitly argues against furtherance of the *inter partes* proceedings by characterizing the *inter partes* requests as *ultra vires*, implying their nullity of effect. It is thus urged that the order for reexamination should be vacated. Petitioner cites *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) in support of its position.

Petitioner's position is not persuasive. Maintaining an active reexamination proceeding <u>is not *ultra vires*</u> by virtue of the 35 U.S.C. 317 statute and its legislative history. In *Recreative*, the issue regarding characterization as *ultra vires* was the presence or absence of a substantial new question

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[1] Discussed below.

of patentability, and the reliance on a patent reference in the reexamination for the same reason as in the patent. In the instant case, the issue regarding characterization as *ultra vires* is the timing of a "final decision" that meets the requirements of 35 U.S.C. 317 for terminating *inter partes* reexamination; such an issue was not existent in *Recreative* The fact situation of the present case is different from that of *Recreative,* and the *Recreative* decision is not on point

As to Petitioner's allegations of harassment in RIM's conduct, evaluation of this issue is beyond the scope of the PTO's reexamination process as laid out in 37 CFR 1.906(c), stating that "[i]ssues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding." Although the PTO has discretion (as specified in the Manual for Patent Examination Procedure (MPEP), Section 2240) to deny a request for reexamination where harassment is clearly present in an aggravated situation, this applies to cumulative requests by a third party for reexamination of the same patent, which is not at issue, because this is the first request by RIM, and this MPEP provision does not refer to terminating proceedings once a reexamination has been ordered. However, the Office does take note of Petitioner's allegation that 19 out of the 24 alleged prior art references submitted in RIM's *inter partes* request, including one or more references from each of the categories of alleged prior art cited in RIM's reexamination request, were produced to NTP in April and May of 2002, for the purpose of determining whether prior art was known at the time of the District Court proceedings But it is further noted that Petitioner has not provided, and the Office does not possess, a detailed list of the specific 19 references that were produced. **The Office requests that the list of all specific references of prior art produced for the District Court proceedings and a copy of each cited reference so produced that is not a U.S. patent <u>be provided to the Office</u> within one month from the date of this decision.**

The second prong, predicated on statutory construction of 35 U.S.C. 317, argues that this statutory provision means that *inter partes* procedures are barred by the entry of judgment by a U.S. District Court, and not by the exhaustion of appeals following such an entry of judgment

As to Petitioner's allegation that 35 U.S.C. 317 must be construed to require the Office to dismiss *inter partes* proceedings upon entry of a final judgment by a U.S. District Court, Petitioner's arguments are unpersuasive. Each of Petitioner's arguments are treated below.

<u>Petitioner's argument II(A): The language of the statute has no stated appeal exhaustion condition or limitation, and the Supreme Court has specifically stated that conditions or limitations cannot be read into patent statutes.</u>

This argument is unpersuasive because the right of appeal from the District Court level is inherent in the due process requirements of litigation. There is no issue of reading conditions or limitations that already inherently exist within legal proceedings into statutes governing those proceedings. Further, the legislative history clearly provided such a condition. "[I]f a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised." (Cong. Rec. *supra.*)

Petitioner's argument II(B): The language of the statute specifically says "a" final decision, not "the" final decision, thus showing that the final decision of the district court applies. This suggests that more than one final decision may apply, negating the interpretation that the singular final decision following all appeals is meant.

This argument is unpersuasive because the construction of the phrase referred to "if **a** final decision in **an** *inter partes* reexamination proceeding instituted by **a** third-party requester is favorable to the patentability of **any** original or proposed amended or new claim" posits a hypothetical proceeding and therefore uniformly relies on the indefinite article in response to the hypothetical example put forth. Petitioner cites *American Bus Ass'n v. Slater*, 231 F.3d 1, 4-5 (D.C. Cir. 2000) to support its position. However, *American Bus Ass'n* holds that where a statute uses a definite article to set forth its available remedies, the definite article limits the scope of remedies available. In contrast, 35 U.S.C. 317 uses an indefinite article, which does not refer to part of the statute itself, as in *American Bus Ass'n*, but rather to a hypothetical event in a hypothetical proceeding. There is simply no parallel. The opinion also cited by Petitioner in *Freytag v. Commisioner of Internal Revenue*, 501 U.S. 868, 902 (1991) similarly refers to the definite rather than the indefinite article in stating that "[t]he definite article 'the' obviously narrows the class of eligible 'Courts of Law' to those courts of law envisioned by the Constitution." Therefore, there is no opinion cited that holds that the use of the indefinite article precludes identifying a specific instance that will satisfy the noun or phrase modified by that indefinite article. The legislative history itself runs counter to Petitioner's argument in stating that "if a third-party requester asserts patent invalidity in a civil action and **a** final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised " (*supra*) The phrase "after any appeals" modifying the phrase "a final decision" might be slightly ambiguous, however it does clearly delineate the point at which a final decision affects the *inter partes* proceeding, counter to Petitioner's argument.

Petitioner's argument II(C): Voiding or eliminating the terms "entered" and "once" in Section 317 violates the cardinal canon of statutory claim construction.

This argument is unpersuasive because the Office has neither voided nor eliminated the terms "entered" and "once". The issue is the timing of when the final judgement has once been entered. Because this entry does not occur with the finality of the word "final" until exhaustion of appeal, the timing of the entry occurs once appeal has been exhausted.

Further, the meaning of the word "once" has multiple meanings, among which are meanings that support the Office's reading of 35 U.S.C. 317 that, in order to terminate an *inter partes* reexamination, a final decision must be after appeal. Petitioner argues that because "once" means "as soon as," the phrase "final decision" being "entered" is the immediate trigger for cessation of *inter partes* proceedings. In addition to the meaning suggested by Petitioner of "at the moment when" and "as soon as," the Merriam Webster dictionary provides that "once" means "at any one time" and "under any circumstances, " and Microsoft's Bookshelf dictionary and the web site www.dictionary.com provide that "once" means "at any time," "ever," "if ever," and "when "

None of these meanings imply an immediately coincident occurrence as argued by Petitioner, and therefore the interpretation of the word "once" by the Office would not make part of 35 U.S C. 317 inoperative or without effect.

As to the opinion cited by Petitioner in *Bennet v Spear*, 520 U.S. 154 (1997), this case held that one paragraph of a statutory section could not be read to completely negate another paragraph in the same section. In that opinion, one paragraph was argued to allow suit on any basis, although the other paragraph clearly restricted the scope upon which certain suits could be filed The Court held that the first paragraph also restricted the scope upon which certain suits could be filed, because, to hold otherwise, would obviate the second paragraph. This is simply not the case in 35 U.S.C. 317. No reading of the phrase "or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office" will obviate the provision ceasing *inter partes* proceedings; it merely affects the interpretation of when such should occur, which is the issue under review.

Further, the Office's position of construing "final decision" to mean after appeal is consistent with the legislative intent of 35 U.S.C. 317 There is no issue as to voiding or eliminating the terms "entered" and "once" because these terms modify the term "final decision," which is meant by the statute to mean that after appeals, as noted in the legislative history stating that "if a third-party requester asserts patent invalidity in a civil action and **a** final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised." (*supra.*)

<u>Petitioner's argument II(D): The legislative history makes clear that third party requesters are limited to "one bite at the apple" and have to make a choice: district court litigation or *inter partes* reexamination.</u>

Petitioner's argument is unpersuasive because 35 U.S.C 317 on its face says nothing proscribing maintenance of both litigation and reexamination <u>prior</u> to a final decision, there is no requirement for consolidating litigation and reexamination proceedings, or for terminating either, prior to a final decision. The only relevant issue is precisely when, after a final decision, i.e. at what stage of finality, is one or the other proceeding to terminate. The legislative history specifically relating to the non-harassment provision of 35 U.S.C. 317 states that "[s]ubtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder." and "if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised." (*supra.*) This

legislative history demonstrates that Congress addressed the need to protect against harassment and decided to place the point at which *inter partes* reexamination must cease after any appeals, and not prior to any appeals as argued by Petitioner.

Petitioner's argument II(E): Section 317 was specifically intended to prevent harassment of the patentee, and to construe "final decision" to mean after appeals would defeat Congress' stated intent. After all appeals for a court litigation are exhausted, the third party has no interest or incentive in harassment. Waiting until after appeals are exhausted to preempt reexamination makes no sense because at that point, the patentee has a fully collectible judgment and the requester has no interest or incentive in using reexamination for harassment.

Petitioner's argument is unpersuasive because it is precisely when there is no longer any economic or legal incentive available to a third party that further legal activity by a third party against a patent holder becomes harassing. Prior to that, conduct by a third party to invalidate a patent is in defense of the third party's property and business interests. Thus, filing for *inter partes* reexamination during appeal of a litigation decision is not the evisceration of 35 U S.C. 317 as argued by Petitioner. Any harassing conduct could not be found until after the exhaustion of any and all appeals.

Petitioner's argument II(F): Congress used the phrase "final decision" in the language of many PTO enabling statutes to mean decisions subject to appeal. The lack of express language as to appellate exhaustion in Section 317 is indicative of the intent to exclude such an exhaustion in view of the presence of such explicit language in other portions of the patent public laws regarding final decisions.

Petitioner's argument is unpersuasive because stylistic conventions as to the presence or absence of limiting phrases indicating appeal in statutory provisions enacted at times different from the statutory provision at issue are not controlling as to how the stylistic convention of the statutory provision at issue should be interpreted. The phrase "final decision" and the word "appeal" occur many times in varying contexts and have different meanings in those contexts in the patent statutes Final decisions are made by examiners, by the Board of Patent Appeals and Interferences, by District Courts, and by Courts of Appeals, including the Supreme Court Similarly, appeals are conducted by the Board of Patent Appeals and Interferences, by District Courts, and by Courts of Appeals, including the Supreme Court. It is the specific statutory construction read in light of legislative intent of the statutory provision at issue that controls, because only it is predicated on its own specific context for interpreting such stylistic usage.

Congress clearly intended for the phrase "final decision" to mean after appeals as shown by the legislative history that "if a third-party requester asserts patent invalidity in a civil action and **a** final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised " (*supra*)

Petitioner's argument II(G): 28 U.S.C. 1291 confirms that the phrase "final decision" is by that by the District Court.

Petitioner's argument is unpersuasive because the issue is not which of the nominally final decisions is meant, but what degree of finality is recognizable for the purpose of ceasing *inter partes* reexamination proceedings. .The term "final decision" is meant by the statute to mean that after appeals, as noted in the legislative history stating that "if a third-party requester asserts patent invalidity in a civil action and **a** final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised." (*supra.*)

Petitioner's argument III: Binding precedent regarding basic principles of res judicata and collateral estoppel preclude the PTO from serving as a vehicle for re-litigating an issue lost in court.

Petitioner's argument is unpersuasive. Whereas petitioner argues that the effect of collateral estoppel is not altered to preclude re-litigation pending appeal, it is the timing of when reexamination must terminate, and not the substantive effect of the termination that is at issue. It is not issue preclusion *per se* that 35 U.S.C. 317 speaks to, because the issues differ between invalidity litigation and reexamination proceedings, even with respect to the same art, because of, for example, the different standards of proof, as articulated in the MPEP 2286 (*infra*).

To the extent Petitioner's argument is that the general requirements of collateral estoppel preclude continuation of the reexamination proceeding, this argument is explicitly refuted because it is inapplicable to reexamination proceedings as articulated in *Ethicon v. Quigg*, 849 F.2d 1422 (Fed.Cir. 1988), footnote 3, which states that"[t]he doctrine of collateral estoppel does not prevent the PTO from completing the reexamination in this situation. Courts do not find patents "valid," *Environmental Designs, Ltd. v. Union Oil Co* ., 713 F.2d 693, 699 n.9, 218 USPQ 865 , 871 n.9 (Fed. Cir. 1983), only that the patent challenger did not carry the "burden of establishing invalidity in the particular case before the court" under 35 U.S.C §282. *Panduit Corp. v. Dennison Mfg. Co* ., 810 F.2d 1561, 1569, 1 USPQ2d 1593, 1598 (Fed Cir. 1987) (emphasis added), accord *Shelcore, Inc. v. Durham Industries, Inc* ., 745 F.2d 621, 627, 223 USPQ 584, 588 (Fed. Cir. 1984) ("A patent is not held valid for all purposes but, rather, not invalid on the record before the court"). "Thereupon, the patent simply remains valid until another challenger carries the §282 burden." *Panduit Corp* ., 810 F.2d at 1570, 1 USPQ2d at 1599. Accordingly, a court's decision upholding a patent's validity is not ordinarily binding on another challenge to the patent's validity, *Stevenson v. Sears, Roebuck & Co* ., 713 F 2d 705, 710, 711, 218 USPQ 969, 974, (Fed Cir 1983), in either the courts or the PTO."

As articulated in MPEP 2286, concerning *ex parte* reexamination,"[t]he issuance of a final district court decision upholding validity during a reexamination also will have no binding effect on the examination of the reexamination. This is because the court states in *Ethicon v. Quigg*, 849 F 2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the Office is not bound by a court's holding of patent validity and should continue the reexamination. The court notes that district

courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a district court must be shown by 'clear and convincing' evidence, whereas in the Office, it is sufficient to show nonpatentability by a 'preponderance of evidence ' Since the 'clear and convincing' standard is harder to satisfy than the 'preponderance' standard, deference will ordinarily be accorded to the factual findings of the court where the evidence before the Office and the court is the same. If sufficient reasons are present, claims held valid by the court may be rejected in reexamination."

It is only the statutory provision in 35 U.S.C. 317 that distinguishes the issue preclusion effects that a final court decision in *inter partes* compared to *ex parte* reexamination proceedings, and not the general law of collateral estoppel. Therefore, it is only the legislative intent of that statute and not judicial interpretation of generic collateral estoppel, that controls the implementation of that statute.

Although not part of this *inter partes* reexamination proceeding, Petitioner is reminded of the concurrent *ex parte* reexamination proceeding, to which *Ethicon* speaks, will be unaffected by the issues of this petition. It is only the *inter partes* procedural nature of the reexamination proceeding, and not the basic substantive existence of the reexamination proceeding, that is at issue in this petition because of the concurrent *ex parte* proceeding.

IV. Decision Dismissing the Petition to Suspend the Present *inter partes* Reexamination Proceeding.

Section 314(c) of Title 35 provides:

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

I. The requirement to conduct the *inter partes* proceeding with special dispatch, in itself, instructs the Office to dismiss a request to suspend the proceedings, absent a showing of good cause, because any such suspension would cease the conduct with special dispatch, contrary to the statutory directive

II. Suspension of the *inter partes* proceedings would cause significant administrative burden to the Office because the concurrent ex parte proceeding would have to be suspended as well, to avoid even larger administrative burden of duplicating the proceedings following the suspension, while seven concurrent ex parte reexamination proceedings on patents related by commonality of inventors and similarity of claimed subject matter would continue The Office would have to repeat the traverse of all the issues regarding patentability that arise in the seven related reexaminations over again in the instant application once the ex parte proceeding, and the *inter partes* proceeding, became unsuspended

III. By analogy, the dismissal of the request for suspension of the *inter partes* proceeding would cause minimal burden to the Petitioner because the ex parte proceeding, unaffected by this petition, remains and the substantive issues in both proceedings are identical It is only the procedural format that distinguishes *ex parte* and *inter partes* proceedings

IV. Therefore, the request to suspend the *inter partes* reexamination proceedings is dismissed.

CONCLUSION

1. Both the petition to dismiss the instant *inter partes* proceedings and to suspend the instant *inter partes* proceedings are dismissed.

2. Because of the *inter partes* reexamination requester's appeal from the order of the U.S District Court for the Eastern District of Virginia, the *inter partes* reexamination proceedings will not be terminated. Rather, the examination and prosecution will continue until requester has exhausted all its appeal avenues, or the time for such expires.

3. Patent owner should submit, within one month from the date of this decision, a listing of all the prior art produced for the District Court proceeding, and a copy of each reference that is not a U.S. patent as requested on page 5 of this decision..

4. **All correspondence relating to an *inter partes* reexamination proceeding** should be directed:

   by Mail to: Mail Stop *inter partes* Reexam
   Central Reexamination Unit
   Office of Patent Legal Administration
   United States Patent & Trademark Office
   P.O. Box 1450
   Alexandria, VA 22313-1450

   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 22202

5. Telephone inquiries with regard to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610 or Kenneth M. Schor, Senior Legal Advisor, at (703) 308 - 6710.

Kenneth Schor for

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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AUG 09 2004

REEXAM UNIT

In re Campana et al *Ex parte* Reexamination Proceeding Control No. 90/006,495 Filed: January 26, 2002 For: U.S. Patent No. 6,317,592	**DECISION, *SUA SPONTE*, MERGING *Ex Parte* and *Inter Partes* REEXAMINATION PROCEEDINGS**
In re Campana et al *Inter partes* Reexamination Proceeding Control No. 95/000,020 Filed: May 29, 2003 For: U.S. Patent No. 6,317,592	

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 C.F.R. § 1.989 at this time.

REVIEW OF FACTS

1. United States Patent No. 6,317,592, issued to Campana et al., on November 13, 2001.

2. An order for *ex parte* reexamination, assigned Reexamination Control No. 90/006,495 ('6495), was mailed December 26, 2002, at the initiative of the Director of the United States Patent and Trademark Office.

3. On February 26, 2003, a patent owner's statement pursuant to 37 C.F.R. § 1.530 was received in the '6495 proceeding.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,020 ('020), was filed May 29, 2003, by third party requester David Stewart, for Research in Motion (RIM).

5. On August 12, 2003, in the '020 proceeding, and on August 14, 2003, in the '6495 proceeding, the patent owner filed a notice of concurrent proceedings under 37 C.F.R. § 1.985, advising the Office of a decision dated August 5, 2003, appealable within 30 days under Federal Rules of Appellate Procedure Rules 3 and 4, issued by the U.S. District Court for the Eastern District of Virginia, which held that the defendant (the requester RIM) had not sustained its' burden of proving the invalidity of any patent claim in the '592 patent. The notice informed the Office of an order issued in *NTP, Inc. v. Research In Motion*, C.A. # 3:01CV767 (E.D.Va., August 5, 2003), and provided a copy of the order and its' accompanying memoranda and other orders issued. In the order, the defendant, RIM, was found to have infringed certain of plaintiff NTP's patent claims in the '592 patent.

6. Reexamination was ordered pursuant to 37 C.F.R. § 1.931 in the '020 proceeding on August 26, 2003. The decision ordering the *inter partes* reexamination also notified the parties to the reexamination that the decision in the litigation referred to in the notice of concurrent proceedings may be grounds for termination of the instant proceeding.

7. On September 8, 2003, the requester appealed the District Court decision in *NTP, Inc. v. Research In Motion*, *supra*, to the United States Court of Appeals for the Federal Circuit.

8. On October 10, 2003, patent owner filed a petition under 37 C.F.R. § 1.181 in the '020 proceeding, requesting that the *inter partes* reexamination proceeding be dismissed, *i.e.*, terminated. Patent owner argued that the Court's holding and decision in *NTP, Inc. v. Research In Motion*, *supra*, is a "final decision" within the meaning of 35 U.S.C. 317(b), and accordingly, the instant *inter partes* reexamination proceeding filed by the requester,

who is the defendant in that litigation, may not (after the court's order) be maintained by the Office.

9. The Office mailed a decision in the '020 proceeding on June 2, 2004, dismissing the petition under 37 C.F.R. § 1.181.

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 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 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 '020 *inter partes* reexamination proceeding reveals that the original specification, drawings and all patent claims are presently in the reexamination file, *i.e.,* no claims have been amended or added, or cancelled. The *inter partes* reexamination proceeding is ready for the examiner's preparation of the first Office action on the merits.

A review of the prosecution history of the '6495 *ex parte* reexamination proceeding reveals that the original specification, drawings and all patent claims are presently in the reexamination file,

i.e., no claims have been amended or added, or cancelled. An owner's statement pursuant to 37 C.F.R. § 1.530 has been received. The *ex parte* reexamination proceeding is ready for the examiner's consideration of such owner's statement and preparation of a first Office action on the merits.

Accordingly, the claims are 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 95/000,020 and 90/006,495 reexamination proceedings are **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

Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding.*

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

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B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester should be directed:

by Mail to: Attn: "Mail Stop *Inter Partes* Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (703) 305-1013
Central Reexamination Unit

by hand: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2100 Crystal Drive
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 parties, including papers filed *via* facsimile transmission. 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 § 2666.01. 37 C.F.R. § 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. 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. 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.

F. Reexamination Certificate:

At the conclusion of the examination of the merged reexamination proceeding, 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. 95/000,020 and *ex parte* Reexamination Control No. 90/006,495 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The reexamination files are being forwarded via the Technology Center 2600 Group Director to the examiner for the preparation of a first Office action on the merits in the merged proceeding, to be issued in due course.

3. Any questions concerning this communication should be directed to Anton W. Fetting, Reexam Legal Advisor at (703) 305-8449.

Lynn M. Kryza
Senior Special Projects Examiner
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,020	05/29/2003	6317592	81208	3141

803 7590 09/16/2005

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2005

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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9/16/05

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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NOVAK DRUCE & QUIGG, LLP

1300 Eye Street NW, Suite 400 East Tower

Washington, DC 20005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 95/000020

PATENT NO. 6,317,592

ART UNI

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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(For *Inter Partes* Reexamination Requester)

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No.: 6,317,592

DECISION DISMISSING PETITION

This is a decision on the July 7, 2005 patent owner petition filed under 37 CFR §§ 1.181 and 1.907 and 35 U.S.C. § 317 in this merged proceeding, requesting (a) that the 90/006,495 and 95/000,020 reexamination proceedings be severed and (b) that *inter partes* proceeding 95/000,020 be dismissed and terminated pursuant to 37 CFR 1.907. On July 20, 2005, the third party requester filed a petition opposing the patent owner's July 7, 2005 petition to sever and terminate.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the July 7, 2005 patent owner petition.

The July 7, 2005 patent owner petition is dismissed for the reasons set forth below.

In addition, for reasons discussed below, requester's July 20, 2005 opposition petition has not been considered and is being returned to requester by separate mailing on even date.

BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on

November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding). The real party in interest who requested the reexamination proceeding is Research In Motion (RIM).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in Control No. 95/000,020. The Notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 Notice provided a copy of the Court order and its accompanying memoranda and other orders issued by the Court. From the materials provided, it might be interpreted that the District Court found that the defendant, the third party requester, RIM, had not sustained its burden of proving the invalidity of any patent claim in the '592 patent, and that defendant RIM was found to have infringed certain of plaintiff NTP's patent claims in the '592 patent.[1] The Court's decision was appealable within 30 days under Federal Rules of Appellate Procedure Rules 3 and 4,

5. On August 26, 2003, the Office issued an order, in the '020 reexamination proceeding, for *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that a decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181, requesting that the '020 reexamination proceeding be dismissed, i.e. terminated. Patent owner argued that the Court's holding and decision in *NTP, Inc. v. Research In Motion* [2] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), and accordingly, the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant in the litigation, [3] could not be maintained by the Office.

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[1] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant" reported at 270 F. Supp. 2d 751; 67 USPQ2D 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 not invalid. See also *NTP, Inc., v. Research In Motion, Ltd.*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM; presumably at least these claims were held to be "not invalid" in order for them to have been held by the Court to be infringed.

[2] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[3] RIM was the defendant in the court proceedings, and is the real party in interest in the '020 reexamination.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [4]

10. On July 20, 2005, requester filed a petition opposing patent owner's petition to sever the merged proceeding and to dismiss and terminate the '020 inter partes reexamination proceeding.

11. On August 2, 2005, the Federal Circuit issued an Order granted a request for panel re-hearing and rehearing en banc for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion.[5]

12. On August 2, 2005, the Federal Circuit issued a new opinion. [6]

DECISION

I. <u>The Issue Presented:</u>

The record shows that the '020 proceeding *inter partes* reexamination request for reexamination was filed on May 29, 2003 on behalf of RIM (the real party in interest). Reexamination was requested of all of the '592 patent claims. Upon determining that the cited prior art raised a substantial new question of patentability,[7] the Office ordered reexamination on August 26, 2003. Thereafter, on August 9, 2004, the Office merged the '020 *inter partes* reexamination proceeding with the previously ordered '495 *ex parte* reexamination proceeding. [8]

The record further shows that requester RIM is the defendant in a civil action regarding the '592 patent (*NTP, Inc. v. Research In Motion,*), and that petitioner had previously petitioned to dismiss the '020 inter partes reexamination proceeding in light of the decision and supporting orders of the District Court. [9] The petition was dismissed on the grounds that a "final decision" had not yet been issued because the appellate process had not been exhausted (*i.e.*, RIM's appeal to the Federal Circuit was still pending). On December 14, 2004, the Federal Circuit

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[4] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004).
[5] *NTP, Inc. v. Research in Motion*, No. 03-1615, 2005 U.S. App. LEXIS 15804 (Fed. Cir. August 2, 2005).
[6] *NTP, Inc. v. Research in Motion*, No. 03-1615, (Fed. Cir. August 2, 2005).
[7] 35 U.S.C. § 312; 37 CFR 1.923.
[8] See 37 CFR 1.989; see also MPEP § 2686.01.
[9] See notes 1-3, *supra*.

rendered a decision in the *NTP, Inc. v. Research In Motion* litigation. The Federal Circuit affirmed the holding of the District Court that RIM had infringed claims 40, 150, 278, 287, 653 and 654 of the '592 patent. [10] As noted in paragraphs 10 and 11, *supra,* the Federal Circuit 's December 14, 2004 opinion has been withdrawn and a new opinion has issued. [11]

Based upon the December 14, 2004 Federal Circuit's withdrawn decision, petitioner requests that the '020 *inter partes* reexamination proceeding now be severed from the merged proceeding and terminated in accordance with the 35 U.S.C. § 317(b). Petitioner's request is grounded in its position that the December 14, 2004 Federal Circuit's withrawn decision is a "final decision" that has been entered against RIM (the third party requester) with respect to the validity of the '592 patent. Petitioner's position equally applies to the Court's August 2, 2005 opinion because the new opinion merely treats matters involving infringement pursuant to 35 U.S.C. § 271.[12]

II. Applicable Statutory Provision:

A. Section 317(b) of Title 35 provides:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. **This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.** [Emphasis added].

B. The legislative history of this section includes the following material, which identifies that its effect occurs after appeals and that its effect does not extend to issues concerning prior art that was unavailable.

> Sec. 4604. Optional *inter partes* Reexamination Procedure
> *****
> Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for *inter partes* reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for *inter partes* reexamination until an *inter partes* reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. **However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO.** [Emphasis added]. [13]

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[10] *Id.* at 1343; 1236.
[11] See notes 5 and 6, *supra.*
[12] *NTP, Inc. v. Research in Motion,* No. 03-1615, 2005 U.S. App. LEXIS 15804 (Fed. Cir. August 2, 2005).
[13] 106 Cong Rec. S14720, Nov. 17, 1999.

III. Analysis and Findings

Petitioner bases its argument for severing the '020 *inter partes* reexamination proceeding from the '694 *ex parte* reexamination proceeding and then terminating the '020 proceeding, upon certain language appearing in the Office's June 2, 2004 decision. The Office's June 2, 2004 decision dismissed the owner's October 10, 2003 petition which requested the '020 *inter partes* reexamination proceeding be dismissed. Specifically, petitioner quotes the June 2, 2004 decision as stating that "the examination and prosecution will continue until requester has exhausted all its appeal avenues, or the time for such expires."[14] Petitioner alleges that "[t[he Office previously recognized that dismissal of this *inter partes* reexamination would be required when a final decision was reached in the NTP versus RIM litigation."[15] Petitioner argues that, based on the December 14, 2004 Federal Circuit's withdrawn decision, the requester has now exhausted all its appeal avenues, and therefore alleges the Federal Circuit's withdrawn decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Accordingly, petitioner urges that the Office must now sever and terminate the '020 *inter partes* reexamination proceeding in accordance with 35 USC § 317(b). Petitioner's position is not persuasive for a number of reasons.

A. Petitioner Has Not Shown That The Federal Circuit Decision Is A "Final Decision" Pursuant to 35 U.S.C. § 317(b)

Petitioner has not presented sufficient information from which to conclude that RIM's appeal rights are exhausted. The Federal Circuit decision is not a "final decision" because, the Federal Circuit vacated and remanded to the District Court for more work to be performed on one of the issues before the Court on appeal. Accordingly, it is entirely possible for the District Court to alter it previous decision concerning the validity of the claims at issue in the pending inter partes reexamination proceeding. Such a decision is not a "final decision" as required by 35 U.S.C. § 317(b) because on remand the lower district court would be required to conduct further work and, therefore, would not be a final exhaustion of all appeals.

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as after a Federal Circuit decision. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[17]

Section 317(b) of Title 35, in pertinent part, states:

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[14] See petition, pg. 5, last sentence, quoting the Decision Dismissing Petition dated June 2, 2004, page 11, item number 2.

[15] Petition, page 6, last paragraph.

[16] See Fed. Cir. R. 41.

[17] It should be noted that a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only "final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not final until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. As explained in its earlier decision, the Office interprets the term "final decision" for either proceeding[18] as "after all appeals" when the parties' obligations become fixed. *See* MPEP § 2686. The Office's interpretation is sound for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

First, "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law that holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a). Clearly, Office proceedings will not terminate if the Federal Circuit issues a remand order requiring the lower tribunal to perform further work that can ultimately be appealed again up to the Federal Circuit.

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after any appeals. *See* 35 U.S.C. § 315 (c) (barred from raising invalidity in a civil action if previously "finally" held valid in a *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are

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[18] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is easy to see that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office. Moreover, when a district court, as in this case, has been ordered on remand by the Federal Circuit to do further work that may alter its original decision, it is clear that any initial decision it previously entered is not final with respect to the issues it has been ordered to address.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> . . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised . . . .

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic and policy support construing the term "final decision" as "after all appeals." For example, in this case, the district court entered an initial decision but has now been ordered to reconsider its decision on remand by the Federal Circuit. Termination of the *inter partes* proceeding prior to exhaustion of appeals would be premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the reexamination proceedings. A completely new request for reexamination would have to be made in a redundant fashion. Clearly, such redundancy is a result Congress did not intend in light of the fact that it provided the PTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to

work properly. In this case, such a "final decision" will not take place until after the district court completes the further work it was ordered to do and any subsequent appeals from its decision are exhausted.

Thus, the Federal Circuit's December 14, 2004 withdrawn decision has not been shown to be a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 *inter partes* reexamination proceeding has not been shown to be required by the statute.

In addition, it appears from the Federal Circuit's replacement August 2, 2005 decision that the issue remanded to the District Court directly bears on the interpretation of a claim limitation appearing in claim 40 of the '592 patent.[19] Presumably, the District Court's construction of the limitation, on remand, will affect issues directly bearing on the '020 *inter partes* reexamination proceeding, and the merged proceeding as a whole. Thus, Petitioner has not shown that there is a "final decision" with respect to the claim validity issue raised in the inter partes reexamination.[20] Petitioner has not demonstrated that RIM will be unable to obtain a different outcome (from the initial District Court finding) regarding the interpretation of one or more of the claims of the '592 patent, and that a different interpretation would not necessarily require that the Court revisit the issue of the validity of the involved claim or claims.

In summary, if further court review can still be sought,[21] then the Federal Circuit decision is not a "final decision" within the meaning of 35 U.S.C. § 317(b). Certainly, petitioner has not supplied sufficient information to establish on the record that the Federal Circuit decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 reexamination proceeding is not required by the statute. Accordingly, there is presently no reason to sever the '020 *inter partes* reexamination proceeding from the merged '495 *ex parte* reexamination proceeding and terminate '020 *inter partes* proceeding, particularly given that the issues in both proceedings are integrally intertwined.

B. Petitioner Has Not Demonstrated That The '020 *Inter Partes* Reexamination Proceeding Is Based Solely On Patents of Printed Publications "Available" to the Requester During the Litigation

Even if petitioner could demonstrate that there has been a "final decision" in the litigation between NTP and RIM within the meaning of 35 USC § 317(b), it appears from a consideration of the language of 35 U.S.C. § 317(b), read in light of the legislative history of that statute, [22] that in certain circumstances, the statute would nevertheless permit the '020 *inter partes* reexamination proceedings to be maintained.

35 U.S.C. § 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

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[19] 392 F. 3d 1336, 1349; 73 USPQ2d 1231, 1241, and, in particular, footnote 5 of the opinion.
[20] The only issue on remand is directed to infringement, as implied by the petition at page 5, lines 1-4.
[21] Or, the decision is "final" in the sense that it is ripe for appeal and the period for seeking review has expired.
[22] See page 4, *supra*.

The legislative history reproduced (and cited) above states:

> "[T]he third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."

In the present instance, a review of the '020 *inter partes* reexamination proceeding, and of the litigation papers made of record by patent owner therein, [23] shows that the patents and printed publications of record in the '020 reexamination *inter partes* reexamination proceeding far outnumber the patents and printed publications **specifically** identified and discussed in the litigation related papers and reported decisions. Further, patent owner's June 30, 2004, Information Disclosure Statement (in the '020 *inter partes* reexamination proceeding) noted that <u>less than all</u> the prior art submitted by the third party requester was submitted in the litigation. Thus, the art advanced by requester in the reexamination proceeding may not be barred by 35 U.S.C. § 317(b), unless petitioner can show that the art:

(a) was "raised" in the District Court litigation, or
(b) "could have" been raised in the litigation by requester.

As to (b) petitioner must show that RIM had a legal right, as to the patent or printed publication, to introduce it into the litigation after it became "available" to RIM.

In addition, it appears from the record that the litigation involving the '592 patent was filed in 2001, and the '020 *inter partes* reexamination proceeding was filed in 2003. Petitioner must show that the patent or printed publication became "available" prior to RIM's filing of the request for *inter partes* reexamination. If the patent or printed publication became "available" at or subsequent to RIM's filing of the request for *inter partes* reexamination, then RIM had a legal right to present it. 35 U. S. C. § 317(b).

Accordingly, petitioner has not demonstrated that all of the patents and printed publications deemed to demonstrate a substantial new question of patentability in the August 26, 2003 order granting reexamination were raised (or could have been raised) in the District Court litigation. Therefore, petitioner has not demonstrated a critical fact to warrant sever and termination of the '020 inter partes reexamination proceeding pursuant to 35 U.S.C. § 317(b).

C. <u>Petitioner Has Not Shown That All of the Claims of The '592 Patent Have Been Held "Not Invalid":</u>

We assume that the district court's prior art validity determination is limited to only those claims that NTP asserted RIM infringed. It does not appear that RIM attempted to invalidate every claim of the patents. With respect to the '592 patent, the issues of infringement and validity appear limited to of claims 40, 150, 278, 287, 653 and 654. Given that only six out of six

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[23] See note 1, supra. Petitioner has now made of record the reported decision of the CAFC on appeal from the District Court.
[24] Petition, page 2, third paragraph, second sentence
[25] Petition, page 3, 4th Statement of Fact

hundred and sixty-five claims of the '592 patent were **specifically** identified in the District Court's final order (August 5, 2003), the District Court's published opinions,[27] and Federal Circuit's published decision,[28] Petitioner has not clearly established that the courts have reached a holding that **all** of the '592 claims are "not invalid" (*i.e.*, valid over the issues addressed in the litigation).

The estoppel effect provided by 35 USC § 317(b) is on a "claim by claim" basis and therefore, each claim must be independently analyzed. 35 USC 317(b) states that:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of **such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. [Emphasis added.]

The petitioner has not clearly pointed out the basis for its position that **all** of the '592 claims have been held "not invalid."[29,30] Further, given the lack of clarity in the case reports as to whether **all** of the '592 patent claims or only those **specifically** identified by claim number were determined to be "not invalid," the Office cannot conclude that the claims which have been held "not invalid" include "any such patent claim" other than claims 40, 150, 278, 287, 653 and 654 (the claims **specifically** identified). Therefore, it appears, that on the existing record, even if the '020 *inter partes* reexamination proceeding were to be severed from the merged proceeding, 35 U.S.C. § 317(b) would **not** require that the '020 *inter partes* reexamination be terminated. Rather, the '020 *inter partes* reexamination proceeding would continue with respect to the patent claims not addressed by the litigation, and the intertwined issues of the two reexamination proceedings would continue on independently. This is not a desirable result. Absent any basis for termination of the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue as a merged proceeding.

Treatment of Requester's Petition in Opposition to Patent Owner's Petition to Sever

A review of requester's petition shows that petition is not enterable into the record of this merged proceeding for several reasons. Therefore, the petition is being returned to requester by a separate mailing of even date. That mailing will address the reasons for non-entry of requester's petition in detail.

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[26] Petition, page 4, penultimate statement of fact.
[27] See note 1, *supra*
[28] See note 7, *supra*
[29] See note 14, *supra*
[30] It is presumed that only claims that are "not invalid", i.e. valid, can be infringed, and so it is clear that claims 40, 150, 278, 287, 653 and 654 of the '592 patent, which have specifically been held to be infringed, have been held to be "not invalid."

Conclusion

1. The petition to sever the '020 *inter partes* reexamination proceedings from its merger with the '6495 proceeding and to then terminate the '020 *inter partes* reexamination proceedings is dismissed.

2. Petitioner has not demonstrated that the decision on appeal by the Federal Circuit is a "final decision" within the meaning of 35 USC § 317(b) so as to satisfy one of the statutory requirements for termination of *inter partes* reexamination proceeding '020.

3. Petitioner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent or was unavailable to the requester for entry into the litigation. Thus, another of the statutory requirements for termination of *inter partes* reexamination proceeding '020 has not been satisfied.

4. Petitioner has not demonstrated that any claims of the '592 patent other than claims 40, 150, 278, 287, 653 and 654 have been held by the courts to be "not invalid." Thus, yet another of the statutory requirements for termination of *inter partes* reexamination proceeding '020 has not been satisfied.

5. The merger of the '6495 *ex parte* reexamination proceeding with '020 *inter partes* reexamination proceeding, will continue, i.e., will not be severed, as petitioner has not demonstrated that there is a statutory basis to terminate the '020 *inter partes* reexamination proceeding.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
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 St.
Alexandria, VA 22314

7. Telephone inquires with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, and in his absence, to the undersigned, at (571) 272-7710.

Kenneth M. Schor,
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
For Patent Examination Policy

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9-14-05

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(For *Inter Partes* Reexamination Requester)

MAILED

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REEXAM UNIT

In re Campana, Jr. et al	:	
Inter Partes Reexamination Proceeding	:	
Control No.: 95/000,020	:	
Filed: May 29, 2003	:	
For: U.S. Patent No. 6,317,592	:	**DECISION**
	:	**DENYING**
In re Campana, Jr. et al	:	**PETITION**
Ex Parte Reexamination Proceeding	:	
Control No.: 90/006,495	:	
Filed: December 26, 2002	:	
For: U.S. Patent No.: 6,317,592	:	

This is a decision on the October 7, 2005 patent owner [1] petition filed under 37 CFR §§ 1.181 and 1.907 and 35 U.S.C. § 317 in this merged proceeding. The present petition requests reconsideration of the Office's September 16, 2005 decision dismissing patent owner's July 7, 2005 original petition; in that original petition, the patent owner requested that the 90/006,495 and 95/000,020 reexamination proceedings be severed, [2] and that *inter partes* proceeding 95/000,020 be dismissed and terminated pursuant to 37 CFR 1.907. In addition to requesting reconsideration of the September 16, 2005 decision, the present petition requests that the Office declare its decision to constitute a final agency action within the meaning of 5 U.S.C. § 704.

[1] United States Patent No. 6,317,592 is owned by NTP, Inc. All references, *infra*, to NTP, Inc are to be understood as referring to the "patent owner."

[2] The July 7, 2005 original "Petition to Sever and Dismiss ... *Inter Partes* Reexamination ..." did not request that the requested relief be in any way limited to any particular claims, or to any particular number of claims. The request for reconsideration now requests that the merged proceeding be terminated with respect to at least the six claims of United States Patent No. 6,317,592 for which validity has "been fully adjudicated," and requests dismissal and termination of the severed 95/000,020 *inter partes* reexamination proceeding.

On October 21, 2005, the third party requester [3] filed a petition in opposition to the patent owner's October 7, 2005 request for reconsideration and for designation of any decision reached as being as a final agency action.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the present patent owner and third party requester petitions.

SUMMARY

The October 7, 2005 patent owner petition is granted to the extent that (a) the September 16, 2005 decision on the July 7, 2005 patent owner petition has been fully reconsidered, and (b) the instant decision is designated as a final agency action under 5 U.S.C. § 704. However, for the reasons set forth below, patent owner's request for reconsideration is denied with respect to the underlying requested relief of severing the merged proceeding and terminating the 95/000,020 *inter partes* reexamination proceeding.

In addition, for reasons discussed below, the third party requester's October 21, 2005 opposition petition is granted to the extent that the merged reexamination proceeding will not be severed and the 95/000,020 *inter partes* reexamination proceeding will not be terminated, but is denied insofar as it opposes designating the instant decision as being a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in Control No. 95/000,020. The notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 notice provided a copy of the court order and its accompanying memoranda and other orders issued by the court. The materials were provided by the patent owner for the purpose of asserting that the District Court found the defendant, third party requester RIM, (a) not to have sustained its burden of proving the invalidity of any patent claim in the '592 patent, and (b) to have infringed

[3] The third party requester in *inter partes* reexamination proceeding 95/000,020 is David L. Stewart. However, the real party in interest is Research in Motion, Ltd. (hereinafter "RIM"). All subsequent references to RIM are to be understood as referring to the "third party requester."

certain of plaintiff NTP's patent claims in the '592 patent. [4] Pursuant to Federal Rules of Appellate Procedure Rules 3 and 4, the District Court's decision was appealable within 30 days.

5. On August 26, 2003, the Office issued an order in the '020 reexamination proceeding granting *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that the decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181 (the "original" petition), requesting that the '020 reexamination proceeding be dismissed, *i.e.*, terminated. Patent owner argued that the District Court's holding and decision in *NTP, Inc. v. Research In Motion* [5] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), and accordingly, the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant in the litigation, could not be maintained by the Office.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by the provisions of 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [6]

10. On July 7, 2005, patent owner filed a petition to sever the instant merged proceeding and to dismiss and terminate the '020 *inter partes* reexamination proceeding.

11. On July 20, 2005, requester filed a petition opposing patent owner's July 7, 2005 petition.

12. On August 2, 2005, the Federal Circuit issued an Order granted a request for panel rehearing and rehearing *en banc* for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion. [7]

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[4] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "*NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant*" reported at 270 F. Supp. 2d 751; 67 USPQ2d 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 to be not invalid. See also *NTP, Inc., v. Research In Motion, Ltd.*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM; presumably, at least these claims were held to be "not invalid" in order for them to have been held by the court to be infringed.

[5] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[6] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004).

[7] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282; 75 USPQ2d 1763 (Fed. Cir. 2005)

13. On August 2, 2005, the Federal Circuit also issued a substituted opinion. [8]

14. On August 16, 2005, third party requester filed a petition for panel rehearing and rehearing *en banc*, based upon the Federal Circuit's August 2, 2005 opinion.

15. On September 16, 2005, the Office rendered a decision dismissing the patent owner's July 7, 2005 petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding.

16. On September 28, 2005, the Office issued a first Office action on the merits (*i.e.*, on the patentability of the '592 patent claims) in which all patent claims, *i.e.* claims 1-665, were rejected. The rejection was based upon prior art (*e.g.* the so-called "TeleNor" prior art), which was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been individually ordered and subsequently merged into a single proceeding. The TeleNor prior art does not appear to have been considered during any of the court proceedings.

17. On October 7, 2005, the Federal Circuit denied the third party requester's petition for a panel hearing and rehearing *en banc*. [9]

18. Also on October 7, 2005, the patent owner filed the instant petition requesting reconsideration of the September 16, 2005 decision, and designation of the decision on the request for reconsideration as a final agency action under 5 U.S.C. § 704.

19. A motion to stay issuance of the Federal Circuit's mandate was filed by RIM on October 13, 2005.

20. On October 21, 2005, the Federal Circuit denied the motion to stay and issued its mandated, remanding the case to the District Court for further proceedings pursuant to the Federal Circuit's August 2, 2005 substituted opinion. [10]

21. On October 21, 2005, the third party requester filed a petition in opposition to the patent owner's October 7, 2005.

22. Subsequent news reports state that that RIM has petitioned Chief Justice Roberts for a stay of the Federal Circuit's mandate pending filing of a petition for certiorari, but the stay was denied. [11]

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[8] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282; 75 USPQ2d 1763 (Fed. Cir. 2005)
[9] *NTP, Inc. v. Research in Motion, Ltd.*, No 03-1615 (Fed. Cir. October 7, 2005)
[10] The substituted opinion is referenced in note 8, *supra*.
[11] *Patent Trademark & Copyright Journal*, Vol. 70 No. 1742, 10/28/05 (BNA). See also "Third Party Requester's ...Opposition to Patent Owner's request for Reconsideration ...", October 21, 2005, at page 9.

DECISION ON PATENT OWNER REQUEST FOR RECONSIDERATION

I. Relief Requested By Patent Owner:

In the instant request for reconsideration, patent owner renews its request that the merged proceeding be severed and that the '020 *inter partes* reexamination proceeding then be terminated. As footnoted above, in the instant request for reconsideration, patent owner requests the Office to sever the merged proceedings for at least six claims of the '592 patent that have been adjudicated as valid, but also requests that the '020 *inter partes* proceeding then be dismissed and terminated. This decision will treat the issue of severance with respect to all claims of the '592 patent and fewer than all claims of the '592 patent, and will also treat the issue of dismissal and termination of the '020 *inter partes* proceeding with respect to all claims of the '592 patent and fewer than all claims of the '592 patent.

II. Summary Of The Issue Presented And Its Resolution:

The issue presented by patent owner can be summarized as being whether the estoppel provisions of 35 USC § 317(b) divest the Office of jurisdiction in the '020 *inter partes* proceeding based on the Federal Circuit ruling and apparent affirmance of the decision of the District Court with respect to claim validity. For the reasons discussed, *infra*, the Office finds that the estoppel provisions of 35 USC § 317(b) do not divest the Office of jurisdiction in the '020 *inter partes* proceeding. The Office concludes that the language of 35 USC § 317(b) divests the Office of jurisdiction to engage in *inter partes* reexamination only when all appeal rights are exhausted insofar as a party to the litigation has no further right to appeal to a higher court or otherwise seek review on the merits by a higher court, and the litigation proceeding is terminated. In this instance, the litigation proceeding has not terminated.

III. Applicable Statutory Provision:

A. Section 317(b) of Title 35 provides:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. **This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.** [Emphasis added].

B. The legislative history of this section includes the following material, which identifies that its effect occurs after appeals and that its effect does not extend to issues concerning prior art that was unavailable:

> Sec. 4604. Optional *inter partes* Reexamination Procedure
> *****
> Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for *inter partes* reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for *inter partes* reexamination until an *inter partes* reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. **However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO.** [Emphasis added]. [12]

IV. Discussion Of September 16, 2005 Decision Dismissing The Underlying Original Petition (To Sever The Merger And Terminate The '020 Proceeding) Filed On July 7, 2005

In the original petition filed on July 7, 2005, patent owner based its argument for severing the '020 *inter partes* reexamination proceeding from the '694 *ex parte* reexamination proceeding and then terminating the '020 proceeding, upon certain language appearing in the Office's June 2, 2004 decision. The Office's June 2, 2004 decision had dismissed patent owner's October 10, 2003 petition requesting that the '020 *inter partes* reexamination proceeding be dismissed. Specifically, patent owner quoted the June 2, 2004 decision as stating that "the examination and prosecution will continue until requester has exhausted all its appeal avenues, or the time for such expires." [13] Patent owner alleged in the original petition that "[t[he Office previously recognized that dismissal of this *inter partes* reexamination would be required when a final decision was reached in the NTP versus RIM litigation." [14]

The relief requested in patent owner's original petition filed on July 7, 2005 was that the merged reexamination proceeding be severed, and that the '020 *inter partes* reexamination proceeding then be terminated. When that petition was filed, the basis for the relief requested by patent owner was that the December 14, 2004 Federal Circuit decision [15] on appeal from the District Court's decision [16] constituted a "final decision" within the meaning of 35 U.S.C. §317(b). [17] Patent owner reasoned that because the Federal Circuit had rendered a final holding of validity with respect to the claims of the '592 patent, 35 U.S.C. § 317(b) precluded the Office from maintaining the '020 *inter partes* reexamination proceeding. Patent owner argued that because the Office could not maintain the '020 *inter partes* reexamination proceeding, the Office was required to (a) sever the merged proceeding, thereby separating the '020 *inter partes* proceeding

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[12] 106 Cong Rec. S14720, Nov. 17, 1999.
[13] See "Petition to ... Sever and Dismiss ..." dated July 7, 2005, page 5, last sentence, quoting the Decision Dismissing Petition dated June 2, 2004, page 11, item number 2.
[14] See "Petition to ... Sever and Dismiss ..." dated July 7, 2005, page 6, last paragraph.
[15] See footnote 6, *supra*.
[16] See item 4 in the "Background," *supra*.
[17] See "Petition to Sever and Dismiss ... *Inter Partes* Reexamination ... ", July 7, 2005, at pages 5-7.

and the '495 *ex parte* reexamination proceeding into two distinct proceedings, and then (b) terminate the '020 *inter partes* proceeding.

The decision of Senior Legal Advisor Schor (hereinafter, the "Office") dismissed the original July 7, 2005 petition for a number of reasons. The Office held that the Federal Circuit decision relied upon by patent owner [18] was not a "final decision" within the meaning of 35 U.S.C. 317(b). Rather, a decision is a "final decision" pursuant 35 U.SC. § 317(b) only after all appeals from that decision are exhausted. The Office decided that, as there had been no final decision on the validity of claims because all appeal rights had not been exhausted, the estoppel provisions of 35 U.S.C. § 317(b)(4) had not been triggered in the present case. [19]

It was further noted that 35 U.S.C. § 317(b) states that "[t]his subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." It appeared from the record of the merged reexamination proceeding that the merged proceeding was being conducted before the Office based upon significantly more applied prior art than had been asserted during the litigation. Patent owner failed to demonstrate that the prior art relied upon by the Office in the merged reexamination proceeding (in which a Director Ordered *ex parte* reexamination proceeding that was ordered on December 26, 2002 was merged with an *inter partes* reexamination proceeding filed on May 29, 2003) was not unavailable to the third party requester during the litigation that commenced in the District Court on November 13, 2001 and concluded in the District Court on May 23, 2003, *i.e.*, was not "newly discovered prior art unavailable to the third party requester and the ... Office at the time of the *inter partes* reexamination proceedings" Therefore, the Office also decided that even assuming, *arguendo*, that the Federal Circuit decision constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), the termination of the '020 *inter partes* reexamination proceeding (and severance of the merged reexamination proceeding) was not required by 35 U.S.C. § 317(b), because, if the proceedings were severed, the '020 *inter partes* reexamination proceeding would still present to the Office a proceeding based upon prior art that was not available to the third party requester (and Office) during the litigation, and, perforce, was not relied upon in the litigation. [20]

In addition, the Office noted that patent owner failed to demonstrate that all of the '592 patent claims had ever been held to be "valid" or "not invalid" in the litigation. It was stated that, from the litigation record, it appeared that only 6 of the 665 claims of the '592 patent had been held to be infringed, and, therefore, held to be "not invalid." The Office pointed out that no other patent claim had been (even inferentially) held to be invalid. Accordingly, even if the merged proceeding were to be severed as requested, the '020 *inter partes* reexamination proceeding would continue with respect to at least 659 claims of the '592 patent. Additionally, the *ex parte* reexamination proceeding would remain, with all 665 claims of the '592 patent subject to reexamination. It was deemed to be undesirable for the two severed proceedings to

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[18] As set forth in the Background section, *supra*, the December 14, 2004 Federal Circuit decision relied upon by patent owner as being a "final decision" had been withdrawn after the petition was filed, and a substituted decision dated August 2, 2005 had been issued by the Federal Circuit. The Office took the position that the August 2, 2005 was also not a "final" decision with the meaning of 35 U.S.C. § 317(b). See Decision Dismissing Petition, dated September 16, 2005, at pages 5-8.

[19] "Decision Dismissing Decision", September 6, 2005, pages 5-8.

[20] *Id*, at pages 8 and 9. This finding by the Office was made prior to the September 28, 2005 Office action in which the so-called "TeleNor" prior art was applied against the claims. The TeleNor prior art provides new art which clearly was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been ordered and merged, and was not considered during any of the court proceedings, <u>and further distances the instant proceeding from the estoppel of 35 U.S.C. § 317(b)</u>.

continue independently of one another, rather than as a single merged proceeding, especially in view of the overlapping issues that would be present in the independent proceedings. [21]

V. Further Analysis And Findings

In support of patent owner's position, the present petition (requesting reconsideration) incorporates by reference all of the arguments made in patent owner's original petition filed on July 7, 2005.[22] However, patent owner's main argument is that there can be no dispute that the validity of the claims of the '592 patent was litigated in a civil action involving the requester, "with the resultant holding that these claims were not invalid." Patent owner further argues that this holding "was part of a final judgment by the United States District Court for the Eastern District of Virginia," an assertion first made by patent owner in a petition filed on October 10, 2003 and subsequently reasserted in patent owner's original July 7, 2005 petition that was based on the Federal Circuit's December 14, 2004 decision on RIM's appeal from the District Court. [23]

Patent owner argues that 35 U.S.C. § 317(b) does not simply say "once a final decision has been entered against a party in a civil action." Nor does Section 317(b) require entry of a "final judgment." Patent owner reads the term "final decision" as being qualified to state ***"[o]nce a final decision has been entered against a party in a civil action ... that the party has not sustained its burden of proving the invalidity of any patent claim in suit ..."*** (Emphasis added by patent owner.) Patent owner concludes that the statute does not require that a decision be "final" with respect to all issues in the case, but only requires that a final decision has been reached with respect to the pertinent validity issues. Patent owner believes that the instant facts show that a final decision on the pertinent validity issues has been reached in the '592 patent litigation. Patent owner's position is that even if litigation is ongoing with respect to issues other than claim validity, such as damages, scope of injunctive relief, etc., the litigation is nevertheless final on the question of claim validity within the meaning of 35 U.S.C. § 317(b).[24] This argument is addressed as now follows.

A. Patent Owner Has Not Established That Third Party Requester's Litigation Appeal Rights Have Been Exhausted Within The Meaning of 35 U.S.C. § 317(b)

The record of the '020 proceeding shows that the request for *inter partes* reexamination was filed on May 29, 2003 on behalf of RIM (the real party in interest). Reexamination was requested for all of the '592 patent claims. Upon determining that the cited prior art raised a substantial new question of patentability, [25] the Office ordered reexamination on August 26, 2003. Thereafter, on August 9, 2004, the Office merged the '020 *inter partes* reexamination proceeding with the previously ordered '495 *ex parte* reexamination proceeding. [26] The litigation record reveals that requester RIM is the defendant in a civil action regarding the '592 patent (*NTP, Inc. v. Research In Motion*).

Patent owner has previously petitioned to dismiss the '020 *inter partes* reexamination proceeding in light of the District Court's decision and supporting orders in the civil action,

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[21] *Id.* at page 10.
[22] "Request for Reconsideration ... " dated October 7, 2005, page 2.
[23] Although not expressly stated by patent owner, it is presumed that patent owner now intends to refer to the substituted Federal Circuit decision of August 2, 2005 as the "final decision" on validity. See the Background section, supra, specifically items 4, 6, 9 and 13.
[24] "Request for Reconsideration ..." dated October 7, 2005 at pages 2-3.
[25] 35 U.S.C. § 312; 37 CFR 1.923.
[26] See 37 CFR 1.989; see also MPEP § 2686.01.

which are adverse to RIM. [27] The Office dismissed the previous petition on the grounds that a "final decision" had not yet been issued for the civil action, because the appellate process had not been exhausted (*i.e.*, RIM's appeal to the Federal Circuit was still pending). On December 14, 2004, the Federal Circuit rendered a decision in the *NTP, Inc. v. Research In Motion* litigation. The Federal Circuit affirmed the holding of the District Court that RIM had infringed claims 40, 150, 278, 287, 653 and 654 of the '592 patent. [28] As noted in paragraphs 10 and 11, *supra*, the Federal Circuit 's December 14, 2004 opinion was withdrawn and a new opinion has issued. [29]

The record also shows that the Federal Circuit's December 14, 2004 decision [30] was withdrawn in favor of a new decision by the Federal Circuit, as a result of a petition for rehearing that was granted on August 2, 2005. [31] Under the interpretation of 35 U.S.C. § 317(b) that patent owner previously advanced, patent owner would have had the Office sever the merged proceeding and terminate the *inter partes* proceeding based upon a decision by the Federal Circuit that was, *almost nine months subsequent to the decision*, withdrawn by the court and could well have resulted in the Federal Circuit taking an entirely different position vis-à-vis claim validity. **In and of itself, this should be sufficient to demonstrate that a decision of a court is not final until all parties have exhausted all rights subsequent to the court's decision.** Nevertheless, a detailed analysis of the meaning of "final decision" in 35 USC § 317(b) is presented below.

B. Patent Owner Has Still Not Shown That The Federal Circuit Decision Is A "Final Decision" Pursuant to 35 U.S.C. § 317(b)

Petitioner has not presented sufficient information from which to conclude that RIM's appeal rights are exhausted. The Federal Circuit decision of August 2, 2005 is not a "final decision" on claim validity, because the Federal Circuit vacated and remanded to the District Court for more work to be performed on an issue that may well effect claim validity. It is entirely possible for the District Court to alter its previous decision concerning the validity of the claims, which are also at issue in the present pending *inter partes* reexamination proceeding. Such a decision is not a "final decision" as required by 35 U.S.C. § 317(b), because, on remand, the District Court is required to conduct further work resulting in a different result subject to appeal. Therefore, there would not be a final exhaustion of all appeals. Even further, it is noted that while third party requester's petition for a stay of the Federal Circuit's injunction has been denied by Chief Justice Roberts, [32] third party requester has stated that it has a right to file a petition for *certiorari* to the United States Supreme Court and intends to do so. [33]

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as after a Federal Circuit decision with exhaustion of all appeal avenues as to the litigation. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[34]

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[27] See notes 1-3, *supra*.
[28] *Id.* at 1343; 1236.
[29] See notes 5 and 6, *supra*.
[30] A decision argued as being "final" by patent owner in the July 7, 2005 "Petition to ... Sever and Dismiss ..."
[31] See Background section, *supra*, specifically items 12 and 13.
[32] See Background section, item 21.
[33] Third Party Requester's Petition ... in Opposition to Patent Owner's Request for Reconsideration... ", October 21, 2005 at page 9. See also Sup. Ct. R. 13., which provides a 90 day period to petition for certiorari.
[34] It should be noted that a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. As explained in both of the earlier decisions on petition, the Office interprets the term "final decision" for both reexamination and civil action proceedings [35] as "after all appeals" when the obligations of both parties become fixed. *See* MPEP § 2686. The Office's interpretation is sound for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

Initially, it is to be noted that "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law, which holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a). Clearly, Office proceedings will not terminate if the Federal Circuit issues a remand order requiring the lower tribunal to perform further work that itself can ultimately be appealed to the Federal Circuit.

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court (litigation) proceedings and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after any appeals. *See* 35 U.S.C. § 315 (c) (third party is barred from

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"final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not final until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

[35] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

raising invalidity in a civil action if claims previously "finally" held valid in an *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is clear that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office. Moreover, when a district court, as in this case, has been ordered on remand by the Federal Circuit to do further work that may alter its original decision, it is clear that any initial decision it previously entered is not final with respect to the issues it has been ordered to address.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> ... if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised ...

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic and policy support construing the term "final decision" as "after all appeals." For example, in this instance, the District Court entered a decision but has now been ordered to reconsider its decision on remand by the Federal Circuit. Termination of the *inter partes* proceeding prior to exhaustion of appeals would be premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the *inter partes* reexamination proceeding. [36] A completely new request for reexamination would have to

[36] Indeed, it is not clear how the Office could grant the requested relief of **severing** the merged proceeding only with respect to the six claims determined to be "not invalid." It is also not clear why severing the merged proceedings on this basis would mandate terminating and dismissing the '020 inter partes reexamination proceeding in its entirety, notwithstanding that 659 claims would remain in the '592 that were not subject to any determination of validity in the litigation.

be made in a redundant fashion, and the added time needed to go through this redundant process clearly runs counter to the "special dispatch" mandate of 35 U.S.C. 314(c). Clearly, such redundancy is a result that Congress did not intend in light of the fact that it provided the USPTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to work in the efficient manner intended by Congress. In this case, such a "final decision" will not take place until after the District Court completes the further work it was ordered to do and any subsequent appeals from the District Court's subsequent decision are exhausted.

Thus, the Federal Circuit's August 2, 2005 decision has not been shown to be a "final decision" within the meaning of 35 U.S.C. § 317(b). Accordingly, termination of the '020 *inter partes* reexamination proceeding has not been shown to be required by the statute.

In addition, it appears from the Federal Circuit's replacement August 2, 2005 decision that the issue remanded to the District Court directly bears on the interpretation of a claim limitation appearing in claim 40 of the '592 patent. [37] Presumably, the District Court's construction of the limitation, on remand, could well effect issues directly bearing on the '020 *inter partes* reexamination proceeding, and the merged proceeding as a whole. Thus, patent owner has not shown that there has been a "final decision" with respect to the claim validity issue raised in the *inter partes* reexamination. Even if the only issue on remand is directed to claim interpretation with respect to infringement, petitioner has not demonstrated that a different construction of the claim would not require revisiting of the validity of the reinterpreted claim. Thus, notwithstanding patent owner's arguments that 35 U.S.C. § 317(b) defines "final decision" in the context of decisions on claim validity, it is clear that the action taken on remand in the District Court may reasonably have a potential impact on claim validity. Even crediting patent owner's position that continuing litigation on issues other than claim validity does not necessarily mean that a given court decision on claim validity is not final, petitioner has nevertheless failed to demonstrated that in this case, RIM will be unable to obtain a different outcome (from the initial District Court finding) regarding the interpretation of one or more of the claims of the '592 patent, and that a different interpretation would not necessarily require that the court revisit the issue of the validity of the involved claim or claims.

Further, there is still the matter of third party requester's right to petition for *certiorari* to the United States Supreme Court from the Federal Circuit's holding of claim validity. It appears that third party requester has the right to petition for *certiorari* on the issue of claim validity through January 5, 2006. [38] In light of this fact, it clearly cannot be concluded that the decision of the validity of *any* claims held valid in the litigation to date is a final decision.

Finally, if the merged proceeding were severed, the '495 *ex parte* reexamination proceeding would still remain intact. The estoppel provisions of 35 U.S.C. § 317(b) would not apply to that proceeding. Pursuant to the guidance provided by the Federal Circuit, the Office would be required to continue the '495 *ex parte* reexamination proceeding notwithstanding that there has been a final holding of claim validity. [39] In the event that the "final decision" of the Federal Circuit were then subsequently modified on the issue of claim validity (whether as a result of a determination on the remand to the District Court or as a result of a review of the Federal Circuit's decision on *certiorari* to the United States Supreme Court) and the litigation on the

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[37] 392 F. 3d 1336, 1349; 73 USPQ2d 1231, 1241, and, in particular, footnote 5 of the opinion.
[38] See note 42, *supra*.
[39] *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988)

question of claim validity then continued, the Office could find itself in a position of having to conduct two separate reexamination proceedings on the same patent, with the proceedings being at two diverse and distinct stages. Many scenarios can be envisioned in which the *ex parte* proceeding might have to be delayed (contrary to the statutory mandate of "special dispatch") pending any prosecution necessary to bring a newly re-started (or re-filed) *inter partes* proceeding to the same point in prosecution as the on-going *ex parte* reexamination proceeding that has continued in the Office. [40] Construing 35 U.S.C. § 317(b) to require that the Office proceed with the *ex parte* proceeding while terminating, or even suspending, the *inter partes* proceeding does not bode well for conducting orderly proceedings within the Office, since the *inter partes* proceeding may potentially have to re-started or reconstituted as a result of a modification on the question of claim validity resulting from ongoing litigation.

In summary, if further court review can still be sought, [41] then the Federal Circuit decision is not a "final decision" within the meaning of 35 U.S.C. § 317(b). Patent owner has not supplied sufficient information to establish on the record that the Federal Circuit decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 reexamination proceeding is not required by the statute. Accordingly, there is presently no reason to sever the '020 *inter partes* reexamination proceeding from the merged '495 *ex parte* reexamination proceeding and terminate the '020 *inter partes* proceeding, particularly given that the issues in both proceedings are integrally intertwined.

C. Patent Owner Has Not Demonstrated That The '020 *Inter Partes* Reexamination Proceeding Is Based Solely On Patents Of Printed Publications "Available" To The Requester (Or Office) During The Litigation

Even if petitioner could demonstrate that there has been a "final decision" in the litigation between NTP and RIM within the meaning of 35 USC § 317(b), the language of 35 U.S.C. § 317(b) reproduced immediately below, read in light of the legislative history of that statute, would nevertheless permit the '020 *inter partes* reexamination proceeding to be maintained.

35 U.S.C. § 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

The legislative history reproduced (and cited) above states:

> "[T]he third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."

In the present instance, a review of the '020 *inter partes* reexamination proceeding, and of the litigation papers made of record by patent owner therein, [42] shows that the patents and printed publications of record in the '020 *inter partes* reexamination proceeding far outnumber the

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[40] As noted by the *Ethicon* court, "nothing ... prevents the Commissioner from conducting orderly proceedings within his office so long as he does not violate the statute." *See Id.*

[41] Or, the decision is "final" in the sense that it is ripe for appeal and the period for seeking review has not expired.

[42] See note 4, *supra*, with respect to available reports involving the District Court litigation

patents and printed publications **specifically** identified and discussed in the litigation related papers and reported decisions. Further, patent owner's June 30, 2004, Information Disclosure Statement (in the '020 *inter partes* reexamination proceeding) noted that less than all the prior art *submitted by the third party requester to establish the substantial new question of patentability* was submitted in the litigation. The art advanced by requester in the reexamination proceeding may not be barred by 35 U.S.C. § 317(b), unless patent owner can show that a given patent or printed publication:

(a) was "raised" in the District Court litigation, or
(b) "could have" been raised in the litigation by requester.

With respect to element (a), the patent owner has not shown that all of the prior art relief upon in the merged reexamination proceeding "was raised" in the District Court litigation. As to element (b), the patent owner has not shown that RIM had a legal right, as to a given patent or printed publication relied on in the merged reexamination proceeding, to introduce that patent or publication into the litigation after it became "available" to RIM. Patent owner has neither alleged nor established that, at the inception of the litigation, RIM knew of the prior art that is of record in the merged reexamination proceeding that was not of record in the litigation. Alternatively, patent owner has not established that RIM learned of this "additional" prior art subsequent to the inception of the litigation and could have raised that art during the litigation but failed to do so. In particular, patent owner has not demonstrated that the prior art applied in the outstanding Office action dated September 28, 2005 that was not considered during the litigation was ever introduced into the litigation, or could have been raised therein by RIM. That is, patent owner has not established that any of the prior art of record in the merged prior was available to be introduced at the inception of the litigation, or that the prior art was available at any stage subsequent to the commencement of the litigation. Thus even if the there had been a "final" court decision within the meaning of 37 U.S.C. § 317(b), Congress legislated that an *inter partes* proceeding based upon prior art that was not raised during litigation of claim validity, and could not have been raised during such litigation, should continue in the Office.

As pointed out, the patent owner has not demonstrated that the merged reexamination proceeding is based entirely upon prior art that was raised, or could have been raised, in the litigation between NTP and RIM. It is further pointed out that the patent owner's request for reconsideration is silent on this issue. For example, patent owner has not stated whether a motion to have prior art that apparently was not of record in the litigation proceedings, (*e.g*, the so-called "TeleNor" prior art), considered by the District Court or the Federal Circuit was ever filed, and if so, what the outcome of such motion was. Accordingly, patent owner has not demonstrated that all of the patents and printed publications deemed to demonstrate a substantial new question of patentability in the *inter partes* reexamination were raised (or could have been raised) in the District Court litigation. Additionally, patent owner has not demonstrated that all of the prior art of record applied in the Office action dated September 28, 2005 [43] was raised in the District Court litigation or was known by and available to third party requester so that it could have been raised in the litigation. Therefore, even assuming, *arguendo*, that the litigation at this stage could be deemed to have reached a "final decision" on claim validity, patent owner has not demonstrated a critical element to warrant sever and termination of the '020 *inter partes* reexamination proceeding pursuant to 35 U.S.C. § 317(b).

[43] For example, the so-called "TeleNor" prior art.

D. Patent Owner Has Not Shown That All of the Claims of The '592 Patent Have Been Held "Not Invalid"

In the September 16, 2005 decision on petition, it was stated that the District Court's prior art validity determination is limited to only those claims that NTP asserted RIM to have infringed. It does not appear that RIM attempted to invalidate every claim of the patents. With respect to the '592 patent, the issues of infringement and validity appear to be limited to claims 40, 150, 278, 287, 653 and 654. Given that only six out of six hundred and sixty-five claims of the '592 patent were **specifically** identified in the District Court's final order (August 5, 2003), the District Court's published opinions, [44] and Federal Circuit's published decision,[45] the patent owner has not established that the courts have reached a holding that **all** of the '592 claims are "not invalid" (*i.e.*, valid over the issues addressed in the litigation). In fact, it now appears that patent owner now wishes to sever the merged reexamination proceeding only with respect to the above mentioned six claims.

The estoppel effect provided by 35 USC § 317(b) is on a "claim by claim" basis and therefore, each claim must be independently analyzed. 35 USC 317(b) states that:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of **such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. [Emphasis added.]

In the petitions filed on October 10, 2003 and July 7, 2005, patent owner did not point out the basis for its position that **all** of the '592 claims have been held "not invalid."[46,47] Further, given the lack of information in the case reports that **all** of the '592 patent claims were determined to be "not invalid," as opposed to only those **specifically** identified by claim number, the Office was, and is, unable to conclude that the claims which have been held "not invalid" include "any such patent claim" other than claims 40, 150, 278, 287, 653 and 654, - the claims **specifically** identified. Therefore, it appears, that on the existing record, even if the '020 *inter partes* reexamination proceeding were to be severed from the merged proceeding, 35 U.S.C. § 317(b) would **not** require that the '020 *inter partes* reexamination be terminated. Rather, the '020 *inter partes* reexamination proceeding would continue with respect to the patent claims not addressed by the litigation, and the intertwined issues of the two formerly merged reexamination proceedings would continue on independently. This is considered by the Office to be a far from desirable result. Absent any basis for termination of the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue as a merged proceeding.

In light of patent owner's present request for relief in the form of severing "with respect to at least the six claims of United States Patent No. 6,217,592, the validity of which have been fully

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[44] See note 1, *supra*
[45] See note 7, *supra*
[46] See note 14, *supra*
[47] It was presumed that only claims that are "not invalid", i.e. valid, can be infringed, and so it is clear that claims 40, 150, 278, 287, 653 and 654 of the '592 patent, the only claims that have specifically been held to be infringed, have also been held to be "not invalid."

adjudicated," [48] it is even more clear that 35 U.S.C. § 317(b) does not require the '020 *inter partes* reexamination proceeding to be terminated. If the merged proceedings were to be severed, there would be no basis upon which to terminate the '020 *inter partes* reexamination proceeding inasmuch as the question of patentability of the remaining 659 claims would remain. Independently conducting two separate reexamination proceedings on the '592 patent with respect to 659 identical claims in each proceeding is not considered by the Office to be a desirable result. Absent any basis for completely terminating the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue on as a merged proceeding.

DECISION ON REQUESTER'S PETITION IN OPPOSITION TO PATENT OWNER'S REQUEST FOR RECONSIDERATION

Relief Requested By Third Party Requester:

Essentially, the third party requester opposition requests that the Office not grant the patent owner's renewal of its request that the merged proceeding be severed and that the '020 *inter partes* reexamination proceeding then be terminated. That relief, requested and argued for by the third party requester, is grantable for the reasons set forth above in denying the patent owner's petition. Accordingly, that aspect of relief will not be further discussed in this portion of the decision. The third party requester additionally urges that the September 16, 2005 decision on petition is not a final agency action because "[A]n agency decision regarding a petition to sever and dismiss an *inter partes* reexamination proceeding does not rise to the level of a final agency action." [49] In support of this position, third party quotes 5 U.S.C. § 704 as follows, and relies upon the emphasized language:

> "Agency action made reviewable by statute and final agency action for which there is no other adequate remedy in a court are subject to judicial review. **A preliminary, procedural, or intermediate agency action or ruling not directly reviewable is subject to review on the review of the final agency action.** Except as otherwise expressly required by statute, agency action otherwise final is final for the purposes of this section whether or not there has been presented or determined an application for a declaratory order, for any form of reconsideration, or, **unless the agency otherwise requires by rule and provides that the action meanwhile is inoperative, for an appeal to superior agency authority.**" (Emphasis supplied by third party requester.)

I. Summary of the Issue Presented and its Resolution:

The sole issue here is whether, in a merged reexamination proceeding in which an *inter partes* reexamination proceeding has been merged with an *ex parte* reexamination proceeding, the refusal to grant a patent owner petition to sever the merged proceeding and to then terminate the *inter partes* reexamination proceeding may properly be designated as a final agency action for purposes of permitting patent owner to seek judicial review. For the reasons discussed, *infra*, the Office concludes that the language of 5 U.S.C. § 704 read in light of the statutes and regulations governing appeals in reexamination proceedings permits the Office to designate a the refusal to grant patent owner the relief petitioned for as a final agency decision.

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[48] See note 2, *supra*.

[49] Third Party Requester's Petition ... in Opposition to Patent Owner's Request for Reconsideration... ", October 21, 2005 at page 14.

II. Applicable Statutory and Regulatory Provisions:

35 U.S.C. § 315 states:

"(a) PATENT OWNER.— The patent owner involved in an *inter partes* reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) THIRD-PARTY REQUESTER.— A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) CIVIL ACTION.— A third-party requester whose request for an *inter partes* reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the *inter partes* reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.

35 U.S.C. § 134 states in pertinent part:

(b) PATENT OWNER.— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) THIRD-PARTY.— A third-party requester in an *inter partes* proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

35 U.S.C. 141 states in pertinent part:

"An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner, or a third-party requester in an *inter partes* reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. ..."

37 CFR 1.181(a) states:

Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

III. Analysis and Findings:

Third party requester does not sufficiently explain why the emphasized portions of the statute (5 U.S.C. § 704), or the entire statute, would preclude designating the instant decision [50] a final agency action pursuant to 5 U.S.C. § 704, particularly since requester appears to acknowledge that the right to appeal in an *inter partes* reexamination is limited to appeal of "any decision adverse to the patentability of any original or proposed amended or new claim of the patent" under 35 U.S.C. § 315. It appears that third party requester believes that the relief sought by patent owner is appealable pursuant 35 U.S.C. § 315. However, third party requester does not expressly articulate any rationale explaining why a decision refusing to sever and terminate this *inter partes* reexamination proceeding would constitute "a decision adverse to patentability of any original or proposed amended or new claim of the patent." It may be that third party requester equates severing the merged proceeding and then terminating the '020 *inter partes* reexamination proceeding as a confirmation of the claims of the '592 patent, and that granting the relief requested by patent owner would divest third party requester of the right to appeal from a finding of validity for one or more of the '592 patent claims. This is, however, not the case.

It is clear from a consideration of 35 U.S.C. §§ 134, 141 and 315 that third party requester in an *inter partes* reexamination proceeding has a right to appeal to the Court of Appeals for the Federal Circuit, and that such appeal is only from a final decision of the Patent and Trademark Office Board of Patent Appeals and Interferences ("BPAI") as to a final decision of the primary examiner **favorable to the patentability** of any original or proposed amended or new claim of a patent. In this instance, however, there cannot be a final decision by the primary examiner as to the patentability of the claims based on the art, since the challenge is that the Office lacks jurisdiction to reexamine a patent and to consider the patentability of any original or proposed amended or new claim of the patent. In this decision, the Office is rendering a final decision that the Office does in fact have jurisdiction to reexamine the '592 patent and to consider the patentability of any original or proposed amended or new claim of that patent. This action by the Office is a final action within the meaning of 5 U.S.C. § 704, and the patent owner has a right to challenge this action by appeal to the courts, since this action is independent of the patentability issue as to the art advanced in the reexamination proceeding.

The action being taken by the Office is to deny a petition to sever the merged proceeding and to also deny patent owner's petition to then terminate the '020 *inter partes* reexamination proceeding. It is not appealable to the BPAI, because it does not involve any final adverse determination by the primary examiner on the question of patentability of any of the pending claim. Rather, pursuant to 37 CFR 1.181(a), the refusal to grant the relief requested by patent owner is petitionable, and the patent owner has done so. Since there is no appeal to the BPAI available to patent owner from the action being taken by the Office, the patent owner has the right to challenge the office holding as to its petition by way of the courts. This decision states that none of the relief requested by patent owner will be granted. Accordingly, it appears that

[50] As indicated in the fourth paragraph of page 2, *supra*, patent owner's "Request for Reconsideration ... " is construed to request that the instant decision reconsidering the "Decision Dismissing Petition" dated September 16, 2005 be designated as a final agency action, and not that the "Decision Dismissing Petition" dated September 16, 2005 be so designated.

the final refusal by the Office to grant the relief requested in patent owner's petitions filed on October 10, 2003 and July 5, 2005 clearly constitutes a final agency action for which there would be a remedy pursuant to 5 U.S.C. § 704 in an appropriate court.

CONCLUSION

1. Patent owner's request to reconsider the September 16, 2005 decision is granted to the extent that the decision has been fully reconsidered, but the request to sever the '020 *inter partes* reexamination proceedings from its merger with the '495 *ex parte* reexamination proceeding and to then terminate the '020 *inter partes* reexamination proceedings is denied.

2. Patent owner has not demonstrated that the August 2, 2005 decision on appeal by the Federal Circuit is a "final decision" within the meaning of 35 U.S.C. § 317(b) that would satisfy the 35 U.S.C. § 317(b) "final decision" requirement for termination of *inter partes* reexamination proceeding '020.

3. Patent owner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent, or was available to the third party requester for entry into the litigation prior to the filing of the request for *inter partes* reexamination. Thus, another of the 35 U.S.C. § 317(b) requirements for termination of the *inter partes* reexamination proceeding '020 has not been demonstrated.

4. Patent owner has not demonstrated that any claims of the '592 patent other than claims 40, 150, 278, 287, 653 and 654 have been held by the courts to be "not invalid." Thus, still another of the 35 U.S.C. § 317(b) requirements for termination of *inter partes* reexamination proceeding '020 has not been demonstrated.

5. The merger of the '695 *ex parte* reexamination proceeding with '020 *inter partes* reexamination proceeding, will continue, *i.e.*, will not be severed, as petitioner has not demonstrated that there is a statutory basis to terminate the '020 *inter partes* reexamination proceeding.

6. Third party requester's petition in opposing patent owner's petition for reconsideration is granted to the extent that the severance and termination relief requested by patent owner will not be granted as set forth above, but is denied with respect to the requested relief of refusing to designate this decision as a final agency action.

7. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

8. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, or, in his absence, to Stephen Marcus, Legal Advisor, at 571-272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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William Wright
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206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

MAILED
FEB 23 2006
REEXAM UNIT

NOVAK DRUCE & QUIGG, LLP
1300 Eye Street NW
400 East Tower
Washington, DC 20005

(For Requester)

In re Thomas J. Campana, Jr. et al.
Inter partes Reexamination Proceeding
Control No. 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Thomas J. Campana, Jr. et al.
Director Ordered
Ex parte Reexamination Proceeding
Control No. 90/006,495
Filed: December 26 2002
For: U.S. Patent No. 6,317,592

DECISION DENYING PETITION
FOR WITHDRAWAL OF ACTION
CLOSING PROSECUTION
(37 CFR 1.949)

This is a decision on the February 17, 2006, patent owner petition titled "Expedited Petition to Withdraw The Action Closing Prosecution of February 1, 2006 Due to Inclusion of New Grounds of Rejection Not Necessitated by Amendment."

The petition is taken as a petition under 37 CFR 1.181(a)(1), as it is a petition from an action of an examiner in the prosecution of a reexamination proceeding which action is not subject to appeal. Accordingly, the petition is before the Director of the Central Reexamination Unit for consideration.

The petition is denied for the reasons set forth below.

DECISION

Patent Owner requests withdrawal of the Action Closing Prosecution action (hereinafter ACP) dated February 1, 2006.

The petition was filed February 17, 2006, together with authorization to charge the fee as required under 37 CFR 1.17 (g). However, the petition is taken as a petition under 37 CFR 1.181(a)(1), and, thus, no fee is needed.

I. Patent Owner Petitioner's Position:

The Patent Owner states that the February 1, 2006 Office action "contained numerous new points and new grounds for rejection that have not been fully developed and to which the Patent Owner has not been permitted to respond through affidavit, declaration or other forms of evidence."

The Patent Owner asserts that the Office relies upon "unsupported hearsay evidence from Norwegian Librarian" and "unsupported factual assertion regarding search techniques used in 1991."

The Patent Owner urges that Verjinski and Perkins, both of record in the proceedings, raise issues of "new inherency rejections."

II. Applicable Regulation And Practice Regarding Action Closing Prosecution:

37 CFR 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.

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 rejectionwhich was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

37 CFR 1.951 Options after Office action closing prosecution in inter partes reexamination.

(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.
(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

MPEP 1207.03, part III

III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

III. Applicable Case Law:

Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991): "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." (The court went on to explain that "this modest flexibility in the rule that anticipation' requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges." 948 F.2d at 1268, 20 USPQ at 1749-50.). Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). This finding of inherency

was not defeated by the fact that one of the references taught away from air entrapment or purposeful aeration.). See also *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 139 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985). See MPEP §§ 2112 - 2112.02 for case law on inherency. Also note that the date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124.

In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970): Where a newly cited reference is added merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of 37 CFR 41.39(a)(2).

IV. Analysis and Findings

The allegation that the February 2006 Office Action is an improper ACP as it contains new points and new grounds of rejection not necessitated by amendment is not deemed persuasive.

The Patent Owner petitioner urges that the Office relies upon unsupported hearsay evidence from a Norwegian Librarian. However, the Norwegian Librarian comments referred to are not a part of the actual Telenor rejection. The statements have no bearing on the actual rejection of the claims. Absent some specific evidence that the Librarian's comments are a part of an applied rejection, this point raised by petitioner cannot be considered a "new grounds for rejection."

Petitioner's comments about unsupported factual assertion regarding search techniques used in 1991 are likewise not persuasive. Again the issues are not a part of any applied rejection of the claims. To establish whether the ACP is premature, the Patent Owner would need to point out where new grounds for rejection have been applied in the Office action, which new grounds were not necessitated by amendment.

Petitioner lastly comments that there are new inherency rejections based upon Verjinski and Perkins.[1] The Patent Owner's comments directed to Verjinski and Perkins are from the remarks section of the February 1, 2006 Office action, in those remarks, the examiner pointed out that the claim construction of the Patent Owner is not supported by the actual claim limitation when read according to the MPEP 2258. "During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984))." The arguments previously presented by the Patent Owner were directed to the claim construction. In any event, even if the Patent

[1] The rejections of claims by the Telenor references are apparently not at issue.

Owner's position was adopted, the remarks presented by the examiner were used to illustrate the point that the narrow construction would still be inherent. This is explained in the remarks of the February 1, 2006 Office action by the examiner. Thus this is in not a new grounds for rejection. Even if this were presented in the actual rejection of the claims by Verjinski or Perkins, which it is not, it would still not be persuasive, since establishing what is old and well-known does not ordinarily establish a new ground of rejection. *In re Hoch, supra.*

Lastly, it is pointed out that the Patent Owner has an avenue of procedure available as addressed in 37 CFR 1.951 in which the "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." The Patent Owner may wish to consider making use of this avenue.

CONCLUSION

1. The Patent Owner's petition under 37 CFR 1.181 for withdrawal of the Action Closing Prosecution is **denied**.

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

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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner for the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

M Reinhart SPRE-CRU 3992 for
Lissi M. Marquis,
Director,
Central Reexamination Unit

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(For *Inter Partes* Reexamination Requester)

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No.: 6,317,592

DECISION DENYING PETITION

MAILED
MAR 20 2006
REEXAM UNIT

This is a decision on the January 23, 2006 patent owner [1] petition filed entitled "PETITION PURSUANT TO 37 CFR 1.181 TO THE DIRECTOR TO COMPLY WITH CONGRESSIONAL MANDATE AND DISMISS INTER PARTES REEXAMINATION OR, IN THE ALTERNATIVE, TO TREAT NTP EQUALLY UNDER THE LAW WITH OTHER SIMILARLY SITUATED PARTIES." The petition is taken as a request for reconsideration of the November 30, 2005 "Decision Denying Petition," which decision was designated as being a final agency action under 5 U.S.C. § 704. The request for reconsideration is based upon a change in circumstances that occurred subsequent to the November 30, 2005 decision. Specifically, patent owner requests that *inter partes* reexamination proceeding 90/000,020 be dismissed. [2] In the alternative, patent owner requests that the Office discontinue what patent owner asserts is disparate treatment of NTP relative to similarly situated parties and suspend (i.e., stay) *inter partes* reexamination proceeding 95/000,020. Patent owner also

[1] United States Patent No. 6,317,592 is owned by NTP, Inc. Any reference, *infra*, to NTP, Inc. are to be understood as referring to the "patent owner."

[2] It is not clear whether patent owner's use of the word "dismissed" (or variations thereof) throughout this petition is intended to mean that the '020 *inter partes* reexamination prosecution should be "terminated." Termination of an *inter partes* reexamination prosecution may, in turn, result in conclusion of the proceeding by publication of a reexamination certificate. See 35 U.S.C. § 316, and the discussion in MPEP § 2694, which points out that conclusion of an *inter partes* reexamination may occur as a result of the vacating the proceeding, which would not result in publication of a reexamination certificate. In prior petitions directed to this issue, patent owner's requested relief was that the 95/000,020 proceeding be "severed and dismissed," but patent owner also used the phrase "severed and terminated" interchangeably. In discussing patent owner's requested relief and rationale therefor, this decision will continue to use patent owner's terminology, *i.e.* "dismiss," or a variation thereof. While it is unclear whether patent owner actually is requesting that the 95/000,020 be concluded by publication of a reexamination certificate, or simply vacated, the result reached in this decision would apply for either interpretation.

requests that the Office remove "the taint of the prior unlawful submissions" by the third party requester. [3] The third party requester has not filed an opposition to the present petition.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the present patent owner petition for reconsideration.

SUMMARY

The patent owner petition is granted to the extent that the November, 2005 decision on the October 7, 2005 patent owner petition has been fully reconsidered in light of the change in circumstances that has occurred subsequent to that decision. However, for the reasons set forth below, patent owner's request for reconsideration is otherwise denied with respect to all of the relief requested, including the requested "dismissing" or staying the 95/000,020 *inter partes* reexamination proceeding.

BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in the '020 proceeding. The notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 notice provided a copy of the court order and its accompanying memoranda and other orders issued by the court. The materials were provided by the patent owner for the purpose of asserting that the District Court found the defendant, third party requester RIM, (a) not to have sustained its burden of proving the invalidity of any patent claim in the '592 patent, and (b) to have infringed certain of plaintiff NTP's patent claims in the '592 patent. [4] Pursuant to Federal Rules of Appellate Procedure Rules 3 and 4,

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[3] The third party requester in *inter partes* reexamination proceeding 95/000,020 is David L. Stewart. However, the real party in interest is Research in Motion, Ltd. (hereinafter "RIM"). Any subsequent reference to RIM is to be understood as referring to the "third party requester."

[4] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "*NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant*" reported at 270 F. Supp. 2d 751, 67 USPQ2d 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 to be not invalid. See also *NTP, Inc., v. Research In Motion, Ltd.*, 392 F.3d 1336, 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM. Presumably, at least these claims were held to be "not invalid" in order for them to have been held by the court to be infringed.

the District Court's decision was appealable within 30 days.

5. On August 26, 2003, the Office issued an order in the '020 reexamination proceeding granting *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that the decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might be shown to provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181 (the "original" petition), requesting that the '020 reexamination proceeding be dismissed, *i.e.*, concluded. Patent owner argued that the District Court's holding and decision in *NTP, Inc. v. Research In Motion* [5] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b) adverse to RIM. It was accordingly urged that the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant RIM in the litigation, could not be maintained by the Office.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by the provisions of 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [6]

10. On July 7, 2005, patent owner filed a petition to sever the instant merged proceeding and to dismiss and terminate the '020 *inter partes* reexamination proceeding.

11. On July 20, 2005, requester filed a petition opposing patent owner's July 7, 2005 petition.

12. On August 2, 2005, the Federal Circuit issued an Order granting a request for panel rehearing and rehearing *en banc* for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion. [7]

13. On August 2, 2005, the Federal Circuit also issued a substituted opinion. [8]

14. On August 16, 2005, RIM filed a petition in the litigation for panel rehearing and rehearing *en banc*, based upon the Federal Circuit's August 2, 2005 opinion.

15. On September 16, 2005, the Office rendered a decision dismissing the patent owner's July 7,

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[5] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[6] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336, 73 USPQ2d 1231 (Fed. Cir. 2004).

[7] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282, 75 USPQ2d 1763 (Fed. Cir. 2005)

[8] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282, 75 USPQ2d 1763 (Fed. Cir. 2005)

2005 petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding.

16. On September 28, 2005, the Office issued a first Office action on the merits (*i.e.*, on the patentability of the '592 patent claims) in which all patent claims, *i.e.* claims 1-665, were rejected. The rejection was based upon prior art (*e.g.* the so-called "TeleNor" prior art) , which was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been individually ordered and subsequently merged into a single proceeding. The TeleNor prior art does not appear to have been considered during any of the court proceedings.

17. On October 7, 2005, the Federal Circuit denied RIM's petition for a panel hearing and rehearing *en banc.* [9]

18. Also on October 7, 2005, the patent owner filed a petition requesting reconsideration of the Office's September 16, 2005 decision, and designation of the decision on the request for reconsideration as a final agency action under 5 U.S.C. § 704.

19. In the litigation, a motion to stay issuance of the Federal Circuit's mandate was filed by RIM on October 13, 2005.

20. On October 21, 2005, the Federal Circuit denied the motion to stay and issued its mandate, remanding the case to the District Court for further proceedings pursuant to the Federal Circuit's August 2, 2005 substituted opinion. [10]

21. Also on October 21, 2005, the third party requester filed a petition in opposition to the patent owner's October 7, 2005 petition.

22. Subsequent news reports stated that that RIM has petitioned Chief Justice Roberts for a stay of the Federal Circuit's mandate pending filing of a petition for *certiorari,* but the stay was denied. [11]

23. On November 17, 2005, the Office issued a decision granting two petitions (by the patent owner for those proceedings) to suspend pending *inter partes* reexamination proceedings 95/000,093 and 95/000,094. Those proceedings involved U.S. Patent Nos. 6,424,333 and 6,275,213, respectively. Those patents will be referred to as the '333 and '213 patents.

24. On November 30, 2005, the Office rendered a decision denying the patent owner's October 7, 2005, petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding. The decision was designated as a final agency action under 5 U.S.C. § 704.

25. On November 30, 2005, the United States District Court for the Eastern District of Virginia, Richmond Division denied a motion for stay of proceedings. [12]

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[9] *NTP, Inc. v. Research in Motion, Ltd.*, No 03-1615 (Fed. Cir. October 7, 2005)
[10] The substituted opinion is referenced in note 8, *supra.*
[11] *Patent Trademark & Copyright Journal*, Vol. 70 No. 1742, 10/28/05 (BNA). See also "Third Party Requester's ...Opposition to Patent Owner's request for Reconsideration ...", October 21, 2005, at page 9.
[12] *Research in Motion, Ltd., Petitioner v. NTP, Inc.* 397 F. Supp. 2d 785, 76, USPQ2d 1857

26. On January 23, 2006, the Supreme Court of the United States denied RIM's petition for *certiorari*. [13]

27 On March 3, 2006, the District Court dismissed the underlying action as a result of a settlement reached by the parties. [14]

DECISION ON RECONSIDERATION

I. Relief Requested By Patent Owner

A. Request That The Proceeding Be Dismissed

The present request for reconsideration was filed prior to the dismissal of the litigation on March 3, 2006. In it, the patent owner first requests that the '020 *inter partes* reexamination proceeding be "dismissed." As a basis for this request, patent owner alleges that the Office must now apply the estoppel provision of 35 U.S.C. § 317(b). [15] Patent owner argues that, in the Decision Denying Petition dated November 30, 2005, the Office incorrectly failed to find that there has been a "final decision" in accordance with 35 U.S.C. § 317(b), and therefore failed to correctly apply the estoppel provision of the statute. Patent owner identifies (1) the reliance by the Office on the existence of an outstanding petition for *certiorari* filed by RIM, and (2) the reliance of the Office on the existence of additional proceedings in the District Court as the reasons relied upon by the Office for refusing to apply 35 U.S.C. § 317(b) estoppel. Patent owner alleges that the circumstances have now changed, and there is in fact a "final decision" within the meaning of 35 U.S.C. § 317(b), because third party requester's petition for *certiorari* has been denied, and because the District Court was not asked by third party requester to revisit validity of any claim of the '592 patent. [16]

In further support of the position that 35 U.S.C. § 317(b) requires the Office to dismiss the '020 *inter partes* reexamination proceeding, patent owner also asserts that the Office has "[defied] the clear statements of Senator Hatch, Senator Leahy and the rest of Congress and ignore[d] Congress' clear statements limiting litigants to 'one bite at the apple'." Patent owner relies upon certain statements by Senators Hatch and Leahy which, in patent owner's view, indicate that the language of 35 U.S.C. § 317(b) requires a third party requester to choose between either pursuing a reexamination, or going directly to Federal court. [17] Patent owner's position is that a third party requester must choose either litigation or *inter partes* reexamination. Patent owner argues that the third party requester, having chosen to pursue litigation with respect to the '592 patent, is estopped from pursing *inter partes* reexamination by reason of 35 U.S.C. § 317(b) because the litigation is, in patent owner's view, finally decided.

B. Request To End "Disparate Treatment" Of Patent Owner By Suspending Proceeding

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[13] *Research in Motion, Ltd., Petitioner v. NTP, Inc.*, 2006 U.S. LEXIS 1053 (U.S. Jan. 23, 2006) (No. 05-763).
[14] *NTP, Inc. v. Research in Motion, LTD.* No. 3:01CV767 (E. D. VA March 3, 2006).
[15] 35 U.S.C. § 317(b) provides in pertinent part the "Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. "
[16] See pages 2-3 and Appendix B of the instant petition.
[17] See pages 3-5 of the instant petition.

Patent owner argues that, in the alternative, patent owner (NTP) has been treated differently than another patent owner (Immersion Corporation) was treated in *inter partes* reexamination proceedings 95/000,093 and 95/000,094 (hereinafter the '093 proceeding and the '094 proceeding reexamination proceedings). [18] The records in the '093 and '094 proceedings show that on September 29, patent owner Immersion Corporation Patent owner filed a petition in each proceeding requesting that the proceeding be suspended. On November 17, 2005, the Office granted the petitions in a single decision addressed to both of the proceedings. NTP asserts that the reasoning in the Immersion decision that supports the grant of the requested suspensions is applicable to the present '020 *inter partes* reexamination proceeding. NTP therefore requests that, if the Office will not dismiss the '020 reexamination proceeding, then for the same reasons relied upon in the decision granting the Immersion petitions to suspend, the Office should "not continue its disparate treatment of NTP as compared to other similarly situated parties," and should suspend the '020 *inter parties* reexamination proceeding. [19]

C. Request To Cleanse the Record Of Information Resulting From Unlawful Contacts and Submissions By The Third Party Requester

Patent owner alleges that in the course of the '020 *inter partes* reexamination proceeding, there have been unlawful contacts and submissions "in violation of the statute." It is further alleged that the third party requester has submitted numerous papers that are null and void and cannot be considered by the Office. Patent owner alleges that the third party requester has engaged in numerous contacts with the Office that are not of record, but which "must be revealed and fully set forth on the public record." Patent owner requests that the Office "devise a plan" to eliminate the "taint and "prejudice" caused by these contacts, "including any assurances" made by Office personnel to the third party requester regarding the timing and outcome of Office activities.

II. Analysis and Findings

A. Dismissal Of The '020 Proceeding

Patent owner argues that the litigation between patent owner and RIM (the real party in interest for the third party requester) has now reached a stage in which there is a final decision on claim validity within the meaning of 35 U.S.C. § 317(b). Patent owner points to the denial of RIM's petition for writ of *certiorari* and to the failure of RIM to move for consideration of claim validity issues on remand to the District Court. Subsequent to the filing of the present petition, the litigation has been dismissed "without prejudice" in view of a settlement agreement reached between patent owner NTP and RIM. [20] While it is not believed that this dismissal "without prejudice" constitutes a "final decision" where RIM "has not sustained its burden of proving the invalidity of any paten claim in suit" pursuant to 35 U.S.C. § 317(b), that issue need not be reached in this decision. Even, assuming for the sake of discussion, if the dismissal "without prejudice" did constitute a final decision on the question of claim validity adverse to RIM, the estoppel provision of 35 U.S.C. § 317(b) is inapplicable on the record of the '020 *inter partes* reexamination proceeding for the reasons previously set forth in the Decision Dismissing Petition dated September 16, 2005 and the Decision Denying Petition dated November 30, 2005, and now repeated, *infra*. Based on those reasons, the '020 *inter partes* reexamination proceeding will not be dismissed and will not be

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[18] The '093 proceeding was filed on May 17, 2005 and reexamination was ordered on August 17, 2005. The '094 proceeding was filed on May 19, 2005 and was ordered on August 17, 2005.

[19] See pages 5-7 of the instant petition.

[20] See note 14, *supra*.

severed from its merger with the '495 *ex parte* reexamination proceeding; rather the merged proceeding will continue.

It is once again pointed out that the '020 *inter partes* reexamination proceeding is directed to a patent for reexamination having six hundred and sixty five claims, only six of which were even involved in the litigation. [21] It is also pointed out once again that there had been no decision on the patentability of any claims other than these six claims, and that the estoppel effect provided by 35 U.S.C. § 317(b) is on a "claim by claim" basis. [22] Therefore, it is reiterated that even if the litigation were presumed to be final with respect to RIM having failed to establish claim invalidity, the '020 *inter partes* reexamination proceeding cannot simply be "dismissed" (*i.e.*, terminated) based upon 35 U.S.C. § 317(b) estoppel. The '020 *inter partes* reexamination proceeding would have to continue with respect to the remaining claims that were not litigated as to claim validity. [23] Once again, it is also pointed out that severance of the merged proceeding would leave the '495 *ex parte* reexamination proceeding intact, because there are no estoppel provisions in the *ex parte* reexamination statutes. Therefore, the '495 *ex parte* reexamination proceeding would have to continue separately on all of the claims, while the '020 *inter partes* proceeding would have to continue separately on fewer than all the claims. It is still deemed to be undesirable for the two severed proceedings to continue independently of one another, because there would clearly be overlapping issues in the independent proceedings.

In addition to the reasons articulated in the immediately preceding paragraph for refusing to terminate the '020 *inter partes* proceeding and to keep the merged proceeding intact, the November 30, 2005 Decision Denying Petition repeated yet another reason that had been set forth in the September 16, 2005 Decision Dismissing Petition, which patent owner has never addressed. [24] Both decisions clearly relied upon the last two sentences of 35 U.S.C. § 317(b), which follow immediately *after* the language quoted in footnote 15, *supra*. The present decision repeats the analysis and continues to rely upon that analysis as follows.

The last sentence of Section 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

If this language were not clear enough, both the Decision Dismissing Petition and the Decision Denying Petition quoted the following legislative history of 35 U.S.C. § 317(b): [25]

> "Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues **which were or which could have been raised. However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."** (Emphasis added.)

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[21] Decision Dismissing Petition, September 16, 2005, pages 9-10; Decision Denying Petition, November 30, 2005, pages 7 and 8.
[22] *Id.*, at page 15; at page 10.
[23] An amendment filed on December 28, 2005 has now increased the total number of claims to seven hundred sixty-four.
[24] Decision Dismissing Petition, September 15, 2005, pages 4 and 8-9; Decision Denying Petition, November 30, 2005, pages 5, 6 and 13-14.
[25] 106 Cong Rec. S14720, Nov. 17, 1999.

The language of the legislative history leaves no room for doubt as to the meaning of 35 U.S.C. § 317(b). It is clear that even where a final decision in a civil action has been rendered, that is, after any appeals, [26] the third-party requester **is not estopped** from requesting *inter partes* reexamination, **if** the request is based upon previously unknown prior art that was not available to the third-party requester and the Office. Indeed, that is clear even from the same Judiciary Committee material relied upon by patent owner in the present petition, [27] which states that:

> " ... a party would have a choice of either pursuing a reexamination or going directly to Federal Court. In either event, the estoppel provisions of this section prevent that party or its privies from raising **the same issues or any issues that could have been raised at that time** in future."
>
> "Symmetrically, **if a claim of invalidity is asserted in litigation, reexamination is precluded on the issues raised in that claim of invalidity or any issue that could have been raised.**"
>
> (Emphasis added in this decision.)

It is considered to be equally clear that, by definition, "newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination" was not available to have raised any issue of claim validity in the litigation that was conducted. Patent owner specifically invokes the following words of Senator Leahy, to assert that the Office is "defy[ing]" them: [28]

> "The Hatch-Leahy substitute enhances protection against harassment by strengthening the estoppel provisions **to prevent a party from raising an issue that was raised or could have been raised in one forum from raising it in any other forum in the future.**" (Emphasis added in this decision.)

Those words, however, clearly and unequivocally demonstrate that the estoppel provisions of 35 U.S.C. § 317(b) apply only to issues that had been raised or could have been raised. Certainly, an issue of claim validity based on prior art that was unknown or unavailable during the litigation cannot be a an issue "that was raised or could have been raised."

The comments of various members of Congress, [29] which are relied upon by patent owner, state: [30]

> "Similarly, estoppel provisions similar to those agreed to in the Senate form a key component on the broad-based agreement on patent reform."

These comments merely express agreement with the words of Senator Leahy, and do **not** support patent owner's position. Nothing in the quoted material attributed to Senator Hatch [31] addresses the question of *newly discovered prior art.*

In the present instance, it appears from the record of the merged reexamination proceeding that the merged proceeding was, and is, being conducted before the Office based upon significantly more applied prior art than had been asserted during the litigation. The patent owner has been repeatedly challenged in the prior decisions on petitions to provide

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[26] Note the use of the word "appeals"; it is clear that a "final decision" requires exhaustion of any available appeals, not just a single appeal. See also Decision Denying Petition, November 30, 2005, pages 10-12; Decision Dismissing Petition, September 16, 2005, pages 6-7.
[27] S. Rep. 105-42 (1997), cited at pages 3-4 of the present petition.
[28] *Id.*
[29] From the context of the remarks, the members of Congress referred to were presumably Representatives.
[30] Page 4 of the present petition.
[31] *Id.*

any evidence that the applied references were known and available to the requester in time to enter them into the District Court proceeding, and the patent owner has failed to address that challenge. Thus, as has been previously pointed out to petitioner patent owner, these references must be found to support the '020 reexamination. This point is, by itself, a basis to maintain the '020 reexamination proceeding, even if (a) patent owner's position as to "final decision" within the meaning of 35 U.S.C. § 317(b) was accepted, (b) all the patent claims had been subject to the litigation and (c) there was no copending '495 *ex parte* reexamination proceeding.

The fact remains that the patent owner still has not shown, or even attempted to show, that the reference material that was cited and applied in the merged proceeding for the first time in the Office action dated September 28, 2005, [32] (and was cited by patent owner in an IDS filed on September 30, 2005), was other than "newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* proceedings." Patent owner has never shown, or attempted to show, that the reexamination orders in the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding were wholly based on prior art that was not "newly discovered" discussed in the District Court proceeding. [33] As discussed in both the September 16, 2005 Decision Dismissing Petition and the November 30, 2005 Decision Denying Petition, and as reiterated and relied on in the present petition, absent a showing that this prior art was available to and known to the third party requester and could have been introduced in the litigation, the estoppel provision of 35 U.S.C. § 317(b) relied upon by patent owner as mandating the dismissal of the '020 *inter partes* reexamination proceeding is simply inapplicable on the present record.

In summary, the '020 *inter partes* proceeding will not be dismissed and will not be severed from the merged proceeding because:

(1) The patent owner has failed to show that the merged reexamination proceeding is being conducted solely based upon "old" prior art, i.e., art that is not "newly discovered prior art" within the meaning of 35 U.S.C. § 317(b). Rather, from a review of the record, it appears that the merged reexamination proceeding is indeed being conducted based upon "newly discovered prior art." [34]

(2) Of the six hundred and sixty five claims of the '592 patent, only six claims were involved in the litigation. Since the estoppel effect provided by 35 U.S.C. § 317(b) is on a "claim by claim"

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[32] This is more than three years and 10 months after the litigation between patent owner and the third party requester was filed, more than two years and four months after the District Court's final order, more than two years and nine months after reexamination was ordered in the '495 Director Ordered *ex parte* reexamination proceeding, more than two years and four months after '020 *inter partes reexamination proceeding* was filed and two years and one month after reexamination was ordered in the '020 *inter partes reexamination proceeding.*

[33] A review of the Memorandum Opinion of Judge Spencer, *NTP Inc., v. Research in Motion, Ltd.*, 2003 U.S. Dist. LEXIS 14338, 67 USPQ2d 1587 (E.D VA, May 23, 2003) shows that in both reexamination proceedings, the order for reexamination relied upon certain prior art that was not discussed in the litigation with respect to claim validity. Therefore, it is clear the Office initially had a basis upon which to assume jurisdiction the '020 reexamination *inter partes* proceeding based upon 35 U.S.C. §§ 313 and 314. The Office clearly had a basis assume jurisdiction over the previously ordered '495 *ex parte* reexamination proceeding under 35 U.S.C. §§ 303 and 304. The record in the merged proceeding clearly shows that certain prior art that has been applied to the claims was first introduced into the proceeding in September, 2005, and patent owner has not shown that this prior art is other than "newly discovered" prior art within the meaning of 35 U.S.C. § 317(b). The Office, therefore, has always had a basis to assume, and retain, jurisdiction over the '495 and '020 reexamination proceedings, notwithstanding any decisions in the litigation between patent owner and the third party requester, whether "final" or otherwise.

[34] See, for example, the so-called "TeleNor" prior art discussed in part 16 of the summary above.

basis, the'020 *inter partes* proceeding would need to continue as to the non-litigated six hundred and fifty nine claims of the '592 patent.

(3) The '495 *ex parte* reexamination is not subject to any litigation estoppel; thus, reexamination by the Office must continue on all the '592 patent claims. As pointed out in (2) immediately above, the '020 *inter partes* reexamination must continue on all claims except those involved in the litigation. The issues of the two proceedings overlap, and it is both administratively inefficient and undesirable for the Office to conduct two separate reexamination proceedings on the '592 patent under these circumstances.

The above reasons provide a strong basis to deny the petition, even aside from the fact that the patent owner has not shown the District Court dismissal "without prejudice"of the underlying action (based on a settlement agreement reached between patent owner NTP and RIM) to in any way be a final decision where RIM "has not sustained its burden of proving the invalidity of any paten claim in suit" pursuant to 35 U.S.C. § 317(b).

B. Suspension of the '020 *Inter Partes* Reexamination Proceeding (Alternative Relief Requested)

Patent owner argues that the Office treatment of patent owner is not consistent with the way in which a different patent owner was treated in the '093 and '094 *inter partes* reexamination proceedings. Patent owner premises this argument on the conclusion that patent owner in the '020 reexamination proceeding and the patent owner in the '093 and '094 *inter partes* proceedings the are "similarly situated." Indeed, patent owner states the reasoning by the Office in the petition granting the suspension of the '093 and '094 *inter partes* reexamination proceedings "is identical to those that NTP has previously explained exist in this proceeding." [35] Patent owner argues that the alleged disparate treatment amounts to an arbitrary and capricious action on the part of the Office. Initially, it is pointed out that the concurrent litigation, which provided the underlying basis for suspension in the '093 and '094 proceedings, no longer currently exists with respect to the '020 *inter partes* reexamination proceeding as a result of March 3, 2006 Order dismissing the litigation "without prejudice." In addition, prior to the dismissal of the NTP-RIM litigation, the facts were very different. In the present instance, for example, there are non-litigated claims for which reexamination has been requested in the '020 reexamination proceeding, there is a concurrent *ex parte* reexamination proceeding having overlapping issues with the '020 reexamination proceeding, and "newly discovered prior art" within the meaning of 35 U.S.C. § 317(b) is being applied. None of these facts were the case when the decision referred to by petitioner was decided. Therefore, petitioner patent owner's arguments on this point are not persuasive, and need no further discussion.

C. Request To "Cleanse The Record", Etc.

Patent owner alleges that there are "unlawful contacts and submissions that the Office has permitted to occur in violation of the statute as part of the inter partes proceedings." Patent owner has not, however, identified any such contacts, or any specific statutes that the alleged contacts are alleged to have violated, let alone how the alleged but unspecified conduct by the unidentified parties has violated one or more of the unidentified statutes. Patent owner further alleges that the third party requester "has submitted numerous papers that are now null and void and cannot be considered by the Office." Yet patent owner has identified no specific papers, and has not

[35] Page 5 of the present petition.

explained why any of these unidentified papers should now be null and void, such that the Office could not consider them. Patent owner alleges that contacts between the Office and the third party requester (including counsel, and other representatives/lobbyists) has tainted and prejudiced patent owner, and demands that the Office devise a plan to eliminate such taint and prejudice as has occurred. Yet patent owner does not identify the particular contacts, or the particular parties involved. Patent owner alludes to assurances communicated by Office personnel to third party requester regarding the timing and ultimate outcome of Office activities. [36] Again, patent owner provides no specifics.

It is noted that patent owner has not earlier requested the sort of relief now requested in any of the previously filed petitions. Patent owner has not established the existence of any changed circumstance that would entitle patent owner to present the request for relief for the first time in response to the Decision Denying Petition dated November 30, 2005, which was designated as being a final agency decision under 5 U.S.C. § 704.

It is also to be noted that the broad devising of a plan to eliminate such taint and prejudice (that is requested) is not directed to petitionable matter, and does not identify the specific actions that patent owner believes to be in need of correction in the present proceeding. A petitioner must provide a foundation for the relief requested, and patent owner failed to do so. Patent owner has not identified any specific contact between any specific Office personnel and any specific parties representing or otherwise in the employ of third party requester, including contacts in which "assurances" of any kind were made to third party requester or any employee or other representative thereof. Patent owner has also failed to explain how any of those alleged (but unspecified) contacts prejudiced or tainted patent owner. In light of the failure of patent owner to present specifics and thereby provide a foundation, and in light of the apparent untimely nature of the request for relief, none of the relief requested by patent owner on page 7 of the present petition can, or will, be granted.

[36] In general, see the present petition, page 7, first paragraph.

CONCLUSION

1. Patent owner's January 23, 2006 petition, taken as a request for reconsideration of the November 30, 2005 Decision Denying Petition, is granted to the extent that the decision has been fully reconsidered, but denied as to the request to "dismiss" or suspend the '020 *inter partes* reexamination proceeding.

2. Patent owner has not demonstrated that the there has been a "final decision" within the meaning of 35 U.S.C. § 317(b) in the litigation between patent owner and third party requester such that § 317(b) would require "dismissal" or termination of the '020 *inter partes* reexamination proceeding.

3. Patent owner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent, or was available to the third party requester for entry into the litigation prior to the filing of the request for *inter partes* reexamination. Thus, another of the 35 U.S.C. § 317(b) requirements for termination of the *inter partes* reexamination proceeding '020 has not been demonstrated.

4. The alternative relief of suspending the '020 *inter partes* reexamination proceeding will not be granted because there is currently no litigation on the '592 patent to provide a basis for considering suspension.

5. Patent owner has wholly failed to present any specific facts supporting the requested relief that the Office cleanse the record of information resulting from unlawful contacts and submissions by the third party requester. Accordingly, that requested relief is denied.

7. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

8. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, or, in his absence, to Stephen Marcus, Legal Advisor, at 571-272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

sm
March 9, 2006

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,020	05/29/2003	6317592	81208	3141

803 7590 09/13/2006

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/13/2006

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

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9/13/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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WASHINGTON, DC 20005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495 95/000,020

PATENT NO. 6,317,592

ART UNI 3992

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

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

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(For Patent Owner)

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SEP 13 2006

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No. : 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DISMISSING PETITION AND, *SUA SPONTE*, "RETURNING" IMPROPER PAPERS

This is a decision on the May 12, 2006 patent owner petition styled "Petition Pursuant to 37 CFR §1.183 or, Alternatively, 37 CFR 1.182 To Grant Patent Owner Leave to File Supplemental comments After Action Closing Prosecution." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed, and its attachments are returned to the patent owner for the reasons discussed below.

PETITION FEE

A single petition fee of $400.00 is being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized in the present petition.

[1] The present petition will be considered under the provisions of both 37 CFR 1.182 and 37 CFR 1.183. A single petition fee is required.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent mailed and assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

5. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

6. On August 9, 2004, the Senior Special Projects Advisor issued a decision, *sua sponte*, by which the '495 reexamination proceeding and the '020 reexamination proceeding were merged into a single combined reexamination proceeding.

7. The August 26, 2003 decision merging the proceedings established that the merged proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

8. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

9. Following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) in the present merged reexamination proceeding on February 1, 2006.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

12. On March 1, 2006, the patent owner filed comments after the ACP. The third party requester has not filed a response to patent owner's comments on the ACP.

14. May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request, and a number of verified statements.

15. Also on May 12, 2006, patent owner filed the present petition seeking entry of all of the papers filed on May 12, 2006.

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

RELEVANT STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. § 311(a) provides:

"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."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

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 1.913 provides:

"Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501."

37 CFR 1.939(a) provides:

"If an unauthorized paper is filed by an party at any time during the *inter partes* reexamination proceeding it will not be considered, and may be returned."

37 CFR 1.951(a) provides:

"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."

MPEP § 2667 provides in part:

"The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and

whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.

Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: the reexamination file (paper file or IFW file history)<; the patent file (paper file or IFW file history)<; or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number."

DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

I. Patent Owner's Position

Patent owner has attached to the present petition - a set of papers to be added to the record as a part of the supplemental response to the March 1, 2006 response to the February 1, 2006 ACP. These papers are submitted to make them available for the examiner's consideration in evaluating the patent owner's supplemental response. Patent owner requests by way of the present petition that these papers be entered into the IFW record (for the present merged proceeding) to provide what patent owner urges to be a complete administrative record.

Recognizing that an ACP has been promulgated, patent owner seeks an entry right for the papers attached to the present petition pursuant to 37 CFR 1.183 and 37 CFR 1.182. It is patent owner's position that these papers should be entered into the record because:

(1) The present circumstances are extraordinary, and the requested relief should be granted under 37 CFR 1.183 as a matter of Office policy and general fairness with respect to the information provided being previously unavailable to patent owner prior to the February 1, 2006 ACP and the March 1, 2006 patent owner response thereto; [3]

(2) The content of the attached papers is necessary for a proper patentability determination; [4]

(3) A transition procedure was announced in the Notice published at 1292 OG 20 (March 1, 2005) by which a patent owner may obtain relief under 37 CFR 1.182 in order to permit the filing of a so-called request for continued reexamination (RCR) analogous to the current request for continued reexamination (RCE) practice available in the examination of nonprovisional patent applications. Such transition procedure is urged to be appropriate in this instance.

II. Findings and Analysis

A. Waiver of the Rules Pursuant to 37 CFR 1.183

A review of the papers filed on May 12, 2006 with the present petition shows that certain of the papers appear to be arguably relevant to the patentability issues in the ACP, *e.g.*, the papers that are directed to the issues raised by patent owner with respect to the so-called "Telenor Documents." [5] However, a review of the May 12, 2006 papers also shows that the papers

[3] Petition dated May 12, 2006, pages 10-11.
[4] *Id.*, at pages 11-12.
[5] *Id.*, at pages 13-14.

include FOIA material, and other material, that is directed to complaints of misconduct and bias against patent owner on the part of Office personnel participating in the decision-making process. [6] Thus, contrary to petitioner patent owner's allegations, the papers presented are not confined to papers that are necessary for a proper patentability determination. Instead, the papers intermingle material directed to substantive patentability issues with material directed to complaints of misconduct/bias that are not substantive patentability issues.

37 CFR 1.3 specifically indicates that "[C]omplaints against examiners and other employees must be made in correspondence separate from other papers." Patent owner has filed a submission **intermingling** (a) the FOIA material that is filed in support of complaints going to the conduct of Office personnel in this proceeding with (b) material directed to the merits of the patentability determination arrived at during this proceeding Patent owner **has not filed** one submission being solely directed to the merits of the patentability determination arrived at during this proceeding, and a separate submission in support of complaints going to the conduct of Office personnel in this proceeding. Thus, petitioner patent owner has filed a submission that is not in compliance with the regulation. The patent owner may comply with the regulation by filing the papers as separate submissions, so that the papers directed to substantive patentability issues may be entered into the present record, and the papers directed to complaints regarding conduct may be kept separately from the record while they are being considered. Thus, compliance with the 37 CFR 1.3 does not present an extraordinary situation that requires waiver of the regulation, but rather, this is a mechanism wholly within control of patent owner which can be employed by the patent owner in compliance with the rules. Therefore, 37 CFR 1.3 will not be waived.

The same analysis applies with respect to 37 CFR 1.4(c), which requires that matters decided by different branches or areas of the Office be submitted in separate papers so that they can be properly directed. Thus, papers directed to the substantive patentability issues raised in the ACP are properly directed to the examiner's consideration, while papers directed to complaints of employee misconduct and bias are not. Again, compliance with this regulation is a matter that is wholly within control of patent owner, and, as such, does not present an extraordinary situation. The interests of justice do not require that this regulation be waived. Therefore, 37 CFR 1.4(c) will not be waived.

As a further consideration, 37 CFR 1.951(a) provides, *inter alia,* that "[A]fter 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 relief requested by patent owner would require waiver of 37 CFR 1.951(a) in order to permit more than a single submission of comments following an ACP. However, the requested relief is precluded because the comments for which entry is sought are not limited to issues raised in the action closing prosecution. Instead, as discussed above, the papers filed on May 12, 2006 intermingle comments directed to the substantive patentability issues raised in the ACP with complaints of misconduct and bias that are not a part of "the issues raised in the Office action closing prosecution." Therefore, patent owner has not established the existence of an extraordinary circumstance that would justify waiving 37 CFR 1.951(a) to permit entry of the papers filed on May 12, 2006. Again, the presentation of papers that are "limited to the issues raised in the Office action closing prosecution" is a matter within control of patent owner. Patent owner can present a paper limited to "the issues raised in the Office action closing prosecution," and also present separate complaints of perceived misconduct and bias in accordance with 37 CFR 1.3 and 37 1.4(c), *i.e.*, by filing a separate paper directed to the complaints of misconduct and bias for consideration by the Office such that the paper can be maintained separate from the record

[6] *Id.*, at page 9.

of the merged reexamination proceeding to be considered by the examiner. The question of whether the interests of justice would justify waiving 37 CFR 1.951(a) so as to permit additional patent owner comments on the ACP is reserved, and will be decided only at such time as patent owner requests waiver of 37 CFR 1.951(a) so permit entry of a paper that is limited to the presentation of comments directed only to the issues of patentability raised in the ACP. On the present record, 37 CFR 1.951(a) will not be waived.

B. 37 CFR 1.182 Is Not Applicable With Respect To A So-Called "Request for Continued Reexamination"

Patent owner requests that pursuant to the Notice published at 1292 OG 20 (March 1, 2005), relief under 37 CFR 1.182 be granted so that patent owner would be permitted to file and have entered "supplemental comments" to the February 1, 2006 ACP. The Notice discusses a change in reexamination practice whereby a patent owner in an *ex parte* reexamination proceeding would newly be required to demonstrate the existence of a different substantial new question of patentability in order to obtain a second or subsequent request for reexamination than was demonstrated in a prior *ex parte* reexamination proceeding for the same patent. Because of that change in practice, a patent owner would no longer be able to obtain the entry of new evidence and/or an amendment (for a patent being reexamined) by filing a second or subsequent request for *ex parte* reexamination based on the same substantial new question of patentability that was found to exist in a pending *ex parte* reexamination proceeding. The Notice then discusses the ability of a patent owner to obtain this relief in a manner analogous to the relief that would available if a so-called "request for continued reexamination" (RCR) practice were in existence. Such relief is available, pursuant to the Notice, by filing a petition under 37 CFR 1.182 requesting such relief, and presenting evidence and/or an amendment that would advance prosecution in the existing *ex parte* reexamination proceeding. Although a patent owner can not file a request for *inter partes* reexamination because 35 U.S.C. § 311(a) and implementing regulation 37 CFR 1.907 expressly preclude a patent owner or its privies from filing a request for *inter partes* reexamination, the Notice nevertheless specifically provides for the possibility of permitting a patent owner to obtain entry of additional evidence and/or an amendments after the promulgation of an ACP in an *inter partes* reexamination by filing a petition under 37 CFR 1.182 requesting such entry.

However, the patent owner petition requests relief which, if granted, would permit patent owner to obtain entry of material that is not confined to evidence and/or an amendment directed to issues of patentability raised in the ACP. Rather, as presented by patent owner, the supplemental comments to the ACP that were filed on May 12, 2006 are directed to complaints of misconduct and bias, as well as issues of patentability raised in the ACP. To grant the requested relief under 37 CFR 1.182 would necessarily require a waiver of 37 CFR 1.3, 37 CFR 1.4(c) and 37 CFR 1.951(a) as discussed above. However, for the reasons pointed out above, waiver of those regulations is not available, because patent owner has not established the existence of an extraordinary situation that would require suspension or waiver of those regulations in the interest of justice. Therefore, the requested relief pursuant to 37 CFR 1.182 is not granted.

C. Disposition Of Papers

The patent owner papers filed on May 12, 2006 cannot be entered into the record. The May 12, 2006 papers intermingle comments that are directed to the issues of patentability raised in the February 1, 2006 ACP with complaints of misconduct and bias on the part of Office officials. Complaints of that nature are required by the regulations to be presented separately from other papers that so that they may be directed within the Office to the appropriate official and

considered without entry into the record of the present merged reexamination proceeding considered by the examiner. Accordingly, the papers filed on May 12, 2006 are improper papers that facially lack an entry right in the present merged proceeding to which they are directed. Patent owner has not established the existence of extraordinary circumstances that would require waiver of the regulations that preclude intermingling of complaints of misconduct and bias with substantive patentability issues in the same paper. Neither has patent owner established the right to have the May 12, 2006 papers entered pursuant to the Notice published at 1292 OG 20 in order to have this evidence considered after an ACP, for reasons pointed out above.

Accordingly, the papers filed on May 12, 2006 are appropriately returned in accordance with provisions of MPEP § 2267. In this instance, the papers were previously scanned into the Image File Wrapper (IFW) of each of the two individual reexamination proceedings that together comprise the present merged reexamination proceeding. Therefore, the papers cannot be physically returned to patent owner. Instead, the papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the IFW with the active papers that comprise the public record.

The present petition itself contains allusions to patent owner's complaints of employee misconduct and bias. Accordingly, though the petition itself is being retained of record in the IFW file, it is being marked as "non-public."

CONCLUSION

1. The May 12, 2006 patent owner petition is dismissed.

2. The papers filed with the May 12, 2006 patent owner petition lack an entry right in the merged reexamination proceeding, and are being "returned" to patent owner by being marked "non-public" and "closed."

3. The present petition will be retained of record in the IFW file, and it is being marked as "non-public."

4. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the public IFW record of *ex parte* reexamination proceedings 90/006,495 and 95/000,020.

5. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

   By Mail to: Mail Stop *Inter Partes* Reexam
   ATTN: Central Reexamination Unit
   Office of Patent Legal Administration
   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
   ATTN: Central Reexamination Unit
   Randolph Building
   401 Dulany St.
   Alexandria, VA 22314

6. In the event that patent owner elects to file a renewed petition and again submit material directed to both complaints of misconduct/bias and substantive issues of patentability raised in the February 1, 2006 ACP, the former material must be separately filed and the "misconduct/bias" paper plainly marked so as to identify it as material that is not to be scanned into the IFW record.

7. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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August 22, 2006

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8-22-06

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CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION GRANTING PETITION

This is a decision on the February 23, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Suspend The Page and Word Count Limitations of 37 CFR § 1.943."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary: Patent owner's petition is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c), and is granted to the extent that, the page limit for the patent owner's appellant's brief is extended to not exceed 60 pages, or 28,000 words, in length.

PETITION FEE

A petition fee under 37 CFR 1.17(f) of $ 400.00 is required for a petition under 37 CFR 1.183. As authorized on page 8 of the present petition, the $ 400.00 petition fee will be charged to patent owner's Deposit Account No. 50-0206.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Senior Special Projects Advisor issued a decision, *sua sponte*, by which the '495 reexamination proceeding and the '020 reexamination proceeding were merged into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 26, 2003 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006.[1]

10. On March 1, 2006, the patent owner filed written comments after the ACP. The third party requester has not filed a paper responsive to the patent owner's comments on the ACP.

11. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request (hereinafter "the FOIA material"), and also a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding.

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

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[1] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

13. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

15. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

16. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material.

17. On January 4, 2007, patent owner filed a Notice of Appeal in this merged proceeding.

18. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition in which patent owner facially requested that all of the material filed on May 12, 2006 be entered into the record.

19. No decision on either the January 4, 2007 patent owner petition or the February 5, 2007 petition has been mailed.

20. Prosecution has progressed to the point where appellant briefs are due from parties. [2]

21. On February 23, 2007, patent owner filed the present petition to suspend the page and word-count limitation of 37 CFR 1.943.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

[2] The third party requester has waived its right to any further response in this proceeding that may be allowed or provided for in accordance with the rules. See the third party requester paper filed on March 27, 2006 coded RXLET.

Petitioner patent owner has requested a waiver of the requirements of 37 CFR 1.943 As the prosecution has advanced to the point where patent owner's appellant's brief is due, the request is being construed as a request for waiver of the requirements of 37 CFR 1.943(c). The request is based on the fact that the examiner's ACP is 209 pages in length and the RAN is over 37 pages in length. [3] Petitioner patent owner further notes that the 37 page RAN included several references to the ACP, but was still 7 pages longer than allowed by 37 CFR 1.943(c) for patent owner's appellant brief. [4] Patent owner asserts that it will be unable to fully address the numerous allegations and rejections set forth in the RAN in the space allotted by 37 CFR 1.943(c). [5] Patent owner additionally advances a number of other arguments in support of the requested relief.

Petitioner patent owner is also requesting that if a decision on the present patent owner petition to waive the provisions of 37 CFR 1.943 is not granted prior to the filing of patent owner's appellant's brief in compliance with the rule, then patent owner be granted leave to file a *supplemental* appeal brief that is not subject to any page or word count limitation.

II. Findings and Analysis

The present petition owner petition fails to specifically state how many additional pages, beyond the permitted 30 page length (or additional words beyond the permitted 14,000 words), petitioner is requesting to "fully address" the appealed the rejections set forth. Given this lack of specificity in petitioner's request and the presence of the 30 page or 14,000 word limit set forth in 37 CFR 1.943(c), the petition as presented cannot be granted. The length limitations on responses in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305, and are analogous to those provided in litigation. [6] Petitioner has failed to provide any justification for an extension of the permitted page or word limit for an appellant's brief without any limitation as to the specific number of pages or words. To allow petitioner the unfettered ability to provide a response of whatever page or word limit petitioner deems necessary to address each of the grounds of the Office action could foreseeably open the door for an appellant's brief so voluminous as to substantially delay the instant reexamination proceeding.

Nevertheless, given the large number of claims involved, the numerous grounds of rejection set forth by the examiner, the number of pages that were required to set forth the examiner's position, as well as petitioner's timely request, the Office will grant the present petition to the extent of waiving the 37 CFR 1.943(c) appellant brief limit of 30 pages or 14,000 words:

(A) For only the filing of patent owner's appellant's brief, and,

(B) To permit patent owner to provide as much as 60 pages or 28,000 words for patent owner's appellant's brief. The Office will enforce compliance with this new limit of 60 pages or 28,000 words, and a strict review of the length of patent owner's appellant's brief will be made upon its receipt. It is to be noted, that pursuant to 37 CFR 1.943(c), if the page limit for any brief is exceeded, "a certificate is required stating the number of words contained in

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[3] Patent owner's present petition, at page 4, second full paragraph.
[4] *Id.*, at page 5, first full paragraph.
[5] *Id.*, at page 6, line 2.
[6] See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000) (Notice of Proposed Rule Making) at page 18160 - "These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure). "

the brief." Failure to comply with the presently extended length limitation will result in *non-entry* of the appellant's brief.

It is to be noted that appellant's brief need not re-state all of the rejections that are detailed in the Office action; it need only refer to them and contest them. Accordingly, twice the regulatory allotted amount is deemed sufficient. Further, in litigation, records are more lengthy than the present record; yet the length of briefs is limited by court rules.

It is emphasized that this waiver is granted based only upon the factors set forth in the preceding paragraph, specifically:

(A) The length of the RAN and the ACP to which numerous references are made in the RAN to which patent owner must respond.

(B) The large number of appealed claims (764 total claims) and the correspondingly large number of rejections that address these claims that are involved in the appeal.

(C) Petitioner patent owner's timely filing of the present petition.

In patent owner petitions dated January 3, 2007 and February 5, 2007, patent owner requested entry into the active IFW record certain material that is voluminous, extending to hundreds of pages. As the record currently stands, there is no present right to have this material entered and considered and this material is not of record in the active IFW record. Accordingly, this material cannot provide, and does not provide any basis for the granting of the present waiver.

ADDITIONAL DISCUSSION

With respect to any subsequently filed patent owner brief that may be filed (for example, a rebuttal brief under 37 CFR 41.71(b)(1)), it will be required patent owner provide a separate petition for waiver, supported by a showing that will independently satisfy the requirements of 37 CFR 1.183.

Additionally, until such time as the material that was the subject of the January 3, 2007 and February 5, 2007 petitions has been determined to enjoy an entry right in the present merged reexamination proceeding, or has otherwise been entered into the active IFW record of the present merged reexamination proceeding, that material may not be submitted as part of patent owner's appellant's brief, including the appendices thereto. In this regard, patent owner should note that the evidence that may be included in the evidence appendix (37 CFR 41.67(b)(ix)) of an appellant's brief is limited to evidence submitted pursuant to 37 CFR 1.130, 37 CFR 1.131, or 37 CFR 1.132 or any other evidence entered into the record by the examiner and relied upon by appellant. Patent owner should further note the requirement that the evidence appendix also include a statement setting forth *where in the record* that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted. In the event that the material that was the subject of the January 3, 2007 and February 5, 2007 petitions is determined to enjoy an entry right and is entered into the record subsequent to filing of patent owner's appellant's brief, such material would be addressed by the Office at that point.

Insofar as the present patent owner petition requests permission to file a supplemental appellant's brief without page or word limitation in the event that the present patent owner petition had not been decided prior to the filing of patent owner's appellant's brief, that request is *moot* in view of the mailing of the present decision prior to the filing of patent owner's appellant's brief.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 60 pages or 28,000 words in length.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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March 8, 2007

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In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

MAILED

MAR 15 2007

CENTRAL REEXAMINATION UNIT

DECISION DENYING PETITION

This is a decision on the February 5, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Reconsider Decision Dismissing Petition And, *Sua Sponte*, "Returning" Papers And Enter The Papers Into The Official Record. " [1]

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary: The petition is granted to the extent that (1) the "Decision Dismissing Petition and, *Sua Sponte*, 'Returning' Improper Papers" [2] dated September 13, 2006, has been reconsidered. For the reasons set forth below, the relief requested by petitioner patent owner is denied. The present decision is designated as a final agency action under 35 U.S.C. § 704.

PETITION FEE

No fee is required for the present Petition for Reconsideration.

[1] Hereinafter "Petition for Reconsideration."
[2] Hereinafter "Decision Dismissing Petition."

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [3]

10. On March 1, 2006, the patent owner filed written comments after the ACP. The third party requester has not filed a paper responsive to the patent owner's comments on the ACP.

11. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request (hereinafter "the FOIA material"), and also a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding.

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

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[3] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and apparently received by patent owner on June 16, 2006.

13. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [4] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

15. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

16. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which does not include the FOIA material.

17. On February 5, 2007, patent owner filed the present Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006 be entered into the record. [5]

18. On February 23, 2007, patent owner filed a petition to suspend the page and word-count limitation of 37 CFR 1.943.

19. On March 5, 2007, patent owner timely filed an appellant's brief.

20. On March 9, 2007, a decision was mailed granting, to a limited extent, the February 23, 2007 petition.

DECISION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 314(c) provides:

> "SPECIAL DISPATCH.– Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

37 CFR 1.3 provides:

> "Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

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[4] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

[5] While the present Petition for Reconsideration broadly seeks relief in the form of entry of both the FOIA material and the material directed to the authenticity of the Telenor documents, see page 10, patent owner's arguments are directed only to entry of the FOIA material.

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.181 provides in pertinent part:

"(a) Petition may be taken to the Director:

...

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

...

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. **Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.**

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions. [Emphasis in bold added.]

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

"The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration."

37 CFR 1.939(a) provides:

"If an unauthorized paper is filed by an party at any time during the *inter partes* reexamination proceeding it will not be considered, and may be returned."

37 CFR 1.951(a) provides:

"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."

MPEP § 2667 provides in part:

> "The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.
>
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: **the reexamination file (paper file or IFW file history)**<; the patent file (paper file or IFW file history)<; or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number." [Emphasis added.]

II. Basis For The September 13, 2006 Decision

On February 1, 2006, an ACP was promulgated by the Office in this merged *inter partes* reexamination proceeding. On March 1, 2006, patent owner timely filed written comments to the ACP under 37 CFR 1.951(a). Thereafter, on May 12, 2006, patent owner filed a second set of written comments in response to the ACP that included (1) papers directed to the merits of the patentability issues in the merged proceeding, and (2) the FOIA material. Recognizing that 37 CFR 1.951(a) permits a patent owner to "once file" comments to an ACP, petitioner patent owner sought a 37 CFR 1.183 waiver of 37 CFR 1.951(a) to permit entry of the second set of comments to the ACP. Patent owner argued that the information for which entry was sought by waiver of 37 CFR 1.951(a) was new information that could not have been earlier presented.

Patent owner also sought entry of the May 12, 2006 submission on alternative grounds under 37 CFR 1.182, in the form of part of a request for continued reexamination (a so-called "RCR") pursuant to the Notice published at 1292 OG 20 (2005). Grant of the petition pursuant to 37 CFR 1.182 and the O. G. Notice would have provided for withdrawal of the ACP, entry of the May 12, 2006 papers and continuation of prosecution in the present merged reexamination proceeding in a manner somewhat analogous to request for continued examination (RCE) practice under 37 CFR 1.114 in a non-provisional patent application.

It was pointed out in the September 13, 2006 decision, in explanation of why the underlying relief requested by petitioner would <u>not</u> be appropriate, that:

A) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

B) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding <u>must be raised in separate papers</u> so as to avoid confusion and delay in addressing the subjects.

C) 37 CFR 1.951(a) provides that after an action closing prosecution, the patent owner is permitted to filing a response that is "limited to the issues raised in the Office action closing prosecution." However, the supplemental response was not so limited. Rather, the supplemental response co-mingled material that was directed to substantive patentability matters to be reviewed by the examiner, and which were ultimately subject to appeal to the

Board of Patent Appeals and Interferences ("BPAI") with material directed to matters to be reviewed through the exercise the USPTO Director's supervisory authority under 37 CFR 1.181.

These points have not been persuasively addressed in the present Petition for Reconsideration.

A. The May 12, 2006 Papers Did Not Comply With 37 CFR 1.3 - No Extraordinary Circumstance Established To Support Waiver Of This Regulation

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The FOIA material that was included in the now "returned" May 12, 2006 papers was argued by patent owner to constitute evidence of improper conduct on the part of Office personnel. The Office construed patent owner's characterization such as, for example, "[T]he PTO Engaged In Improper Communications with Third Parties That Are Not Reflected In The Record Of Decision for the Reexamination" and "[T]he non-record communications demonstrate actual bias against Patent Owner by persons participating in the decision-making process" [6] as constituting complaints regarding the conduct of Office employees. Yet this complaint was submitted as part of papers directed to other matters, *i.e.*, the question of claim patentability in this merged proceeding. Accordingly, entry of the May 12, 2006 papers was considered to be barred by 37 CFR 1.3. It was determined that patent owner did not establish any reason why patent owner could not simply comply with 37 CFR 1.3 and file the FOIA material outside of the active IFW record of the present merged reexamination proceeding, separately from proffered materials directed to substantive patentability matter. Neither did patent owner establish any reason why papers filed in the active IFW record of the present reexamination proceeding could not be limited to matters directed to substantive patentability issues. It is now to be noted that, in a petition filed on January 3, 2007, patent owner has separately requested entry of papers that were essentially limited only to matters directed to substantive patentability issues.

B. The May 12, 2006 Papers Did Not Comply With 37 CFR 1.4(c)(3) - No Extraordinary Circumstance Established To Support Waiver Of This Regulation

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the May 12, 2006 papers included both (a) the FOIA material, (material argued to establish improper conduct on the part of Office employees, as discussed in Section II(A) immediately above) and (b) material directed to the authenticity of the Telenor documents (material directed to an issue of claim patentability). Patent owner filed such papers notwithstanding that the matters raised therein are decided by different branches of the Office and resolved by different appellate review tribunals:

(a) Decision on petition to the USPTO Director, and
(b) Consideration by the examiner, which may ultimately be reviewed by the Board of BPAI.

Accordingly, entry of the May 12, 2006 papers was considered to be barred by 37 CFR 1.4(c). Again, patent owner apparently recognized this and requested waiver of the regulation. It was determined that patent owner did not establish any reason why patent owner could not simply comply with 37 CFR 1.4(c) and file the FOIA material outside of the active IFW record of the present merged reexamination proceeding and separately from materials directed to

[6] See the original Petition filed on May 12, 2006, at page 10.

substantive patentability matter. Neither did patent owner establish any reason why papers filed in the active IFW record of the present merged reexamination proceeding could not be limited to matters directed to substantive patentability issues. Again, it is now to be noted that, in the petition filed on January 3, 2007, patent owner does in fact request entry of papers that are essentially limited only to matters directed to substantive patentability issues. Thus, petitioner did not establish the existence of an extraordinary situation, when justice requires waiver of 37 CFR 1.4(c) in this merged proceeding.

C. The May 12, 2006 Papers Did Not Comply With 37 CFR 1.951(a) - No Extraordinary Circumstance Established To Support Waiver Of This Regulation

The May 12, 2006 papers purported to be a second set of written comments directed to the outstanding ACP dated February 1, 2006. Pursuant to 37 CFR 1.951(a), a patent owner may once file written comments limited to the issues raised in the Office action closing prosecution. The May 12, 2006 papers did contain material directed to the Telenor documents, and such is directed to the issue of the patentability of the claims of the patents being reexamined. This issue, and all issues of claim patentability, would ultimately be resolved by appeal to the Board. However, the Office determined that because the May 12, 2006 papers included the FOIA material, the May 12, 2006 papers also contained comments and documents that were not limited to the issues raised in the ACP Office (*i.e.*, the material was not limited to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct (*e.g.* improper contact with third parties) on the part of Office employees/officials. A determination of whether the FOIA material in fact established misconduct on the part of Office personnel is only available by way of petition to the USPTO Director, and not by an appeal to the Board. Patent owner did not establish that compliance with the provisions of 37 CFR 1.951(a) represented an extraordinary situation such that waiver of the regulation was required. Patent owner could simply have limited the submission in the record of this merged reexamination proceeding to material directed to the issue of patentability of the claims, and separately filed material directed to conduct matters outside of the active IFW record. Once again, it is now to be noted that the petition filed on January 3, 2007, patent owner does in fact request entry of papers that are essentially limited only to matters directed to substantive patentability issues.

D. The May 12, 2006 Papers Did Not Establish A Basis For Relief Under 37 CFR 1.182

Patent owner's petition dated May 12, 2007 did not establish why the concurrently filed papers should be entered as part of as part of a so-called "request for continued reexamination" pursuant to the Notice published at 1292 OG 20. Facially, such relief would not be appropriate because, absent a 37 CFR 1.183 waiver of 37 CFR 1.3 and 1.4(c), the May 12, 2006 papers submitted would continue to be non-enterable papers for the reasons discussed above. That is, absent waiver of 37 CFR 1.3 and 1.4(c), granting the relief requested would have approved of the entry of papers into the active IFW record that were otherwise precluded by 37 CFR 1.3 and 1.4(c). Again, patent owner did not establish that compliance with these regulations would present an extraordinary situation so as to justify waiving any of 37 CFR 1.3 or 37 CFR 1.4(c).

III. Findings And Analysis With Respect To The Present Request For Reconsideration

A. Certificate of Service

37 CFR 1.903 requires, *inter alia*, that after the filing of a request for *inter partes* reexamination by a third party requester, any document filed by the patent owner must be served on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248. 37 CFR 1.903

also states that any document must reflect service or the document may be refused consideration by the Office, and that the failure of the patent owner to serve documents may result in their being refused consideration.

It appears that the present Petition for Reconsideration was accompanied by the filing of a collection of FOIA material, and some material related to the Telenor documents. However, the Certificate of Service that accompanied patent owner's filing of all of the papers filed by patent owner on February 5, 2007 states only that counsel for patent owner "caused a copy of the foregoing 'PETITION PURSUANT TO 37 CFR § 1.181 OR, ALTERNATIVELY, 37 CFR § 1.182, OR, ALTERNATIVELY, 37 CFR § 1.181 TO RECONSIDER DECISION DISMISSING PETITION AND SUA SPONTE, 'RETURNING' PAPERS AND ENTER THE PAPERS INTO THE OFFICIAL RECORD" to be served on the third party requester. It cannot be established from the language of the Certificate of Service that the papers accompanying the present Petition for Reconsideration (*i.e.*, the copies of the FOIA material and the material related to the Telenor documents) were considered to be part of the petition and were, therefore, also served on the third party requester.

Therefore, the patent owner petition is incomplete, and cannot be granted, because (1) the record does not clearly show that all of the patent owner's papers filed concurrently with the present Petition for Reconsideration have been served on the third party requester, and (2) it is not clear that the such papers have actually been served on the third party requester.

B. Patent Owner's Request To Reconsider The Decision Dated September 13, 2006 Is Not Timely Filed

37 CFR 1.181(f) provides, *inter alia*, that any petition under Part I of 37 CFR ("...any petition under this part...") which is not filed within two months of "the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided." 37 CFR 1.181(f) also provides that this two-month period "is not extendable." Thus, any petition filed pursuant to 37 CFR 1.181, 1.182 or 1.183 may be dismissed as untimely filed, if it is not filed within two months of the mailing date of the notice from which relief is requested. When the Office's September 13, 2006 Decision on Petition was mailed on May 12, 2006, a two month non-extendable period under 37 CFR 1.181(f) was established for requesting reconsideration of the Decision on Petition.

The two-month period for reconsideration of the September 13, 2006 decision expired after November 13, 2006. Patent owner did not file the present Request for Reconsideration of the September 13, 2006 Decision on Petition on or before November 13, 2006. Had petitioner patent owner filed the present petition (together with the supplemental patent owner comments and the verified statement evidence) by November 13, 2006, it would have preceded the Right of Appeal Notice (RAN) that was issued almost one month after November 13, 2006. To the extent that 37 CFR 1.181(f) allows for discretion on the part of the USPTO Director to accept the present petition as timely filed, the present Request for Reconsideration contains no explanation of why patent owner did not submit the present Request for Reconsideration for entry of the papers submitted therewith within two months of the September 13, 2006 decision. Indeed, the present petition is almost identical to the petition filed on May 12, 2006, differing only in that it expands upon arguments for entry of the materials related to conduct issues, in order to respond to the September 13, 2006 Decision. The present Request for Reconsideration offers no explanation as to why it could not have been filed within the two month period established by 37 CFR 1.181(f). *Accordingly, the present petition offers no explanation as to why the USPTO Director should exercise discretion and accept the presently filed papers that have been filed more than a month late.*

Also weighing heavily against accepting the late filed Request for Reconsideration is that if the underlying requested relief is granted, the Office will need to do substantial re-work to then issue a new RAN, or possibly reopen prosecution, if new issues are raised. Patent owner has argued the importance of the information submitted; however, that must be balanced against the significant delay that consideration of such information would entail as well as petitioner's lack of equities due to delay in requesting reconsideration. In litigation, where a time period for filing a pleading is missed, the material contained therein can also be important. Yet, when the time period is missed, the pleading will not be admitted, in order to maintain an orderly court proceeding. It is no different in this instance, where it is especially important to maintain an orderly reexamination proceeding since:

> 35 U.S.C. § 305 mandates that the *ex parte* reexamination of the present merged proceeding must be conducted with special dispatch within the Office, and
>
> 35 U.S.C. § 314(c) mandates that the *inter partes* reexamination is to be conducted with special dispatch.

Nothing in the present petition, or in the record of the merged reexamination proceeding as a whole, provides a compelling basis to act counter to both 35 U.S.C. § 305 and 35 U.S.C. § 314(c) by removing the present merged proceeding from its status as a proceeding that is ready for the appeal process to commence. In this regard, note is taken of the fact that an ACP been promulgated and commented on by patent owner, a Right of Appeal Notice has been promulgated and a Notice of Appeal in response thereto has been timely filed. The merged proceeding is ripe for appeal on the present record, and patent owner has not established a persuasive reason why the merged reexamination proceeding should now be reopened and delayed, especially given that patent owner itself has introduced a large delay factor by not timely filing the present Request for Reconsideration.

Accordingly, patent owner's supplemental comments to the action closing prosecution and the verified statements in support of the supplemental comments will not be entered and considered in the present merged reexamination proceeding.

C. Patent Owner's Petition To Reconsider The Decision Dated September 13, 2006 Does Not Establish The Existence Of An Extraordinary Circumstance Justifying Waiver Of The Rules

1. Material For Which Entry Is Requested Based Upon Waiver of the Rules

As has been pointed out, the May 12, 2006 material for which patent owner seeks a 37 CFR 1.183 waiver in order to permit entry into the record of the present merged proceeding is of two kinds. Some of the material filed by patent owner on May 12, 2006 is alleged by patent owner to demonstrate that the Telenor documents (applied to evidence claim unpatentability) are not in fact prior art. The rest of the material filed on May 12, 2006, (the so-called "FOIA material"), is alleged by patent owner to evidence improper communications in an effort to demonstrate "actual bias against Patent Owner by persons participating in the decision-making process," which in turn resulted in a reexamination process that was "not fair and impartial," in that "the outcome was predetermined against" patent owner. [7] Patent owner further alleges that the material evidences improper communications that were "expressly in violation of statutory requirements." [8]

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[7] See the paragraph bridging pages 4 and 5 of the present Petition for Reconsideration.
[8] *Id.*

2. Relief Pursuant to 37 CFR 1.183 (Waiver of the Regulations)

a. Requirement Necessary for Relief Pursuant to 37 CFR 1.183

37 CFR 1.183 provides that where an extraordinary situation is presented, a requirement of the regulations that is not a requirement of the statutes may be waived in the interest of justice. Patent owner again requests that 37 CFR 1.951(a) be waived in order to permit entry of the May 12, 2006 papers. The waiver is asserted to be necessary because 37 CFR 1.951(a) permits patent owner to only once file written comments responsive to the February 1, 2006 ACP, while the May 12, 2006 papers constitute a second set of written comments responsive to the ACP.

b. Patent Owner's Position

Patent owner's position is that entry of the FOIA material into the active IFW record is not precluded by either 37 CFR 1.3 (a regulation that requires that complaints against examiners and Office employees be submitted in correspondence separate from other papers) or 37 CFR 1.4(c) (a regulation that requires that where different matters may be considered by different branches or sections of the Office, each distinct subject must be contained in a separate paper to avoid confusion and delay in dealing with the different subjects). Rather, patent owner argues that the FOIA material has been submitted to demonstrate that the "so-called patentability determination was actually a patentability pre-determination and/or based upon the improper communications. " [9] Patent owner takes the position that the FOIA material is, therefore, relevant to the patentability determination in this merged proceeding. [10] Specifically, patent owner relies upon 37 CFR 1.104(a)(2), which requires that a patent owner be informed of the reasons for any adverse action and be provided with such information as may be useful in aiding the patent owner to judge the propriety of continuing its prosecution. Patent owner also relies upon 37 CFR 1.104(b) to assert that the examiner's actions in this proceeding are incomplete because they do not acknowledge the alleged improper communications. Patent owner additionally relies upon 37 CFR 1.104(d)(2) to assert that the examiner is required to inform patent owner of facts within the personal knowledge of an employee of the Office when a rejection is based thereon. [11] Patent owner argues that the FOIA material demonstrates that all of these regulatory provisions were violated by the Office, that these violations go to the merits of the patentability determination in this merged proceeding and not to employee conduct, and that the FOIA material is, accordingly, enterable into the active IFW record. Patent owner apparently concludes that the FOIA material is directed to substantive patentability issues, and accordingly, entry of the FOIA material requires a waiver of 37 CFR 1.951(a) only. Patent owner argues that this rule should be waived because the interests of justice require such a waiver.

c. Patent Owner Has Not Demonstrated That the FOIA Material is Directed to Substantive Patentability Issues Such That Waiver of 37 CFR 1.951(a) Alone Would Permit Entry Thereof

Initially, it is to be noted that, in related reexamination proceedings involving other patents owned by patent owner, patent owner has in fact argued that the FOIA material goes to actual bias on the part of specifically named Office employees. [12] Whether patent owner now intends,

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[9] See Petition for Reconsideration at page 5, last paragraph

[10] *Id.*, at page 7.

[11] See Petition for Reconsideration at page 6.

[12] As one example, in the August 23, 2006 petition filed by patent owner (a paper that is is in the non-public sections of the IFW records) for merged reexamination control nos. 90/006,493, 90/006,680 and 90/007735 (directed to patent owner's U.S. Patent 5,819,172), patent owner names specific Office employees and characterizes their conduct as having been improper. In the October 23, 2006 petition for reconsideration in that merged proceeding, patent owner has actually styled a subsection of the petition using the phrase "NTP's Evidence of Examiner Bias."

or ever intended, to categorize such material as evidence that is, in its nature, directed to the substantive patentability determination in the present merged reexamination proceeding, is wholly irrelevant. The FOIA material undeniably goes to the conduct of Office employees that patent owner alleges to have been improper, which conduct is alleged to have resulted in bias against the patent owner, and patent owner has stated as much in the related reexamination proceedings involving patents owned patent owner and involving the same third party requester in the present merged reexamination proceeding. [13] The FOIA material clearly is presented in order to complain about alleged misconduct and bias on the part of Office employees.

Patent owner has not demonstrated that the FOIA material goes to the substantive patentability issues in this merged reexamination proceeding to any extent. The FOIA material proffered by patent owner merely constitutes "evidence," upon which patent owner then bases certain allegations, including allegations that the outcome of this reexamination proceeding has been "pre-determined" (whether as the result of bias or for other reasons). Patent owner argues that pursuant to the provisions of 37 CFR 1.104, this material must be considered and evaluated by the examiner as part of the examiner's determination of substantive patentability issues. However, the mere presentation of evidence by patent owner in support of allegations advanced by patent owner does not establish the truth of the proposition that the present status of this merged reexamination proceeding is the result of improper conduct by Office employees, and/or bias on the part of Office employees or that the results of the proceeding have been pre-determined. The issue of whether one or more Office employees in fact engaged in improper conduct, and whether any such improper conduct would in fact demonstrate bias (to affect the outcome of this merged reexamination proceeding on the question of patentability), is, in the first instance, a matter for determination by the Director (or his delegate for that purpose). The Examiner is **not** the Office official charged with making that determination, and does not have the authority to do so. In accordance with 37 CFR 1.104(a)(1), the examiner in a reexamination proceeding "shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention." Further, the regulation charges the examiner with making an examination that "shall be complete with respect both to compliance with the applicable statutes and rules, and to the patentability of the invention as claimed, ..." The first quoted provision of 37 CFR 1.104(a)(1) makes it clear that examiner is not charged with making a determination of any substantive issue other than a consideration of the available prior art that relates to the subject matter of the invention claimed in the proceeding to which the examiner is assigned. The second quoted sentence merely requires that the patentability determination based upon a consideration and application of the relevant prior art is to be made in accordance with the relevant statutes and rules. It is not part of the examiner's responsibility under 37 CFR 1.104(a)(1) to consider whether evidence of alleged improprieties on the part of Office officials has resulted in a bias against an official that would bear on the outcome of a proceeding, because such a determination does not arise from a consideration, under the applicable statutes and rules, of the available prior art. [14] Indeed, since it is the examiner who in the first instance determines the outcome of patentability issues in the proceeding to which the examiner has been assigned, it is not reasonable to assert that the examiner should be considering evidence that goes to whether misconduct and internal bias within the Office has pre-determined the outcome on the question of patentability in that proceeding.

Consideration of the meaning of 37 CFR 1.104(a)(1), as set forth in the preceding paragraph, will also demonstrate that patent owner's reliance upon 37 CFR 1.104(a)(2), 37 CFR 1.104(b) and 37 CFR 1.104(d)(2) as requiring that the FOIA materials be considered by the examiner as evidence

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[13] *Id.*

[14] MPEP § 1004 lists the matters within the jurisdiction of the Primary Examiner.

directed to substantive patentability issues is misplaced. The provisions of 37 CFR 1.104(a)(2), (b), and (d)(2) must be read in the context of 37 CFR 1.104(a)(1), which limits the examiner's role to an investigation of the available prior art and a patentability determination based on that prior art in light of the applicable statutes and rules. Thus, 37 CFR 1.104(a)(2), which requires that a patent owner be informed of the reasons for any adverse action and provided with such information as may be useful in aiding the patent owner to judge the propriety of continuing its prosecution, means that the patent owner must be informed of the rationale supporting the examiner's determination that the available prior art has mandated a particular holding on claim patentability, in light of the statute and rules governing patentability. The provisions of the 37 CFR 1.104(a)(2) have nothing to do with determining the presence or absence of influence on the patentability determination based upon evidence of allegedly improper communications (that are in turn alleged to establish bias resulting in a pre-determined outcome of a patentability determination) without regard to how the prior art is applied. Evidence of that kind is simply not prior art, and allegations based upon such evidence are not prior art. 37 CFR 1.104(b) means that the examiner's action has to be complete in all matters respecting the merits of a patentability determination of the claimed invention, based upon the available prior art, as applied in accordance with the statutes and rules. 37 CFR 1.104(b) does not mean that the examiner is to evaluate evidence proffered to demonstrate improper conduct and bias on the part of Office personnel and to somehow factor that evaluation into the examiner's substantive patentability determination. *It is to be noted that if claims are unpatentable over specified prior art, they remain so despite any allegation of bias and evidence proffered to support the allegation.* 37 CFR 1.104(d)(2) requires that where the evidence of prior art is in whole or in part based upon the personal knowledge of the an Office employee, the data must be as specific as possible and must be supported by an affidavit of that employee, if so requested by an applicant. 37 CFR 1.104(d)(2) is not at all relevant to an evaluation by the examiner of evidence proffered to show alleged misconduct by Office personnel or an allegation of bias on the part of Office personnel, because such evidence and allegations are simply not prior art. 37 CFR 1.104(d)(2) merely means that to the extent that an examiner has personal knowledge that would amount to relevant prior art in the reexamination proceeding pursuant to 37 CFR 1.104(a)(1), that personal knowledge can be considered by the examiner, and it may be required that such personal knowledge be cast in the form of a verified statement. The FOIA material is not proffered as prior art to be considered in determining the patentability of the claimed invention in the present merged reexamination proceeding, [15] and it is not merits evidence that the Examiner would be either authorized or required to consider under any provision of 37 CFR 1.104.

Patent owner has also failed to demonstrate why consideration of the FOIA material by the examiner would have any impact on the substantive patentability determination that has been reached with respect to the claims in the present merged reexamination proceeding in view of the prior art of record in the merged proceeding. Patent owner has not explained why, if a rejection in the merged reexamination is based upon prior art that in fact demonstrates that one or more claims are not patentable, consideration of the FOIA material would change that outcome. Patent owner has also not demonstrated why, if one or more patent claims presently determined to be unpatentable at this stage of the proceeding are in fact patentable over the prior art, patent owner would be unable to convincingly demonstrate such to the examiner, or failing that, to persuade the Board of Patent Appeals and Interferences] that the claims are patentable on appeal, or failing that, to obtain a favorable decision on patentability by appeal to the Courts. Stated differently, patent owner has not demonstrated that there is any necessary link between (a) the alleged improper conduct and bias (on the part of Office personnel), and (b) the patentability of the claims in the present reexamination proceeding (which must be *objectively* determined by the above mentioned deciding officials). It is entirely possible that the

[15] The FOIA material was also not proffered as prior art in any of the other pending reexamination proceedings involving patent owner's patents and the present third party requester.

claim rejections currently of record are proper, even if inappropriate influence could somehow be shown. To the extent that patent owner is arguing that the rejections are improper, patent owner has not shown why the alleged misconduct and bias that has occurred to date will somehow influence the BPAI or the Courts. If patent owner believes that the misconduct and bias would extend to the BPAI or the Courts, that issue would be addressed under 37 CFR 1.3, and could not be addressed on the merits by the examiner.

For all of the foregoing reasons, patent owner has not demonstrated that waiver of 37 CFR 1.951(a) is appropriate or required. Patent owner has not demonstrated that a second set of written comments in response to the February 1, 2006 ACP should be entered into the active IFW record of the present merged reexamination proceeding in the interests of justice, because patent owner has not demonstrated that the second set of comments is confined to material that relates only to substantive patentability matters in the present proceeding. Rather, the FOIA material has not been shown by patent owner to be directed to the substantive patentability matters that exist in the present merged reexamination proceeding. To the extent that the FOIA material, as proffered by patent owner, is still co-mingled with the Telenor documents, there is no basis for waiving 37 CFR 1.951(a). Grant of a waiver of 37 CFR 1.951(a) would not serve the interests of justice, at least because it would sill be required that the FOIA material be entered notwithstanding that entry is precluded by 37 CFR 1.3 and 37 CFR 1.4(c) which are not waived for reasons set forth below. Therefore, even if the present Petition for Reconsideration had been timely filed, the requested waiver of 37 CFR 1.951(a) would not be granted.

d. Patent Owner Has Not Demonstrated That the Either 37 CFR 1.3 or 37 CFR 1.4(c) Should Be Waived to Permit Entry of the FOIA Material

In the present request for reconsideration, patent owner does not now appear to be requesting a waiver of either 37 CFR 1.3 or 37 CFR 1.4(c). Rather, patent owner now appears to take the position that the FOIA material was not filed as a matter of complaint against Office personnel, but as material bearing upon patentability that should be considered by the examiner. For the reasons set forth in Section III(C)(2)(c) above, patent owner has not demonstrated that the FOIA material is directed to substantive patentability issues, and has not demonstrated that the material should therefore be entered based upon solely on a waiver of 37 CFR 1.951(a). It is further deemed to be appropriate to reconsider whether the FOIA material, if offered as a complaint directed to improper conduct and bias, should be entered pursuant to a waiver of 37 CFR 1.3 and 37 CFR 1.4(c) in conjunction with a waiver of 37 CFR 1.951(a).

There does not appear to be any basis for waiving the provisions of 37 CFR 1.3 to permit entry of the FOIA material into the IFW record together with the material directed to the Telenor documents. The regulation will not be waived because there is no extraordinary circumstance that demands entry of this material into the active IFW record of the present merged proceeding. The suspension or waiver of a provision of the rules under 37 CFR 1.183 is an extraordinary action, which will not normally be considered if the rules provide an avenue for obtaining the relief sought. *Cantello v. Rasmussen,* 220 USPQ 664 (Comm'r Pat. 1982). In this instance, to the extent that the FOIA material relates to misconduct and bias on the part of Office personnel, the patent owner could have easily obtained consideration of the FOIA material in the Office by timely filing the FOIA material in compliance with the provisions of 37 CFR 1.3, so that the FOIA material could have been considered outside of the active IFW record of the present merged reexamination proceeding by the appropriate Office officials. Thus, petitioner had a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183, but chose not to exercise it. Therefore, no basis has been provided for waiver of 37 CFR 1.3.

There also does not appear to be any basis for waiving the provisions of 37 CFR 1.4(c) to permit entry of the FOIA material into the IFW record together with the material directed to the Telenor documents. The regulation will not be waived because there is no extraordinary situation that demands entry of this material into the active IFW record of the present merged proceeding. Again. patent owner could have obtained consideration of the FOIA material in the Office by timely filing the FOIA material in compliance with the provisions of 37 CFR 1.4(c), so that the FOIA material could be considered outside of the active IFW record of the present merged reexamination proceeding, and by the appropriate Office officials in the appropriate area of the Office. As demonstrated in Section III(C)(2)(c) above, the FOIA material has nothing to do with the merits of the substantive patentability determinations that are of record in the merged reexamination proceeding. Therefore, there is no basis for entry of the FOIA material into the active IFW record for consideration of that material by either the examiner or the BPAI in the event that patent owner perfects an appeal.

Thus, even if the present Petition for Reconsideration had been timely filed, patent owner has not demonstrated any basis to waive 37 CFR 1.3 and 1.4(c).

3. Relief Pursuant to 37 CFR 1.182 in the Form of A So-Called "Request for Continued Reexamination

Patent owner requests that, pursuant to the Notice published at 1292 OG 20 (March 1, 2005), relief under 37 CFR 1.182 should be granted, so that patent owner would be permitted to file and have entered "supplemental comments" to the February 1, 2006 ACP. The O.G. Notice discusses a change in reexamination practice whereby a patent owner in an *ex parte* reexamination proceeding would newly be required to demonstrate the existence of a different substantial new question of patentability in order to obtain a second or subsequent request for reexamination than was demonstrated in a prior *ex parte* reexamination proceeding for the same patent. Because of that change in practice, a patent owner is no longer able to obtain the entry of new evidence and/or an amendment (for a patent being reexamined) by filing a second or subsequent request for *ex parte* reexamination based on the same substantial new question of patentability that was found to exist in a pending *ex parte* reexamination proceeding. The O.G. Notice then discusses the ability of a patent owner to obtain this relief in a manner analogous to the relief that would available if a so-called "request for continued reexamination" (RCR) practice were in existence. Such relief is available pursuant to the O.G. Notice by filing a petition under 37 CFR 1.182 requesting such relief, and presenting evidence and/or an amendment that would advance prosecution in the existing *ex parte* reexamination proceeding. Although a patent owner can not file a request for *inter partes* reexamination because 35 U.S.C. § 311(a) and implementing regulation 37 CFR 1.907 expressly preclude a patent owner or its privies from filing a request for *inter partes* reexamination, the O.G. Notice nevertheless specifically provides for the possibility of permitting a patent owner to obtain entry of additional evidence and/or an amendments after the promulgation of an ACP in an existing *inter partes* reexamination by filing a petition under 37 CFR 1.182 requesting such entry.

The requested relief under 37 CFR 1.182 and the O.G. Notice, if granted, would permit patent owner to obtain entry of material that is not evidence directed solely to issues of patentability raised in the ACP, and is also not an amendment directed solely to issues of patentability raised in the ACP. Rather, the supplemental comments paper that was filed on May 12, 2006 is directed in part to the FOIA material. For the reasons set forth in Section III above, the FOIA material is not directed to substantive patentability issues in the present merged reexamination. Rather, it is material that purports to support allegations by patent owner that Office officials engaged in misconduct and were biased against patent owner so as to pre-determine the outcome of this merged reexamination proceeding. As previously discussed, material of that

character constitutes a complaint regarding the conduct of Office personnel, and can only be considered if filed in accordance with the provisions of 37 CFR 1.3. Further, 37 CFR 1.4(c) precludes submission of material of that character if it is intermingled with material that is directed to the entirely different issues of patentability raised in the ACP and RAN, such as the Telenor documents. Therefore, to grant the requested relief under 37 CFR 1.182 would necessarily require a waiver of both 37 CFR 1.3 and 37 CFR 1.4(c), in addition to a waiver of 37 CFR 1.951(a) as discussed above. However, for the reasons set forth above, even if the present Petition for Reconsideration had been timely filed, waiver of those regulations is not available, because patent owner has not established the existence of an extraordinary situation that would require suspension or waiver of those regulations in the interest of justice. Therefore, the requested relief pursuant to 37 CFR 1.182 is not granted.

As a final point, the RCR remedy is provided for entry of papers after ACP. Patent owner delayed renewing its request for an RCR until February 5, 2007, at which point the RAN was issued. The proceeding is now ready for appeal, and both an appeal and an appellant's brief have now been filed. If an RCR were to be granted at this stage, the Office would need "reverse" the appeal process and do substantial re-work.

IV. Synopsis

The patent owner has filed a set of papers on February 5, 2007 together with the present Petition for Reconsideration that cannot be entered into the active IFW record. The February 5, 2007 papers intermingle papers that are directed to the issues of patentability raised in the February 1, 2006 ACP and which are now ready for appeal, with FOIA material that constitutes complaints of misconduct and bias on the part of Office officials. Complaints of that nature are required by the regulations to be presented separately from other papers that so that they may be directed within the Office to the appropriate official and considered without entry into the record of the present merged reexamination proceeding considered by the examiner. Accordingly, the additional papers filed on February 5, 2007 are improper papers that facially lack an entry right in the present merged proceeding to which they are directed. Patent owner has not established the existence of extraordinary circumstances that would require waiver of the regulations that preclude intermingling of complaints of misconduct and bias with substantive patentability issues in the same paper. Neither has patent owner established the right to have any of the additional papers filed on February 5, 2007 entered pursuant to the Notice published at 1292 O.G. 20 in order to have this evidence considered after an ACP and a RAN.

V. Disposition Of Papers:

The additional papers filed on February 5, 2007 are appropriately returned in accordance with provisions of 37 CFR 1.939(a) and MPEP § 2667. In this instance, the papers have been scanned into the Image File Wrapper (IFW) of each of the two individual reexamination proceedings that together comprise the present merged reexamination proceeding. Therefore, the papers cannot be physically returned to patent owner. Instead, the papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the active IFW record with the other active papers that comprise the public record of the proceedings.

CONCLUSION

1. The February 5, 2007 patent owner Petition for Reconsideration is granted to the extent that the September 13, 2006 Decision Dismissing Petition has been fully reconsidered, both procedurally and on its merits.

2. The February 5, 2007 patent owner Petition for Reconsideration is denied with respect to disturbing the holding of the September 13, 2006 Decision Dismissing Petition, and with respect to the underlying relief requested by patent owner.

3. The papers filed with the February 5, 2007 patent owner Request for Reconsideration will remain in the IFW as "closed" and "non-public" papers. The papers will not be considered by the examiner on their merits, because they lack an entry right in the present merged reexamination proceeding.

4. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the active IFW record of *ex parte* reexamination proceeding 90/006,495 and in the active IFW record of *inter partes* reexamination proceeding 95/000,020.

5. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

6. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

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March 13, 2007

March 13, 2007
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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.
90/006,495	12/26/2002	6317592		9470

803 7590 03/30/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2007

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

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3/30/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495

PATENT NO. 6,317,592

ART UNI 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,020	05/29/2003	6317592	81208	3141

803 7590 03/30/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER

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3/30/07

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 95/000020
PATENT NO. 6,317,592
ART UNI 3992

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(For Third Party Requester)

MAILED

MAR 3 0 2007

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DENYING PETITION

This is a decision on the January 3, 2007 patent owner petition styled "Petition Pursuant to 37 CFR § 1.183 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.181 To Enter Evidence Against The Authenticity Of The Telenor Documents Into The Record Of The *Inter Partes* Proceeding." [1]

The petition, and the above-captioned merged reexamination proceedings, are before the Office of Patent Legal Administration for consideration.

The petition is denied, for the reasons discussed below. The present decision is designated as a final agency action under 35 U.S.C. § 704.

PETITION FEE

A single petition fee of $400.00 is being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized in the present petition.

[1] A single petition fee is required for the alternative requests for relief under the provisions of 37 CFR 1.182 and 37 CFR 1.183.

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REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006.[2]

10. On March 1, 2006, the patent owner filed comments after the ACP. The third party requester has not filed a paper responsive to the patent owner's comments on the ACP.

11. On May 12, 2006, the patent owner filed papers which included supplemental comments, copies of materials obtained as a result of the FOIA request, and also a number of verified statements directed to the issue of the authenticity of the Telenor documents [3] that have been relied upon (applied) as prior art in the merged reexamination proceeding.

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] The Telenor documents are made up of eight volumes, one of which is stapled with three staples down its left spine, and the others of which are bound together along one edge with glue. The Telenor documents were catalogued and maintained in Trondheim University Library in Norway. Some volumes are dated "22/2/89" and the rest are dated "24/4/89", facially qualifying them as prior art to the '592 patent under 35 U.S.C. § 102(b).

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12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

13. On September 13, 2006, a Decision (1) dismissing the May 12, 2006 petition, (2) "returning" the papers that were filed on May 12, 2006, [4] and (3) inviting petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006. [5] A request for reconsideration of the September 13, 2006 Decision was, however, filed on February 5th - see fact # 15 below.

15. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

16. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

17. On January 3, 2007, the patent owner filed the present petition requesting entry of a paper titled "Patent Owner's Supplemental Patent Owner Comments After An Action Closing Prosecution" and supporting evidence into the record, at this point in the prosecution (i.e., after the RAN had been issued).

18. On February 5, 2007, patent owner filed a petition requesting reconsideration of the September 13, 2006 decision dismissing the May 12, 2006 patent owner petition.

19. On February 23, 2007, patent owner filed a petition requesting waiver of the page and word count limitations established by 27 CFR 1.943 for filing appellant's brief filed under 37 CFR 41.67.

20. On March 7, 2007, patent owner filed its appellant brief.

21. On March 9, 2007, a decision was mailed granting patent owner's February 23, 2007 petition for waiver of the provisions of 37 CFR 1.943 to the extent stated in the decision.

22. On March 15, 2007, a decision was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration.

RELEVANT STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. § 314(c) provides:

> "SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

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[4] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW.

[5] See 37 CFR 1.181(f), reproduced below, and the discussion regarding the regulation as to the timeliness requirements for petitions.

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37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.181 provides in pertinent part:

"(a) Petition may be taken to the Director:

...

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

...

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. **Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.**

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions." [Emphasis in bold added.]

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

"The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration."

37 CFR 1.937(a) provides:

"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.

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37 CFR 1.939(a) provides:

> "If an unauthorized paper is filed by an party at any time during the *inter partes* reexamination proceeding it will not be considered, and may be returned."

37 CFR 1.951(a) provides:

> "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."

MPEP § 2667 provides in part:

> "The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.
>
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: **the reexamination file (paper file or IFW file history)**<; the patent file (paper file or IFW file history)<; or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number." [Emphasis added.]

DECISION DENYING THE PETITION

I. Patent Owner's Position

Patent owner recognizes that an Action Closing Prosecution (ACP) was promulgated in this merged proceeding on February 1, 2006, that patent owner timely filed comments on the ACP on March 1, 2006, and that 37 CFR 1.951(a) limits patent owner to the filing of a single response to an ACP. Patent owner has accordingly petitioned to obtain an entry right for the supplemental response to the ACP. [6] Patent owner invokes, in the alternative, 37 CFR 1.181, 37 CFR 1.182 and 37 CFR 1.183 as providing a basis *for entry of the supplemental response to the ACP*. Patent owner's position, as set forth in the present petition, can be summarized as follows:

(1) Patent owner urges that extraordinary circumstances exist to justify entry, and consideration by the examiner, of the supplemental comments to the ACP and the material submitted in support thereof. [7] The extraordinary circumstances asserted by patent owner are that the

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[6] The January 3, 2007 patent owner petition states, in the paragraph bridging pages 1 and 2 (emphasis added):

> Pursuant to 37 C.F.R. 1.183, Patent Owner submits that **the requirement for Patent Owner to *once*, file comments** within thirty days of an Office Action Closing Prosecution (see 37 C.F.R. § 1.951 (emphasis added)) should be suspended or waived, where, as here, new information that has been deemed relevant to substantive patentability issues by the PTO becomes available after the expiration of the thirty day period of time for filing comments after ACP.

[7] The supporting material consists of verified statements that purport to demonstrate that the Telenor documents are not authentic documents.

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supporting material was not available to patent owner until after the ACP had been promulgated. Therefore, to the extent that 37 CFR 1.951 permits a patent owner to only once file comments to an ACP, a 37 CFR 1.183 waiver of the provisions of 37 CFR 1.951 is requested in the interest of justice. In patent owner's view, the waiver should be granted as a matter of Office policy and general fairness, since the information requested to be entered was unavailable to patent owner prior to the February 1, 2006 ACP and the March 1, 2006 patent owner response thereto. [8]

(2) Patent owner further urges that the content of the presently submitted papers has been deemed to be arguably relevant by the Office. Therefore, even if a 37 CFR 1.183 waiver of 37 CFR 1.951 is not granted, the papers should nevertheless be entered into the record and considered by the examiner *under the provisions of 37 CFR 1.182,* because there is no regulation specifically permitting entry of the papers. [9]

(3) Patent owner asserts that it would be unfair to refuse entry to the submitted papers, because the papers are relevant, and could not have been earlier submitted, since they were not available to patent owner in time to include them in a timely response to the ACP. Therefore, even if relief is not available under either 37 CFR 1.182 or 37 CFR 1.183, patent owner argues prosecution that should be *reopened* under the general supervisory provisions of 37 CFR 1.181 for the limited purpose of permitting entry of the submitted papers. [10]

II. Findings and Analysis

A. Inclusion of FOIA Material in the Present Petition

While the present petition purports to be limited to requesting entry of evidence against the authenticity of the Telenor documents, the petition is in fact not so limited. Instead, the papers (for which entry is now sought) submitted with the present petition, , include a declaration executed on April 24, 2006 by one Kevin P. Anderson. The declaration relates to the FOIA material obtained by patent owner - see Facts 7 and 9 above. As noted in Facts 11-14 above, patent owner filed a petition on May 12, 2006 requesting entry of papers that included both the Telenor documents and the FOIA material, and the petition was dismissed in a decision dated September 13, 2006. Patent owner requested reconsideration of that decision on February 5, 2007, and that petition was denied on March 15, 2007, as to the underlying relief requested – Fact 21.

Entry of the papers submitted with the present petition into the active IFW record of the present merged reexamination proceeding, that is, papers that intermingle material directed to the Telenor documents with FOIA material, will not be permitted for the reasons discussed in the September 13, 2006 and March 15, 2007 decisions that addressed patent owner's request for entry of the intermingled papers. The rationale set forth in the decisions applies with equal force to the present petition; i.e.:
(1) Patent owner has failed to establish that waiver of the applicable regulations (37 CFR 1.3, 1.4(c) and 1.951(a)) under 37 CFR 1.183 is necessary in the interest of justice so as to permit entry of the intermingled papers, and
(2) Relief under 37 CFR 1.182 to permit a request for continued reexamination can not be granted because such relief would still require waiver of 37 CFR 1.3 and 37 CFR 1.4(c).

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[8] See the paragraph bridging pages 1 and 2 and the paragraph bridging pages 9 and 10 of the present petition.
[9] See the first full paragraph of page 2 and footnote 3, of the present petition.
[10] See the first paragraph of page 3, and footnote 3, of the present petition.

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B. Consideration of the Petition

Notwithstanding the matter discussed in section II.A. above, the substance of the present patent owner petition has been considered as if the FOIA were not commingled within the present petition, in the interest of handling this merged reexamination proceeding with special dispatch as required by both 35 U.S.C. § 305 and 35 U.S.C. § 314(c).

The May 12, 2006 Petition and September 13, 2006 Decision

The record of this merged reexamination proceeding shows that the verified statements in support of the patent owner's proposed supplemental comments after ACP (for which patent owner now requests an entry right) were originally submitted by patent owner on May 12, 2006, for entry and consideration by the examiner with respect to the merits of the patentability determination set forth in the ACP. The submission of that material was accompanied by a petition requesting exercise of the Director's supervisory authority under 37 CFR 1.181, or in the alternative, relief under either of 37 CFR 1.182 or 37 CFR 1.183, in order to obtain entry of that material. [11] The entry of these verified statements, as requested by the May 12, 2006 petition, was refused based on the Office's position that these verified statements were *commingled* with material that was not directed to the merits of the patentability determination set forth in the ACP. All of the commingled material submitted on May 12, 2006 was deemed to have been filed in a manner that failed to comply with the regulations, [12] because some of the material was directed to allegations of misconduct and bias on the part of Office personnel, and some of the material was directed to substantive patentability issues. The Decision refusing entry of, and "returning," all material filed on May 12, 2006 except the petition itself, **was mailed on September 13, 2006.**

Current Petition Decided Under 37 CFR 1.181(f)

37 CFR 1.181(f) provides, *inter alia*, that any petition under Part I of 37 CFR ("...any petition under this part...") which is not filed within two months of "the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided." 37 CFR 1.181(f) also provides that this two-month period "is not extendable." Thus, any petition filed pursuant to 37 CFR 1.181, 1.182 or 1.183 may be dismissed as untimely filed, if it is not filed within two months of the mailing date of the notice from which relief is requested.

In this case, the relief requested with respect to the presently submitted papers directed to the merits of the proceeding [13] is precisely the same as the relief directed to the merits papers of the proceeding that was originally requested in the May 12, 2006 patent owner petition which included copies of the same papers as are presently submitted (material directed to the authenticity of the Telenor documents intermingled which include additional non-enterable material as discussed above). When the Office's September 13, 2006 decision on the May 12, 2006 petition issued, it put patent owner on notice, pursuant to 37 CFR 1.181(f), that entry of the

[11] It does not appear that any specific patent owner supplemental comments after ACP, other than the comments set forth in the petition itself, accompanied the verified statements.

[12] For example, 37 CFR 1.3 and 37 CFR 1.4(c).

[13] I.e., aside from the commingled FOIA material discussed above in part II.A above.

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presently submitted papers would not be granted due to a defect in the submission. [14] Accordingly, after curing the defect in the May 12, 2006 submission pursuant to the September 13, 2006 petition decision, patent owner could have submitted those papers (*i.e.*, the papers presently submitted for entry in the record) together with the present petition (whether more properly styled as a petition for reconsideration or styled as the present petition is styled) within two months of the September 13, 2006 decision.

The two-month period for reconsideration of the September 13, 2006 decision expired after November 13, 2006. Had petitioner patent owner filed the present petition (together with the supplemental patent owner comments and the verified statement evidence) by November 13, 2006, it would have preceded the Right of Appeal Notice (RAN) that was issued almost one month after November 13, 2006. To the extent that 37 CFR 1.181(f) allows for discretion on the part of the USPTO Director to accept the present petition as timely filed, the present petition contains no explanation of why patent owner did not submit the present petition for entry of the papers submitted therewith within two months of the September 13, 2006 decision. The papers submitted for entry with the present petition decision differ only slightly from those submitted on May 12, 2006 to establish that the Telenor documents are not authentic. [15] Indeed, the present petition is almost identical to the petition filed on May 12, 2006, differing only in that it omits arguments for entry of the materials related to conduct issues. The papers for which entry is requested consist of duplicates of the verified statements that had been filed in order to contest the authenticity of the Telenor documents, (aside from the document directed to the FOIA material discussed in Part II.A above) together with a paper styled as "Patent Owner's Supplemental Comments After An Action Closing Prosecution." This last mentioned paper appears to be the only paper directed to the issue of the Telenor documents that was prepared subsequent to the September 13, 2006 Decision on Petition. The present petition offers no explanation as to why the present petition could not have been filed with attached papers within the two month period established by 37 CFR 1.181(f). *Accordingly, the present petition*

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[14] See Decision on Petition, September 13, 2006, page 5, last paragraph, wherein it was stated: "Again, the presentation of papers that are 'limited to the issues raised in the Office action closing prosecution' is a matter within control of patent owner. Patent owner can present a paper limited to the 'issues raised in the Office action closing prosecution,' and also present separate complaints of perceived misconduct and bias in accordance with 37 CFR 1.3 and 37 1.4(c), *i.e.*, by filing a separate paper directed to the complaints of misconduct and bias for consideration by the Office such that the paper can be maintained separate from the record of the merged reexamination proceeding to be considered by the examiner. The question of whether the interests of justice would justify waiving 37 CFR 1.951(a) so as to permit additional patent owner comments on the ACP is reserved, and will be decided only at such time as patent owner requests waiver of 37 CFR 1.951(a) so permit entry of a paper that is limited to the presentation of comments directed only to the issues of patentability raised in the ACP." The inclusion of FOIA material with the material directed to the authenticity of the Telenor documents effectively makes the present patent owner petition a request for reconsideration of the decision on petition dated September 13, 2006 as to the entry of the material directed to the merits. However, even if patent owner regards the present to be an original petition for relief, the material directed to the Telenor documents that patent owner previously had in its possession by the end of April, 2006, could easily have been submitted by a petition filed within two months of the decision of the September 13, 2006. Whether the present petition is regarded as being a request for reconsideration of the September 13, 2006 petition, or as an original petition, the September 13, 2006 decision clearly invited patent owner to file a paper presenting the Telenor material without intermingling it with additional nonenterable FOIA material. The September 13, 2006 decision constituted "action or notice from which relief is requested" under 37 CFR 1.181(f). And, 37 CFR 1.181(f) provides that "[A]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided." Moreover, the regulation provides that "[T]his two-month period is not extendable." However, patent owner did <u>not</u> file the present request for relief within two months from the September 13, 2006 action or notice as required by the 37 CFR 1.181(f), but instead delayed such filing until almost four months from September 13, 2006, thereby permitting prosecution to continue resulting in the issuance of a RAN on December 12, 2006. Pursuant to 37 CFR 1.953(c), "no amendment can be made in response to the Right of Appeal Notice." Further, patent owner has also filed a Notice of Appeal, and on March 7, 2007, patent owner filed its appellant brief. No reason was provided for the delay until after the RAN was issued.

[15] See footnote 10, *supra*.

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offers no explanation as to why the USPTO Director should exercise discretion and accept the presently filed papers that have been filed more than a month late.

Also weighing against accepting the late filed petition is that if the requested relief were to be granted, the Office would then need to do substantial re-work to issue a new RAN, or possibly reopen, if new issues are raised, in addition to the work of considering the newly submitted material. Petitioner patent owner has argued the importance of the information submitted; however, that must be balanced against the delay that consideration of such information would entail as well as petitioner's lack of equities since avoiding the delay was entirely within petitioner's control. In litigation, where a time period for filing a pleading is missed, the material contained therein can also be important. Yet, when the time period is missed, the pleading will not be admitted, in order to maintain an orderly court proceeding. It is no different in this instance.

Pursuant to 35 U.S.C. § 305 the *ex parte* reexamination of the present merged proceeding must be conducted with special dispatch within the Office. Likewise, pursuant to 35 U.S.C. § 314(c), the *inter partes* reexamination is to be conducted with special dispatch. **Nothing in the present petition, or in the record of the merged reexamination proceeding as a whole, provides a compelling basis to act counter to both 35 U.S.C. § 305 and 35 U.S.C. § 314(c) by removing the present merged proceeding from a proceeding that is ready for the appeal process to commence.** In this regard, note is taken of the fact that an ACP been promulgated and commented on by patent owner, a Right of Appeal Notice has been promulgated, a Notice of Appeal in response thereto has been timely filed and petitioner patent owner has filed an appellant's brief (on March 5, 2007). The merged proceeding is ripe for appeal on the present record, and patent owner has not established a persuasive reason why the merged reexamination proceeding should now be reopened and delayed, especially when patent owner itself has introduced a large delay factor by not timely filing pursuing its request for entry of papers that were in its possession not later than May 12, 2006. If prosecution were to be reopened, the proceeding would be delayed by issuance of an additional ACP, responsive comments, issuance of another RAN, and the filing of another Notice of Appeal and another Brief. This delay would fly in the face of the pending litigation [16] and the statutory mandate to advance the prosecution with special dispatch which would provide the court the benefits of the Office's action.

For the foregoing reasons, the January 3, 2007 patent owner's supplemental comments to the action closing prosecution and the accompanying verified statements will not be entered and considered in the present merged reexamination proceeding.

ADDITIONAL DISCUSSION

Even assuming that the present petition had been timely filed, the petition would not have shown an adequate cause for the relief requested. The material that has been submitted with the present petition is essentially, but not completely, confined to verified statements that question the authenticity of the so-called Telenor documents that have been applied to the claims as prior art. Patent owner's argument is grounded upon the verified statement of David Richard Browne, a Forensic Documents Examiner, who at the time of execution of his verified statement was head of the Questioned Documents Department of BSB Forensic Ltd., an

[16] In a ruling handed down by Judge James R. Spencer of the U.S. District Court for the Eastern District of Virginia on March 22, 2007, action was stayed in a patent infringement lawsuit (NTP v PALM) until the Office rules on the validity of the '592 patent (and other Campana patents).

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independent company. [17] A brief review of the verified statement of Mr. Browne shows that his ultimate conclusions are at best speculative, based on conjecture, and not sufficient to require withdrawal of the Telenor documents [18] as a prior art reference on any basis argued by patent owner.

None of Mr. Browne's findings would warrant a conclusion by a reasonable patent examiner that, as alleged by patent owner, the Telenor documents are not authentic and that the parent copy was not on file in the Trondheim University Library in Norway as of the dates facially set forth on the Telenor documents. [19] For example, even if it is accepted that these reference materials, located in a library, may have been unbound to facilitate photocopying, such fails to constitute persuasive evidence, by any evidentiary standard, that these documents are not authentic and do not, as of the dates on the face of these documents, teach the subject matter set forth therein, when read through the eyes of one of ordinary skill in the art. Further, nothing in Mr. Browne's verified statement rules out the conclusion that his findings may be a result of innocent causes. Nothing in Mr. Browne's verified statement states unequivocally that the documents in question are not authentic teaching documents that constitute prior art to the '592 patent. In fact, the last two statements by Mr. Browne in his report [20] are that:

> "Without knowledge of the other documents in the University library and or the Telecommunications Research Institute and the control procedures in use, or the copiers in use, **it is not possible to give a definite opinion as to the dates of any alterations.**"
>
> "However my findings are significant and do **cast doubt** as to when these documents were created, when changes were made and what text was actually on the pages when they were first filed."
>
> [Emphasis added.]

Mr. Browne's statement that there may be "doubt" does not present any concrete basis to establish the likely truth of patent owner's allegations regarding the authenticity of the Telenor documents; [21] nor does it carry patent owner's burden of rebutting the status of the Telenor documents as printed publications that are prior art to the '592 patent that is *prima facie* established by the dates on the document. Patent owner's failure to adequately address the caveats expressed by patent owner's own expert regarding the expert's inability to establish definite dates for any alterations, or what text was actually on the pages as first filed the University library procedures, would preclude any reasonable examiner from accepting the patent owner's allegations regarding the Telenor documents, or concluding that these documents are not prior art printed publications (valid references) for what they disclose.

Certificate of Service:

As an additional point, the record is not clear that the service of all the patent owner papers in question was actually made. 37 CFR 1.903 requires, *inter alia*, that after the filing of a request for

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[17] Additional verified statements have been submitted by a number of declarants in order to establish "chain of custody" of the examined Telenor documents.

[18] The Telenor documents are eight volumes documents, one of which is stapled with three staples down its left spine and the others of which are bound together along one edge with glue, which were catalogued and maintained in Trondheim University Library in Norway.

[19] See "Patent Owner's Supplemental Comments After an Action Closing Prosecution," which accompanies the present petition. at page 1 ("Telenor documents are not authentic") and at page 2 ("'Telenor Documents' refers to the documents cited in the present reexamination" and "The Telenor Documents do not qualify as printed publications under 35 U.S.C. § 102(b) because they have been manipulated and altered.")

[20] Report of David Richard Browne, entitled "Re: NTP" signed April 21, 2006 , page 6, attached as Exhibit 2 to Declaration of David Richard Browne Under 37 C.F.R. § 1.132" executed April 21, 2006

[21] See footnote 16.

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inter partes reexamination by a third party requester, any document filed by the patent owner must be served on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248. 37 CFR 1.903 also states that any document must reflect service or the document may be refused consideration by the Office, and that the failure of the patent owner to serve documents may result in their being refused consideration.

The Certificate of Service that accompanied patent owner's filing of all of the papers filed on January 3, 2007 by states only that petitioner "caused a copy of the foregoing 'PETITION PURSUANT TO 37 CFR § 1.183 OR, ALTERNATIVELY, 37 CFR § 1.182, OR, ALTERNATIVELY, 37 CFR § 1.181 TO ENTER EVIDENCE AGAINST THE AUTHENTICITY OF THE TELENOR DOCUMENTS INTO THE RECORD OF THE INTER PARTES PROCEEDING' to be served" on the third party requester. It is not clear from the language of the Certificate of Service whether the papers accompanying the petition (*i.e.*, the patent owner's supplemental comments and the supporting verified statements) were considered to be part of the petition and were, therefore, also served on the third party requester. Therefore, (1) the record does not clearly show that the patent owner's supplemental comments and the verified statements in support of those comments have been served on the third party requester, and (2) it is not clear that the patent owner's supplemental comments and the verified statements in support of those comments have actually been served on the third party requester.

DISPOSITION OF IMPROPER PAPERS

As pointed out above, the Office's September 13, 2006 decision clearly invited the patent owner to file a paper presenting the material directed to Telenor material without intermingling it with additional nonenterable FOIA material. The September 13, 2006 decision constituted "action or notice from which relief is requested" under 37 CFR 1.181(f). 37 CFR 1.181(f) provides that (a) "any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided," and (b) "this two-month period is not extendable." In spite of this, patent owner did not file the present request for relief within two months from the September 13, 2006 action or notice as required by the 37 CFR 1.181(f), but instead delayed such filing until almost four months from September 13, 2006, thereby permitting prosecution to continue resulting in the issuance of a RAN on December 12, 2006. [22] (Further, patent owner has now filed a Notice of Appeal, and an appeal brief.) Patent owner's delay until after the RAN was issued has not been explained, while entry of the submission at this point would cause considerable delay (as detailed above) clearly running counter to the statutory mandate for special dispatch. Accordingly, the Office is exercising its discretion to return the present submission (petition papers and attachments). With respect to such discretion, MPEP 2672 states (emphasis added):

> "I. ONE OPPORTUNITY TO MAKE SUBMISSIONS UNDER 37 CFR 1.951(a) AND (b) After an Action Closing Prosecution (ACP), the patent owner may once file (pursuant to 37 CFR 1.951(a)) written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims. Where the patent owner does so, the third party requester may once file (pursuant to 37 CFR 1.951(b)) comments responsive to the patent owner's comments. **Any second or supplemental submission after ACP by either the patent owner or the third party requester will thus be returned.** "

[22] Pursuant to 37 CFR 1.953(c), "no amendment can be made in response to the Right of Appeal Notice."

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MPEP 2667 I.A.3 states (emphasis added):

> "3. Improper Patent Owner Response
>
> The patent owner can only file once under 37 CFR 1.951(a). Any second or supplemental submission after ACP by the patent owner **will be returned, unless prosecution has been reopened.** See MPEP § 2672."

These provisions of the MPEP are grounded on 37 CFR 1.939 (Unauthorized papers in *inter partes* reexamination), which provides.

> "(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.**"

The rule provides discretion for the Office to return an unauthorized (improper) paper, and the MPEP shows that the Office procedure is, and has been, to return second or supplemental submissions after ACP filed by a party. In the present instance the petition is integrally tied to the "Patent Owner's Supplemental Patent Owner Comments After An Action Closing Prosecution" and supporting evidence to present one composite set of supplemental comments/arguments after ACP. It is to be noted that the petition is not confined to advancing reasons why the interests of justice would mandate either waiver of the regulations, or relief not provided for in the regulations. Rather, the petition itself is argumentative as the authenticity of the Telenor documents. [23] Accordingly, the present petition, the patent owner's supplemental comments after ACP and the supporting evidence (hereinafter, "the January 3, 2007 patent owner papers") are appropriately returned in accordance with provisions of 37 CFR 1.939(a) and MPEP §§ 2672 and 2667 I.A.3. In this instance, the January 3, 2007 patent owner papers have already been scanned into the Image File Wrapper (IFW) of each of the two individual reexamination proceedings that together comprise the present merged reexamination proceeding. Therefore, the papers cannot be physically returned to patent owner. Instead, the papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the active IFW record with the other active papers that comprise the public record of the proceedings. The January 3, 2007 patent owner papers, are being placed in a separate archive e-file, which is not part of the public record.

CONCLUSION

1. The January 3, 2007 patent owner petition is <u>denied</u>.

2. The January 3, 2007 patent owner papers will not remain in the active IFW record for the merged proceeding, and will not be considered by the examiner on their merits, because they lack an entry right in the merged reexamination proceeding. Instead, the he January 3, 2007 patent owner papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the active IFW record with the other active papers that comprise the public record of the proceedings.

3. The present decision will be placed in the active IFW record for the merged proceeding.

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[23] For example, the petition, at page 4, states:

> "Many of the claims under reexamination have been rejected on the basis of several volumes of technical documents (the "Telenor documents") that are alleged to have been catalogued in Norges teknisk-naturvitenskapelige universitet (NTNU) library in Trondheim, Norway prior to the earliest filing date of the '592 patent. Patent Owner...."

As pointed out above, patent owner could easily have properly submitted this before the RAN issued; and, at present, it does not have an entry right in the proceeding.

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4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

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March 28, 2007

March 29, 2007
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MAILED

MAY 23 2007

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION GRANTING PETITION

This is a decision on the April 4, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Suspend The Page and Word Count Limitations of the Decision Granting Petition Dated March 9, 2007."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary:

Patent owner's petition, taken as a petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) limit as to page length, is granted to the extent that the page limit for the appellant's brief is extended to not exceed 141 pages or 51,225 words in length.

It is being presumed that the patent owner is substituting, via its attachment to the petition, the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007. If this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, and the April 4, 2007 "Appeal Brief" will become the sole patent owner appellant brief of record in the proceeding.

PETITION FEE

A petition fee under 37 CFR 1.17(f) of $ 400.00 is required for a petition under 37 CFR 1.183. As authorized on page 8 of the present petition, the $ 400.00 petition fee will be charged to patent owner's Deposit Account No. 50-0206.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 26, 2003 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006.[1]

10. On March 1, 2006, the patent owner filed written comments after the ACP. The third party requester did not file a paper responsive to the patent owner's March 1, 2006 comments.

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[1] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

11. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request (hereinafter "the FOIA material"), and also a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" relied upon (applied) as prior art in the merged reexamination proceeding.

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

13. On September 13, 2006, the Office issued a Decision Dismissing Petition that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision on or before November 13, 2006. A request for reconsideration of the September 13, 2006 Decision was, however, filed on February 5, 2007 – see item # 18 below.

15. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

16. On January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006.

17. On January 4, 2007, patent owner filed a Notice of Appeal in the merged proceeding, together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

18. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, in which petition the patent owner facially requested that all of the material filed on May 12, 2006 be entered into the record.

19. On February 23, 2007, patent owner filed a petition to suspend the page and word-count limitation set for an appellant's brief by 37 CFR 1.943.

20. On March 5, 2007, patent owner timely filed its appellant's brief. [2]

21. On March 9, 2007, a decision granting patent owner's February 23, 2007 petition to suspend the page and word-count limitation of 37 CFR 1.943 was granted to increase the page and word-count limitation to the limited extent set forth in that decision.

22. On March 15, 2007, the Office issued a decision denying patent owner's February 5, 2007 petition. The March 15, 2007decision was designated as a final agency action under 35 U.S.C. § 704.

23. On March 30, 2007, the Office issued a decision dismissing patent owner's January 3, 2007 petition.

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[2] The record shows that two different versions of an appellant's brief were filed on March 5, 2007.

24. On April 4, 2007, patent owner filed the present petition to request leave to file a 141-page, 51,255-word Supplemental Brief attached to the petition as Appendix A.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

II. Findings and Analysis

A review of the record shows that, on February 23, 2007, patent owner filed a petition requesting a waiver of the requirements of 37 CFR 1.943(c) to permit the filing of an appeal brief in excess of the 30-page or 14,000-word limit for an appellant's brief filed in an *inter partes* reexamination proceeding. No specific page or word count limitation was requested in the February 23, 2007 petition. As the time for filing the patent owner's appellant's brief extended only through March 5, 2007, patent owner filed an appellant's brief on March 5, 2007 that was certified to comply with 37 CFR 1.943(c) by including 13,887 words. Also on March 5, 2007 patent owner filed another, more voluminous appellant's brief, apparently in anticipation that the relief requested in the February 23, 2007 petition would be granted. However, on March 9, 2007, a decision was mailed granting the March 5, 2007 patent owner petition for waiver of 37 CFR 1.943(c) only to the extent that the appeal brief could include as many as 60 pages or 28,000 words. [3,4] In view of the showing now provided via the present petition, waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 141pages or 51,225 words in length.

The present patent owner petition is accompanied by an attachment designated Appendix A. The document appearing in Appendix A is styled as an "Appeal Brief." The present petition itself requests leave to file a "Supplemental Appeal Brief." [5] Although there is no certificate of compliance attached to the "Supplemental Appeal Brief," it is stated in the present petition [6] to be a 141-page, 51,255-word document, exclusive of both the Claims Appendix and other reference materials. Note is taken that petitioner patent owner "considers the Evidence

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[3] See Decision Granting Petition, March 9, 2007.

[4] The more voluminous appellant's brief filed on March 5, 2007 could not be entered, because it did not certify the number of pages or words contained therein.

[5] *Id.*, at pages 1-2.

[6] *Id.*

Appendix and the Related Proceedings Appendix to be reference materials and are thus not included in the word count." [7]

The length limitations for appellant's briefs and other briefs and party papers in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305. These length limitations are analogous to similar length limitations established in Federal appellate litigation practice. [8] It is agreed that, as opined by petitioner patent owner, the Evidence Appendix and Related Proceedings Appendix that are required by 37 CFR 41.67 are, at least implicitly, excluded from the page and word count limitations established by 37 CFR 1.943(c). To the extent necessary, the provisions of 37 CFR 1.943(c) are hereby waived to expressly exclude the Evidence Appendix and related Proceedings Appendix from the 37 CFR 1.943(c) page and word limits.

The "Appeal Brief" attached as Appendix A to the present petition is within the expanded page and word limit set by the present decision. Although the patent owner makes repeated refers to the "Appeal Brief" attached as Appendix A as being a "Supplemental Appeal Brief," [9] the relief requested with respect to giving petitioner patent owner leave to submit the "Appeal Brief" attached as Appendix A to the present petition can accordingly be granted, but this is so **only by presuming that the patent owner is substituting, via the attachment to the petition, the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007.** [10] In the interest of special dispatch, the undersigned will engage in that presumption, and grant the relief requested on an interim basis. **In the event that petitioner does not accept the substitution of the April 4, 2007 "Appeal Brief" as a replacement for the two March 5, 2007 appellant's briefs that are currently in the record, petitioner patent owner must file a paper so stating within 15 DAYS of the mailing date of this decision. If such a paper is not filed, the presumption will become final, and the April 4, 2007 "Appeal Brief" will become the sole patent owner's appellant brief of record in this merged reexamination proceeding.**

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 141 pages or 51,225 words in length.

2. It has been presumed that the patent owner is substituting, via attachment to the petition, the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007. In the event that this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, and the April 4, 2007 "Appeal Brief" will become the sole patent owner's

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[7] *Id.*, at footnote 1

[8] See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000) (Notice of Proposed Rule Making), at page 18160 - "These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure). "

[9] See, for example, page 2 and page 6 of the present patent owner petition.

[10] As pointed out above, on March 5, 2007, patent owner filed two appellant's briefs; each is styled as "Appeal Brief."

appellant brief of record in this merged reexamination proceeding.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired,[11] jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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May 17, 2007

5-18-07
C:\Kiva\Kenpet6\IP\95_0020+6495_183-waive 1.943-increase appellant brief pg limit set in prior decision.doc
C:\Kiva\Kimpropa\IP\95_0020+6495_183-waive 1.943-increase appellant brief pg limit set in prior decision.doc

[11] In this instance, if no patent owner paper is received within 15 days of the mailing of this decision, the CRU should ensure that the proceeding is processed to reflect the substitution of the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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William Wright
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(For Patent Owner)

MAILED

SEP 2 1 2007

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
1300 Eye Street NW
400 East Tower
Washington, DC 20005

(For Requester)

In re Thomas J. Campana, Jr. et al.
Inter partes Reexamination Proceeding
Control No. 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Thomas J. Campana, Jr. et al.
Director Ordered
Ex parte Reexamination Proceeding
Control No. 90/006,495
Filed: December 26 2002
For: U.S. Patent No. 6,317,592

DECISION GRANTING PETITION

This is a decision on the September 14, 2007, patent owner petition entitled "PETIION UNDER §§ 1.181, 1.182 AND 1.183 FOR SUSPENSION OF RULE 41.66(D) TO GRANT PATENT OWNER LEAVE TO SEEK AND OBTAIN AN EXTENSION OF TIME PURSUANT TO 37 CFR 1.956 TO FILE ITS REBUTTAL BRIEF."

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

The petition is granted for the reasons set forth below.

PETITION FEE

A petition fee of $400.00 under 37 CFR 1.17(f), as required by 37 CFR 1.183, is being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized at page 10 of the present petition. A petition fee of $200.00 under 37 CFR 1.17(g), as required by 37 CFR 1.956, is also being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized in the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for reexamination of the '592 patent was mailed, and the resulting proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and the resulting proceeding was assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Senior Special Projects Advisor issued a decision, *sua sponte*, by which the '495 reexamination proceeding and the '020 reexamination proceeding were merged into a single combined reexamination proceeding ("the present merged reexamination proceeding").

6. The August 26, 2003 decision merging the proceedings set forth that the present merged proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. Following extensive prosecution on the patentability of the claims in the present merged proceeding, the Office issued a Right of Appeal Notice ("RAN") on December 12, 2006.

8. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

9. On August 7, 2007, the patent owner filed an amended appellant's brief (37 CFR 41.66(a)) that was accepted as a proper filing.

10. An examiner's answer (37 CFR 41.69), responsive to the August 7, 2007 patent owner appellant's brief, was mailed on August 24, 2007.

11. The present patent owner petition was filed on September 14, 2007 for the purpose of extending the time permitted (37 CFR 41.66(d)) in which patent owner may file a rebuttal brief (37 CFR 41.71) in reply to the examiner's answer.

12. Seven other patents related to the '592 patent are each concurrently undergoing *ex parte* reexamination proceedings and are under appeal.

RELEVANT AUTHORITY

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 1.956 provides in part:

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g).

37 CFR 41.30 provides that for *ex parte* appeals:

Applicant means either the applicant in a national application for a patent or the applicant in an application for reissue of a patent.

37 CFR 41.41(a)(1) provides:

Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

37 CFR 41.60 provides, that for *inter partes* appeals:

Appellant means any party, whether the owner or a requester, filing a notice of appeal or cross appeal under § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed.

Respondent means any requester responding under § 41.68 to the appellant's brief of the owner, or the owner responding under § 41.68 to the appellant's brief of any requester. No requester may be a respondent

37 CFR 41.66(d) provides:

Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

37 CFR 41.71 provides, in part:

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b)(1) The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

DECISION

The '592 patent is one of eight patents directed to related subject matter and owned by the same patent owner that are currently being reexamined. Some of the seven other reexamination proceedings are merged proceedings, wherein two or more *ex parte* reexamination proceedings for the same patent have been merged. Each of the seven reexamination proceedings is being conducted pursuant to the regulations and examining practice governing *ex parte* reexamination. The present merged reexamination proceeding for the '592 patent involves an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding that have been merged in accordance with Office

practice. The present merged proceeding is being conducted under the rules governing an *inter partes* reexamination proceeding. [1]

Appeals in *ex parte* reexamination proceedings are conducted pursuant to 37 CFR Part 41, subpart B (*Ex Parte* Appeals). The appeal in the present merged reexamination proceeding for the '592 patent is being conducted in accordance with 37 CFR Part 41, subpart C (*Inter Partes* Appeals). *Ex parte* appeal practice provides for an appeal brief (which in reexamination, will always be filed by the patent owner, an examiner's answer issued in response to the appeal brief, and a reply brief filed by the patent owner. 37 CFR 41.41 provides that the reply brief must be filed within two months of the date of the examiner's answer.

Inter partes appeal practice provides for an appellant's brief (analogous to an appeal brief in *ex parte* reexamination), which may be filed by either the patent owner or the third party requester pursuant to 37 CFR 41.67, then a respondent's brief, which may be filed by the party who did not file the appellant's brief. The examiner will then issue an examiner's answer under 37 CFR 41.66 that is responsive to the appellant's brief, and to the respondent's brief, if one has been filed. Under 37 CFR 41.66(d), any appellant may then file a rebuttal brief in reply to the examiner's answer. 37 CFR 41.66(d) further provides the rebuttal brief must be filed within one month of the date of the examiner's answer, and that the time for filing the rebuttal brief may not be extended.

Patent owner has requested that the provisions of 37 CFR 41.66 [2] be waived in accordance with the provisions of 37 CFR 1.183 to the extent that 37 CFR 41.66 precludes patent owner from requesting an extension of time. The petition is taken as (a) a petition to waive the provisions of 37 CFR 41.66(d) to the extent that they preclude any extension of time, and (b) a petition to then grant a one-month extension of time, since both types of relief are required to achieve petitioner's goal.

The facts of this particular proceeding include: (1) there are seven other reexamination proceedings that are directed to patents that are owned by patent owner, which patents are directed to subject matter related to the subject matter of the present '592 patent; (2) patent owner will have two months in which to file a brief that is responsive to an examiner's answer in those seven proceedings, but is limited, by rule, to one-month in which to file a brief responsive to the examiner's answer in the present merged proceeding; and (3) the examiner's answer is lengthy, due in large part to the complexity of the involved technology. Based on these facts, and the present fact-situation taken as a whole, it is deemed that justice requires waiver of 37 CFR 41.66(d) to permit patent owner to request an extension of the one-month period provided by 37 CFR 41.66(d).

Further, in view of the complex nature of the technology involved in the appeal in the present merged reexamination proceeding and the resulting length of the examiner's answer, it is deemed that sufficient cause exists to grant patent owner's request to extend the period in which patent owner may file a rebuttal brief directed to the examiner's answer by one-month. Therefore, the period in which to file the rebuttal brief will extend through October 24, 2007. Any request in this proceeding for an additional extension of time in which to file a rebuttal brief will require both an additional

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[1] Reference may be had to 37 CFR 1.989 regarding merger of copending *ex parte* and *inter partes* reexaminations proceedings for the same patent, and to MPEP § 2686.01 for the circumstances in which merger will take place, and the manner in which the merged proceeding will be conducted.

[2] Patent owner has requested a waiver of 37 CFR 41.66(**b**) on page 1 of the petition, but has also requested a waiver of 37 CFR 41.66(**d**) on pages 1, 2 and 9. Patent owner has also requested, in the alternative, that the Commissioner (*sic*, "Director") "replace" the one-month requirement of 37 CFR 41.66(d) with a two month requirement." The present petition is taken as a request to waive the provisions of 37 CFR 41.66(d), which are directed to the filing of a rebuttal brief, (the type of brief that patent owner intends to file). 37 CFR 41.66(b) relates to a respondent's brief, which as discussed above, is an original "appeal brief" that has been filed by the second party to file such a brief.

showing under 37 CFR 1.183 to support another waiver of 37 CFR 41.66(d) to permit an additional extension of time, as well as a showing of sufficient cause to support the requested additional extension of time.

CONCLUSION

1. Patent owner's petition to waive the provisions of 37 CFR 41.66(d) so as to entertain an extension of the one-month period in which to file a rebuttal brief is granted.

2. Patent owner's request for a one-month extension of time is also granted.

3. Patent owner's rebuttal brief is due on or before October 24, 2007.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at 571-272-7710, or, in his absence, to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

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September 20, 2007

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UNITED STATES PATENT AND TRADEMARK OFFICE

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11/7/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP

1300 EYE STREET NW

400 EAST TOWER

WASHINGTON, DC 20005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495 + 95/000,020

PATENT NO. 6,317,592

ART UNI 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,495	12/26/2002	6317592		9470

803 7590 11/07/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/07/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

MAILED

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CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION GRANTING PETITION

This is a decision on the October 24, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Suspend The Page and Word Count Limitations of 37 CFR 1.943."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary:

Patent owner's petition, taken as a petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) limit as to page length and word count, is granted to the extent that the page limit for the appellant's currently filed Supplemental Rebuttal Brief is extended to not exceed 131 pages or 39,146 words in length.

It is being presumed that the patent owner is substituting the Supplemental Rebuttal Brief filed concurrently with the present petition for the Rebuttal Brief that was also concurrently filed with the present petition. If this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, and the October 24, 2007

Supplemental Rebuttal Brief will become the sole patent owner rebuttal brief entered into the active record in the present merged reexamination proceeding.

PETITION FEE

A petition fee under 37 CFR 1.17(f) of $ 400.00 is required for a petition under 37 CFR 1.183. As authorized on page 6 of the present petition, the $ 400.00 petition fee will be charged to patent owner's Deposit Account No. 50-0206.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

9. On January 4, 2007, patent owner filed a Notice of Appeal in the merged proceeding, together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

10. On March 5, 2007, patent owner timely filed its appellant's brief. [1]

11. On April 4, 2007, patent owner filed the present petition to request leave to file a 141-page, 51,255-word Supplemental Brief attached to the petition as Appendix A.

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[1] The record shows that two different versions of an appellant's brief were filed on March 5, 2007.

12. On May 23, 2007, the April 4, 2007 patent owner petition was granted.

13. An examiner's answer that was properly executed by appeal conferees and that was responsive to the Supplemental Brief filed on April 4, 2007 was mailed on August 24, 2007.

14. On September 14, 2007, patent owner filed a petition requesting a one-month extension of time in which to file a rebuttal brief responsive to the examiner's answer.

15. On September 21, 2007, a decision granting the September 21, 2007 patent owner petition by patent owner on an extension of time for patent owner to file a rebuttal brief was mailed.

16. On October 24, 2007, the last day for filing the patent owner's rebuttal brief, patent owner filed a Rebuttal Brief, also filed a Supplemental Rebuttal Brief, and also filed the present patent owner petition requesting waiver of 37 CFR 1.943(c) to permit entry of the Supplemental Rebuttal Brief.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

II. Findings and Analysis

The present patent owner petition requests that the page and word limits established by 37 CFR 1.943(c) be waived to permit filing of a rebuttal brief that fully addresses the examiner's answer. Specifically, the patent owner requests that the Office (1) permit patent owner to file a supplemental rebuttal brief that includes 131 pages and 39,146 words, (2) then accept the Supplemental Rebuttal Brief filed on October 24, 2007. A certificate of service in compliance with 37 CFR 1.903 accompanies the present patent owner petition. The Supplemental Rebuttal Brief is accompanied by a certificate of service in compliance with 37 CFR 1.903, and by a certification that the Supplemental Rebuttal Brief includes 131 pages and 39,146 words.

The length limitations for appellant's briefs and other briefs and party papers in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305. These length limitations are analogous to similar length limitations established in

Federal appellate litigation practice. [2] Inasmuch as this proceeding involves an unusually large number of claims, and noting that the page and word limitations were previously waived with respect to the appellant's brief in a decision dated April 4, 2007, it is found that waiver of the page and word count limitations of 37 CFR 1.943(c) is appropriate with respect to filing of a rebuttal brief by petitioner patent owner. However, entry of the Supplemental Rebuttal Brief that was filed on October 24, 2007 into the active IFW record of the present merged reexamination proceeding as a result of waiver of the provisions of 37 CFR 1.943(c) is limited as follows:

(1) The Supplemental Rebuttal Brief filed on October 24, 2007 was accompanied by the simultaneous filing of both the present patent owner petition, and a Rebuttal Brief in compliance with the page and word count limitations of 37 CFR 1.943(c). Although the Office is granting the relief requested by petitioner with respect to giving petitioner patent owner leave to submit a rebuttal brief including 131 pages and 39,146 words, the acceptance of the October 24, 2007 Supplemental Rebuttal Brief for entry into the active IFW record is conditioned **upon the presumption that the patent owner is substituting, via the attachment to the petition, the Supplemental Rebuttal Brief for the concurrently filed Rebuttal Brief. It otherwise appears that the Rebuttal Brief complies with the page and word count provisions of 37 CFR 1.943(c) such that it would be enterable into the record of the present merged reexamination proceeding as a matter of right (assuming that it otherwise complies with 37 CFR 41.77 and MPEP § 2678).** In the interest of special dispatch, the undersigned will engage in that presumption, and grant the entry of the October 24, 2007 Supplemental Rebuttal Brief into the active IFW record on an interim basis. **In the event that petitioner does not accept the substitution of the October 24, 2007 Supplemental Rebuttal Brief as a replacement for the Rebuttal Brief filed on October 24, 2007, petitioner patent owner must file a paper so stating within 15 DAYS of the mailing date of this decision. If such a paper is not filed, the presumption will become final, and the October 24, 2007 Supplemental Rebuttal Brief will become the sole patent owner's rebuttal brief entered into the active IFW record in this merged reexamination proceeding.**

(2) The acceptance of the Supplemental Rebuttal Brief filed on October 24, 2007 into the active record is also predicated upon a determination by the Primary Examiner that it complies with all of the provisions governing the filing of an appellants' rebuttal brief as set forth in 37 CFR 41.71, and the corresponding practice provisions in MPEP § 2678. Stated differently, even if the presumption that the Supplemental Rebuttal Brief filed on October 24, 2007 replaces the October 24, 2007 Rebuttal Brief is confirmed by patent owner or otherwise becomes final, the Supplemental Rebuttal Brief will not be entered into the active IFW record unless it complies with the rules and practice pertaining to an appellant's rebuttal brief that is filed in an *inter partes* reexamination proceeding.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's rebuttal brief is extended to not exceed 131 pages or 39,146 words in length.

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[2] See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000) (Notice of Proposed Rule Making), at page 18160 - "These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure). "

2. It has been presumed that the patent owner is substituting, via the relief requested in the present petition, the Supplemental Rebuttal Brief filed on October 24, 2007 for the Rebuttal Brief that was also filed on October 24, 2007. In the event that this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, the Supplemental Rebuttal Brief filed on October 24, 2007 will become the sole patent owner's rebuttal brief entered into the active IFW record of this merged reexamination proceeding, and the concurrently filed Rebuttal Brief will sealed by marking it "closed" and "non-public" in the IFW. The sealed Rebuttal Brief will not be part of the active record in this merged proceeding.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers.

4. After the Central Reexamination Unit has processed the Supplemental Rebuttal Brief and all party papers, or there are no such papers and the time for filing same has expired, [3] jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding. Such action shall begin with a review of the Supplemental Rebuttal Brief filed on October 24, 2007 for compliance with the applicable regulations and examining practice.

5. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

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November 1, 2007

[3] In this instance, if no patent owner paper is received within 15 days of the mailing of this decision, the CRU should ensure that the proceeding is processed to reflect the substitution of the "Supplemental Rebuttal Brief" filed October 24, 2007 for the October 24, 2007 Rebuttal Brief, and mark the latter "closed" and "non-public."

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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11/7/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495 & 95/000,020
PATENT NO. 6,317,592
ART UNI 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/006,495	12/26/2002	6317592		9470

803 7590 11/07/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/07/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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MAILED

NOV 07 2007

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DISMISSING PETITION

This is a decision on the October 17, 2007 patent owner petition entitled "ORIGINAL PETITION PURSUANT TO 37 CFR § 1.181 IN RESPONSE TO STATEMENTS MADE IN THE EXAMINER ANSWER TO ENTER INTO THE RECORD FOR APPEAL EVIDENCE AGAINST THE AUTHENTICITY OF THE TELENOR DOCUMENTS"

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary: The petition is granted to the extent that the petition has been considered. For the reasons set forth below, the relief requested by petitioner patent owner is dismissed.

PETITION FEE

The petition is being considered pursuant to 37 CFR 1.183 to waive the provisions of 37 CFR 41.63 and/or 37 CFR 41.71 in order to permit the filing and entry of additional new or non-admitted evidence, or an affidavit or other evidence at this stage of proceedings. A $400.00 petition fee has been charged to Deposit Account No. 50-0206 as authorized by petitioner patent owner at page 14 of the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues <u>separately</u> in accordance with 37 CFR 1.3 and 1.4(c).

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

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[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material and was limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents, was not entered into the record.

16. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the January 3, 2007 patent owner petition.

17. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsider of the March 30, 2007 or, alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

18. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration.

19. On August 20, 2007 and August 24, 2007, an examiner's answer was mailed. [2]

20. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

21. On October 17, 2007, patent owner filed the present petition.

DECISION

I. Relevant Authority

37 CFR 41.63 provides:

> "(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).

[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007Examiner's Answer bears the signatures of two appeal conferees.

37 CFR 41.71 provides, in part:

"(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
(2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

"After the examiner's answer, only a rebuttal brief (or an amended rebuttal brief, where appellant is given one opportunity to correct a defective original rebuttal brief (MPEP § 2679)) will be received into the reexamination proceeding. No other submission will be considered, and any such other submission will be returned as an improper paper. 37 CFR 1.939."

II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings. Patent owner has contested the prior art status of the Telenor documents, and has taken the position that it is unclear that the Telenor documents as relied upon by the Office are even authentic documents that have not been tampered with.

In support of the position taken on the authenticity of the Telenor documents, patent owner has filed a verified statement by a document examiner, and certain supporting documents related to the chain of custody of the Telenor documents that patent owner submitted to the document examiner for analysis. The verified statement and supporting documents have been refused entry in the present merged proceeding, although they have been entered in others of the reexamination proceedings. The refusal to enter the rebuttal documents in the present merged reexamination proceeding was on procedural grounds, and been repeated the subject of three petition decisions that have been designated as final agency decisions under 5 U.S.C. § 704 and are of record in the present merged reexamination proceeding. [3]

III. Analysis and Findings

Patent owner now seeks entry of the evidence attacking the authenticity of the Telenor documents yet again. Patent owner has requested that this petition be decided under 37 CFR 1.181, or 37 CFR 1.182, or 37 CFR 1.183, or 37 CFR 41.64(d) (*sic*, 41.64(b)). It does not appear that the petition sets forth a request for supervisory direction of the examiner under 37 CFR 1.181. 37 CFR 1.182 is inapplicable because the regulations specifically address (*i.e.*, provide for) the present situation by precluding entry of the requested material as a matter of procedure. It would appear, however, that the present petition may properly be construed to request waiver of the provisions of the regulations, specifically 37 CFR 41.63 and/or 37 CFR 41.71. [4] The

[3] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[4] To the extent that the petition might be viewed as requesting waiver of the regulations that have been previously cited as precluding entry of the Telenor documents (as in the three decisions cited in footnote 3), the Office will not

petition will be treated as a requesting relief that requires waiver of the provisions of 37 CFR 41.63 and/or 37 CFR 41.71, as well as the waiver of any other regulation that is necessary, for entry of the material itemized at page 7 of the present petition.

Patent owner's rationale for again requesting waiver of the rules to permit patent owner to enter into evidence material that addresses the authenticity of the Telenor documents that patent owner has previously been filed, but which has been refused entry into the record, is that on pages 230-231 of the examiner's answer dated August 24, 2007, the examiner has allegedly included an assertion that the patent owner "'has not proffered evidence to support arguments' that the Telenor documents relied upon by the Office in rejecting the claims of the '592 patent have been altered in any way." [5] Patent owner argues that patent owner has been prejudiced by the examiner's language because the language in question is inaccurate, inasmuch as patent owner did file (*i.e.*, proffer) evidence directed to the authenticity of the Telenor documents, (although such evidence has not been entered into the record). [6] Patent owner further argues that patent owner has been prejudiced because the examiner is relying upon the alleged failure to proffer evidence as support for the examiner's conclusion that certain statements appearing in an email by one Torv Aursoy (hereinafter "the Aursoy statement") are reliable even if they are deemed to be hearsay. [7] Patent owner states that patent owner is not attempting to reargue the merits of the previous petition decisions that refused entry of the evidence attacking the Telenor documents. [8] Instead, patent owner argues that the examiner's statements that are alleged to be inaccurate and prejudicial provide an independent basis for supplementing the record by entering the evidence relating to the authenticity of the Telenor documents into the record that was previously excluded, for purposes of addressing the examiner's position regarding the Aursoy statement. Patent owner also argues that due process and fundamental fairness also require entry of the previously excluded evidence relating to the Telenor documents.

A review of the examiner's answer, particularly at pages 230-231, shows that the examiner's position is <u>not</u> as characterized by the partial quotation that appears on page 1 of the present patent owner petition. [9] Rather, the examiner's language regarding the failure of patent owner "to proffer any evidence" was made <u>solely</u> in the context of the patent owner's failure to proffer <u>evidence</u> rebutting the truthfulness of the assertions in the Aursoy statement. Patent owner alleges the Aursoy statement is unreliable because it is hearsay, and that patent owner has in fact proffered evidence to so demonstrate. However, throughout the detailed argument at pages 9-14 of the present petition, patent owner appears to confuse the <u>issue of whether patent</u>

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revisit those final agency decisions yet again. 37 CFR 41.64(d) does not exist, but to the extent that petitioner may have intended to petition for waiver of 37 CFR 41.64(b), it is noted that 37 CFR 41.64 is not involved here since jurisdiction has not passed to the Board of Patent Appeals and interferences. 37 CFR 41.63 precludes the entry of evidence after the filing of a notice of appeal and prior to a decision on the appeal, while 37 CFR 41.71 precludes the rebuttal brief of a patent owner in an *inter partes* reexamination proceeding from including any new or non-admitted amendment, or an affidavit or other evidence. Inasmuch as the present merged proceeding is being conducted under the *inter partes* statutes, regulations and practice, (<u>see</u>: Decision, *Sua Sponte*, Merging *Ex Parte* and *Inter Partes* Reexamination Proceedings, at page 4), 37 CFR 41.63 and/or 37 CFR 41.71 would preclude entry of any affidavit or other evidence at this stage of the present merged proceeding. Accordingly, the relief requested by petitioner would require waiver of the provisions of 37 CFR 41.63 and/or 37 CFR 41.71.

[5] Note is taken that only the language in the single quotation marks appears in what the examiner wrote. The language in the double quotation marks appears at page 1 of the present patent owner petition and includes language not appearing in the examiner's answer.

[6] See page 2 of the present patent owner petition.

[7] *Id.*

[8] See page 10 of the present patent owner petition.

[9] See footnote 5; only the words "has not proffered evidence" are the examiner's words.

owner submitted evidence challenging the authenticity of the Telenor documents with the issue of whether patent owner has submitted (*i.e.*, "proffered") evidence to rebut the truthfulness of the Aursoy statement. The Aursoy statement is an email in which an unverified statement is made regarding the receipt and cataloguing of the Telenor documents in a library in Trodheim, Norway. [10] The Aursoy statement is relied upon by the examiner to establish the status of the Telenor documents as a printed publication having a definite publication date. [11] On the other hand, the evidence directed to the authenticity of the Telenor documents relates to a verified statement and a supporting report by a forensics document expert in which the expert expresses an opinion on the authenticity of the Telenor documents. The evidence regarding authenticity of the Telenor documents also includes "chain of custody" verified statements regarding the Telenor documents that were analyzed by the expert.

As reproduced on page 11 of the petition, the language at pages 230-231 of the examiner's answer states only that patent owner has not proffered evidence rebutting the truthfulness of the Aursoy statement. Again, the Aursoy statement relates to receipt and cataloging of the Telenor documents in a library in Norway, and is relied upon in support of those documents being a printed publication and obtaining that status as of a given date. The examiner's answer, at pages 230-231, states that patent owner was free to investigate the truthfulness of the allegedly hearsay statements in the Aursoy email and to present evidence to rebut them, but had failed to present such evidence. The language that appears at pages 230-231 of the examiner's answer is not a statement that patent owner has not proffered evidence that is directed to the authenticity of the Telenor documents. The examiner's answer does not state or imply that patent owner did not investigate the hearsay nature of the Aursoy statement. The examiner's answer does not imply that patent owner did not proffer evidence regarding the authenticity of the Telenor documents. The examiner's answer states only that patent owner submitted no evidence (as opposed to comments in the nature of argument) directed to rebutting the truthfulness of the Aursoy statement. The examiner's answer is most certainly is not a general allegation that patent owner has never proffered any evidence that the Telenor documents have been altered in any way, as characterized on the page 1 of the instant petition.

On the other hand, inspection of the evidence proffered by patent owner that has been refused entry into the record of this merged reexamination proceeding (for the reasons set forth in the decisions cited in footnote 3) shows that patent owner has proffered evidence including (1) a verified statement by a documents expert that does not specifically address the Aursoy statement, and (2) verified statements by various individuals that pertain to the chain of custody of the material obtained by patent owner that was submitted to the documents expert for examination. The excluded evidence proffered by patent owner also includes a verified statement establishing that an inquiry on behalf of patent owner was directed to the university library that houses the Telenor documents, that the inquiry was directed to ascertaining the "checkout history" of those documents, and an inquiry into the procedures utilized in the library, (if any), for ascertaining whether materials returned to the library were returned in the same condition in which they had been checked out was also made. [12] Patent owner's

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[10] The Aursoy email was made of record on January 10, 2006.

[11] Examiner's answer, pages 230-231.

[12] On page 7 of the present patent owner petition, Patent owner lists the evidence previously submitted regarding the authenticity of the Telenor documents. In addition to the items mentioned, the list includes Patent Owner's Supplemental Comments to the Action Closing Prosecution." Obviously, comments are not "evidence," and the examiner's quoted statement cannot be read to be inclusive of such proffered, but non-entered, comments. It is noted that patent owner has not pointed to any paper filed by patent owner, entered or not, in which evidence (not comments/arguments) was specifically directed to rebutting the truthfulness of the allegedly hearsay Aursoy statement, as opposed to the rebutting the authenticity of the Telenor documents.

argument that a statement in the examiner's answer that is directed to a failure to proffer rebuttal evidence on the issue of the truthfulness of the Aursoy statement that is being relied upon to establish a date or receipt and the cataloging of the Telenor documents somehow warrants entry into the record of evidence that is directed to the entirely different issue of whether the Telenor documents are authentic and unaltered documents is simply not persuasive. Further, there are three final agency decisions refusing entry (on procedural grounds) of the evidence that was directed to the authenticity of the Telenor documents in the active record present in the active record. Although the evidence directed to the authenticity of the Telenor documents has been excluded from the active record, no reasonable person could conclude that patent owner has failed to proffer evidence in respect to the authenticity of the Telenor documents.

It is also to be noted that with respect to the issue of the truthfulness of the Aursoy statement, notwithstanding that it is allegedly hearsay evidence, patent owner filed a paper entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951" on March 1, 2006. That paper included comments that are directed to the truthfulness of the Aursoy email statement, and such comments are of record. However, as noted, *supra*, comments are not evidence. Patent owner has not pointed to any paper in which patent owner submitted evidence (as opposed to comments/arguments) that is specific to the issue of the truthfulness of the allegedly hearsay statements in the Aursoy statement. Thus it does not appear that the examiner's position is technically inaccurate with respect to the failure of patent owner to submit "evidence" directed to rebutting the Aursoy email statement. However, to the extent that patent owner believes such comments/arguments to fit within the language at pages 230-231 of the examiner's answer as being "evidence," it would appear that no reasonable person could be prejudiced by that statement since the record clearly shows that patent owner in fact submitted such comments. Therefore, petitioner patent owner has not demonstrated that patent owner has been prejudiced by the language at pages 230-231 of the examiner's answer so as to warrant entry of any excluded evidence that was directed to the truthfulness of the statements contained in the Aursoy email.

There is an additional reason why patent owner's petition fails to demonstrate that the language in the examiner's answer prejudices patent owner's position and thereby warrants entry of the excluded evidence directed to the truthfulness of the Aursoy statement. The present merged reexamination proceeding is at the appeal stage. It would appear that patent owner may, or may not, prevail on the merits of the appeal. To the extent that the truthfulness of the Aursoy statement is ultimately accepted because, as argued by the examiner, there is a lack of evidence in the record that shows that the statement Aursoy is not truthful, it is immaterial whether evidence showing that the statement was not truthful was proffered by patent owner or not. It is the absence of such evidence, not the reason why the evidence is absent, that would have been the determinant for the acceptance of the truthfulness of the Aursoy statement. The examiner's characterization of the reason why such evidence is not in the record is unimportant with respect to whether such evidence is, or is not in the record, and if it is in the record, whether such evidence establishes patent owner's position, or not.

Finally, the Brundidge declaration attached to the present petition has been considered, but does not mandate the relief requested by petitioner patent owner. In the context of the overall circumstances in which multiple related patents owned by patent owner were being reexamined in a plurality of reexamination proceedings (each directed to one of the patents), the alleged position attributed by declarant to Ms. Lissi Marquis (the Director of the Central Reexamination Unit) and Mr. Mark Reinhart (a Special Program Examiner in the Central

Reexamination Unit) cannot be taken to mean that evidence submitted for entry into the record of a given reexamination proceeding would be entered into the record of another reexamination proceeding notwithstanding the failure of patent owner to file the evidence in that proceeding in accordance with the applicable regulations. Further, the alleged position attributed to Ms. Marquis and Mr. Reinhart cannot be taken to apply to comments in the nature of argument (as opposed to evidence), particularly if such comments are untimely filed. In this instance, patent owner's March 1, 2006 comments regarding the truthfulness of the Aursoy email statement have already been entered into the record. Patent owner has not explained what other comments or evidence on that specific issue have previously been proffered and excluded from the record, why patent owner is entitled to have such entered notwithstanding that the have been previously excluded, or why presentation of new comments/evidence on that specific issue should be entered at this late point in the merged reexamination proceeding.

In summary, it appears to be the fact that the proffer of evidence directed to the authenticity of the Telenor documents was repeatedly defective and was also, in one instance, untimely. The result is that such evidence has been excluded from the record. Patent owner has not convincingly established why it should be permitted to recover from the effects of patent owner's failure to have that evidence entered into the record, by arguing prejudice based upon the examiner's characterization of why the record does not contain evidence directed to the entirely different issue of the truthfulness of the Aursoy statement. There is, in fact, no evidence in the record (as opposed to comments in the nature of argument) that specifically bears upon the truthfulness of the allegedly hearsay statements in the Aursoy email. The examiner's characterization of why evidence on that is absent from the record is irrelevant to the outcome that might result based on the absence of such evidence. Petitioner patent owner has not established any basis for holding that the language at page 230-231 in any way prejudices petitioner's appeal so as to warrant the requested relief.

CONCLUSION

1. The October 17, 2007 patent owner petition is dismissed.

2. Jurisdiction of the merged reexamination proceeding is being retained in the Office of Patent Legal Administration to render a decision on the patent owner petition filed on October 24, 2007 that requests suspension of the page and word count limits to permit entry of a Supplemental Rebuttal Brief that has been filed simultaneously with patent owner's Rebuttal Brief. Thereafter, jurisdiction will be returned to the Central Reexamination Unit for appropriate action.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

sm
October 30, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 29 2008

CENTRAL REEXAMINATION UNIT

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In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DISMISSING PETITION

This is a decision on the December 10, 2007 patent owner petition entitled "PETITION PURSUANT TO 37 CFR § 1.181, § 1.182 AND § 1.183 TO WITHDRAW THE NOTIFICATION REGARDING DEFECTIVE REBUTTAL BRIEF DATED NOVEMBER 9, 2007."

The petition and the above-captioned merged reexamination proceedings is before the Director of the Central Reexamination Unit, and is being treated as a request for the exercise of the USPTO Director's supervisory authority as delegated to the undersigned.

Summary: The petition is dismissed.

PETITION FEE

The relief requested is considered to be relief pursuant to 37 CFR 1.181. No fee is required for a petition filed pursuant to 37 CFR 1.181. Accordingly, a refund of the petition fee of $400.00 that has been charged to Deposit Account No. 50-0206 will be scheduled in due course.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues <u>separately</u> in accordance with 37 CFR 1.3 and 1.4(c).

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

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[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material and was limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief and evidence appendix.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents, was not entered into the record.

16. On April 4, 2007, patent owner filed a substitute appeal brief after obtaining an expansion of the page and word count limitations imposed by the rules.

17. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 were mailed denying the January 3, 2007 patent owner petition.

18. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsider of the March 30, 2007 or, alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

19. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration.

20. On July 11, 2007, a Notice was mailed informing patent owner that the appeal brief filed on March 5, 2007 was not in compliance with the rules.

21 On August 7, 2007, patent owner filed redacted versions of the appealed brief and evidence appendix that replaced the unredacted versions filed on April 4, 2007.

22. On August 20, 2007 and August 24, 2007, an examiner's answer was mailed. [2]

23. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

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[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007 Examiner's Answer bears the signatures of two appeal conferees.

24. On October 17, 2007, patent owner filed a petition to obtain entry into the record of certain evidence alleged to establish that the so-called Telenor documents that have been applied as a prior art reference have been altered.

25. On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief.

26. On November 7, 2007, the October 17, 2007 patent owner petition was dismissed.

27. On November 9, 2007, a Notification was mailed informing patent owner that the supplemental rebuttal brief filed on October 24, 2007 was defective on the grounds that it was deemed to raise issues that were not present in the examiner's answer as to whether patent owner had proffered evidence that the Telenor documents had been altered.

28. On December 10, 2007, (a Monday), patent owner timely filed a redacted version of the October 24, 2007 supplemental rebuttal brief, in which the material objected to in the November 9, 2007 Notification was redacted.

29. On December 14, 2007, patent owner was notified that jurisdiction of the appeal was transferred to the Board of Patent Appeals and Interferences (BPAI), and that the December 10, 2007 redacted supplemental rebuttal brief was part of the appeal record.

30. On December 10, 2007, patent owner filed the present petition.

DECISION

I. Relevant Authority

37 CFR 41.71 provides, in part:

> "(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
> (b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
> (2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

> "The rebuttal brief must (A) clearly identify each issue, and (B) point out where the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in any respondent brief. A rebuttal brief will not be entered if it does not clearly identify each issue and/or is not limited to issues raised in the examiner's answer or in any respondent brief. Such a rebuttal brief will remain in the file, but it will not be addressed nor considered, except to inform the appropriate party that it was not entered and why.."

II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings. Patent owner has contested the prior art status of the Telenor documents, by taking the position that it is unclear that the Telenor documents as relied upon by the Office are authentic documents that have not been tampered with.

In support of the position taken on the authenticity of the Telenor documents, patent owner filed a verified statement by a documents examiner, and certain supporting documents related to the chain of custody of the Telenor documents that patent owner submitted to the documents examiner for analysis. The verified statement and supporting documents had been refused entry in the present merged proceeding, although they have been entered in others of the reexamination proceedings. The refusal to enter the rebuttal documents in the present merged reexamination proceeding was on procedural grounds, and has been the subject of three petition decisions that have been designated as final agency decisions under 5 U.S.C. § 704 and are of record in the present merged reexamination proceeding. [3]

In the course of prosecution, the merged reexamination proceeding entered the appeal stage. As part of the appeal process, on April 4, 2007, patent owner filed an appeal brief containing an evidence appendix as required by 37 CFR 41.67. [4] However, patent owner was thereafter notified by the examiner that the expanded appeal brief and evidence appendix filed on April 4, 2007 did not comply with 37 CFR 41.67 because certain supplemental declarations referred to were not entered into the record, and because the appeal brief did not identify where in the record such declarations were found. Patent owner thereafter filed redacted versions of the appeal brief and the evidence appendix on August 7, 2007. The redacted appeal brief, at pages 45-48, merely argued that the Telenor documents were not printed publications for purposes of 35 U.S.C. § 102 and that the Office had not supported its position that these documents did constitute printed publications with any evidence. These arguments were addressed at pages 230-231 in the examiner's answer, wherein the examiner noted that the record contained an email authored by one Tove Aursoy, the Coordinator of Library Catalogs at the NTNU library. The statements in the Aursoy email explain when the Telenor documents were received and catalogued.

On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief together with a petition to suspend the page and word count limitation imposed by 37 CFR 1.943. The petition was granted, and therefore the supplemental rebuttal brief was entered into the record. However, on November 9, 2007, following the November 7, 2007 decision that dismissed the patent owner's October 17, 2007 petition to have the evidence directed to the authenticity of the Telenor documents entered, the examiner mailed a Notification to patent owner holding that the supplemental rebuttal brief was defective and setting a

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[3] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[4] This appeal brief was filed because patent owner had obtained an increase in the page and word count limitations imposed on appeal briefs by 37 CFR 1.943.

period in which to file an amended rebuttal brief. The holding was based upon the examiner's position that the supplemental rebuttal brief went addressed issues that were not present in the examiner's answer regarding whether or not patent owner proffered evidence directed to the authenticity of the Telenor documents. Patent owner timely filed a redacted version of the rebuttal brief concurrently with the present petition.[5]

III. Analysis and Findings

a. Patent Owner's Position

Patent owner's rationale for requesting relief in the form of being permitted to proceed with its unredacted supplemental rebuttal brief is that patent owner should, in fairness, be entitled to submit any argument addressing why the Aursoy statement "does not reliably establish the publication date of the Telenor art, and therefore that the Patent Office has failed to carry its burden of proof." [6] Patent owner appears to believe that the examiner's comments that the statements in the Aursoy email are accurate and reliable, even if hearsay, because patent owner has not proffered proof that such statements are not accurate and reliable, are prejudicial. Patent owner believes that it has proffered proof that the Telenor documents are not authentic, and cannot, therefore, be applied as prior art. Patent owner disputes that the examiner's answer was directed solely to the truthfulness of the Aursoy, because the examiner's answer also "plainly references the "accuracy" and "reliability" of the statements in the Aursoy email. Stated differently, patent owner alleges that because the examiner has relied on the Aursoy statement to prove the publication date of the Telenor documents, the patent owner's proffer of evidence that purportedly goes to whether the Telenor documents have been altered clearly constitutes evidence that the Aursoy email statement is not accurate or reliable. Patent owner's theory is that "if the (Telenor) art has been altered, the Aursoy statement is not a truthful statement of the publication date of the art currently relied upon to reject the patent" in this merged proceeding. [7] Patent owner opines that the examiner is micro-managing the content of patent owner's rebuttal brief, and that "[D]ue process and fundamental fairness require that the Patent Owner be granted "reasonable latitude fashion its legal arguments that address and counter assertions in the Examiner's Answer that Patent Owner failed to proffer any evidence challenging the truthfulness, accuracy and reliability of the Aursoy hearsay statements. [8] Patent owner also relies on the following quotation from the examiner's answer: *"Here, there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. Furthermore, Appellant has not proffered evidence to the contrary."* {Emphasis in the original.] [9]

b. The Patent Owner's Position Is Wholly Unpersuasive

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[5] It is noted that in order to comply with the Notification that the supplemental rebuttal brief filed on October 24, 2007 was defective, patent owner filed a redacted supplemental reply brief on December 10, 2007. Jurisdiction of the appeal was thereafter transferred to the BPAI. Jurisdiction of the present patent owner petition is, however, properly with the Central Reexamination Unit, in the Office of the Deputy Commissioner for Patent Examination and Policy. See MPEP § 1000.02(c) and compare MPEP §§1000.02(f) and (g).

[6] Petition, page 3, first full paragraph.

[7] *Id.*, page 8, the last paragraph.

[8] *Id.*, page 3, the last paragraph.

[9] *Id.*, page 14, first paragraph.

A review of the record of this proceeding, including the examiner's answer, particularly at pages 230-231, and of the Aursoy document itself [10], shows that patent owner's position here is not well taken because it is based upon a co-mingling and confusion of two distinct issues.

Patent owner's contention that the examiner is relying upon the Aursoy statement to prove the date of the Telenor documents is incorrect. The Telenor documents facially include a date. On pages 230-231 of the examiner's answer dated August 24, 2007, in a section entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported by Evidence," the examiner relied upon the Aursoy email to address patent owner's arguments at pages 45-48 of the amended appeal brief filed on August 7, 2007. Those arguments are that the Telenor documents are not printed publications under 35 U.S.C. § 102(b). The examiner addressed those arguments by noting in the examiner's answer that the Aursoy email includes statements regarding the receipt dates for various ones of the Telenor documents at the NTNU library in Trondheim Norway, and the date on which the Telenor documents were cataloged at that library. [11] The examiner considered that based upon the dates of receipt and cataloguing, the Telenor documents qualified as printed publications under 35 U.S.C. § 102(b). The examiner further considered that to the extent that patent owner had characterized the Aursoy statement as being unreliable because it is hearsay, the patent owner had not offered evidence **that the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were not in fact facially accurate and reliable. Accordingly, the examiner concluded that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents appeared to be facially accurate and reliable**. The examiner's answer also notes that the examiner considers that that although patent owner was free to investigate the truth of **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents**, the record did not contain any evidence submitted by patent owner directed to showing that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were inaccurate or untrue. The examiner concluded that on the record, **the statements contained in the Aursoy email regarding the receipt and cataloguing of the Telenor document**, must, therefore, be considered to be reliable even if such statements are deemed to be hearsay. Further, the statements deemed by the examiner to be facially accurate and reliable are **statements respecting receipt and cataloging of the Telenor documents**. They are not statements regarding **the technical content of those documents**.

Thus, patent owner's position that patent owner's proffer of evidence going to the authenticity of the Telenor documents, (*i.e.*, the filing of verified statements **directed to the issue of whether the content of the Telenor documents had been (subsequently) altered so as to change the technical teachings thereof**) was an attempt by patent owner to contest the accuracy and reliability of the content of the Aursoy email, co-mingles and confuses two distinct issues. The first issue is whether an unverified statement that a document was received on a given date and then catalogued is truthful, accurate and reliable, and supports

[10] The Aursoy email was filed entered into the record as part of the third party requester comments pursuant to 37 CFR § 1.947 on January 10, 2006. The email amounts to an unverified statement regarding the receipt and cataloguing of the Telenor documents in the NTNU library in Trondheim, Norway.

[11] The Telenor documents include eight volumes, and the volumes include various dates.

that document being a printed publication as of the date that it was available to, and locatable by, interested persons of ordinary skill in the art. The second issue is whether the technical content of that document is, or is not, authentic, such that the printed publication is not a printed publication of the receipt and cataloguing dates. The two are wholly different issues.

Viewed with the distinction between the two issues discussed above in mind, it is clear that when read in context, the examiner's position in the examiner's answer that is quoted at the end of Section 3(a), *supra*, and on page 14 of the present petition, is not a basis for affording patent owner the requested relief. The quoted statement simply sets forth the examiner's position that the statements in the Aursoy email, on their face, have nothing to do with any subsequent alteration of the technical information set forth in any of the Telenor documents. Evidence alleging such an alteration simply does not provide any evidence to support a belief that statements in the Aursoy email are facially inaccurate or unreliable for the proposition for which it was offered by Aursoy. Patent owner has not proffered any evidence directed to the topics addressed by the Aursoy email, namely the receipt and cataloguing of the Telenor documents, although patent owner did offer comments on the Aursoy email in the March 1, 2006 paper entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951". To the extent that patent owner proffered evidence going to the authenticity of the technical content of the Telenor documents, the proffer of such evidence has nothing to do with the issue of whether the documents are *prima facie* entitled to status as a printed publication as of a particular date based upon the receipt and cataloging of such documents as set forth in the uncontradicted email statement of Tove Aursoy.

It is also to be noted that in the October 17, 2007 petition, patent owner alleged that on pages 230-231 of the examiner's answer dated August 24, 2007, the examiner had included an assertion that the patent owner "'has not proffered evidence to support arguments' that the Telenor documents relied upon by the Office in rejecting the claims of the '592 patent have been altered in any way." [12] In the present petition paper, patent owner now casts the argument in slightly different language: "[O]n pages 230-231 of the Examiner's Answer, the Patent Office asserts, among other things, that the Patent Owner 'has not proffered evidence to support arguments' that statements by Tove Aursoy are accurate and reliable." [13] Again, it is pointed out that the statements in the email of Tove Aursoy are limited to the receipt date and the subsequent cataloguing of documents. The Aursoy statements do not address the authenticity or accuracy of the technical content of the documents. The receipt date and cataloguing is material to the status of the Telenor documents as *prima facie* constituting printed publications which, if early enough in date, would in turn *prima facie* constitute prior art pursuant to 35 U.S.C. § 102 and the case law construing the statute as to what does, and does not, constitute a "printed publication." The authenticity of the technical content of the Telenor documents goes to the issue of whether the technical content of the publications is such as to be evidence of non-entitlement of an applicant or a patent owner to one or more claims due to anticipation under 35 U.S.C § 102 and/or non-obviousness under 35

[12] See page 1 of patent owner's October 17, 2007 petition. It is once again pointed out, as was done in the November 7, 2007 decision dismissing patent owner's October 17, 2007 petition, that only the language in the single quotation marks actually appears in what the examiner wrote in the August 24, 2007 examiner's answer.
[13] See page 7, first full paragraph, of the present patent owner petition paper.

U.S.C. § 103. Evidence introduced as to the latter is not evidence that is necessarily directed to the former.

On the present record, it is clear that evidence directed to the authenticity of the technical content of the Telenor documents is not material to the question of whether the Telenor documents constitute printed publications as of a given date, regardless of the content thereof. Patent owner cannot convert a proffer of evidence on authenticity of the technical content of the Telenor documents into evidence that somehow contradicts Aursoy's email statements that are limited to the issues of receipt and cataloguing of the Telenor documents, and to other library procedures not relevant here. That the record does not contain evidence that patent owner contends would show that the technical content of the printed publications were somehow altered as to their technical content after the date of the invention claimed in the patent that is the subject of the present merged reexamination proceeding, and so cannot therefore constitute prior art as to such claimed invention, is due to patent owner's unwillingness and/or inability to comply with the regulations for submitting such evidence after having been notified of how to submit such evidence within the requirements of the regulations, and having been given a period of time in which to do so. The situation cannot be remedied by converting an accurate statement by the examiner regarding the record as it pertains to the statements in the Aursoy email into a procedural error on the part of the examiner. [14]

For the foregoing reasons, it is considered that the examiner did not commit any procedural error in holding that the supplemental rebuttal brief filed on April 4, 2007 failed to comply with 37 CFR 41.71 and the practice implementing the regulation set forth in MPEP § 2679. Therefore, the examiner will not be directed to withdraw the requirement for the filing of an amended supplemental rebuttal brief that was set forth in the Notification filed on November 9, 2007.

[14] See footnote 3, *supra*.

CONCLUSION

1. The December 10, 2007 patent owner petition is dismissed.

2. The April 4, 2007 supplemental reply brief (and the confirmation copy thereof filed on June 7, 2007) have been sealed by being marked "closed" and non-public." These documents form no part of the official Image File Wrapper of the merged reexamination proceeding.

3. Jurisdiction of the merged reexamination proceeding is being transferred to the Office of Patent Legal Administration for consideration of the patent owner petition filed on January 11, 2008 that requests reconsideration of the Decision on Petition dated November 7, 2007.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

JUN 19 2008

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DENYING PETITION

This is a decision on the March 31, 2008 patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R § 1.181, § 1.182 AND § 1.183 TO RECONSIDER THE JANUARY 29, 2008 DECISION DENYING ORIGINAL PETITION PURSUANT TO 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO WITHDRAW THE NOTIFICATION REGARDING DEFECTIVE REBUTTAL BRIEF DATED NOVEMBER 9, 2007."

The petition and the above-captioned merged reexamination proceeding are before the Director of Technology Center 1700. The petition is being treated as a request for the exercise of the USPTO Director's supervisory authority as delegated to the undersigned.

Summary: The petition is denied. The decision is designated as a final agency action under 5 U.S.C. § 704.

PETITION FEE

The relief requested is considered to be relief pursuant to 37 CFR 1.181. No fee is required for a petition filed pursuant to 37 CFR 1.181. Accordingly, a refund of the petition fee of $400.00 that has been charged to Deposit Account No. 50-0206 (accounting date April 3, 2008) will be scheduled in due course.

Copied from 90006495 on 06/25/2008

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

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5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

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[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

Copied from 90006495 on 06/25/2008

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material and was limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief and evidence appendix.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents, was not entered into the record.

16. On April 4, 2007, patent owner filed a substitute appeal brief after obtaining an expansion of the page and word count limitations imposed by the rules.

17. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 were mailed denying the January 3, 2007 patent owner petition.

18. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsider of the March 30, 2007 or, alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

19. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration.

20. On July 11, 2007, a Notice was mailed informing patent owner that the appeal brief filed on March 5, 2007 was not in compliance with the rules.

21 On August 7, 2007, patent owner filed redacted versions of the appealed brief and evidence appendix that replaced the unredacted versions filed on April 4, 2007.

22. On August 20, 2007 and August 24, 2007, an examiner's answer was mailed.[2]

23. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007 Examiner's Answer bears the signatures of two appeal conferees.

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24. On October 17, 2007, patent owner filed a petition to obtain entry into the record of certain evidence alleged to establish that the so-called Telenor documents that have been applied as a prior art reference have been altered.

25. On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief.

26. On November 7, 2007, the October 17, 2007 patent owner petition was dismissed.

27. On November 9, 2007, a Notification was mailed informing patent owner that the supplemental rebuttal brief filed on October 24, 2007 was defective on the grounds that it was deemed to raise issues that were not present in the examiner's answer as to whether patent owner had proffered evidence that the Telenor documents had been altered.

28. On December 10, 2007, (a Monday), patent owner timely filed a redacted version of the October 24, 2007 supplemental rebuttal brief, in which the material objected to in the November 9, 2007 Notification was redacted.

29. Also on December 10, 2007, patent owner filed a petition to withdraw the November 9, 2007 Notification that the supplemental rebuttal brief filed on October 24, 2007 was defective.

30. On December 14, 2007, patent owner was notified that jurisdiction of the appeal was transferred to the Board of Patent Appeals and Interferences (BPAI), and that the December 10, 2007 redacted supplemental rebuttal brief was part of the appeal record.

31. On January 7, 2008, patent owner filed a petition for reconsideration of the November 7, 2007 decision on petition.

32. On January 29, 2008, the December 10, 2007 patent owner petition was dismissed in a decision by the Director of the Central Reexamination Unit.

33. On March 31, 2008, (a Monday), patent owner filed the present petition for reconsideration of the January 29, 2008 decision on petition.

DECISION

I. Relevant Authority

37 CFR 41.71 provides, in part:

"(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
(2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other

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evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

"The rebuttal brief must (A) clearly identify each issue, and (B) point out where the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in any respondent brief. A rebuttal brief will not be entered if it does not clearly identify each issue and/or is not limited to issues raised in the examiner's answer or in any respondent brief. Such a rebuttal brief will remain in the file, but it will not be addressed nor considered, except to inform the appropriate party that it was not entered and why."

II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings. Patent owner contested the prior art status of the Telenor documents, by taking the position that it is unclear that the Telenor documents as relied upon by the Office are authentic documents that have not been tampered with.

In support of the position taken on the authenticity of the Telenor documents, patent owner filed evidence in the form of a verified statement by a documents examiner, and certain supporting documents related to the chain of custody of the Telenor documents that patent owner submitted to the documents examiner for analysis. The verified statement and supporting documents have been refused entry in the present merged proceeding, although they have been entered in others of the reexamination proceedings. The refusal to enter the rebuttal documents in the present merged reexamination proceeding was based on patent owner's failure to comply with the Office's rules, and has been the subject of three petition decisions that have been designated as final agency actions under 5 U.S.C. § 704. These decisions are of record in the present merged reexamination proceeding.[3]

In the course of prosecution, the merged reexamination proceeding entered the appeal stage. On April 4, 2007, as part of the appeal process, patent owner filed an appeal brief containing an evidence appendix as required by 37 CFR 41.67.[4] However, patent owner was thereafter notified by the examiner that the expanded appeal brief and evidence appendix filed on April 4, 2007 did not comply with 37 CFR 41.67 because certain supplemental declarations referred to were not entered into the record, and because the appeal brief did not identify where in the record such declarations were found. Patent owner thereafter filed, on August 7, 2007, redacted versions of the appeal brief and the evidence appendix. The redacted appeal brief, at pages 45-48, merely argued that the Telenor documents were not printed publications for purposes of 35 U.S.C. § 102 and that the Office had not supported its position that these documents did constitute printed publications with any evidence. These arguments were addressed at pages 230-231 in the examiner's answer, wherein the examiner

[3] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[4] This appeal brief was filed because patent owner had obtained an increase in the page and word count limitations imposed on appeal briefs by 37 CFR 1.943.

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noted that the record contained an email authored by one Tove Aursoy, the Coordinator of Library Catalogs at the NTNU library. The statements in the Aursoy email explain when the Telenor documents were received and catalogued.

On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief together with a petition to suspend the page and word count limitation imposed by 37 CFR 1.943. The petition was granted, and therefore, the supplemental rebuttal brief was entered into the record. However, on November 9, 2007, following the November 7, 2007 decision that dismissed the patent owner's October 17, 2007 petition to have the evidence directed to the authenticity of the Telenor documents entered,[5] the examiner mailed a Notification to patent owner that held the supplemental rebuttal brief to be defective. The Notification set a period of time in which to file an amended rebuttal brief. The holding that the supplemental brief was defective was based upon the examiner's position that the supplemental rebuttal brief addressed issues that were not present in the examiner's answer regarding whether or not patent owner proffered evidence directed to the authenticity of the Telenor documents. Patent owner timely filed a redacted version of the rebuttal brief concurrently with the December 10, 2007 petition requesting entry of the unredacted supplemental rebuttal brief.[6]

III. The January 29, 2008 Decision Dismissing the December 10, 2007 Petition

a. Patent Owner's Position

As presented in the petition filed on December 10, 2007, patent owner's rationale for requesting relief in the form of being permitted to proceed with its unredacted supplemental rebuttal brief was that patent owner should, in fairness, be entitled to submit any argument addressing why the Aursoy statement "does not reliably establish the publication date of the Telenor art, and therefore that the Patent Office has failed to carry its burden of proof."[7]

Patent owner took the position that because the examiner had commented in the examiner's answer on appeal that patent owner had never proffered any evidence challenging the statements made in an email from Tove Aursoy, patent owner had been prejudiced. Patent owner asserted that the examiner's comments were prejudicial to patent owner because patent owner had proffered proof that the Telenor documents are not authentic, and cannot, therefore, be applied as prior art. Patent owner alleged in the December 10, 2007 petition that because the examiner has relied on the Aursoy email statement to prove the publication date of the Telenor documents, the patent owner's proffer of evidence directed to whether the Telenor documents have been altered was a proffer of evidence that the Aursoy email statement is not accurate or reliable. Patent owner's reasoning, as presented in the December 10, 2007 petition, was that "if the (Telenor) art has been altered, the Aursoy statement is not

[5] A decision on the January 7, 2008 patent owner petition for reconsideration of the November 7, 2007 petition decision was still pending at the time that the instant petition was filed.

[6] It is noted that in order to comply with the Notification that the supplemental rebuttal brief filed on October 24, 2007 was defective, patent owner filed a redacted supplemental reply brief on December 10, 2007. Jurisdiction of the appeal was thereafter transferred to the BPAI. Jurisdiction of the December 10, 2007 patent owner petition was properly with the Central Reexamination Unit, in the Office of the Deputy Commissioner for Patent Examination and Policy. See MPEP § 1000.02(c) and compare MPEP §§1000.02(f) and (g). Jurisdiction of the present petition for reconsideration is properly with the undersigned to review a decision of the Central Reexamination Unit Director.

[7] Petition dated December 10, 2007, page 3, first full paragraph.

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a truthful statement of the publication date of the art currently relied upon to reject the patent" in this merged proceeding.[8] Patent owner was of the opinion that the examiner was micro-managing the content of patent owner's rebuttal brief, and that "[D]ue process and fundamental fairness require that the Patent Owner be granted "reasonable latitude fashion its legal arguments that address and counter assertions in the Examiner's Answer that Patent Owner failed to proffer any evidence challenging the truthfulness, accuracy and reliability of the Aursoy hearsay statements.[9] Patent owner also relied on the following quotation from the examiner's answer: "***Here, there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. Furthermore, Appellant has not proffered evidence to the contrary.***" [Emphasis in the original.][10]

b. The January 29, 2008 Petition Decision

The January 29, 2008 petition decision was predicated on a complete and thorough review of the record of this merged reexamination proceeding. In particular, a review of the examiner's answer at pages 230-231, and a review of the Aursoy email document itself,[11] showed that patent owner's position was not well taken because it was based upon a co-mingling and confusion of two distinct issues.

Patent owner's contention that the examiner relied upon the Aursoy statement to prove the date of the Telenor documents is incorrect. The Telenor documents facially include a date. On pages 230-231 of the examiner's answer dated August 24, 2007, in a section entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported by Evidence," the examiner relied upon the Aursoy email to address patent owner's arguments at pages 45-48 of the amended appeal brief filed on August 7, 2007. Patent owner's arguments were that the Telenor documents are not printed publications under 35 U.S.C. § 102(b). The examiner addressed those arguments by noting in the examiner's answer that the Aursoy email includes statements regarding the receipt dates for various ones of the Telenor documents at the NTNU library in Trondheim Norway, and the dates on which the Telenor documents were cataloged at that library.[12] The examiner considered that based upon the dates of receipt and cataloguing, the Telenor documents qualified as printed publications under 35 U.S.C. § 102(b). The examiner further considered that to the extent that patent owner had characterized the Aursoy email statement as being unreliable because it is hearsay, the patent owner had not offered evidence **that the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were not in fact facially accurate and reliable. Accordingly, the examiner concluded that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents appeared to be facially accurate and reliable**. The examiner's answer also noted that the examiner considered that although patent owner was free to investigate **the truth of the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor**

[8] *Id.*, page 8, the last paragraph.
[9] *Id.*, page 3, the last paragraph.
[10] *Id.*, page 14, first paragraph.
[11] The Aursoy email was entered into the record as part of the third party requester comments pursuant to 37 CFR § 1.947 on January 10, 2006. The email amounts to an unverified statement regarding the receipt and cataloguing of the Telenor documents in the NTNU library in Trondheim, Norway.
[12] The Telenor documents include eight volumes, and the volumes include various dates.

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documents, the record did not contain any evidence submitted by patent owner directed to showing that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were inaccurate or untrue. The examiner concluded that on the record, **the statements contained in the Aursoy email regarding the receipt and cataloguing of the Telenor document**, must, therefore, be considered to be reliable even if such statements are deemed to be hearsay. Further, the statements deemed by the examiner to be facially accurate and reliable are **statements regarding the receipt and cataloging of the Telenor documents**. They are not statements regarding **the technical content of those documents**.

Thus, the position taken by patent owner in the December 10, 2007 petition was determined to be that patent owner's proffer of evidence going to the authenticity of the Telenor documents, (*i.e.*, the filing of verified statements **directed to the issue of whether the content of the Telenor documents had been (subsequently) altered so as to change the technical teachings thereof**) was an attempt by patent owner to contest the accuracy and reliability of the content of the Aursoy email. However, it was determined in the January 29, 2008 decision that patent owner's position co-mingled and confused two distinct issues. The first issue was whether an unverified statement that a document was received on a given date and then catalogued is truthful, accurate and reliable, and supports that document being a printed publication as of the date that it was available to, and locatable by, interested persons of ordinary skill in the art. The second issue was whether the technical content of that document is, or is not, authentic, such that the printed publication is not a printed publication as of the receipt and cataloguing dates for content that had been altered. The two are wholly different issues.

Viewed with the distinction between the two issues discussed above in mind, it was determined in the January 29, 2008 petition decision that when read in context, the examiner's position in the examiner's answer that is quoted at the end of Section 3(a), *supra*, and on page 14 of the December 10, 2007 petition, was not a basis for affording patent owner the requested relief. It was determined in the January 29, 2008 petition decision that the quoted statement merely set forth the examiner's position that the statements in the Aursoy email, on their face, have nothing to do with any subsequent alteration of the technical information set forth in any of the Telenor documents. It was further determined in the January 29, 2008 petition decision that evidence alleging such an alteration simply does not provide any evidence to support a belief that statements in the Aursoy email are facially inaccurate or unreliable for the proposition for which they were offered by Aursoy. It was also determined in the January 29, 2008 petition decision that patent owner had not proffered any evidence directed to the topics addressed by the Aursoy email, namely the receipt and cataloguing of the Telenor documents, although patent owner had offered comments on the Aursoy email in the March 1, 2006 paper entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951." To the extent that patent owner proffered evidence going to the authenticity of the technical content of the Telenor documents, it was determined in the January 29, 2008 petition decision that the proffer of such evidence had nothing to do with the issue of whether the documents are *prima facie* entitled to status as a printed publication as of a particular date based upon the receipt and cataloging of such documents as set forth in the uncontradicted email statement of Tove Aursoy.

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In the October 17, 2007 petition, patent owner had alleged that on pages 230-231 of the examiner's answer dated August 24, 2007, the examiner had included an assertion that the patent owner "'has not proffered evidence to support arguments' that the Telenor documents relied upon by the Office in rejecting the claims of the '592 patent have been altered in any way."[13] In the December 10, 2007 petition, patent owner had cast the argument in slightly different language: "[O]n pages 230-231 of the Examiner's Answer, the Patent Office asserts, among other things, that the Patent Owner 'has not proffered evidence to support arguments' that statements by Tove Aursoy are accurate and reliable."[14] It was, therefore, reiterated in the January 29, 2008 decision that the statements in the email of Tove Aursoy were limited to the receipt date and the subsequent cataloguing of documents. It was held that the Aursoy statements did not address the authenticity or accuracy of the technical content of the documents. It was also held in the January 29, 2008 petition decision that the receipt and cataloguing dates were material to the status of the Telenor documents as *prima facie* constituting printed publications which, if early enough in date, would in turn *prima facie* constitute prior art pursuant to 35 U.S.C. § 102 and the case law construing the statute as to what does, and does not, constitute a "printed publication." It was additionally held in the January 29, 2008 petition decision that the authenticity of the technical content of the Telenor documents goes to the issue of whether the technical content of the publications is such as to be evidence of non-entitlement of an applicant or a patent owner to one or more claims due to anticipation under 35 U.S.C § 102 and/or non-obviousness under 35 U.S.C. § 103. It was further held that evidence introduced as to the latter is not evidence that is necessarily directed to the former.

IV. The March 31, 2008 Petition for Reconsideration

A review of March 31, 2008 petition for reconsideration shows that patent owner has essentially rehashed the position and arguments presented in the December 10, 2007 petition. Patent owner has not presented in the March 31, 2008 petition for reconsideration any persuasive rebuttal of any of the reasoning that resulted in the December 10, 2007 petition being dismissed. Rather, patent owner continues to adhere to the position that a proffer of evidence directed to whether the Telenor documents had, at some time, been altered as to their original content, equates to a proffer of evidence that would rebut a statement made with respect to when the Telenor documents were received and catalogued at the NTNU library in Trondheim Norway.

However, in the March 31, 2008 petition for reconsideration, patent owner for the first time now states:

> "[I]n particular, Patent Owner submitted the Declaration of Dr. V. Thomas Rhyne under 37 C.F.R. §132 (hereinafter "Rhyne Dec.)" wherein Dr. Rhyne, one of ordinary skill in the art, states that the Telenor documents were not catalogued or indexed in such a way to make them available to persons interested and ordinarily skilled in the relevant art of the Campana patents. See, e.g., Rhyne Dec, ¶s 70-76, which sets forth the testimony of one of ordinary skill in the art

[13] See page 1 of patent owner's October 17, 2007 petition. It is once again pointed out, as was done in the November 7, 2007 decision dismissing patent owner's October 17, 2007 petition, that only the language in the single quotation marks actually appears in what the examiner wrote in the August 24, 2007 examiner's answer.
[14] See page 7, first full paragraph, of the present patent owner petition paper.

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that the documents were not properly indexed and catalogued, and therefore do not constitute a printed publication for purposes of 35 U.S.C. §102.[15]

There are several "Rhyne Declarations" in the record. None were referenced in the original petition filed on December 10, 2007. No specific "Rhyne Declaration" is referenced in the statement from the present petition for reconsideration that is quoted above. However, the December 28, 2005 declaration of Dr. V. Thomas Rhyne does discuss indexing and cataloguing of the Telenor documents at paragraphs 70-75. In those paragraphs, Dr. Rhyne, an expert in the field of electrical engineering and a registered patent practitioner, opines that one of ordinary skill in the art would not have found the Telenor documents in a search that exercised reasonable diligence, due to the manner in which Dr. Rhyne guesses that one of ordinary skill in the art would have formulated a search.

To the extent that the Rhyne declaration is deserving of consideration in a petition for the requested relief, after having not been relied upon in the December 10, 2007 petition, it is not seen that these statements are at all directed at the specific statements contained in the Aursoy email.[16] The Rhyne declaration does not dispute that the Telenor documents were received and catalogued at the NTNU library as stated in the Aursoy email. Yet again, patent owner has confused issues; the reliability and truthfulness of the statements contained in the Aursoy email have nothing to do with the issue of the usefulness of the key words under which the Telenor documents were catalogued as aids for locating the Telenor documents. Therefore, Dr. Rhyne's declaration in no way renders the examiner's statement at pages 230-231 of the examiner's answer untrue. To the extent that it may be agued that Dr. Rhyne's opinion that one of ordinary skill in the art would not have found the Telenor documents that were catalogued under the phrases "mobile telephone" and "communication protocol", but not under phrases such as "email" or "electronic mail" or "electronic message," such an argument may go to the issue of whether the Telenor documents are, or are not, printed publications, but Dr. Rhyne's opinion does nothing to rebut anything stated in the Aursoy email. Accordingly, the existence in the record of the Rhyne Declaration filed on December 28, 2005 in no way opens the door for patent owner to discuss evidence directed to whether the Telenor documents were altered, when such evidence has properly been excluded from the record. At best, Dr. Rhyne's opinion goes to whether the Telenor documents that were catalogued at the time and in the manner set forth in the Aursoy email statement were "properly" catalogued.

On the present record, it remains clear that evidence directed to the authenticity of the technical content of the Telenor documents is not material to the question of whether the Telenor documents constitute printed publications as of a given date, regardless of the content thereof. Similarly, evidence that would establish whether the content of the Telenor documents had, at some point in the existence of the Telenor documents, been altered from their original content, would not be material to the status of the Telenor documents as a printed publication as of the date they were received and catalogued at the NTNU library as described in the Aursoy email. Patent owner cannot convert a proffer of evidence on the

[15] Petition ... To Reconsider ..." March 31, 2008 at page 14.

[16] It should be noted the Dr. Rhyne candidly states that his opinion on this issue is based on circumstances that were "presented" to him which has "not attempted to confirm or refute." Rhyne Declaration, filed December 28, 2005, at page 27. There is nothing to indicate that Dr. Rhyne ever saw, or was presented with, the statements in the Aursoy email.

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authenticity of the technical content of the Telenor documents into evidence that somehow contradicts the truth of the statements contained in the Aursoy email, which statements are limited to the issues of receipt and cataloguing of the Telenor documents, and to other library procedures not relevant here. Neither can Dr. Rhyne's opinion regarding the quality of the cataloguing of the Telenor documents contradict the truth or statements contained in the Aursoy email. That the present record does not contain the evidence that patent owner contends would show that the technical content of the Telenor printed publications was somehow altered after the date of the invention claimed in the patent that is the subject of the present merged reexamination proceeding, (and so cannot therefore constitute prior art as to such claimed invention due to that alteration), appears to be due to patent owner's unwillingness and/or inability to comply with the Office's rules for submitting such evidence after having been notified of how to submit such evidence within the requirements of the rules, and having been given a period of time in which to do so. The absence from the record of evidence directed to the authenticity of the technical content of the Telenor printed publications [17] cannot be remedied by attempting to convert an accurate exposition by the examiner regarding what the record specifically shows with respect to how and when the Telenor documents were received and catalogued in the NTNU library, (*i.e.*, the statements in the Aursoy email), into a procedural error on the part of the examiner.

For the foregoing reasons, it is considered that, in the January 29, 2008 petition decision, the Director of the Central Reexamination Unit correctly determined that the examiner did not commit any procedural error in holding that the supplemental rebuttal brief filed on October 24, 2007 failed to comply with both 37 CFR 41.71 and the practice implementing the regulation set forth in MPEP § 2679. Therefore, the decision of the Director of the Central Reexamination Unit will not be disturbed, and the examiner will not be directed to withdraw the requirement for the filing of an amended supplemental rebuttal brief that was set forth in the Notification filed on November 9, 2007.

[17] See footnote 3, *supra*.

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CONCLUSION

1. The March 31, 2008 patent owner petition is granted to the extent that the January 29, 2008 decision dismissing the December 10, 2007 petition has been fully reconsidered. However, the March 31, 2008 patent owner petition is denied with respect to the relief requested by patent owner.

2. The October 24, 2007 supplemental reply brief has been sealed by being marked "closed" and non-public." This document forms no part of the official Image File Wrapper of the merged reexamination proceeding.

3. Jurisdiction of the merged reexamination proceeding is being returned to the Board of Patent Appeals and Interferences.

4. This decision is designated as a final agency action under 5 U.S.C. § 704.

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-1100, or in her absence, to Greg Morse at (571) 272-3838 or Andy Kashnikow at (571) 272-4361.

Marian C. Knode

Marian C. Knode, Director
Technology Center 1700

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(For Patent Owner)

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JUN 19 2008

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

DECISION DENYING PETITION

This is a decision on the January 7, 2008 patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.181 OR, ALTERNATIVELY, 37 C.F.R. § 1.182 OR ALTERNATIVELY 37 C.F.R. § 1.183 TO RECONSIDER THE NOVEMBER 7, 2007 DECISION DENYING ORIGINAL PETITION PURSUANT TO 37 C.F.R. § 1.181 IN RESPONSE TO STATEMENTS MADE IN THE EXAMINER ANSWER TO ENTER INTO THE RECORD FOR APPEAL EVIDENCE AGAINST THE AUTHENTICITY OF THE TELENOR DOCUMENTS."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration. The petition is a request for reconsideration of the decision dated November 17, 2007, in which the Office dismissed October 17, 2007 petition in which patent owner requested entry into the record of evidence "against the authenticity" of certain documents.

Summary: The petition for reconsideration is granted to the extent that the petition decision dated November 17, 2007 has been reconsidered. For the reasons set forth below, the relief requested by petitioner patent owner is denied. The present decision is designated as a final agency action under 5 U.S.C. § 704.

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PETITION FEE

The relief requested would require that the provisions of 37 CFR 41.63 and/or 37 CFR 41.67 be waived pursuant to 37 CFR 1.183, in order to permit the filing and entry of additional new or non-admitted evidence, or an affidavit or other evidence at this stage of the proceeding. Accordingly, a petition fee of $400.00 has been charged to Deposit Account No. 50-0206 pursuant to patent owner's instructions at page 17 of the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006,[1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues, *i.e.*, the material directed to the authenticity of the Telenor documents, separately, as required by 37 CFR 1.3 and 1.4(c).

[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

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9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by the provisions of 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which was stated not to include the FOIA material and to be limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief and evidence appendix.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents (as well as the other materials for which entry was requested) were not entered into the record. Relief was denied because the request for reconsideration was untimely filed and the FOIA material remained co-mingled with the material directed to the Telenor documents in contradiction to the requirement of the rules.

16. On April 4, 2007, patent owner filed a substitute appeal brief after obtaining an expansion of the page and word count limitations imposed by the rules.

17. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the January 3, 2007 patent owner petition because the FOIA material still remained co-mingled with the material directed to the Telenor documents.

18. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsideration of the March 30, 2007 decision, or alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

19. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration since the matter was regarded as ripe for judicial review in light of the two prior decisions designated as final agency actions, and because, contrary to patent owner's arguments, the FOIA material continued to remain co-mingled with the material directed to the Telenor documents.

20. On July 11, 2007, a Notice was mailed informing patent owner that the appeal brief filed on March 5, 2007 was not in compliance with the rules.

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21 On August 7, 2007, patent owner filed redacted versions of the appeal brief and evidence appendix that replaced the unredacted versions filed on April 4, 2007.

22. On August 20, 2007, and on August 24, 2007, an examiner's answer was mailed by the Office.[2]

23. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

24. On October 17, 2007, patent owner filed a petition to obtain entry into the record of certain evidence alleged to establish that the so-called Telenor documents that have been applied as a prior art reference had been altered.

25. On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief.

26. On November 7, 2007, the October 17, 2007 patent owner petition was dismissed.

27. On November 9, 2007, a Notification was mailed informing patent owner that the supplemental rebuttal brief filed on October 24, 2007 was defective on the grounds that it was deemed to raise issues that were not present in the examiner's answer, i.e., issues regarding whether patent owner had, or had not, proffered evidence that the Telenor documents had been altered.

28. On December 10, 2007 (a Monday), patent owner timely filed a redacted version of the October 24, 2007 supplemental rebuttal brief, in which the material objected to in the November 9, 2007 Notification was redacted.

29. On December 10, 2007, patent owner filed a petition requesting supervisory review of the examiner's November 9, 2007 Notification.

30. On December 14, 2007, patent owner was notified that jurisdiction over the appeal and the present proceeding was transferred to the Board of Patent Appeals and Interferences (BPAI), and that the December 10, 2007 redacted supplemental rebuttal brief was part of the appeal record.

31. On January 11, 2008, patent owner filed the present request for reconsideration of the November 7, 2007 decision dismissing the October 17, 2007 patent owner petition.

32. On January 29, 2008, the December 10, 2007 patent owner petition was dismissed by the Director of the Central Reexamination Unit (CRU), after jurisdiction over the proceeding was returned to the CRU by the BPAI.

33. On February 7, 2008, the BPAI returned jurisdiction over the proceeding to the CRU, relinquishing jurisdiction under 37 CFR 41.64(b). Jurisdiction has been assumed by the Office of Patent Legal Administration to address the patent owner's January 11, 2008 petition for reconsideration of the November 7, 2007 decision.

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[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007 Examiner's Answer bears the signatures of two appeal conferees.

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34. On March 31, 2008, patent owner filed a petition reconsideration of the January 29, 2008 CRU decision.

DECISION

I. Relevant Authority

37 CFR 41.63 provides:

"(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).

37 CFR 41.71 provides, in part:

"(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
(2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

"After the examiner's answer, only a rebuttal brief (or an amended rebuttal brief, where appellant is given one opportunity to correct a defective original rebuttal brief (MPEP § 2679)) will be received into the reexamination proceeding. No other submission will be considered, and any such other submission will be returned as an improper paper. 37 CFR 1.939."

II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of its related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings, including the present merged reexamination proceeding. Patent owner has taken the position that it is unclear that the Telenor documents as relied upon by the Office are authentic documents that have not been tampered with, and has contested the prior art status of the Telenor documents with respect to the contents thereof.

In support of the position taken on the authenticity of the Telenor documents, patent owner filed a verified statement by a documents examiner in a manner that failed to comply with the Office's rules. Similarly, patent owner filed certain supporting documents related to the chain of custody of the Telenor documents that also failed to comply with the Office's rules. As a result of patent owner's failure to comply with the rules for submitting such documents, these documents have

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not been entered in the present merged proceeding.[3] The refusal to enter the rebuttal documents in the present merged reexamination proceeding was on procedural grounds; involving the failure to submit the documents in a manner that complied with the Office's rules. After the Office issued the first decision on September 13, 2006, refusing entry of these documents, subsequent decisions refusing entry thereafter noted that entry of the material directed to the authenticity of the Telenor documents would require withdrawing the proceeding from the appeal stage and much re-work by the Office, which clearly runs counter to the statutorily mandated special dispatch required for reexamination proceedings. Ultimately, the improper filing of these documents was the subject of three petition decisions refusing the relief requested of entering the material directed to the authenticity of the Telenor documents. Each of these decisions were designated as final agency decisions under 5 U.S.C. § 704 and are of record in the present merged reexamination proceeding.[4]

As part of the appeal process, on April 4, 2007, patent owner filed an appeal brief containing an evidence appendix as required by 37 CFR 41.67.[5] However, patent owner was notified by the examiner on July 11, 2007 that the appeal brief and evidence appendix filed on April 4, 2007 did not comply with 37 CFR 41.67 because the appeal brief did not identify where in the record certain supplemental declarations were found. The declarations in question were not found because these were the declarations directed to the authenticity of the Telenor documents (discussed above) that had been refused entry into the record because of patent owner's failure to properly file the documents with the Office. Patent owner thereafter filed redacted versions of the appeal brief and the evidence appendix on August 7, 2007. The redacted versions of the appeal brief and evidence appendix did not argue or reference material directed to the authenticity of the Telenor documents. However, in the redacted appeal brief, patent owner argued, at pages 45-48, that the Telenor documents were not printed publications for purposes of 35 U.S.C. § 102 and that the Office had not supported its position that the Telenor documents constituted printed publications with any evidence. This line of argument was based on how issues directed to the cataloguing and indexing of the Telenor documents at the NTNU library.[6] In the examiner's answer mailed on August 24, 2004, at pages 230-231, the examiner addressed the patent owner's arguments that the Telenor documents did not qualify as printed publications under 35 U.S.C. § 102. The examiner pointed out that the record contained an e-mail authored by one Tove Aursoy, the Coordinator of Library Catalogs at the NTNU library. In that e-mail, Aursoy explains the procedures employed at the NTNU library when the Telenor documents were received and catalogued, states that these procedures were applied to the Telenor documents, and gives the dates of receipt and cataloguing of the Telenor documents.

On October 17, 2007, prior to filing a rebuttal brief directed to the examiner's answer, patent owner again filed a petition requesting entry of the previously excluded evidence directed to the

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[3] This material was entered in other reexamination proceedings where patent owner complied with the Office's rules for submitting such documents.

[4] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[5] This appeal brief was filed because patent owner had obtained an increase in the page and word count limitations imposed on appeal briefs by 37 CFR 1.943, and replaced a previously filed appeal brief that was limited in accordance with the requirements of 37 CFR 1.943.

[6] The foundation for the patent owner's arguments begins at page 41 of the August 7, 2007 redacted appeal brief and is direct to establishing that the Telenor documents were cannot be considered printed publications due to how they were catalogued and indexed at the NTNU library, located in Trondheim, Norway.

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authenticity of the Telenor documents.[7] On October 24, 2007, patent owner filed both a rebuttal brief and a supplemental rebuttal brief together with a petition for relief from the page and word count limitations of 37 CFR 1.943.[8] The petition for relief from the page and word count limitations was granted in a decision dated November 7, 2007, and the supplemental rebuttal brief was entered into the record. However, patent owner's October 17, 2007 petition for entry of the evidence directed to the authenticity of the Telenor documents was dismissed in a separate decision dated November 7, 2007. Following dismissal of the October 17, 2007 petition, the examiner issued a Notification on November 9, 2007, informing patent owner that patent owner's supplemental rebuttal brief would not be entered into the record because, in contravention of 37 CFR 41.67, the patent owner's supplemental rebuttal brief improperly included discussions of issues not raised in the examiner's answer. Specifically, the patent owner's supplemental rebuttal brief discussed the excluded evidence directed to the authenticity of the Telenor documents, and failed to include any reference to the portion of the record containing the discussed excluded evidence directed to the authenticity of the Telenor documents.[9]

The present January 7, 2008 request for reconsideration is directed to the November 7, 2007 decision dismissing patent owner's petition for entry of the excluded evidence directed to the authenticity of the Telenor documents. It is noted that patent owner filed a redacted supplemental rebuttal brief on December 10, 2007, and concurrently filed a petition requesting supervisory review and reversal of the examiner's holding that the October 24, 2007 supplemental rebuttal brief was improper for the purpose of having the October 24, 2007 supplemental rebuttal brief reinstated into the record. The December 10, 2007 petition has been dismissed.

III. Analysis and Findings

a. Patent Owner's Position[10]

Patent owner's rationale for again requesting waiver of the rules to permit patent owner to enter into evidence the information that was previously filed to question the authenticity of the Telenor documents is essentially the same argument presented in the original October 17, 2007 petition. Patent owner renews the argument that patent owner has been prejudiced by the examiner's statement that patent owner has not proffered any evidence rebutting the statements contained in the Aursoy e-mail, which e-mail is relied upon by the examiner to establish that the Telenor documents are printed publications. In patent owner's view, the language in question is inaccurate and prejudicial because patent owner did file (*i.e.*, proffer) evidence directed to the authenticity of the Telenor documents (although such evidence has not been entered into the record). Patent owner argues that the proffer of the evidence directed to the authenticity of the Telenor documents clearly relates to the truthfulness, accuracy and reliability of the statements

[7] The Office had already issued the three different petition decisions that were each designated as final agency actions, as previously discussed.

[8] The rebuttal brief filed on October 24, 2007 is designated as being a "supplemental" rebuttal brief because it was intended to replace the concurrently filed rebuttal brief that, as filed, was limited by the page and word count limitations of 37 CFR 1.943, in the event that the concurrently filed petition was granted.

[9] See 37 CFR 41.67(a)(vii) and (c)(1)(vii).

[10] This section of the decision is intended to summarize the eight pages of arguments presented patent owner on pages 9-16 of the present request for reconsideration. The failure to specifically list or reproduce a particular argument is not to be taken as an indication that such argument was not fully and carefully considered. Rather, it is the main thrust of patent owner's argument that is set forth in this section.

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contained in the e-mail authored by Tove Aursoy, which is relied upon by the examiner to establish that the Telenor documents are printed publications. Patent owner further urges that the proffer of the evidence directed to the authenticity of the Telenor documents demonstrates that Aursoy cannot show that the Telenor documents submitted to the NTNU library, where they were received and catalogued, are the same documents relied upon by the Office as "prior art." Accordingly, patent owner argues that one must not give additional weight to the Aursoy statements, as the examiner has done, based upon the examiner's determination that the patent owner has not submitted evidence contesting the Aursoy statement. Patent owner believes that the statements in the Aursoy e-mail are "not the least bit probative of the publication date of the Telenor 'art' if the documents relied on by the PTO's (*sic*, PTO) are not the same as those catalogued in the NTNU library in 1986 and 1989."[11]

Patent owner further argues in the present request for reconsideration that the certain statements in the examiner's answer such as "[A]ppellant was free to investigate alleged hearsay assertions during the prosecution" but did not present evidence directed to the Aursoy hearsay statement are unfair and prejudicial statements. Patent owner takes the position that the evidence directed to the authenticity of the Telenor documents constitutes evidence directed to the Aursoy hearsay statement. In particular, patent owner argues that the following statement in the examiner's answer is unfair and prejudicial:

> "For example, the Aursoy statements were introduced into the record of the current reexamination proceeding on January 10, 2006, over a year before the mailing date of this Office Action, with the Appellant have had an opportunity to investigate said alleged hearsay assertions and present rebutting evidence, even in the form of declarations and affidavits. 37 § 1.116(e) (*sic*, 37 CFR 1.116(e)). Epstein[12] also indicated that the truthfulness of the assertions in the alleged hearsay documents can be assumed when the documents appear on their face to be accurate and reliable and ***Appellant fails to proffer any evidence to support arguments to the contrary.*** Id. at 1566. Here there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. ***Furthermore, Appellants has not proffered evidence to support arguments to the contrary.***[13] [Emphasis that includes italics and bold font supplied by patent owner.]

Patent owner also argues the evidence relating to the authenticity of the Telenor documents, excluded as a result of patent owner's failure to properly and timely submit it, should now be entered, even after prosecution in the present merged proceeding has progressed to the point where a rebuttal brief directed to an examiner's answer has been filed, because such entry would allegedly not delay or impede the ability of the Office to conduct the prosecution of the present merged proceeding with special dispatch. Patent owner relies on the Office's entry of the evidence in question into reexamination proceedings for related patents, and the relatively

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[11] "Petition ... to Reconsider The November 7, 2007 Decision ..." at pages 15-16.

[12] The examiner's reference is to *In re Epstein*, 32 F.3d 1559 (Fed. Cir. 1994)

[13] It is to be noted that what the examiner is stating here is that there is nothing about the Aursoy statement itself that suggests that the statements in the **Aursoy e-mail relating to the receipt and cataloging of the Telenor documents in the NTNU library is inaccurate or has been itself altered in any way.** This statement was made by the examiner in the context of establishing that the Aursoy e-mail is reliable, notwithstanding that it is not a verified statement and may be criticized as being "hearsay." This statement in the examiner's answer was not directed or related to evidence of alteration of the Telenor documents or the lack of a proffer of evidence directed to any allegations of such alternation; neither could it have been properly so directed inasmuch as the record is devoid of any evidence going to the issue of alteration of the Telenor documents.

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contemporaneously completed examiner's answers in those related proceedings for support of this position.

Patent owner additionally argues that patent owner was promised by the Office that evidence and information submitted in one reexamination proceeding would be considered in all reexamination proceedings. Patent owner continues to rely on the Declaration of Carl Brundidge that was attached to the October 17, 2007 petition to support this argument. Patent owner also states that, despite patent owner's failure to file the evidence in compliance with the Office's rules, it is fundamentally unfair to exclude from the record, and from patent owner's brief, any reference to the irregularity of the Telenor documents, and then to take advantage of the absence of such evidence in the record to argue that the evidence was not proffered in the first place.

b. Timeliness Considerations

On February 1, 2006, the Office mailed an Action Closing Prosecution (ACP) in the present merged *inter partes* reexamination proceeding. Patent owner timely filed comments directed to the ACP under the 37 CFR 1.951, which provides, *inter alia* that a patent owner may once file comments after an ACP. However, on May 12, 2006, patent owner filed additional material addressed to the ACP, together with a petition requesting waiver of 37 CFR 1.951 to permit entry of that additional material into the Image File Wrapper (IFW) record of the present merged *inter partes* reexamination proceeding. The May 12, 2006 submission included supplemental comments, copies of materials obtained as a result of the FOIA request, and also a number of verified statements directed to the issue of the authenticity of the Telenor documents. In a decision dated September 13, 2006, the Office dismissed the petition for the relief requested by patent owner in the May 12, 2006 petition. Entry of the May 12, 2006 papers was refused in a decision dated September 13, 2006. Entry was refused because the material for which entry into the file of the present merged *inter partes* reexamination proceeding was requested was not limited to addressing the ACP or the merits of the present merged *inter partes* reexamination proceeding. Rather, material related to alleged misconduct was co-mingled with material directed to the merits of the present merged *inter partes* reexamination proceeding (including the issue of the authenticity of the Telenor documents). The refusal to enter the material submitted on May 12, 2006, was without prejudice to patent owner obtaining entry of the merits directed material and consideration of the material directed to the alleged misconduct if the former was submitted to the file of the present merged proceeding and the latter was submitted separately submitted to so that it would be maintained separate from the record of the merged *inter partes* reexamination proceeding while it was being considered. Patent owner was expressly so informed.[14]

Patent owner took no further action regarding the refusal to enter the material directed to the authenticity of the Telenor documents until January 3, 2007, when patent owner again submitted a petition to waive the regulations and enter supplemental material after the ACP. However, the Office's September 13, 2006 decision on the May 12, 2006 petition put patent owner on notice, pursuant to 37 CFR 1.181(f), that entry of the material directed to the authenticity of the Telenor documents would not be granted due to the co-mingling of FOIA material and material directed to the authenticity of the Telenor documents. The Office's September 13, 2006 decision also clearly invited patent owner to submit the material directed to the authenticity of the Telenor documents

[14] "Decision Dismissing Petition and, Sua Sponte, 'Returning' Improper Papers," September 13, 2006, page 5, first full paragraph

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without co-mingling it with additional nonenterable FOIA material. The September 13, 2006 decision constituted "action or notice from which relief is requested" under 37 CFR 1.181(f). And, 37 CFR 1.181(f) provides that "[A]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided." Moreover, the regulation provides that "[T]his two-month period is not extendable." However, patent owner did not file a request for relief to obtain entry of the Telenor material within two months from the September 13, 2006 action or notice as required by the 37 CFR 1.181(f), but instead delayed such filing until almost four months from September 13, 2006, thereby permitting prosecution to continue resulting in the issuance of a RAN on December 12, 2006. Pursuant to 37 CFR 1.953(c), "no amendment can be made in response to the Right of Appeal Notice." Patent owner provided no reason for the delay in submitting material that would amend the record of the present merged proceeding until after the RAN was issued. Accordingly, the Telenor material, which constituted an amendment to the record, was denied entry. Patent owner filed other petitions to obtain entry of the Telenor material in which no reason was provided for the delay in filing the Telenor material until after the RAN was issued, and these too were denied entry.

The present merged proceeding had progressed to the point where nothing else remained other than that the Board of Patent Appeals and Interferences (BPAI's) render its decision. Yet, notwithstanding that patent owner had been advised how to seasonably and correctly submit the material directed to the authenticity of the Telenor documents, but had failed to do so, and notwithstanding that the Office has previously rendered three final agency actions pursuant to 5 U.S.C. § 704 that afford patent owner the opportunity to seek judicial review of the refusal to enter such material into the record of the present merged proceeding, and notwithstanding that 37 CFR 41.63 expressly provides that "[a]ffidavits 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), patent owner has filed yet another petition to obtain entry of that material. The filing of the petition itself necessitated that the Board of Patent Appeals and Interferences relinquish jurisdiction and remand the proceeding for consideration of the present petition. Even beyond the delay in this proceeding introduced by the necessity of the remand, it is apparent that if the previously excluded material directed to the authenticity of the Telenor documents for which entry is requested were entered into the record at this point, in contravention to 37 CFR 41.63, the present merged reexamination proceeding would have to be reopened and the proceeding would no longer be at the appeal stage, ready for the BPAI's decision. The Telenor documents were first filed on September 28, 2005, and entry of the evidence in accordance with the relief presently requested by patent owner would have the effect of negating the prosecution that occurred subsequent to September 28, 2005. The material directed to the authenticity of the Telenor documents was not timely presented, and waiver of the any rule(s) necessary to permit entry of the such material would, therefore, have a significant effect in retarding the statutorily mandated "special dispatch" in reexamination.

c. The Patent Owner's Position For Requesting Entry and Consideration of the Evidence Directed to the Authenticity of the Telenor Documents Is Wholly Unpersuasive

(1) Evidence Directed To The Technical Content Of The Telenor Documents Is **Not** Evidence That Is Directed To The Statements In The Aursoy E-mail, Because The E-mail Does Not Address The Content Of The Telenor Documents

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A review of the record of this proceeding, including the examiner's answer, particularly at pages 230-231, and of the Aursoy document itself,[15] shows that patent owner's position that the proffer of the evidence directed to the authenticity of the Telenor documents constitutes evidence rebutting the statements in the Aursoy e-mail is not well taken. The fundamental flaw in patent owner's position is that it is based upon a co-mingling and confusion of two distinct issues. One issue is **whether the unverified statements in the Aursoy e-mail are reliable statements regarding the receipt and cataloguing of the Telenor documents at the NTNU library, and regarding certain library procedures.** If the statements in the Aursoy e-mail are reliable, then such statements would support the proposition that the Telenor documents *prima facie* constitute printed publications as of a particular date, in accordance with 35 U.S.C. § 102 and the case law that interprets the meaning of "printed publication." The second issue is **whether the technical teachings contained in the Telenor documents have been altered after the date of receipt and cataloguing, so that the Telenor documents can not be applied as of the *prima facie* publication date to questions of the novelty and non-obviousness pursuant 35 U.S.C. §§ 102 and 103 because the Telenor documents did not contain those technical teachings as of the *prima facie* publication date.** The two issues are wholly distinct and separate from each other, and it is to the second issue that the excluded material proffered by patent owner was directed, not to the first issue. And it is to be noted that the examiner has not raised an issue of whether the Telenor documents were altered. Such issue would be patent owner's to raise, since the content of a printed publication is presumably accurate. Patent owner was entitled to raise that issue, but was not entitled to do so in a manner that contravened the rules, for the reasons set forth in the three final agency actions dated March 15, 2007, March 30, 2007 and July 2, 2007, respectively.

Pages 230-231 of the examiner's answer dated August 24, 2007, include a section entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported by Evidence." In that section, the examiner relied upon the statements in the Aursoy e-mail to address the patent owner's argument at pages 45-48 of the amended appellant brief to the effect that the Telenor documents are not printed publications under 35 U.S.C. § 102(b). The examiner addressed that argument by pointing out that the Aursoy e-mail is evidence of (1) the receipt dates for various ones of the Telenor documents at the NTNU library in Trondheim Norway, and (2) the date on which the Telenor documents were cataloged at that library.[16] The examiner found that, based upon the dates of receipt and cataloguing, the Telenor documents qualified as printed publications under 35 U.S.C. § 102(b) and as prior art to the claims at bar. The examiner further found that, to the extent that patent owner had characterized the statements in the Aursoy e-mail as being unreliable hearsay, the patent owner had not proffered evidence **that the statements in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents** were facially inaccurate and unreliable. The examiner noted that, although patent owner was free to investigate the truth of **the statements in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents**, the record does not contain any evidence submitted by patent owner directed to showing that **the statements in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents** were inaccurate or untrue. The examiner concluded that, on the record and in light of certain case law,[17] that **the statements contained in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents**, must be accepted as accurate, reliable and true, even if such statements are deemed

[15] The Aursoy e-mail was entered into the record as part of the third party requester comments pursuant to 37 CFR § 1.947 on January 10, 2006.
[16] The Telenor documents include eight volumes, and the volumes include various dates.
[17] See page 8, *supra*, and footnote 12.

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to be hearsay. The statements in the Aursoy e-mail that are deemed by the examiner to be facially accurate and true are not statements directed to **the technical content of the Telenor documents**. There are no statements whatsoever in the Aursoy e-mail pertaining to **the technical content of those documents**. The examiner then proceeding to rely upon the technical content of the Telenor documents, there being no evidence in the record that such content was inaccurate and/or not effective prior art as of the date afforded to the Telenor documents by reason of it being a dated publication that was indexed and available in the NTNU library.

Thus, it is clear that the argument presented by patent owner co-mingles and confuses (a) **the issue of whether an unverified statement that a document was received on a given date and then catalogued is truthful, accurate and reliable**, with (b) **the issue of whether the technical content of that document is, or is not, authentic**. It is for that reason that patent owner's position is untenable. The two issues are wholly different issues, and there is simply no nexus between the two issues. In the present merged reexamination proceeding, the portion of the examiner's answer that is complained of is directed to issue (a), which is the issue that was raised by patent owner at pages 45-48 of the appellant's brief in a section entitled "The Office's Allegation that the Telenor Documents are Printed Publications is not Supported by any Evidence." Perforce, the examiner was required to respond to that issue.[18]

Patent owner's prior proffers of evidence going to the authenticity of the Telenor documents, (*i.e.*, the filing of verified statements **directed to the issue of whether the content of the Telenor documents had been (subsequently) altered so as to change the technical teachings thereof)** were not equivalent to an attempt by patent owner to contest the accuracy and reliability of the content of the Aursoy e-mail, which document is confined to receipt and cataloguing of the Telenor documents (and certain other library procedures), and thus, **had nothing to do with the alterations argued to be established by the excluded evidence.**

(2) Patent Owner Has Not Been Prejudiced By Statements In The Examiner' Answer Regarding The Failure Of Patent Owner To Submit Evidence Contravening The Statements In The Aursoy E-Mail

Patent owner filed a paper on March 1, 2006 entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951." That paper did include **comments** that are directed to the truthfulness of the Aursoy e-mail statement, and such comments are of record.[19] However, comments are not evidence and cannot take the place of evidence in the record. Moreover, the comments were limited to an allegation that the Aursoy e-mail was simply hearsay. Patent owner has argued that the examiner made prejudicial comments by stating that patent owner has not submitted evidence directed to rebutting the statements contained in the Aursoy email. However, patent owner has not pointed to any paper in which patent owner submitted evidence (as opposed to comments/arguments) **that is specific to the issue of the truthfulness of the allegedly hearsay statements in the Aursoy statement**. Thus, it does not appear that the examiner's position as quoted, for example, on page 8, *infra*, is technically inaccurate with respect to the failure of patent owner to proffer "evidence" directed to rebutting the Aursoy e-mail statement. To the extent that patent owner believes patent owner's comments/arguments (that the Aursoy e-mail was hearsay) are encompassed by the language at pages 230-231 of the examiner's answer as being "evidence," it is found that no reasonable person could be prejudiced by the examiner's position that patent owner has not proffered "evidence" directed to

[18] See: 37 CFR 41.69(a).
[19] See subsection XI.A., pages 10-11.

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rebuttal of the statements in the Aursoy email, since the record clearly shows that patent owner in fact submitted such comments. Further, as has been found in section (b)(1) above, the proffered evidence that was excluded as to the Telenor reference evidence was not directed to the Aursoy e-mail statement; thus, the examiner's position that patent owner did not submit "evidence" directed to the statements set forth in the Aursoy email was also not prejudicial to patent owner. It should be noted that patent owner was free to point out in the rebuttal brief where evidence **directed to the Aursoy e-mail statement** was proffered; this patent owner did not do in the rebuttal brief, nor in the present petition. In view of the above, petitioner patent owner has not demonstrated that patent owner has been prejudiced by the language at pages 230-231 of the examiner's answer so as to warrant entry of any excluded **evidence**, as there was directed to the truthfulness of the statements contained in the Aursoy e-mail.

It is also pointed out that the evidence excluded from the record (for the reasons set forth in the decisions listed in "footnote 4" includes (1) a verified statement by a documents expert that does not specifically address the Aursoy statement, and (2) verified statements by a number of individuals that pertain to the chain of custody of the material that patent owner submitted to the documents expert for examination. The excluded evidence proffered by patent owner does include a verified statement establishing that the NTNU library was visited by the author of the verified statement, and that certain inquiries on behalf of patent owner were made. However, it appears that those inquiries were directed to ascertaining the "checkout history" of documents, and the procedures utilized in the library, (if any), for ascertaining whether materials returned to the library were returned in the same condition in which they had been checked out was also made. Patent owner has not argued that the declarant stated that any inquiry was made with respect to **the initial receipt and cataloguing of documents, or whether the content of such documents was "checked" for authenticity at the time of receipt and cataloguing**. Therefore, entry of the excluded evidence directed to the authenticity of the Telenor documents could not address the truth, accuracy or reliability of the statements in the Aursoy e-mail, which statements are limited to the receipt and cataloguing of documents, (and to certain library procedures), that do not involve ascertaining whether materials are returned to the library in the same condition in which they had been checked out.

Instead, the excluded evidence was proffered to establish patent owner's theory that the Telenor documents relied upon by the Office were altered subsequent to their receipt at the library, something that is not the subject of the statements set forth in the Aursoy e-mail. Whether such evidence may be relevant is not at issue in this merged reexamination proceeding, as it has been excluded from the record of the present merged reexamination proceeding because patent owner failed to submit such evidence in accordance with Office's rules, as clearly set forth in prior discussed three final agency decisions. Entry at this point would severely "back-up" the proceeding and clearly run counter to the statutory mandate for "special dispatch" as discussed below.[20] That the record does not contain such evidence, (a circumstance which may be prejudicial to patent owner because patent owner's theory that the technical content of the Telenor printed publications was somehow altered after the date of the invention claimed in the presently reexamined patent is not supported in the present record by anything other than argument), any prejudice to patent owner as a result of the absence of such evidence from the present record is solely due to patent owner's failure to comply with the regulations when filing such evidence, **even after having been notified of how to submit such evidence within the requirements of the regulations, and having been given a period of time in which to do so**. A prior art printed publication is evidence for that which it teaches, and in the absence of evidence

[20] See the decisions cited in footnote 4.

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that a teaching in a printed publication is not prior art at as of a given date, the examiner is constrained to apply the printed publication as prior art. That such is the present state of the record is not something that occurred because the examiner has stated that patent owner failed to proffer any evidence **to rebut the statements in the Aursoy e-mail.**

(3) Entry of the Excluded Evidence Directed to the Authenticity of the Telenor Documents Would Impede the Statutory Requirement That This Merged Proceeding be Conducted with Special Dispatch

Patent owner has taken issue with the Office's position that admission of the evidence directed to the authenticity of the Telenor documents into the record of this merged reexamination proceeding would have impeded the treatment of the proceeding with special dispatch as required by the reexamination statute. Patent owner's position is equally unpersuasive with respect to this issue. Given that the Office promulgated three final agency decisions refusing to enter that evidence, that the earliest such decision was mailed on March 15, 2007, that patent owner did not resort to the Federal District Court for relief, and the proceeding has now progressed to the point where nothing else remains other than for the Board of Patent Appeals and Interferences (BPAI's) to render a decision, patent owner is not well placed in equity to request that the prosecution of the merged proceeding be reopened, especially since patent owner's own failure to timely comply with directions on how to submit the evidence directed to the authenticity of the Telenor documents is the reason why such evidence remains excluded from the present record. Patent owner urges that consideration of the evidence directed to the authenticity of the Telenor documents would not impede special dispatch, as evidenced by the fact that, in other concurrently conducted reexamination proceedings, such evidence has been entered. However, those other proceedings did not have examiner's answers completed; they were at earlier stages when the evidence directed to the authenticity of the Telenor documents was properly submitted. This proceeding is significantly older and farther advanced than the other proceedings. Further, the Telenor documents were entered into the record September 28, 2005, and submission of the patent owner's evidence submitted on the authenticity of the Telenor documents was not proposed by patent owner until May 12, 2006. Entry of the evidence in accordance with the relief presently requested by patent owner would have the effect of negating the prosecution that occurred subsequent September 28, 2005. Thus, the present merged reexamination proceeding would no longer be at the appeal stage, ready for the BPAI's decision.

(4) The Brundidge Declaration Does Not Mandate The Requested Relief

The Brundidge declaration referenced at page 14, footnote 4, of the present petition for reconsideration was originally attached to the October 17, 2007 petition. The Brundidge declaration relates to a position allegedly expressed to declarant by Ms. Lissi Marquis (the Director of the Central Reexamination Unit) and Mr. Mark Reinhart (a Special Program Examiner in the Central Reexamination Unit).[17] This declaration was considered in the November 7, 2007 decision dismissing that petition. Nevertheless, the Brundidge declaration has again been considered. The Brundidge declaration is, however, still deemed to fail to justify granting the relief requested by petitioner patent owner.

[17] Declarant states, at page 2 of the declaration, that "[M]r. Reinhart and Ms. Marquis assured us that - - in the interest of fairness and for complete resolution of the issues - - evidence submitted in a particular proceeding would be considered in all reexamination proceedings."

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Initially, it is to be noted that oral statements made with respect to a reexamination proceeding are not given effect.[18] However, even assuming that the Office would give effect to the oral statement attributed to Ms. Marquis and Mr. Reinhart, that statement cannot be applied to help petitioner patent owner in this proceeding. In the context of the overall circumstances in which multiple related patents owned by patent owner were being reexamined in a plurality of reexamination proceedings (each directed to one of the patents), the statement attributed by declarant to Ms. Marquis and Mr. Mark Reinhart cannot be taken to mean that evidence properly submitted and entered in one of the given reexamination proceedings would be entered into the record of another reexamination proceeding **notwithstanding the failure of patent owner to file the evidence in that other proceeding in accordance with the applicable regulations of the Office**. Also, the alleged position attributed to Ms. Marquis and Mr. Reinhart cannot be taken to apply to **comments in the nature of argument (as opposed to evidence), particularly if such comments are untimely filed**. In this instance, patent owner's March 1, 2006 comments regarding the truthfulness of the Aursoy e-mail statement have in fact already been entered into the record. Patent owner has not explained what **other** comments or evidence **on that specific issue** have previously been proffered and excluded from the record, why patent owner is entitled to have any such excluded comments entered, or why presentation of new comments/evidence **on that specific issue** should be entered at this late point in the merged reexamination proceeding.

In summary, it appears to be the fact that the proffer of evidence directed to the authenticity of the Telenor documents was repeatedly defective and no proper submission of the proffered evidence was timely submitted. The result is that such evidence has not been entered into the record. Patent owner has not persuasively established why it should be permitted to recover from the effects of patent owner's own failure to have that evidence entered into the record and severely back-up the proceeding, by arguing prejudice based upon the examiner's characterization of why the record does not contain evidence directed to the entirely different issue of the truthfulness of the Aursoy statement. There is, in fact, no **evidence** in the record (as opposed to comments in the nature of argument) that **specifically** bears upon the truthfulness of the allegedly hearsay statements in the Aursoy e-mail. The examiner's characterization of why evidence on the issue of the authenticity of the technical teachings in the Telenor documents is absent from the record is irrelevant to the entry of the evidence it seeks to have entered via this petition, especially inasmuch as petitioner patent owner was given multiple opportunities to present such evidence in a manner that was both compliant with the regulations and timely. Petitioner patent owner has not established any basis for holding that patent owner's appeal in this proceeding has been prejudiced by **any** actions of the examiner or of the Office as a whole. Accordingly, there is no basis upon which to grant the requested relief.

CONCLUSION

1. The January 7, 2008 patent owner Petition for Reconsideration is granted to the extent that the October 17, 2007 Decision Dismissing Petition has been fully reconsidered, both procedurally and on its merits.

[18] 37 CFR 1.2 provides that "[a]ll business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

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2. The January 7, 2008 patent owner Petition for Reconsideration is denied with respect to disturbing the holding of the October 17, 2007 Petition Dismissing Petition and with respect to the underlying relief requested by patent owner.

3. Jurisdiction of the merged reexamination proceeding is being forwarded to the Central Reexamination Unit for appropriate action on the March 31, 2008 patent owner petition.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

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June 19, 2008

June 19, 2008
C:\Kiva\Kimpropa\SO\95_020 6495 181-182-183_ Recon of Entry Refusal_Telenor evidence-not authentic_on appeal

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Paper No. 17

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1900 Market Street
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(For Third Party Requester)

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6900 Jericho Turnpike
Syosset, NY 11791

(For Patent Owner)

MAILED
JUN 17 2004
REEXAM UNIT

In re Chang	:	
Inter Partes Reexamination Proceeding	:	DECISION ON REQUEST FOR
Control No. 95/000,023	:	RECONSIDERATION OF
Filed: July 17, 2003	:	NOTICE OF DEFECTIVE PAPER
For: U.S. Patent No. 6,354,304	:	

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration (OPLA) regarding a request for reconsideration of a notice of defective paper filed by the third party requester on March 15, 2004, requesting the Director to hold that the comments filed by requester on January 8, 2004, were filed within 30 days of the certificate of service of the patent owner's response to the examiner's Office action.

For the reasons set forth below, the comments filed by the third party requester in response to patent owner's reply to the Office action of October 28, 2003, are held to be timely filed.

BACKGROUND

1. On July 17, 2003, a request for *inter partes* reexamination of U.S. Patent No. 6,354,304 patent was filed by a third party requester.

2. On October 28, 2003, reexamination was ordered. On the same date, the first Office action on the merits was mailed.

3. On December 8, 2003, patent owner filed a response to the Office action. Attached to the response is a certificate of service stating that a true copy of the response was deposited in the first-class mail on December 8, 2003. The certificate is signed by James P. Doyle, attorney for patent owner and patentee.

4. On January 8, 2004, requester filed comments on patent owner's response. The comments were filed 31 days after the noted certificate of service. The statute requires any comments be received in the Office within 30 days of the certificate of service.

5. On March 8, 2004, a "Notice Re Defective Paper in Inter Partes Reexamination" was mailed to the third party requester noting that the comments filed in reply to patent owner's response was not timely submitted. Requester was informed that the comments were filed 31 days after the service of copy date, and accordingly were filed one-day late and would not be considered by the examiner.

6. On March 15, 2004, requester filed a request for reconsideration of the notice of defective paper. On March 17, 2004, a supplemental request for reconsideration was filed containing attachments inadvertently omitted from the March 15 copy of the request for reconsideration. Requester argues that the comments were timely filed because they were filed within 30 days of the date of service of patent owner's response. Requester argues the papers were not served until December 12, 2003, when it was actually received by requester because no copy received by requester contained a "signed" certificate of service as required by the rules.

7. On March 17, 2004, patent owner filed an opposition to the request for reconsideration arguing that the comments are late because there is no requirement that proof of service appear on the paper served. Patent owner argues that "A party on whom a paper has been served does not require certification that it has been served, because the best possible proof of service -- the signed and dated paper and the post-marked envelope -- is in the served party's hands."

8. On April 12, 2004, requester filed a reply to patent owner's opposition. Requester argues that patent owner's argument that the served party does not need a complete copy of what was filed because of the post-mark is incorrect and that where there is no signed certificate of service, the recipient is to consider the actual date of receipt as the effective date for purposes of calculating the due date for the response.

DECISION

Under 37 CFR 1.903:

> "... After filing of a request for inter partes reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party to the reexamination proceeding in the manner provided in §1.248... ." (Emphasis added).

Under 37 CFR 1.248(b):

> "(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed." (Emphasis added).

The rules provide that any "document" filed by either party must include proof of service appearing on or be affixed to the "papers filed." The only fair reading of the rules requires that a true copy of the document filed be served on the other party so that each party's file contains the same copy of the document that is in the official file (which in the instant case includes a signed certificate of service). Accordingly, absent the signed certificate of service, the paper served was not the "document" filed in the Office.

Under 37 CFR 1.248(a)(1):

> "(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:
>
> (1) By delivering a copy of the paper to the person served."

37 CFR 1.248(b)(1)-(2) further provides:

> "(b) ... Proof of service may be made by:
>
> (1) An acknowledgment of service by or on behalf of the person served or
>
> (2) A statement signed by the attorney or agent containing the information required by this section."

As noted above, the copy received by requester was not signed. Petitioner, however, avers that a copy of the response filed by patent owner was received on December 12, 2003. Accordingly, patent owner's response is held to have been served (delivered) on requester on December 12, 2003. Any comment by requester on patent owner's response would be due within 30 days, or January 11, 2004. Therefore, requester's comments filed January 8, 2004, were timely filed.

In view of the above, the request for reconsideration is granted. The comments filed on January 8, 2004, have been accepted and will be considered by the examiner.

CONCLUSION

1. The third party requester request for reconsideration filed March 15, 2004, is granted.

2. The comments filed on January 8, 2004, has been accepted, and will be entered.

3. Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610.

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,025	08/04/2003	6293319	956-112(183313)	8475

24573 7590 10/31/2007
BELL, BOYD & LLOYD, LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/31/2007

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

REEXAMINATION CONTROL NUMBER *95/000,025*.

PATENT NUMBER *6,293,319*.

TECHNOLOGY CENTER *OPLA*.

ART UNIT *3771*.

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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MAILED
OCT 31 2007
CENTRAL REEXAMINATION UNIT

In re Phil Trigiani :
Inter Partes Reexamination Proceeding : **DECISION ON**
Control No. 95/000,025 : **PETITION**
Filed: August 4, 2003 :
For: U.S. Patent No. 6,293,319 :

This is a decision addressing the June 19, 2007 petition filed by the patent owner entitled "Petition to Reopen Prosecution," which is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 41.68(b)(1)(viii) (hereinafter, "the June 19, 2007 patent owner petition").

This decision also addresses the July 18, 2007 opposition to the June 19, 2007 patent owner petition, filed by the third party requester (hereinafter, "the July 18, 2007 third party requester opposition").

The June 19, 2007 patent owner petition, the July 18, 2007 third party requester opposition, and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The June 19, 2007 patent owner petition is **granted in part**. Specifically, the patent owner's May 11, 2007 respondent brief, including the unredacted versions of the August 19, 2004 exhibits A and B, **will be entered and will be considered on the merits**.

The June 19, 2007 patent owner petition is **dismissed in part**. Specifically, the supplemental Trigiani declaration and accompanying exhibits filed on June 19, 2007, **will not be entered.** The supplemental Trigiani declaration and accompanying exhibits filed on June 19, 2007 **will remain in the file, but will not be treated on the merits.**

In addition, this decision notifies the patent owner that the undesignated color document entitled "The Ultimate In Ultraviolet Leak Protection" by UView Ultraviolet Systems, Inc., which was submitted with the Trigiani declaration, will not be entered, will remain in the artifact file, and will not be addressed on the merits.

REVIEW OF FACTS

- On September 25, 2001, U.S. Patent No. 6,293,319 (the '319 patent) issued to Phil Trigiani.

- On August 4, 2003, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,025 (the '025 proceeding).

- On October 15, 2003, an order granting the reexamination request was mailed.

- On December 9, 2003, U.S. Reissue Patent No. 38,342 (for reissue of the '319 patent) issued to Phil Trigiani.

- On March 9, 2004, a notice was mailed, requiring the patent owner to submit an amendment pursuant to MPEP 2686.03 II A, replacing the existing claims with a clean copy of the claims as reissued in reissue patent no. RE 38,342.

- On April 12, 2004, the patent owner filed an amendment in response to the March 9, 2004 notice, accompanied by a certificate of mailing dated April 9, 2004. A certificate of service was not received.

- On April 15, 2004, the patent owner filed a duplicate of the April 12, 2004 amendment, accompanied by a certificate of service indicating that the April 12, 2004 amendment was served on the third party requester on April 15, 2004.

- On June 16, 2004, a first Office action on the merits was mailed.

- On August 19, 2004, the patent owner filed a response to the June 16, 2004 Office action, accompanied by attachments including a declaration under 37 CFR 1.131 of Phil Trigiani with supporting exhibits (hereinafter, "the August 19, 2004 Trigiani declaration".) A certificate of mailing dated August 11, 2004, and a certificate of service indicating that the August 19, 2004 patent owner response with attachments was served on the third party requester on August 11, 2004, were also received.

- On September 13, 2004, the third party requester filed written comments, with an attachment, directed to the June 16, 2004 Office action and the patent owner's August 19, 2004 response to that Office action. A certificate of mailing dated September 9, 2004, and a certificate of service indicating that the September 13, 2004 third party requester comments with attachment were served on the patent owner on September 9, 2004, were also received.

- On September 15, 2005, an action closing prosecution was mailed.

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[1] The request for *inter partes* reexamination identified Spectronics Corporation as the real party in interest.

- On January 24, 2007, a right of appeal notice was mailed.
- On February 14, 2007, the third party requester filed a notice of appeal.
- On April 16, 2007, the third party requester filed an appellant brief with appendices,[2] accompanied by a certificate of mailing dated April 12, 2007, and a certificate of service indicating that the April 16, 2007 appellant brief and appendices were served on the patent owner on April 12, 2007.
- On May 11, 2007, the patent owner filed a respondent brief with appendices.
- On June 19, 2007, the patent owner filed the instant petition entitled "Petition to Reopen Prosecution" (the June 19, 2007 patent owner petition), accompanied by a supplemental declaration entitled "Supplemental Declaration of Phil Trigiani under 37 C.F.R. §§ 1.131 and 1.132," with supporting exhibits[3] (hereinafter, "the supplemental Trigiani declaration".)
- On July 18, 2007, the third party requester filed an opposition to the June 19, 2007 patent owner petition, entitled "Third Party Requester's Response to Patent Owner's Petition to Reopen Prosecution" (the July 18, 2007 third party requester opposition.)

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[2] Color versions of prior art documents were submitted by the third party requester with the appellant brief filed on April 16, 2007, and have been placed in an artifact file pursuant to MPEP 2618. Black and white versions of these prior art documents appear to also have been submitted. The black and white versions of these documents have been scanned into the Office's Image File Wrapper (IFW) system and have been made part of the official record. **The Office takes this opportunity to notify the parties that, while color versions of prior art may be placed in an artifact file pursuant to MPEP 2618, artifact files are not easily available to the examiner, the Board, or the public. For this reason, color versions of prior art documents should only be submitted when absolutely necessary, such as when it is not possible to submit the prior art documents in a black and white format that is capable of being scanned into the Office's IFW system.**

[3] The patent owner states that the exhibits accompanying the supplemental Trigiani declaration, which was filed with the June 19, 2007 patent owner petition, include "unredacted versions of Trigiani Exhibits A and B [the August 19, 2004 exhibits A and B] as Exhibits Q and R." See page 2 of the June 19, 2007 patent owner petition. Exhibits Q and R, however, bear no resemblance either to the originally-filed, redacted versions of the August 19, 2004 exhibits A and B, or to the unredacted versions of these exhibits, which were filed with patent owner's May 11, 2007 respondent brief. Exhibits Q and R appear to be entirely different exhibits. Furthermore, the supplemental Trigiani declaration also refers to "exhibit P." Office records fail to reveal, however, that an "exhibit P" was received. Finally, an undesignated color document entitled "The Ultimate In Ultraviolet Leak Protection" by UView Ultraviolet Systems, Inc., was received by the Office on June 19, 2007 and placed in an artifact file pursuant to MPEP 2618. Artifact files, however, are not easily available to either the examiner or the Board (see footnote 2 above). Furthermore, because the processing of artifact files occurs separately from the Office's procedure for scanning documents, errors may occur in processing documents or other evidence placed in an artifact file. For these reasons, the parties are reminded that **color versions of prior art documents should only be submitted when absolutely necessary, such as when it is not possible to submit the prior art documents in a black and white format that is capable of being scanned into the Office's IFW system.** In any event, however, the supplemental Trigiani declaration with supporting exhibits, as well as this artifact file containing the undesignated color document, will not be entered into the official file as stated in this decision.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

(b) RESPONSE. —

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner 's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner 's response.

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

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.

37 CFR 1.248 provides:

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served with someone in his employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;

(5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the Official Gazette.

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:

(1) An acknowledgement of service by or on behalf of the person served or

(2) A statement signed by the attorney or agent containing the information required by this section.

(c) See § 41.106(e) of this title for service of papers in contested cases before the Board of Patent Appeals and Interferences.

37 CFR 1.903 provides, in pertinent part:

The patent owner and the third party requester will be sent copies of Office actions issued during the inter partes reexamination proceeding. After filing of a request for inter partes reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

37 CFR 1.937(b) provides:

The inter partes reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.939(a) provides, in pertinent part:

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.

37 CFR 1.945 provides:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 41.63(c) provides:

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 41.64(a) provides:

Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

MPEP 41.68(b)(1)(viii) provides, in pertinent part (emphasis added):

Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. **Reference to unentered evidence is not permitted in the respondent's brief.** See § 41.63 for treatment of evidence submitted after appeal.

37 CFR 41.77(b) provides, in pertinent part (emphasis added):

> . . . **When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options** with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:
>
> (1) Reopen prosecution. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both . . .

MPEP 715.07 II provides, in pertinent part:

> If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration. When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided . . .

MPEP 2618 provides, in pertinent part:

> If the copy provided is not legible, or is such that its image scanned into the Image File Wrapper system (IFW) will not be legible, it is deemed to not have been provided. An exception is color photographs and like color submissions, which, if legible as presented, will be retained in an "artifact" file and used as such.

MPEP 2667 I B 3 provides, in pertinent part:

> Third party comments in response to a patent owner submission which does not respond to an Office action are not permitted, since 37 CFR 1.947 only permits comments in response to the patent owner's response to an Office action. For example, where the patent owner submits a new power of attorney, the third party requester is not permitted to submit a set of comments, because the patent owner submission is not a response to an Office action. If the third party requester does comment, it will be returned.

DECISION

The June 19, 2007 Patent Owner Petition and the July 18, 2007 Third Party Requester Opposition

<u>The June 19, 2007 Patent Owner Petition is Taken as a Petition under 37 CFR 1.183 to Waive the Provisions of 37 CFR 41.63(c) and 41.68(b)(1)(viii)</u>

The patent owner requests that the '025 *inter partes* reexamination proceeding be reopened[4] to permit consideration of certain newly submitted exhibits filed with, and discussed in, the patent owner's May 11, 2007 respondent brief, and to permit consideration of a newly submitted supplemental declaration entitled "Supplemental Declaration of Phil Trigiani under 37 C.F.R. §§ 1.131 and 1.132," with supporting exhibits, which was filed on the June 19, 2007 (the supplemental Trigiani declaration).

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[4] Jurisdiction over an *inter partes* reexamination proceeding remains with the examiner until all briefs and examiner's answers have been entered, after which the proceeding is transmitted to the Board, pursuant to 37 CFR 41.64. In the '025 proceeding, jurisdiction will be returned to the examiner after the present decision, since an examiner's answer has not yet been mailed.

Affidavits or other evidence filed after the date of filing an appeal, however, will not be admitted pursuant to 37 CFR 41.63(c). Furthermore, any reference to unentered evidence in respondent's brief is prohibited by 37 CFR 41.68(b)(1)(viii). To request entry of a respondent brief that includes, and discusses, unentered evidence, and to request entry of the supplemental Trigiani declaration and exhibits, the patent owner must file a petition under 37 CFR 1.183, accompanied by the petition fee set forth in 37 CFR 1.17(f), to waive the provisions of 37 CFR 41.63(c) and 37 CFR 41.68(b)(1)(viii).

Since the June 19, 2007 patent owner petition was accompanied by an authorization for the Office to charge fees to deposit account no. 02-1818, the June 19, 2007 patent owner petition is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 41.68(b)(1)(viii). Accordingly, deposit account no. 02-1818 will be charged the $400 petition fee set forth in 37 CFR 1.17(f).

The third party requester urges that the June 19, 2007 patent owner petition is premature, because the Board has not rendered a decision in this appeal.[5] Jurisdiction over an *inter partes* reexamination proceeding resides with the examiner, however, until all briefs and examiner's answers have been entered, after which the proceeding is transmitted to the Board, pursuant to 37 CFR 41.64. In the '025 proceeding, jurisdiction resided with the examiner prior to the Office of Patent Legal Administration assuming jurisdiction for the sole purpose of this decision, and jurisdiction will be returned to the examiner, since an examiner's answer has not yet been mailed. For this reason, the filing of a 37 CFR 1.183 petition to waive the provisions of 37 CFR 41.63(c) and 41.68(b)(1)(viii) is not premature, since there is no need to await the Board's return of jurisdiction to the examiner.

Analysis

The patent owner draws attention to two of the supporting exhibits to the (initially-filed) August 19, 2004 Trigiani declaration, designated as exhibits A and B, from which certain dates were redacted pursuant to MPEP 715.07 II (hereinafter, "the August 19, 2004 exhibits A and B"). The patent owner states that, in response to arguments raised in the third party requester's April 16, 2007 appellant brief, the patent owner newly filed *unredacted* versions of the August 19, 2004 exhibits A and B with patent owner's May 11, 2007 respondent brief (in which the newly filed unredacted versions are also discussed). The patent owner apparently urges the Office to waive the provisions of 37 CFR 41.63(c) and 41.68(b)(1)(viii), and specifically urges the Office to enter into the record the unredacted versions of the August 19, 2004 exhibits A and B, which were submitted with the patent owner's May 11, 2007 respondent brief.[6]

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[5] See the paragraph bridging pages 2 and 3 of the July 18, 2007 third party requester opposition.

[6] See the first paragraph appearing on the first page of the June 19, 2007 petition, which states, in pertinent part: "Patent Owner suggests several reasons to support reopening prosecution, including: (1) to place unredacted versions of certain exhibits which were submitted with Patent Owner Respondent's Brief into the record." See also the second full paragraph of page 2 of the June 19, 2007 petition, which states, in pertinent part: ". . . Patent Owner submitted unredacted versions of Trigiani Exhibits A and B [the redacted versions were filed on August 19, 2004] along with Patent Owner Respondent's Brief on May 11, 2007. Accordingly, Respondent respectfully petitions to have this reexamination proceeding reopened, to place [unredacted versions of] Trigiani Exhibits A and B into the record."

The patent owner also urges the Office to enter the newly submitted supplemental Trigiani declaration with supporting exhibits, which accompanies the June 19, 2007 patent owner petition.[7] The patent owner urges that the supplemental Trigiani declaration includes exhibits newly uncovered by the patent owner in a litigation involving a related patent, and that these exhibits further confirm the patentability of claims 1 to 5 of the '319 patent, provide a significant amount of evidence of perfection of the claimed device prior to October 31, 1997, and also provide other evidence to support [the] commercial success of the invention.[8]

The patent owner, however, fails to provide any reason why the unredacted versions of the August 19, 2004 exhibits A and B, and the supplemental Trigiani declaration and accompanying exhibits, are necessary and were not earlier presented. As the third party requester correctly points out,[9] the issue regarding the redacted dates of the August 19, 2004 exhibits A and B was originally raised by the third party requester in his comments filed on September 13, 2004, in response to patent owner's August 19, 2004 response. While the September 15, 2005 action closing prosecution stated that all claims were patentable, the patent owner was aware that the third party requester had a right to appeal in an *inter partes* reexamination proceeding, as is the case here, and should have filed a submission after the action closing prosecution to address the newly raised issue in the requester's comments. The patent owner fails to provide any reason why the unredacted versions of the August 19, 2004 exhibits A and B, and the supplemental Trigiani declaration and accompanying exhibits, were not presented in response to the September 15, 2005 action closing prosecution. Nor has the patent owner provided any reason why the supplemental Trigiani declaration and accompanying exhibits were not submitted at the time of filing patent owner's May 11, 2007 respondent brief. The patent owner refers to litigation involving a related patent which uncovered evidence "which was not previously before the Examiner." As the third party requester correctly states, however, the question is not whether the evidence was previously before the examiner, but whether it could have previously been placed before the examiner.[10] The patent owner makes no mention of when this litigation began, when the evidence was uncovered, or why the patent owner was not previously aware of this evidence.

In summary, the patent owner petition fails to provide good and sufficient reasons why the unredacted versions of the August 19, 2004 exhibits A and B and the supplemental Trigiani declaration and accompanying exhibits are necessary, why they were not earlier presented, and why they should be entered after an appeal has been filed. Nor has the patent owner provided good and sufficient reasons why the supplemental Trigiani declaration and accompanying exhibits should be entered after the patent owner's respondent brief has been filed.

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[7] See the second full paragraph of page 2 of the June 19, 2007 petition, which states, in pertinent part: "Further, Patent Owner submits a Supplemental Declaration of Phil Trigiani under 37 C.F.R. §§ 1.131 and 1.132 ("Supplemental Trigiani Declaration") which includes unredacted versions of Trigiani Exhibits A and B as Exhibits Q and R. Accordingly, Respondent respectfully petitions to have this reexamination proceeding reopened and to allow the Supplemental Trigiani Declaration be placed on the record and considered in conjunction with its exhibits."

[8] See the last paragraph of page 2 of the June 19, 2007 petition.

[9] See the third full paragraph of page 3 of the July 18, 2007 third party requester opposition.

[10] See the second full paragraph of page 3 of the July 18, 2007 third party requester opposition.

Unredacted versions of the August 19, 2004 exhibits A and B were not previously submitted by the patent owner in the '025 proceeding. Since the patent owner failed to file the present petition with patent owner's May 11, 2007 respondent brief, the patent owner's May 11, 2007 respondent brief is defective pursuant to 37 CFR 41.63(c) and 41.68(b)(1)(viii). This will now be addressed.

The third party requester urges that the entry of the unredacted versions of the August 19, 2004 exhibits A and B would only cause further delay and would not address all of the issues pending on appeal.[11] The submission of the unredacted versions of the August 19, 2004 exhibits A and B with patent owner's May 11, 2007 respondent brief, however, provides the Office with the dates of these exhibits, which necessarily serves to clarify the record and may also simplify the issues on appeal, at least with respect to one of the references applied against the appealed claims, as also noted by the third party requester.[12] For these reasons *only*, the June 19, 2007 patent owner petition is **granted in part**. Specifically, the Office is exercising its option to waive, *sua sponte,* the provisions of 37 CFR 41.63(c) and 41.68(b)(1)(viii) **to the extent that the patent owner's May 11, 2007 respondent brief, including the unredacted versions of the August 19, 2004 exhibits A and B, will be entered and will be considered on the merits**.

The supplemental Trigiani declaration and accompanying exhibits, however, are not deemed to clarify the record or simplify the issues on appeal. In particular, the patent owner has provided no reason, nor does there appear to be a reason, why the newly submitted evidence that the patent owner states was submitted to show commercial success and to confirm the patentability of claims 1 to 5 of the '319 patent, was not presented in response to the first Office action.

Furthermore, the patent owner has not provided any reason why any additional evidence, which the patent owner states was submitted to show perfection of the claimed device prior to October 31, 1997, was not presented with the August 19, 2004 Trigiani declaration. As the third party requester points out, the patent owner has been aware of the need to prove the date of invention since at least June 16, 2004, the mail date of the first Office action on the merits.[13] In addition to the timing issue, the patent owner has provided no explanation as to why the entry of this newly submitted evidence is necessary and is not purely cumulative to the evidence already of record.

For the reasons given above, the June 19, 2007 patent owner petition is dismissed in part and granted in part. Specifically, the supplemental Trigiani declaration and accompanying exhibits filed on June 19, 2007, will not be entered. The supplemental Trigiani declaration and accompanying exhibits filed on June 19, 2007 will remain in the file, but will not be further treated on the merits. On the other hand, the patent owner's May 11, 2007 respondent brief, including the unredacted versions of the August 19, 2004 exhibits A and B, will be entered and will be considered on the merits.

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[11] See the last paragraph of page 3 and the first three full paragraphs of page 4 of the July 18, 2004 third party requester opposition.

[12] The third party requester argues, in the first and second full paragraphs appearing on page 4 of the July 18, 2007 opposition, that "[o]wner's newly submitted evidence addresses only one of those primary references . . . Owner's newly submitted evidence goes only to the issue of whether the date of the claimed invention predates U.S. Patent 6,056,162 (Leighley), having an effective filing date of October 31, 1997."

[13] See the second full paragraph of page 3 of the July 18, 2007 third party requester opposition.

Finally, an undesignated color document entitled "The Ultimate In Ultraviolet Leak Protection" by UView Ultraviolet Systems, Inc., was newly submitted to the Office on June 19, 2007 with the supplemental Trigiani declaration, and was placed in an artifact file pursuant to MPEP 2618 (see footnote 3). This undesignated color document will not be entered, will remain in the artifact file, and will not be further addressed on the merits, for the same reasons as those given immediately above.

The third party requester urges that the '025 reexamination proceeding "has been pending far too long," and cautions the Office to avoid further delays.[14] In view of the statutory requirement to conduct *inter partes* reexamination proceedings with special dispatch,[15] any response to this decision by the patent owner must be received within fifteen (15) days from the mail date of this decision, and any opposition by the third party requester to the patent owner's response, which will be limited to issues raised by the patent owner's response to this decision, must be received within fifteen (15) days from the date of service of patent owner's response. In addition, the third party requester is given one month, or thirty (30) days, whichever is longer, from the mail date of this decision to file a supplemental appellant brief solely limited to the new issues raised by the submission of the unredacted versions of the August 19, 2004 exhibits A and B, and patent owner's arguments directed to those exhibits, in patent owner's respondent brief. The patent owner may once file a supplemental respondent brief, solely limited to issues raised by the third party requester's supplemental appellant brief (if filed), within a period of fifteen (15) days from the date of service of the supplemental appellant brief. These time periods may not be extended.

CONCLUSION

1. The June 19, 2007 patent owner petition is **granted in part**. Specifically, the patent owner's May 11, 2007 respondent brief with appendices, including the unredacted versions of the August 19, 2004 exhibits A and B, will be entered and will be considered on the merits.

2. The June 19, 2007 patent owner petition is **dismissed in part**. Specifically, the supplemental Trigiani declaration and accompanying exhibits filed on June 19, 2007, will not be entered. It will remain in the file, but will not be further treated on the merits. In addition, the undesignated color document entitled "The Ultimate In Ultraviolet Leak Protection" by UView Ultraviolet Systems, Inc., that was also submitted with the Trigiani declaration, will not be entered, will remain in the artifact file, and will not be further addressed on the merits.

3. The patent owner is given a period of **fifteen (15) days** from the mail date of this decision to file any response to this decision. This time period may not be extended. Any response to this decision by the patent owner must be served on the third party requester pursuant to 37 CFR 1.903 and 37 CFR 1.248.

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[14] See the paragraph bridging pages 3 and 4 of the June 19, 2007 patent owner petition.
[15] See 35 U.S.C. 314(c).

4. The third party requester may once file an opposition within a period of **fifteen (15) days** from the date of service of any response by the patent owner to this decision. The third party requester's opposition shall be limited to issues raised by the patent owner's response to this decision. The time for submitting an opposition by the third party requester may not be extended. No reply to any such opposition may be filed by the patent owner.

5. The third party requester is given **one month, or thirty (30) days**, whichever is longer, from the mail date of this decision to file a supplemental appellant brief. This time period may not be extended. The supplemental appellant brief shall be limited to the new issues raised by the submission of the unredacted versions of the August 19, 2004 exhibits A and B, and patent owner's arguments directed to those exhibits, in patent owner's respondent brief. A copy of the supplemental appellant brief must be served on the patent owner pursuant to 37 CFR 1.903 and 37 CFR 1.248.

6. If the third party requester files a supplemental appellant brief, the patent owner may once file a supplemental respondent brief within a period of **fifteen (15) days** from the date of service of the third party requester's supplemental appellant brief. This period may not be extended. The supplemental respondent brief shall be limited to issues raised by the supplemental appellant brief. If the patent owner timely files a supplemental respondent brief in response to an untimely filed supplemental appellant brief, the supplemental respondent brief will be moot, and consequently, will remain in the file but will not be further treated on the merits.

7. If no response from the patent owner is received in response to this decision, and no supplemental appellant brief is timely filed by the third party requester in response to this decision, jurisdiction over this reexamination proceeding will be forwarded to the examiner for action.

8. Jurisdiction over this proceeding is being retained by the Office of Patent Legal Administration pending all responses to this decision, or the expiration of all periods for response to this decision.

SUBMISSION OF CORRESPONDENCE

All correspondence relating to this *inter partes* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Inter Partes* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

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

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

cn

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Alexas D. Skucas King & Spalding LLP 1185 Avenue of the Americas New York, New York 10036	))))	**FOR PATENT OWNER**

MAILED

DEC 2 8 2006

CENTRAL REEXAMINATION UNIT

Bradley J. Thorson, Esq. Patterson, Thuente, Skaar, & Christensen 4800 IDS Center, 80 South 8th Street Minneapolis, MN 55402-2100	)))))	**FOR THIRD PARTY REQUESTER**

In re Vaisnys et al. Reexamination Proceeding Control No. 95/000,027 Filed: October 10, 2003 For: U.S. Patent No. 6,577,102	)))))	**DECISION ON PETITION UNDER 37 CFR 1.59(b) AND MPEP 724.05 TO EXPUNGE DOCUMENT SUBMITTED UNINTENTIONALLY**

This is a decision on the patent owner petition under 37 CFR 1.59(b), filed October 4, 2006, to expunge information. The petition is before the Office of Patent Legal Administration for decision.

The petition is **DISMISSED**.

BACKGROUND

1. Patent No. 6,577,102 (the '102 patent) issued on June 10, 2003.

2. A request for reexamination, assigned Control No. 95/000,027 (the '027 proceeding), was filed by a third party requester on October 10, 2003.

3. Reexamination was ordered in the '027 reexamination proceeding on January 6, 2004.

4. An Office action on the merits was mailed on January 6, 2004.

5. On September 26, 2006, Cardiac Science, Inc. filed an assignment for patent number 6,577,102 (the present '102 patent, being reexamined) for recordation in the Office's assignment records, and the assignment was recorded . The assignment purports to convey ownership of patent 6,577,102 from Cardiac Science, Inc. to Cardiac Science Corporation. Cardiac Science, Inc is the real party in interest pursuant to 37 CFR 1.915(b)(8) that filed the request for *inter partes* reexamination that was assigned control number 95/000,027. However, Cardiac Science Inc. is not, and was not, the owner of patent number 6,577,102 at the time of the submission for recordation . The Office's assignment records reflect that the patent owner at the time of the submission for recordation was DIFIBTECH LLC.

6. Third Party requester filed the present petition pursuant to 37 CFR 1.59(b) and MPEP 724.05, paragraph II, requesting that the unintentionally submitted information be expunged from the Patent Assignment Abstract of Title for U.S. Patent 6,577,102.

DECISION ON PETITION TO EXPUNGE

Petitioner alleges that, in completion of a massive volume of merger documents submitted to the United States Patent and Trademark Office, the requester inadvertently submitted an assignment document to the United States Patent and Trademark Office that inadvertently transferred ownership of '102 from Cardiac Science, Inc. To Cardiac Science Corporation. Petitioner points out that neither of these entities had any ownership in '102 patent. Accordingly, petitioner seeks to have the assignment submitted September 26, 2006, expunged from the Office's assignment records.

37 CFR 1.59 is titled "Expungement of information or copy of papers in **application file**." The body of the regulation is also directed to an application files. To the extent that an application file is construed to include a reexamination file, the present petition does not request expungement of information of information from the reexamination file, but rather from the assignment records of the Office. Accordingly, the regulation does not provide for the remedy sought, and the petition to have the material expunged is **DISMISSED**.

As to the issue expungement from the Office's assignment records, in general, petitions to correct, modify or "expunge" assignment records are rarely granted. Such petitions are granted only if the petitioner can show that:

(A) the normal corrective procedures outlined in MPEP 323.01(a) through 323.01(c) will not provide the petitioner with adequate relief; and

(B) the integrity of the assignment records will not be affected by granting the petition. See MPEP 323.01(d).

In this instance, the patent owner and petitioner requester may wish to arrange to record corrective papers with the Assignment Service Division as outlined in 323.01(c). See MPEP 323.01 (c) *infra.*

> 323.01(c) Assignment or Change of Name Improperly Filed and Recorded by Another Person Against Owner's Application or Patent [R-3]
>
> When the owner of an application or registration discovers that due to a typographical error, another party has improperly recorded an assignment or name change against the owner' s application or patent, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.
>
> The owner should contact the party who recorded the papers with the erroneous information and request that such party record corrective papers. However, if the party cannot be located or is unwilling to file corrective papers, then the true owner must record the necessary papers with the Assignment Services Division to correct the error.
>
> Specifically, the owner should submit the following to the Assignment Services Division:
>
> (A) a completed cover sheet identifying the application or patent against which the assignment was improperly recorded;
>
> (B) an affidavit or declaration (1) identifying itself as the correct owner, (2) stating that the previously recorded document was submitted with erroneous information, and (3) providing the reel and frame number of the previously recorded document; and
>
> (C) the required fee (37 CFR 3.41) for each application or patent to be corrected.
>
> The affidavit or declaration should include a summary of the true chain of title to make it clear that the chain of title for the application or patent identified should not be considered altered by the incorrect assignment or name change, and a statement that the original applicant or patentee or last correct assignee has been, and continues to be, the owner of the application, or patent at issue.
>
> On the corrected cover sheet, the owner should check the box titled "Other" in the area of the cover sheet requesting the "Nature of Conveyance," and indicate that the submission is to correct an error made in a previously recorded document that erroneously affects the identified application(s), or patent(s). The party should also write the name of the correct owner in both the box requesting the name of the conveying party and the box requesting the name and address of the receiving party; this is to make it clear that ownership never changed and that any assignment or name change recorded against the application(s) or patent(s) was erroneous.

The present petition paper does not have an entry right in the Image File Wrapper (IFW) for the '027 reexamination proceeding. The third party requester paper is nowhere provided for in the reexamination statute or regulations. Accordingly, the petition papers filed October 4, 2006, will not be retained in the record. Inasmuch as the petition papers have been scanned into the electronic Image File Wrapper (IFW) and cannot be removed from the IFW, the petition papers will be "returned" to the third party requester by being marked "closed" and "non-public." The petition papers will not be part of the official record of the present reexamination proceeding.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.59(b) to expunge is dismissed.

2. The parties may wish to file corrective papers as outlined in MPEP 323.01(c) with the Assignment Service Division.

3. The petition papers filed October 4, 2006, are being marked "closed" and "non-public." The petition papers will not be part of the official record of the present reexamination proceeding.

4. Telephone inquiries related to the present decision should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757 or, in his absence, to the undersigned at 571-272-7710.

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

December 26, 2006
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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.
95/000,027	10/10/2003	6577102	1798.151US01	4776

7590 04/20/2007

Alexas D. Skucas
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New York, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 20 2007

CENTRAL REEXAMINATION UNIT

Alexas D. Skucas King & Spalding LLP 1185 Avenue of the Americas New York, NY 10036	:	For Patent Owner
Bradley J. Thorson, Esq. Patterson, Thuente, Skaar & Christense 4800 IDS Center, 80 South 8th Street Minneapolis, MN 55402-2100	:	For Requester
In re: Vaisnys et al. *Inter Partes* Reexamination Proceeding Control No. 95/000,027 Filed: October 10, 2003 For: US Patent No. 6,577,102	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.956]

This is a decision on the June 6, 2006 patent owner "Request for Extension of Time in Interpartes Re-Examination Pursuant to 37 CFR 1.956 and MPEP 2665," requesting that the time for responding to the Action Closing Prosecution mailed May 10, 2006 be extended by two months.

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 Action Closing Prosecution mailed May 10, 2006, which set a one month date for filing a response thereto. The request for extension is the first request for an extension of time with respect to the Action Closing Prosecution. The petition for extension of time was timely filed on June 6, 2006, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR § 1.956 Patent owner extensions of time in inter partes reexamination.

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

MPEP 2665 Extension of Time for Patent Owner Response
States in part.

> "Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period."

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

The patent owner notes the lengthy nature of the action, which included several new grounds of rejection, and the fact that new prior art has been applied therein.

Analysis and Findings

On balance, it is considered that, while the petition explains the "sufficient cause" for an extension of time, such cause does not merit an extension of *two* months. It is clear Patent Owner requires some additional time to prepare a complete response. However, an extension of time of one month is considered sufficient, there being no extraordinary circumstances present which would merit a two month extension.

Accordingly, the time for filing a reply to the outstanding Office action is extended for one month and therefor the reply is due on July 10, 2006. Patent Owner may expect that any further extensions of time to respond to the Office action will be granted only in an extraordinary situation. See MPEP 2665.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Action Closing Prosecution dated May 10, 2006 is **granted for one month**.

2. The Patent Owner's response is due July 10, 2006.

3. Response may be submitted as follows:

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

4. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Floyd B. Chapman
Wiley, Rein & Fielding LLP
1776 K Street, N.W.
Washington, D.C. 20006

(For Third Party Requester)

MAILED
FEB 13 2004
REEXAM UNIT

David and Raymond Patent Group
1050 Oakdale Lane
Arcadia, CA 91006

(For Patent Owner)

In re Zheng	:	DECISION ON PETITION
Inter Partes Reexamination Proceeding	:	REQUESTING ACCEPTANCE OF
Control No. 95/000,031	:	LATE RESPONSE TO NOTICE
Filed: December 10, 2003	:	OF INCOMPLETE REQUEST FOR
For: U.S. Patent No. 6,296,304	:	*INTER PARTES* REEXAMINATION

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration (OPLA) regarding a petition filed by the third party requester on January 13, 2004, requesting the Director to accept a late response to a *Notice of Incomplete Request for Inter Partes Reexamination.*

For the reasons set forth below, the petition is granted and the January 13, 2004, response to the notice has been accepted and entered into the reexamination file.

BACKGROUND

1. On December 10, 2003, a request for *inter partes* reexamination of U.S. Patent No. 6,296,304 (the '304) patent was filed by a third party requester.

2. On December 18, 2003, a *Notice of Incomplete Request for Inter Partes Reexamination* was mailed to the requester with a response period of 15 days set from the date of mailing of the notice. A response was due no later than January 2, 2004. The time period for response was noted as *not* being extendable.

3. On January 13, 2004, a complete response to the notice was submitted by the third party requester along with a petition to the Director requesting that the late response be accepted in view of the fact that the notice was never received.

DECISION

Under 37 CFR 1.915(d):

> "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. Failure to comply with the notice may result in the *inter partes* reexamination proceeding being vacated." (Emphasis added.)

The rule states that a failure to comply to the notice (e.g., the response to the notice is not timely submitted), *may* result in the reexamination proceeding being vacated. The rule does *not* require that the reexamination proceeding be vacated. Petitioner alleges that the notice of incomplete request was never received, and that he became aware of the notice pursuant to a telephone call on January 8, 2004, from Legal Instruments Examiner M. A. Twitty in the Central Reexamination Unit of the USPTO.

Petitioner avers that a search of his office, the incoming mail boxes of the firm, the Reexamination Binder (created to store all communications relating to the reexamination), and the index (the equivalent to a file jacket) failed to locate the notice. Petitioner further avers that a review of the docketing records also failed to find any evidence of its receipt. Petitioner submits copies of docketing records to substantiate this averment.

Section 711.03(c), part II, of the Manual of Patent Examining Procedure sets forth that a grantable petition establishing nonreceipt of an Office communication requires two items:

(1) a statement from the practitioner averring that the Office communication was not received and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(2) a copy of the docket record(s) where the non-received Office communication would have been entered had it been received and docketed.

In view of the above, the petition is granted. The response filed on January 13, 2004, has been accepted and will be processed in the reexamination file, and the '031 *inter partes* reexamination proceeding will continue.

Telephone inquiries with regard to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610. Telephone inquiries with regard to the status of the file should be directed to Marsha Twitty at (703) 308-9692; (703) 305-1013 FAX.

CONCLUSION

1. The third party requester petition filed January 13, 2004, is granted.

2. The response filed on January 13, 2004, has been accepted, and will be entered.

3. Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,033	01/06/2004	6644184	600.1299RE	3916

7590 08/12/2008

Thomas C. Pontani
Cohen Pontani Lieberman & Pavani
551 Fifth Avenue Suite 1210
New York, NY 10176

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas C. Pontani
Cohen Pontani Lieberman & Pavani
551 Fifth Avenue Suite 1210
New York, NY 10176

(For Patent Owner)

MAILED

AUG 12 2008

CENTRAL REEXAMINATION UNIT

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018

(For Requester)

In re Hajek *et alia*
Reexamination Proceeding
Control No. 95/000,033
Request Deposited: January 6, 2004
For: U.S. Patent No. 6,644,184

: DECISION DISMISSING
: PETITION
: FOR EXTENSTION OF TIME
: 37 CFR 1.956
:

This is a decision on the July 28, 2008, patent owner Petition for Extension of Time requesting that the time to submit a response to the office action mailed July 15, 2008 be extended an additional two months. Although there is a certificate of facsimile transmittal dated August 20, 2004, this date can not be given to the present request as it is clearly an error. Furthermore, the fax number listed is no longer current.

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

The petition is dismissed for a two-month extension of time for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,644,184 (the '184 patent) issued to Hajek et alia on November 11, 2003.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,033 ('033), was deposited by a third party requester on January 6, 2004.

3. An order granting reexamination of the '184 patent was mailed April 5, 2004.

4. A non-final office action was mailed on July 8, 2004 setting a two-month period for response.

5. A first request for extension of time was filed on August 20, 2004 requesting a two-month extension of time.

6. The first request for extension of time was granted-in-part and the period for response was extended by one month.

7. Later in prosecution, an ACP was mailed on July 15, 2008, setting a one month period for response.

8. A second request for extension of time was received in the office on July 28, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed July 15, 2008. The request for extension is the second request for an extension of time. The present petition for extension of time was timely filed on July 28, 2008. The petition failed to include the petition fee required by 37 CFR 1.956.

37 CFR 1.956 states:

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

Addressing the requirement of 37 CFR 1.956 to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2665 states, in pertinent part:

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.

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

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...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is insufficient to justify an extension of time. The request does not include a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted. Furthermore, petitioner has failed to pay the required petition fee.

Therefore, the request for a two-month extension of time is **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.

2. Patent owner is invited to file a renewed petition for extension of time, with the petition fee, to address the deficiencies noted above, in order to appropriately establish "sufficient cause" for granting the extension of time. Any such renewed petition would be directed to the Central Reexamination Unit.

3. If a response is not timely filed, Patent Owner may wish to consider filing a petition under 37 CFR 1.137 to accept an untimely filed paper (see also MPEP 2668).

4. The Patent Owner's response is due **15 August 2008**.

5. Responses may be submitted via EFS or as follows:

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

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

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

Eric Keasel for

Gregory Morse
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

AUG 19 2008

CENTRAL REEXAMINATION UNIT

Thomas C. Pontani
Cohen Pontani Lieberman & Pavani
551 Fifth Avenue Suite 1210
New York, NY 10176

(For Patent Owner)

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018

(For Requester)

In re Hajek *et alia*	: DECISION GRANTING
Reexamination Proceeding	: IN PART PETITION
Control No. 95/000,033	: FOR EXTENSTION OF TIME
Request Deposited: January 6, 2004	: 37 CFR 1.956
For: U.S. Patent No. 6,644,184	:

This is a decision on the August 14, 2008, patent owner Renewed Petition for Extension of Time requesting that the time to submit a response to the office action mailed July 15, 2008 be extended an additional two months.

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

The petition is granted in part and a one month extension is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,644,184 (the '184 patent) issued to Hajek et alia on November 11, 2003.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,033 ('033), was deposited by a third party requester on January 6, 2004.

3. An order granting reexamination of the '184 patent was mailed April 5, 2004.

4. A non-final office action was mailed on July 8, 2004 setting a two-month period for response.

5. A first request for extension of time was filed on August 20, 2004 requesting a two-month extension of time.

6. The first request for extension of time was granted-in-part and the period for response was extended by one month.

7. Later in prosecution, an ACP was mailed on July 15, 2008, setting a one month period for response.

8. A second request for extension of time was received in the office on July 28, 2008.

9. The second request for extension of time was dismissed on August 12, 2008.

10. A renewed petition and request for extension of time was filed on August 14, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed July 15, 2008. The request for extension is the second request for an extension of time. The present renewed petition for extension of time was timely filed on August 14, 2008. The renewed petition included an authorization to charge the petition fee required by 37 CFR 1.956. Said fee has been applied.

37 CFR 1.956 states:

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

Addressing the requirement of 37 CFR 1.956 to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2665 states, in pertinent part:

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.

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

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...

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

The request does include a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted (see generally at page 2 of the petition). The petition also notes some scheduling issues. Reference is made to the petition for details of this and other issues.

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is sufficient to justify 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.

Petitioner's request for an extension of time is **granted-in-part.** An extension of time of one month is considered sufficient.

Accordingly, the time for filing the response is extended for one month and therefore the response is due on or before September 15, 2008.

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

CONCLUSION

1. Petitioner's request is **granted-in-part**.

2. The Patent Owner's response is due **15 September 2008**.

3. Responses may be submitted via EFS or as follows:

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

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

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,033	01/06/2004	6644184	600.1299RE	3916

7590 01/13/2010

EXAMINER

Thomas C. Pontani
Cohen Pontani Lieberman & Pavani
551 Fifth Avenue Suite 1210
New York, NY 10176

ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILLIAM C. GEBRIS
DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

Date:
MAILED
JAN 13 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000033
PATENT NO. : 6644184
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Cohen Pontani Lieberman & Pavane
Suite 1210
551 Fifth Avenue
New York, NY 10176

(For Patent Owner)

MAILED

JAN 13 2010

CENTRAL REEXAMINATION UNIT

Davidson, Davidson & Kappel, LLC
14th Floor
485 Seventh Avenue
New York, NY 10018

(For Requester)

In re Hajec et al
Inter Partes Reexamination Proceeding
Control No. 95/000,033
Filed: January 6, 2004
For: U.S. Patent No. 6,644,184

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

This is a decision on the October 22, 2009 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.945(b) "and/or" 37 CFR 1.111(a)(2), to permit entry and consideration of the supplemental amendment filed on March 17, 2009.

The March 17, 2009 supplemental amendment, however, has been entered and considered by the examiner as stated on page 20 of the action closing prosecution, mailed on December 18, 2009.[1] For this reason, the October 22, 2009 patent owner petition under 37 CFR 1.183 is **dismissed as moot**.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 has been received.

CONCLUSION

- The October 22, 2009 patent owner petition under 37 CFR 1.183 is **dismissed as moot**.
- Jurisdiction over the present proceeding is returned to the Central Reexamination Unit to await any response to the December 18, 2009 action closing prosecution, or the expiration of time for response to the December 18, 2009 action closing prosecution.
- All correspondence relating to this *inter partes* reexamination proceeding should be directed to:

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

[1] The supplemental amendment filed on October 22, 2009 was also entered and considered by the examiner, also as stated on page 20 of the December 18, 2009 action closing prosecution.

By Mail: Mail Stop "*Inter Partes* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

DEC 12 2007

CENTRAL REEXAMINATION UNIT

Moore & Van Allen, PLLC for BOFA (For Patent Owner)
430 Davis Drive, Suite 500
PO Box 13706
Research Triangle Park, NC 27709

Law Offices of Gary A. Rosen, PC (For Third Party Requester)
1831 Chestnut Street, Suite 802
Philidelphia, PA 19103

In re Reexamination Proceeding :
Jamily Pentz et al. :
Control No. 95/000,035 : DECISION GRANTING PETITION
Filed: February 9, 2004 :
U.S. Patent No. 6,471,127 :
:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on October 12, 2007, for entry of late papers based upon unintentional delay.

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

The petition is granted.

DECISION

37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ...."

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (an appeal brief and $510.00 brief fee (item 1 NOTE: A notice of appeal was made of record on October 4, 2007, the appropriate fee charged and accepted by the Office), the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement regarding the delay (item 3), and a Certificate of Service on the Third Party Requester.

Accordingly, the petition for entry of the late papers is granted.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is granted.

2. A fee in the amount of 2050 USD ($510.00 + $1540) has been charged in accordance with petitioner's EFS web submission containing the present petition.

3. Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit for processing of papers received, after which jurisdiction will be returned to (CRU) Art Unit 3992 for consideration of the proceeding.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Escalante Ovidio, in CRU Art Unit 3992, who can be reached at 571-272-7537.

5. 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

11-27-07
C:\Kiva\kpet-abe\IP_reex\ 95-00035 -grant_uninten.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,038	02/27/2004	6527941	1428620.00003US1	2250

23483 7590 12/28/2009

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALEX R. SLUZAS, ESQ.
PAUL AND PAUL
2900 TWO THOUSAND MARKET STREET
PHILADELPHIA, PA 19103

Date:

MAILED

DEC 28 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000038
PATENT NO. : 6527941
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

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

WILMERHALE/BOSTON
60 State Street
Boston, MA 02109

(For Patent Owner)

MAILED

DEC 28 2009

Alex R. Sluzas, Esq.
Paul & Paul
2900 Two Thousand Market Street
Philadelphia, PA 19103

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Andersen *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,038
Filed: February 27, 2004
For: U.S. Patent No. 6,527,941

: **DECISION**
: **REFUSING**
: **ENTRY OF**
: **PAPERS**

This is a decision on the October 15, 2009 third party requester papers styled "Petition of Third Party Requester to Suspend the Rules Pursuant to 37 C.F.R. § 1.183," and "Petition of Third Party Requester Pursuant to 37 C.F.R. § 1.182 to Deny Patent Owner's Request for Extension of Time to Respond to the Examiner's Actions" and the October 29, 2009 third party paper styled as "Petition of Third Party Requester Pursuant to 37 C.F.R. § 1.181(a)(1) to Modify or Withdraw Action Closing Prosecution and Reverse Decision Granting Extension of Time." On November 18, 2009, patent owner filed an opposition to requester's October 29, 2009 petition.

The papers are before the Office of Patent Legal Administration.

The papers are refused entry into the record, without consideration on the merits, for the reasons set forth below.

BACKGROUND

1. On March 4, 2003, the Office issued U.S Patent number 6,527,941 (hereafter the '941 patent) issued to Andersen *et al.*

2. On February 27, 2004, a request for *inter partes* reexamination of the '941 patent was filed with the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,038 (hereinafter the '038 reexamination proceeding).

3. On May 4, 2004, the Office issued an order, in the '038 reexamination proceeding, granting *inter partes* reexamination of the '941 patent. 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 June 19, 2009, prosecution had advanced to appeal before the Board of Patent Appeals and Interferences (BPAI). The BPAI issued a decision reversing the examiner and imposing rejections that the examiner had refused to adopt, in accordance with 37

CFR 41.77 (a). The BPAI gave the patent owner the options of timely requesting reopening of prosecution or requesting rehearing. The BPAI's decision noted that extensions of time are governed by 37 CFR 1.956.

5. On July 20, 2009, patent owner timely filed a request to reopen prosecution before the examiner. Patent owner concurrently submitted a response that includes amendments to the claims, arguments and new evidence.

6. On August 21, 2009, requester submitted comments on patent owner's July 20, 2009 response.

7. On September 18, 2009, the Office issued an Action Closing Prosecution (ACP).

8. On October 8, 2009, patent owner submitted a request for a one-month extension of the time for filing a response to the September 18, 2009 ACP.

9. On October 15, 2009, third party requester filed a petition requesting waiver of the rules to oppose and an opposition to patent owner's October 8, 2009 request for the one-month extension of time.

10. On October 16, 2009, the Office issued a decision granting patent owner's request for a one month extension of time to respond to the September 18, 2009 ACP.

11. On October 29, 2009, third party requester filed a petition to modify or withdraw the September 18, 2009 ACP and a reversal of the October 16, 2009 decision granting patent owner a one month extension of time to respond to the September 18, 2009 ACP.

12. On November 18, 2009, patent owner filed an opposition to third party requester's October 29, 2009 petition.

RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

35 U.S.C. 314(b)(2) states:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.937 states:

> (b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.939(a) states:

> 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.

37 CFR 1.945 states:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.947 states in pertinent part:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.

37 CFR 1.956 states:

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

MPEP § 2665, after quoting 37 CFR 1.956, states in pertinent part:

> As noted above, a request for extension of time under 37 CFR 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch. (Emphasis in the original.)

DECISION REFUSING ENTRY OF THE THIRD PARTY REQUESTER OPPOSITION

The October 15, 2009 requester petitions in opposition to patent owner's October 8, 2009 request for an extension of time do not have an entry right in the instant proceeding. Likewise, the October 29, 2009 requester petition to October 16, 2009 Office decision and the September 18, 2009 ACP and patent owner's November 18, 2009 opposition to requester's October 29, 2009 petition do not have an entry right in the instant proceeding for the reasons set forth below.

Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. This right is implemented by 37 CFR 1.947, which provides that a third party requester may once file written comments within a period of 30 days from the of service of a patent owner's response to an Office action on the merits **pursuant to 37 CFR 1.945**. A request for extension of time under 37 CFR 1.956, nor a petition of an Office decision granting an extension of time however, is **not** a "response" to an "Office action on the merits." [1] Neither 35 U.S.C. § 314 (b)(2) nor the regulations provide any right for the third party

[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of a reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent

requester to file an opposition or comment on a patent owner's request for an extension of time under 37 CFR 1.956; there is no right to petition the Office's decision and exercise of discretion. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of an extension of time in an *inter partes* reexamination proceeding or the exercise of the Office's discretion in general. The lack of such a right was not raised in the enactment of the *inter partes* reexamination statute (or in any of the precursor bills), and there is no evidence to indicate that enacting such a right was ever contemplated by Congress. Accordingly, the third party requester's opposition to patent owner's request for extension of time, and petition for review of the Office's exercise of discretion are papers not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly were not provided for (i.e., were not permitted) in the regulations that implemented the *inter partes* reexamination statute. The third party requester's opposition to patent owner's request for extension of time and petition for review of the Office's discretion are therefore, not enterable into the record, because it is not provided for by the reexamination statute or regulations.

It is noted that whether a patent owner's request for extension of time is grantable in accordance with 37 CFR 1.956 is a matter within the jurisdiction of the Office. For example, 35 U.S.C. § 314(a) provides that reexamination will be conducted "according to the procedures established for initial examination under the provisions of sections 132 and 133." Further, 35 U.S.C. § 132(b) provides that "[t]he Director shall prescribe regulations to provide for the continued examination of applications for patent," while 35 U.S.C. § 133 establishes that the maximum statutory period in which to respond is six months. Accordingly, it follows that 37 CFR 1.956 permits a patent owner to secure an extension of time for taking action in an *inter partes* reexamination proceeding when a shortened statutory period for filing a response to an Office action is set by the Office, and 37 CFR 1.956 is consistent with the authority to conduct *inter partes* reexamination proceedings conferred upon the Office by 35 U.S.C. §§ 311 *et seq.*.

It is to be noted that, while the requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office, [2] the consideration of a request for extension of time filed under 37 CFR 1.956 is clearly within the Office's jurisdiction, based on the incorporation of 35 U.S.C. §§ 132 and 133 into the *inter partes* reexamination statute via 35 U.S.C. § 314(a), as is the Office's discretion in handling matters of extension of time based on equities. Therefore, the requester's opposition to patent owner's request for extension of time and petition of the Office's exercise of its discretion are not enterable into the record as addressing the jurisdiction of the Office to act on its own accord as well as upon patent owner's request, and it will be refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a), "[i]f 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. For the reasons discussed above, the requester's opposition petition papers filed on October 16, 2009 and October 29, 2009 do not have a right of entry into the record of the present reexamination

---

owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of "reply" to an Office action. Note that 37 CFR 1.111 states that such "reply" must request further examination or reconsideration of the Office action, and therefore precludes a request for extension of time from being a "reply," or response within the context of the regulations governing reexamination.

[2] Compare the discussion in MPEP § 2646 regarding an opposition to a petition to vacate an order granting a request for reexamination on the grounds that the order granting reexamination was an *ultra vires* act. Such a jurisdictional issue is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding.

proceeding, and, as such, are not authorized papers. As patent owner's November 18, 2009 opposition is in response to an improper paper, it is also improper without a right of entry into the record of the present reexamination proceeding, and, therefore is also not an authorized. Because the present petition and opposition papers were filed using the EFS-Web system and have already been incorporated into the electronic Image File Wrapper (IFW), they will all be expunged from the record by marking them as "closed" and "non-public" in the IFW. A copy of the present decision will, however, be made of record in the reexamination file.

CONCLUSION

1. The third party requester's petition papers dated October 15, 2009 and October 29, 2009 and patent owner's November 18, 2009 opposition paper are all refused entry as they are improper papers. The papers are not enterable into the record of the present reexamination proceeding, because such submissions are not provided for in the reexamination statute or the regulations promulgated under the statute.

2. Because the petition and opposition papers were previously incorporated into the IFW, the these papers are being expunged from the record by marking them as "closed" and "non-public" in the IFW record of the present reexamination proceeding. No copy of these papers will be maintained of record in the Office.

3. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.

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

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,038	02/27/2004	6527941	1428620.00003US1	2250

23483 7590 03/15/2010

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,038	02/27/2004	6527941	2863

EXAMINER
DIAMOND, ALAN D.

ART UNIT	PAPER
3991	

ALEX R. SLUZAS, ESQ.
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DATE MAILED:
MAILED
MAR 15 2010
CENTRAL REEXAMINATION UNIT

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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WILMERHALE/BOSTON
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Alex R. Sluzas, Esq.
Paul & Paul
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Philadelphia, PA 19103

(For Requester)

MAILED

MAR 15 2010

CENTRAL REEXAMINATION UNIT

In re Andersen *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,038
Filed: February 27, 2004
For: U.S. Patent No. 6,527,941

DECISION
DISMISSING
PETITION

This is a decision on the January 5, 2010 patent owner petition entitled, "Petition Under 37 C.F.R. § 1.183 to Correct Misleading Statements in the Record."

The petition is before the Office of Patent Legal Administration.

The petition is dismissed for the reasons set forth below.

FEE

Petitions under 37 CFR 1.183 require a petition fee of $400.00 as set forth by 37 CFR 1.17(f). This petition fee was charged to petitioner's credit card as authorized in the January 5, 2010 EFS-web charge authorization.

BACKGROUND

1. On March 4, 2003, the Office issued U.S Patent number 6,527,941 (hereafter the '941 patent) issued to Andersen *et al.*

2. On February 27, 2004, a request for *inter partes* reexamination of the '941 patent was filed with the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,038 (hereinafter the '038 reexamination proceeding).

3. On May 4, 2004, the Office issued an order, in the '038 reexamination proceeding, granting *inter partes* reexamination of the '941 patent. 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 June 19, 2009, the proceeding advanced to appeal before the Board of Patent Appeals and Interferences (BPAI). The BPAI issued a decision reversing the examiner and imposing rejections that the examiner had refused to adopt, in accordance with 37 CFR 41.77 (a). The BPAI gave the patent owner the options of timely requesting reopening of prosecution or requesting rehearing. The BPAI's decision noted that extensions of time are governed by 37 CFR 1.956.

5. On July 20, 2009, patent owner timely filed a request to reopen prosecution before the examiner. Patent owner concurrently submitted a response that includes amendments to the claims, arguments and new evidence.

6. On August 21, 2009, requester submitted comments on patent owner's July 20, 2009 response.

7. On September 18, 2009, the Office issued an Action Closing Prosecution (ACP).

8. On November 18, 2009, patent owner timely filed an amendment and comments to the September 18, 2009 ACP.[1]

9. On December 15, 2009 the third party requester filed its comments.

10. On January 5, 2010, patent owner filed a petition entitled, "Petition Under 37 C.F.R. § 1.183 to Correct Misleading Statements in the Record".

RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

35 U.S.C. § 314(b)(2) and (c) state:

> (2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.
>
> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.951(a) provides:

> 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.

MPEP § 2672, subsection I provides:

> After an Action Closing Prosecution (ACP), the patent owner may once file (pursuant to 37 CFR 1.951(a)) written comments limited to the issues raised in the reexamination proceeding and/or present

[1] On October 16, 2009 the Office granted patent owner a one-month extension of time to November 18, 2009 to respond to the September 18, 2009 ACP.

a proposed amendment to the claims. Where the patent owner does so, the third party requester may once file (pursuant to 37 CFR 1.951(b)) comments responsive to the patent owner's comments. Any second or supplemental submission after ACP by either the patent owner or the third party requester will thus be returned.

MPEP § 2667, subsection I.A.3 provides:

> The patent owner can only file once under 37 CFR 1.951(a). Any second or supplemental submission after ACP by the patent owner will be returned, unless prosecution has been reopened. See MPEP § 2672.
>
> Where a paper is to be returned based on the above reason or other appropriate reasons, and the paper is not accompanied by a petition under 37 CFR 1.182 or 1.183, the CRU Director or the RLA will return the paper. Where a petition under 37 CFR 1.182 or 1.183 has been filed, the reexamination proceeding should be addressed in the OPLA, to issue a decision on the petition.

DECISION

In the present petition, patent owner requests that the Office suspend the strictures of 37 CFR 1.951(a) on patent owner and permit the filing of a "correction" to third party requester's December 15, 2009 comments after ACP. Patent owner argues that suspension of the rules is appropriate, because patent owner feels third party requester has made erroneous comments and patent owner believes they should be corrected before further review by the Office. Contrary to the assertions of patent owner, disputes as to issues of fact are resolved by appeal and not by petition before appeal. Patent owner will have the opportunity to argue disputes of fact on appeal. It is wholly inappropriate in an *inter partes* proceeding to seek unilateral "correction" of a fact in dispute, which should be decided before the appropriate fact finder on appeal.

Furthermore, by statutory mandate reexamination proceedings must be conducted "with special dispatch within the Office." By permitting a party by petition to have multiple iterations of comments and rebuttals would frustrate the Office's statutory mandate of special dispatch. There is no indication anywhere in the reexamination statute, the legislative history, nor the case law, that multiple iterations of input regarding non-petitionable matters prior to decision on appeal was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. Patent owner's petition only presents a dispute that goes to an issue of fact and not an issue of law. Issues of fact go to the merits of the proceeding and therefore redress is sought by way of argument on appeal and not by unilateral petition in an *inter partes* proceeding. Therefore, the facts and circumstances do not present an ***extraordinary situation*** under 37 CFR 1.183 justifying suspension of the rules. Therefore, justice does not require suspension of 37 CFR 1.951(a). Accordingly, the present petition is DISMISSED.

CONCLUSION

1. Patent owner's January 5, 2010 petition under 37 CFR 1.183 is <u>dismissed</u>.

2. Jurisdiction of the '038 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

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

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,038	02/27/2004	6527941	1428620.00003US1	2250

23483 7590 04/15/2010
WILMERHALE/BOSTON
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BOSTON, MA 02109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2010

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

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DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Paul and Paul

2900 Two Thousand Market St

Philadelphia, PA 19103

MAILED

APR 15 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,038*.

PATENT NUMBER *6,527,941*.

TECHNOLOGY CENTER *1700*.

ART UNIT *1753*.

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 Requester)

MAILED

APR 15 2010

CENTRAL REEXAMINATION UNIT

In re Andersen *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,038
Filed: February 27, 2004
For: U.S. Patent No. 6,527,941

: **DECISION**
: **ENTERING**
: **PAPERS**

This is a decision regarding entry of the February 25, 2010 third party requester paper entitled, "PETITION FOR RECONSIDERATION OF REFUSAL TO ENTER AND CONSIDER THE OF [SIC] PETITION OF THIRD PARTY REQUESTER PURSUANT TO 37 C.F.R. § 1.181(a)(1) TO MODIFY OR WITHDRAW ACTION CLOSING PROSECUTION," and patent owner's March 29, 2010 paper entitled, "PATENT OWNER'S OPPOSITION TO THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF THE REFUSAL TO ENTER AND CONSIDER THE PETITION OF THIRD PARTY REQUESTER PURSUANT TO 37 C.F.R. § 1.181(a)(1) TO MODIFY OR WITHDRAW ACTION CLOSING PROSECUTION.

The petition and opposition papers are before the Office of Patent Legal Administration.

The papers are entered into the record, and jurisdiction is transferred to the Central Reexamination Unit for consideration on the merits.

BACKGROUND

1. On March 4, 2003, the Office issued U.S Patent number 6,527,941 (hereafter the '941 patent) issued to Andersen *et al.*

2. On February 27, 2004, a request for *inter partes* reexamination of the '941 patent was filed with the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,038 (hereinafter the '038 reexamination proceeding).

3. On May 4, 2004, the Office issued an order, in the '038 reexamination proceeding, granting *inter partes* reexamination of the '941 patent. 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 June 19, 2009, the proceeding advanced to appeal before the Board of Patent Appeals and Interferences (BPAI). The BPAI issued a decision reversing the examiner and

imposing rejections that the examiner had refused to adopt, in accordance with 37 CFR 41.77 (a). The BPAI gave the patent owner the options of timely requesting reopening of prosecution or requesting rehearing. The BPAI's decision noted that extensions of time are governed by 37 CFR 1.956.

5. On July 20, 2009, patent owner timely filed a request to reopen prosecution before the examiner. Patent owner concurrently submitted a response that includes amendments to the claims, arguments and new evidence.

6. On August 21, 2009, requester submitted comments on patent owner's July 20, 2009 response.

7. On September 18, 2009, the Office issued an Action Closing Prosecution (ACP).

8. On October 8, 2009, patent owner submitted a request for a one-month extension of the time for filing a response to the September 18, 2009 ACP.

9. On October 15, 2009, third party requester filed a petition requesting waiver of the rules and an opposition to patent owner's October 8, 2009 request for the one -month extension of time.

10. On October 16, 2009, the Office issued a decision granting patent owner's request for a one month extension of time to respond to the September 18, 2009 ACP.

11. On October 29, 2009, third party requester filed a petition to modify or withdraw the September 18, 2009 ACP and to reverse the October 16, 2009 decision granting patent owner a one month extension of time to respond to the September 18, 2009 ACP.

12. On November 18, 2009, patent owner filed an opposition to third party requester's October 29, 2009 petition.

13. On December 28, 2009, the Office refused entry of third party requester's October 15, 2009 and October 29, 2009 papers and patent owner's November 18, 2009 papers.

14. On February 25, 2010, third party requester filed the preent request for reconsideration of the December 28, 2009 Office decision refusing entry of the October 29, 2009 papers.

15. On March 29, 2010, patent owner filed an opposition to third party requester's February 25, 2010 request for reconsideration.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR 1.181(a) states:

Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

DECISION

The February 25, 2010 requester paper asserts a right of entry as to the present petition, as a modification of the October 29, 2009 petition paper, addresses a single, distinct request for relief that is within the scope of 37 CFR 1.181 and accordingly requests entry and consideration of the February 25, 2010 petition in the '038 proceeding. Patent owner's March 29, 2010 opposition to requester's February 25, 2010 petition asserts the December 28, 2009 Office decision was proper and should be maintained.

As requester has properly presented a petition directed to one cause of relief, in accordance with 37 CFR 1.4(c), which solely addresses an action taken by the examiner of record in the '038 proceeding that falls within the scope of 37 CFR 1.181. The February 25, 2010 petition is thus enterable upon the record.

The Central Reexamination Unit (CRU) possesses jurisdiction to address this petition filed under 37 CFR 1.181. Accordingly, jurisdiction is being forwarded via the Director of the Central Reexamination Unit (CRU), for consideration of the petition and the opposition, and issuance of a decision in due course.

CONCLUSION

1. The third party requester's petition paper dated February 25, 2010 and patent owner's March 29, 2010 opposition paper are of record.

2. Jurisdiction is being forwarded via the Director of the Central Reexamination Unit (CRU), for consideration of the petition and the opposition, and issuance of a decision in due course.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,043	05/26/04	6721743	

EXAMINER
Luke Wassum

ART UNIT	PAPER
2167	

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DATE MAILED:

09/13/06

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

REEXAMINATION CONTROL NUMBER *95/000,043*.

PATENT NUMBER *6,721,743*.

TECHNOLOGY CENTER *2100*.

ART UNIT *2161*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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In re: Hisashi Sakakibara	: DECISION ON PETITION
Reexamination Proceeding	: TO CONTINUE
Control No.: 95/000,043	: *INTER PARTE*
Filed: May 26, 2004	: REEXAMINATION
For: U.S. Patent No.: 6,721,743	: PROCEEDINGS

This is a decision on the February 13, 2006 patent owner petition, denominated "PETITION UNDER 37 C.F.R. § 1.182 - QUESTIONS NOT SPECIFICALLY PROVIDED FOR."

This is also a decision on the petition filed February 13, 2006 under 37 CFR 1.183 requesting waiver of the rule prohibiting extensions of time.

The petition is before the Office of Patent Legal Administration.

The petition fees of $400 set forth in 37 CFR 1.17(f) for the present petitions under 37 CFR 1.182 and 37 CFR 1.183 have been paid by check.

For the reasons set forth below, the petition under 37 CFR 1.182 is granted. The reexamination prosecution is hereby continued, and prosecution of the proceeding is reopened to the extent set forth below.

For the reasons set forth below, the petition under 37 CFR 1.183 is dismissed as moot.

REVIEW OF FACTS

1) U.S. Patent No. 6,721,743 (the '743 patent) issued on April 13, 2004.

2) On May 26, 2004, a third party requester filed a request for *inter-partes* reexamination of the '743 patent, and the resulting proceeding was assigned control No. 95/000.043 (the '0043 reexamination proceeding). The request proposed rejection of the '743 patent claims over US Patent No. 6,594,640 issued to Postrel [hereinafter Postrel '640] on July 14, 2003.

3) On July 14, 2004, the Office mailed an Order granting reexamination for the '0043 reexamination proceeding, and the Order was accompanied by a first Office action rejecting all the claims as anticipated by the Postrel '640 reference.

4) On October 14, 2004 the Patent owner filed an amendment under 37 CFR 1.945 in response to the July 14, 2004 Office action.

5) On November 12, 2004, the third party requester filed comments under 37 CFR 1.947 on the patent owner's response of October 14, 2004.

6) On November 23, 2004, a Notice Re Defective Paper in *Inter Partes* Reexamination was issued, indicating that the patent owner Amendment of October 14, 2004 was not in compliance with 37 CFR 1.530(f)(1) & (2).

7) On December 23, 2004, the patent owner filed an Amendment in response to the Notice Re Defective Paper of November 23, 2004. Claims 1-3, 5 and 6 were amended, claim 8 was cancelled, and new claims 11-21 were added in this submission.

8) On January 11, 2005, the patent owner filed a Supplement Amendment to the patent owner Amendment of December 23, 2004, further amending claim 6.

9) On January 21, 2005, the third party requester filed comments under 37 CFR 1.947 directed to the patent owner Amendment of December 23, 2004, including an IDS citing USPN 6,820,061 issued to Postrel (hereinafter '061 Postrel), which is a continuation patent application of '640 Postrel. The '061 Postrel reference was submitted pursuant to 37 CFR 1.948(a)(3).

10) On February 9, 2005, the third party requester filed comments under 37 CFR 1.947 directed to the patent owner's Supplemental Amendment of January 11, 2005.

11) On March 22, 2005, the patent owner filed a first Supplemental Remarks in response to the third party requester's response and IDS of January 21, 2005.

12) On April 7, 2005, the patent owner filed a second Supplemental Remarks, including an IDS.

13) On April 11, 2005, an Action Closing Prosecution (ACP) under 37 CFR 1.949 was issued. The Office action rejected (a) claims 1-7, 9, 10, and 16-21 as anticipated by Postrel '640; (b) claims 11 and 12 as unpatentable over Postrel '640 in view of Jennings (US Patent No. 5,659,165); and (c) 13-15 as unpatentable over Postrel '640 in view of Jennings and further in view of Gutierrez-Sheris (US Patent Application Publication 2002/0029190). The action refused consideration of the Supplemental remarks filed March 22, 2005 as not complying with 37 CFR 1.111(a)(1)(2) as incorporated through 37 CFR 1.937(b).

14) On April 21, 2005, the third party requester filed a response under 37 CFR 1.947 to the patent owner first Supplemental Remarks of March 22, 2005 (see item 11 above).

15) On May 9, 2005, the third party requester filed a response under 37 CFR 1.947 to the patent owner second Supplemental Remarks of April 7, 2005 (see item 12 above).

16) On June 10, 2005, the patent owner filed the Comments and Amendment After ACP in accordance with 37 CFR 1.951.

17) On Monday, July 11, 2005, the third party requester filed a response under 37 CFR 1.947 to the patent owner Comments and Amendment After ACP of June 10, 2005.

18) On January 12, 2006, a Right of Notice of Appeal (RAN) under 37 CFR 1.953 was issued and set one-month or thirty days (whichever is longer) for the patent owner to file a notice of appeal. The RAN did not enter the June 10, 2005 patent owner proposed Comments and Amendment After ACP.

19) On Monday, February 13, 2006, patent owner filed a Notice of Appeal.

20) Concurrently with the Notice of Appeal of February 13, 2006, patent owner filed a petition under 37 CFR 1.181 requesting withdrawal of the ACP and reopening of the prosecution.

21) Also on February 13, 2006, patent owner filed a petition denominated "Petition under 37 CFR 1.182 – Questions Not Specifically Provided For" requesting relief similar to that which would be in effect if RCR practice would be enacted. This petition is being addressed in the present decision.

22) A petition under 37 CFR 1.183 requesting suspension of the rules prohibiting extensions of time was filed concurrently with the Notice of Appeal on February 13, 2006. This petition is also being addressed in the present decision.

23) Patent owner filed an Appeal Brief under 37 CFR 41.67 on April 13, 2006.

24) Third party requester filed a Respondent Brief under 37 CFR 41.68 on Monday, May 15, 2006.

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 Action Closing Prosecution received in the Office on June 10, 2005.[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 will no longer be ordered on the basis of a

[1] Item 16 in the Review of Facts.
[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

"substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated:

> "[A] patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an *ex parte* reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including 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."
>
> "Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect."

Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) is now available via a 37 CFR 1.182 petition in appropriate circumstances.

As with a Request for Continued Examination (RCE) in an application, an RCR must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the proposed RCR practice includes a requirement that the filing of a RCR 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.

In this instance, as stated by the petitioner: "[O]n January 12, 2006, the USPTO issued A Right of Notice of Appeal, in which the Examiner did not enter the patent owner proposed Comments and Amendment After ACP." The Examiner rendered an extensive decision explaining that the Amendment After ACP would not to be entered because it did not meet the provisions of 37 CFR 1.116(b). (RAN at page 3, paragraph #5 and page 7, paragraph #12.) Of particular interest here is that patent owner presented a proposed amendment cancelling 1 pending claim and amending 18 of the 19 remaining pending claims. The Examiner stated: "[T]he proposed amendment is quit extensive, and would certainly require much more than a cursory review." (Right of Appeal Notice at p. 9).

Based on the facts and circumstances of the present situation, it is found that the amendment after-final rejection furthers the prosecution of the reexamination proceeding, and provides the requisite *bona fide* effort by the patent owner to advance the prosecution.

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 (1) the Amendment After ACP received June 10, 2005 and (2) the Comments of the Third Party Requester received July 11, 2005. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After ACP, the Third Party's Comments, and all papers submitted as part of the appeal process. The Examiner will then issue an Office action treating these papers as responses of patent owner and a third party requester comment's thereon received **after** a first Office action.

DECISION ON PETITION UNDER 37 CFR 1.183

Petitioner requests a waiver of the rule prohibiting extension of time for the filing of the appeal brief until after decisions are rendered on the petitions under 37 CFR 1.181 and 37 CFR 1.182 filed February 13, 2006.

Patent owner timely filed[3] a Brief on Appeal on April 13, 2006. Accordingly, no extension of time nor waiver of any rule was necessary and no further relief can be provided. Accordingly, the petition is dismissed as moot.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The petition under 37 CFR 1.183 is dismissed as moot.

3) The prosecution of the present '0043 *inter-partes* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted under 37 CFR 1.182 absent a showing of extraordinary circumstances.

4) The closing of prosecution rendered via the ACP mailed 11April 2005 is withdrawn, and prosecution of the proceeding is reopened.

5) The Amendment After Action Closing Prosecution received July 10, 2005 and the requester comments filed July 11, 2005 will be entered by the Technology Center, and will then be considered by the examiner. These papers (and all papers submitted relating to the appeal process) will be treated as a response by patent owner and a third party comments received **after** a first Office action.

[3] Item 23 in the Review of Facts.

6) A decision denying the petition under 37 CFR 1.181 (requesting withdrawal of the ACP and reopening of the prosecution) is being mailed on even date with this decision.

7) The reexamination proceeding is being forwarded to the Technology Center for further handling and examination not inconsistent with this decision.

8) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

September 12, 2006
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CENTRAL REEXAMINATION UNIT

Mehdi D. Sheikerz STAAS & HALSEY LLP 1201 New York Ave, N.W., Suite 700 Washington, D.C. 20005	FOR OWNER
Anthony R. Barkume, P.C. 20 Gateway Lane Manorville, New York 11949	FOR THIRD PARTY REQUESTER
In re Inter Partes Reexamination of: U.S. Patent No. 6,721,743 Inter Parte Reexamination Control No. 95/000,043 Filed: May 26, 2004 For: VALUE POINTS EXCHANGING MANAGING METHOD AMONGS FIRST AND SECOND BUSINESS ENTITIES WHERE VALUE POINTS AVAILABLE TO ON-LINE CUSTOMER OBTAINING GOODS OR SERVICES	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on the petition under 37 CFR 1.181, filed on 13 February 2006, for withdrawal of ACP to reopen prosecution and for entering the patent owner comments and amendments after ACP.

BACKGROUND

On 26 May 2004, the third party requester filed the above-identified Inter Parte Reexamination. The requester cited USPN 6,594,640 to Postrel (hereinafter '640 Postrel) and proposed rejection of the '743 patent claims based upon '640 Postrel reference.

On 14 July 2004, a non-final Office Action with the order granting Inter Parte Reexamination was issued. All of the patent claims 1-10 were rejected as being anticipated by ' 640 Postrel.

On 14 October 2004, the patent owner filed an Amendment in response to the Office Action of 14 July 2004.

On 12 November 2004, the third party requester filed a response to the patent owner Amendment of 14 October 2004.

On 23 November 2004, a Notice Re Defective Paper in Inter Parte Reexamination was issued, indicating that the patent owner Amendment of 14 October 2004 was not in compliance with 37 CFR 1.530(f)(1) & (2).

On 23 December 2004, the patent owner filed an Amendment in response to the Notice Re Defective Paper of 23 November 2004.

On 10 January 2005, the patent owner filed a Supplement Amendment to the patent owner Amendment of 23 December 2004, amending claim 6.

On 21 January 2005, the third party requester filed a response to the patent owner Amendment of 23 December 2004, including an IDS citing USPN 6,820,061 issued to Postrel (hereinafter '061 Postrel) which is a continuation patent application of '640 Postrel. The '061 Postrel reference was being submitted pursuant to 37 CFR 1.948(a)(3).

On 09 February 2005, the third party requester filed a response to the patent owner Supplemental Amendment of 10 January 2005.

On 22 March 2005, the patent owner filed a first Supplemental Remarks in response to the third party requester's response and IDS of 21 January 2005.

On 07 April 2005, the patent owner filed a second Supplemental Remarks, including an IDS.

On 11 April 2005, an Action Closing Prosecution (ACP) was issued.

On 21 April 2005, the third party requester filed a response to the patent owner first Supplemental Remarks of 22 March 2005.

On 09 May 2005, the third party requester filed a response to the patent owner second Supplemental Remarks of 07 April 2005.

On 10 June 2005, the patent owner filed the Comments and Amendment After ACP.

On 11 July 2005, the third party requester filed a response to the patent owner Comments and Amendment After ACP of 10 June 2005.

On 12 January 2006, a Right of Notice of Appeal (RAN) was issued and set one-month or thirty days (whichever is longer) for the patent owner to file a notice of appeal.

REGULATIONS AND PRACTICES

The relevant portions of the Regulations and Practices are reproduced below. Emphasis is added to draw attention to the critical phrases.

37 CFR 1.116(b)(3) states that:

> An amendment touching the merits of the application or patent under reexamination **may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented**.

37 CFR 1.948(a) states that:

> (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
>
> (1) which is necessary to rebut a finding of fact by the examiner;
>
> (2) which is necessary to rebut a response of the patent owner; or
>
> (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and **must include a discussion of the pertinency of each reference to the patentability of at least one claim**.

37 CFR 1.949 states that:

> 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.

37 CFR 1.951 states that:

> (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.
>
> (b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

DECISION

Pursuant to 37 CFR 1.949, the ACP of 11 April 2005 is proper and shall not be withdrawn to reopen prosecution. The ACP did not include a new ground of rejection.

Pursuant to 37 CFR 1.951 and 37 CFR 1.116(b)(3), the Comments and Amendment after ACP shall not be admitted if the patent owner failed to provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. The patent owner's reason for entering the Comments and Amendment after ACP is that the '061 Postrel was cited following the order for inter parte reexamination. It is pointed out that the '061 Postrel was submitted pursuant to 37 CFR 1.948(a)(3) and not submitted pursuant to 37 CFR 1.948(a)(1) & (2). Further, the ACP of 11 April 2005 did not rely on the '061 Protrel to render a rejection of claims and the ground of rejections in the ACP and in the non-final Office Action of 14 July 2004 were the same. Thus, the Comments and Amendment after ACP of 10 June 2005 shall not be admitted.

Further review of the petition under 37 CFR 1.181 filed on 13 February 2006, it appears that the patent owner is seeking relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect. This is a petition under 37 CFR 1.182 that was filed concurrently with the petition being reviewed by the undersigned.

For the above stated reason, the petition is **DISMISSED**.

The instant inter parte reexamination proceeding is being forwarded to the Office of Patent Legal Administration to consider and decide the petition under 37 CFR 1.182 filed on 13 February 2006.

Any inquiry concerning this decision should be directed to Special Program Examiner, Vincent N. Trans, whose telephone number is (571) 272-3613.

James Dwyer, Director
Technology Center 2100
Computer Architecture, Software, and
Information Security

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FOR THIRD PARTY REQUESTER

In re Inter Partes Reexamination of:
U.S. Patent No. 6,721,743
Inter Parte Reexamination Control No. 95/000,043
Filed: May 26, 2004
For: VALUE POINTS EXCHANGING MANAGING METHOD AMONGS FIRST AND SECOND BUSINESS ENTITIES WHERE VALUE POINTS AVAILABLE TO ON-LINE CUSTOMER OBTAINING GOODS OR SERVICES

DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on the petition under 37 CFR § 1.181, filed on 12 March 2008, for withdrawal of ACP mailed 08 March 2007 to reopen prosecution and for entering the Patent Owner Comments and Amendment after ACP of 07 May 2007.

BACKGROUND

On 26 May 2004, the third party requester filed the above-identified Inter Parte Reexamination. The requester cited USPN 6,594,640 to Postrel (hereinafter '640 Postrel) and proposed rejection of the '743 patent claims based upon '640 Postrel reference.

On 14 July 2004, a non-final Office Action with the order granting Inter Parte Reexamination was issued. All of the patent claims 1-10 were rejected as being anticipated by ' 640 Postrel.

On 14 October 2004, the patent owner filed an Amendment in response to the Office Action of 14 July 2004.

On 12 November 2004, the third party requester filed a response to the patent owner Amendment of 14 October 2004.

On 23 November 2004, a Notice Re Defective Paper in Inter Parte Reexamination was issued, indicating that the patent owner Amendment of 14 October 2004 was not in compliance with 37 CFR § 1.530(f)(1) & (2).

On 23 December 2004, the patent owner filed an Amendment in response to the Notice Re Defective Paper of 23 November 2004.

On 10 January 2005, the patent owner filed a Supplement Amendment to the patent owner Amendment of 23 December 2004, amending claim 6.

On 21 January 2005, the third party requester filed a response to the patent owner Amendment of 23 December 2004, including an IDS citing USPN 6,820,061 issued to Postrel (hereinafter '061 Postrel) which is a continuation patent application of '640 Postrel. The '061 Postrel reference was being submitted pursuant to 37 CFR § 1.948(a)(3).

On 09 February 2005, the third party requester filed a response to the patent owner Supplemental Amendment of 10 January 2005.

On 22 March 2005, the patent owner filed a first Supplemental Remarks in response to the third party requester's response and IDS of 21 January 2005.

On 07 April 2005, the patent owner filed a second Supplemental Remarks, including an IDS.

On 11 April 2005, an Action Closing Prosecution (ACP) was issued.

On 21 April 2005, the third party requester filed a response to the patent owner first Supplemental Remarks of 22 March 2005.

On 09 May 2005, the third party requester filed a response to the patent owner second Supplemental Remarks of 07 April 2005.

On 10 June 2005, the patent owner filed the Comments and Amendment after ACP.

On 11 July 2005, the third party requester filed a response to the patent owner Comments and Amendment after ACP of 10 June 2005.

On 12 January 2006, a Right of Notice of Appeal (RAN) was issued and set one-month or thirty days (whichever is longer) for the patent owner to file a notice of appeal.

On 13 February 2006, a Notice of Appeal from the examiner to the Board of Patent Appeals and Interferences was filed along with petitions under 37 CFR §§§ 1.181, 1.182 and 1.183.

On 12 April 2006, a Reissue application having serial number 11/402,336 was filed.

On 13 April 2006, the Patent Owner Appeal Brief was filed.

On 15 May 2006, the Third Party Requester filed a Respondent Brief.

On 13 September 2006, the Patent Owner's petition under 37 CFR § 1.181 was dismissed and the Patent Owner's petition under 37 CFR § 1.182 was granted to continue examination by reopening prosecution and entering the Comments and Amendment after ACP of 10 June 2005.

On 08 December 2006, a Sua Sponte Decision was issued to suspend all actions in the reissue application until the *inter partes* reexamination is completed.

On 08 March 2007, a 2nd ACP rejecting all claims 1, 3-7 and 9-21 was issued.

On 07 May 2007, the Patent Owner filed Comments and Amendment after 2nd ACP. The amendment after 2nd ACP added new claim 22 without canceling any corresponding claim(s).

On 06 June 2007, the Third Party Requester filed a response to the Patent Owner Comments and Amendment after 2nd ACP.

On 11 February 2008, a 2nd Right of Appeal Notice (RAN) was issued refusing entry of the Patent Owner Amendment and Remarks of 07 May 2007 after the 2nd ACP.

On 12 March 2008, the instant petition under 37 CFR § 1.181 was filed along with a petition under 37 CFR § 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect.

REGULATIONS AND PRACTICES

The relevant portions of the Regulations and Practices are reproduced below. Emphasis is added to draw attention to the critical phrases.

37 CFR § 1.116(b) states that:

> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (3) An amendment touching the merits of the application or patent under reexamination **may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented**.

37 CFR § 1.949 states that:

> 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.

37 CFR § 1.951(a) states that:

> 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.

37 CFR § 1.953 states that:

> (a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an inter partes reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.
>
> (b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an inter partes reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.
>
> (c) 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.

MPEP 2672 (III) states:

> **Once an ACP that is not premature has been entered in a reexamination proceeding, the patent owner no longer has a right to unrestricted further prosecution. Consideration of the proposed amendments submitted after ACP (pursuant to 37 CFR § 1.951(a)) will be governed by the strict standards of 37 CFR §1.116.** *The patent owner's submission of comments under 37 CFR § 1.951(a) must be limited to the issues raised in the ACP*. If the submission addresses issues not already raised in the ACP, then the comments will be returned. No additional opportunity will be given for the patent owner to correct the defect unless a petition under 37 CFR § 1.183 is granted to waive 37 CFR § 1.951 as to its one opportunity limitation for the patent owner comment. If such a petition under 37 CFR § 1.183 is granted and the patent owner submits corrected comments under 37 CFR § 1.951(a), the third party requester may then once file supplemental comments responding to the patent owner's corrected comments within one month from the date of service of the patent owner's corrected comments on the third party requester.

DECISION

A review of the decision on petition under 37 CFR § 1.182 mailed 13 September 2006 (see page 5) indicates that the 2nd ACP of 08 March 2007 is not premature pursuant to 37 CFR § 1.949; thus, the ACP of 08 March 2007 is proper and shall not be withdrawn to reopen prosecution.

Pursuant to 37 CFR § 1.951 and 37 CFR § 1.116(b), the Comments and Amendment after ACP filed on 07 May 2007shall not be admitted since the proposed new claim 22 without canceling any corresponding claims does not comply with 37 CFR § 1.116(b)(1) or (b)(2) and the patent owner failed to provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented as set forth in 37 CFR § 1.116(b)(3). The patent owner's reasons for entering the proposed new claim 22 after 2nd ACP is that (1) in Patent Owner's opinion claim 22 is allowable over the applied Postrel reference and (2) Postrel is not proper prior art with regard to the new limitation "managing ... **goods or services solely provided by the first business entity** ...". As pointed out in the 2nd RAN of 11 February 2008, this new limitation "goods or services solely provided by the first business entity" in the proposed new claim 22 has not been previously considered by the Office; thus, would require further search and/or consideration. Further, it is pointed out that MPEP 2672(III) clearly states that the patent owner no longer has a right to unrestricted further prosecution once an ACP that is not premature has been entered in a reexamination proceeding and states that consideration of the proposed amendments submitted after ACP will be governed by the strict standards of 37 CFR §1.116. A further review of the instant petition, it evolves that the Patent Owner never contended such a limitation "goods or services solely provided by the first business entity" was presented and considered prior to the 2nd ACP. Thus, the Comments and Amendment after ACP of 07 May

2007 shall not be admitted at this time and the 2nd RAN mailed on 11 February 2008 is not premature pursuant to 37 CFR § 1.953.

And further review of the instant petition under 37 CFR § 1.181, it appears that the patent owner is seeking relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect. This is a petition under 37 CFR 1. § 182.

For the above stated reason, the petition under 37 CFR § 1.181 is **DENIED**.

The instant inter parte reexamination proceeding is being forwarded to the Office of Patent Legal Administration to consider and decide the petition, filed on 12 March 2008, under 37 CFR § 1.182.

Any inquiry concerning this decision should be directed to Vincent N. Trans whose telephone number is (571) 272-3613.

Jack Harvey, Director
Technology Center 2100
Computer Architecture, Software, and
Information Security

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JUL 21 2008

CENTRAL REEXAMINATION UNIT

Mehdi D. Sheikerz
Staas & Halsey, LLP
1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005

(For Patent Owner)

Anthony R. Barkume, P.C.
20 Gateway Lane
Manorville, New York 11949

(For Requester)

In re: Hisashi Sakakibara
Reexamination Proceeding
Control No.: 95/000,043
Filed: May 26, 2004
For: U.S. Patent No.: 6,721,743

: DECISION ON PETITION
: TO CONTINUE
: *INTER PARTES*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the March 12, 2008 patent owner petition, denominated "PETITION UNDER 37 C.F.R. 1.182 - QUESTIONS NOT SPECIFICALLY PROVIDED FOR."

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 petitions under 37 CFR 1.182 and 37 CFR 1.183 have been charged to Deposit account DA 19-3935.

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

BACKGROUND

U.S. Patent No. 6,721,743 ("the '743 patent") issued to Hisashi Sakakibara on April 13, 2004. An order in reexamination control no. 95/000,043 ("the '0043 proceeding") granting *inter partes* reexamination of the '743 patent was mailed on July 14, 2004. The Order was accompanied by a first Office action rejecting all pending claims of the '743 patent.

Prosecution of the proceeding has progressed to the stage that a Right of Appeal Notice ("RAN") was mailed on January 12, 2006, setting a 30 day period for the patent owner to file a notice of appeal.

Patent owner filed a timely Notice of Appeal on Monday February 13, 2006. Concurrently, patent owner filed a petition denominated "Petition under 37 CFR 1.182 – Questions Not Specifically Provided For" requesting relief similar to that which would be in effect if RCR practice would be enacted. In a decision mailed September 13, 2006, the Office granted the petition under 37 CFR 1.182, reopening prosecution and directing the examiner to consider all

patent owner papers submitted subsequent to the action closing prosecution mailed April 11, 2005. The September 13, 2006 decision provided:

> ....the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of (1) the Amendment After ACP received June 10, 2005 and (2) the Comments of the Third Party Requester received July 11, 2005. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After ACP, the Third Party's Comments, and all papers submitted as part of the appeal process. The Examiner will then issue an Office action treating these papers as responses of patent owner and a third party requester comment's thereon received **after** a first Office action.[1] ...
>
> The prosecution of the present '0043 *inter-partes* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted under 37 CFR 1.182 absent a showing of extraordinary circumstances.[2] (Emphasis in the original.)

Prosecution was reopened and has now progressed to the stage that a second RAN was issued on February 11, 2008, setting a 30 day period for the patent owner to file a notice of appeal. Patent owner filed a timely Notice of Appeal on March 12, 2008. Concurrently, patent owner filed (1) a "Petition under 37 CFR 1.181 to Enter Patent Owner Comments and Amendment after ACP and to Reopen Prosecution" and (2) a petition denominated "Petition under 37 CFR 1.182 – Questions Not Specifically Provided For" requesting continued reexamination for the present proceeding. The petition under 37 CFR 1.182 is being addressed in the present decision.

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 Action Closing Prosecution received in the Office on May 7, 2007.

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."[3] Notice was provided therein that a second (or subsequent) reexamination will 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. The Notice advised patent owners that relief from closing of prosecution in the form of a continuation of the reexamination prosecution (after a final Office action) was made available via a 37 CFR 1.182 petition in appropriate circumstances. However, this relief is

---

[1] Page 5 of the "Decision on Petition to Continue Inter partes Reexamination Proceedings", mailed September 13, 2006 in reexamination proceeding 95/000,043

[2] Item 3 in "Conclusion" on page 5 of the "Decision on Petition to Continue Inter partes Reexamination Proceedings", mailed September 13, 2006 in reexamination proceeding 95/000,043

[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

restricted in nature, as the statutory mandate for special dispatch in reexamination proceedings is still paramount.

In this instance, continuing prosecution was previously granted, already delaying the conclusion of the '043 proceeding, and patent owner was advised that no further such relief would be granted absent a showing of extraordinary circumstances. Prosecution has now progressed to the point that the Patent owner's Brief on Appeal under 37 CFR 41.67 and the Third Party's Respondent Brief under 37 CFR 41.68 have been filed. There is no showing of extraordinary circumstances that would justify withdrawing the present proceeding from its advanced stage in the appeal process. It is noted that the arguments regarding the propriety of the examiner's action in closing prosecution and/or non-entry of various papers are matters within the jurisdiction of the Technology Center and, accordingly, have been addressed in the decision on the petition under 37 CFR 1.181 filed March 12, 2008, and such arguments do not present an extraordinary circumstance to justify the relief requested in the present petition.

Since patent owner's petition does not establish extraordinary circumstances, the petition is dismissed.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) A decision by the Technology Center Director denying the petition under 37 CFR 1.181 (requesting withdrawal of the ACP and reopening of the prosecution) is being mailed on even date with this decision.

3) The reexamination proceeding is being forwarded to the Technology Center for further handling and examination not inconsistent with this decision.

4) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

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

July 18, 2008
C:\Kiva\Kenpet7\95_0043_182-second_RCR_dismiss.doc

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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.
95/000,043	05/26/2004	6721743	370-031	5307

7590 12/14/2009

Staas and Halsey LLP
Suite 700 1201 New York Avenue NW
Washington, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BARKUME & ASSOCIATES, P.C.
20 GATEWAY LANE
MANORVILLE, NY 11949

Date:
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DEC 14 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000043
PATENT NO. : 6721743
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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Staas and Halsey LLP
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(For Patent Owner)

MAILED

Anthony R. Barkume, PC
20 Gateway Lane
Manorville, NY 11949

(For Requester) DEC 14 2009

CENTRAL REEXAMINATION UNIT

In re Sakakibara
Reexamination Proceeding
Control No.: 95/000,043
Filed: May 26, 2004
For: U.S. Patent No. 6,721,743

: DECISION *SUA*
: *SPONTE* WAIVING
: RULES UNDER 37 CFR
: 1.183

This is a decision under 37 CFR 1.183 *sua sponte* waiving the provisions of 37 CFR 1.943(c) to the extent set forth below.

35 U.S.C. § 314 provides, in relevant part:

> Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of

words contained in the brief.

The appeal brief filed May 12, 2008 fails to comply with 37 CFR 1.943(c) as follows: the brief contains in excess of thirty pages and fails to include a certificate of word count certifying the brief contains 14,000 words or less.

The respondent brief filed June 12, 2008 fails to comply with 37 CFR 1.943(c) as follows: the brief contains in excess of fifteen pages and fails to include a certificate of word count certifying the brief contains 7,000 words or less.

The rebuttal brief filed January 21, 2009 fails to comply with 37 CFR 1.943(c) as follows: the brief contains in excess of fifteen pages and fails to include a certificate of word count certifying the brief contains 7,000 words or less.

An examiner's answer has been prepared and mailed in this proceeding. This issue was not raised by the examiner or by the opposing party, and apparently did not prevent the examiner or the opposing party from treating the issues in this appeal on their merits. At this point in time, requiring a new appeal brief, respondent brief and rebuttal brief would require a response period for the new brief, a new examiner's answer, and a response period following the examiner's answer, which would run contrary to the statutory mandate of 35 U.S.C. § 314 that "all inter partes reexamination proceedings ... including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

Based on the particular facts and circumstances of this proceeding, coupled with the fact that the briefs have already been addressed in an examiner's answer and the mandate for special dispatch in *inter partes* reexamination proceedings, the requirements of 37 CFR 1.943(c) are hereby waived for the above noted briefs in this reexamination proceeding.

CONCLUSION

1. The provisions of 37 CFR 1.943(c) are hereby waived for appeal brief of May 12, 2008, the respondent brief of June 12, 2008 and the rebuttal brief of January 21, 2009, in this *inter partes* reexamination proceeding.

2. Telephone inquiries with regard to this decision should be directed to Jessica Harrison, at (571) 272 - 4449.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,049	08/27/2004	6651618	E025 7001	8921

7590 08/01/2008

Finnegan Henderson Farabow Garrett
& Dunner LLP
901 New York Avenue NW
Washington, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/01/2008

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LOUIS T. ISAF
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P.O. BOX 7037
ATLANTA, GA 30357-0037

MAILED

AUG 0 1 2008

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,049*.

PATENT NUMBER *6,651,618*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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

(For *Inter Partes* Requester)

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

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

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

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

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

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

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

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

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

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

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

Under 37 CFR 1.989(a):

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

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

In accordance with 37 CFR 1.989 (a), the 95/000,049 and 90/008,927 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, the *ex parte* reexamination was filed by the patent owner; thus, there is no *ex parte* reexamination third party requester.

B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester should be directed:

by Mail to:

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

by hand to:

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

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

C. Amendments:

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

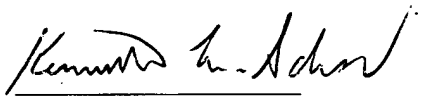
Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,049 and *ex parte* Reexamination Control No. 90/008,927 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course. The resolution of the statutory disclaimer under 37 CFR 1.321(a) filed by the patent owner on December 28, 2007, for the '618 patent, is to be taken into account.

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



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

July 31, 2008
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901 New York Avenue
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(For Patent Owner)

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SEP 25 2007

CENTRAL REEXAMINATION UNIT

Blakely Sokoloff Taylor
& Zafman
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025

(For *Inter Partes* Requester)

In re Weber et al.
Ex parte Reexamination
Proceeding
Control No. 90/007,885
Filed: January 20,2006
For: U.S. Patent No. 6,688,280

In re Weber et al.
Inter partes Reexamination
Proceeding
Control No. 95/000,050
Filed: September 17, 2004
For: U.S. Patent No. 6,688,280

DECISION TO MERGE
REEXAMINATION PROCEEDINGS

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

REVIEW OF THE FACTS

1. United States Patent Number 6,688,280 issued February 10, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,050 was filed September 14, 2004,by Clyde C. Bryant for Entec Engine Corporation, the real party in interest.

3. An order and an office action for reexamination of *inter partes* reexamination Control Number 95/000,050 was mailed on December 10, 2004.

4. On January 24, 2005, patent owner filed, in the '050 proceeding, a response to the Office action.

5. On numerous dates after January 24, 2005, patent owner filed, in the '050 proceeding, an IDS submission under 37 CFR 1.933 and 37 CFR 1.555(a).

6. On February 25, 2005, requester filed, in the '050 proceeding, comments after the patent owner's response.

7. On September 22, 2005, examiner mailed an Office action closing prosecution, in the '050 proceeding.

8. On October 24, 2005,patent owner filed, in the '050 proceeding, a response to the Office action closing prosecution.

9. On November 25, 2005, requester filed, in the '050 proceeding, comments after the patent owner's response to the action closing prosecution.

10. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,885 was filed January 20, 2006, by the patent owner.

11. On January 25, 2006, patent owner filed, in the '885 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

12. An order for reexamination of *ex partes* reexamination Control Number 90/007,885 was mailed on February 8, 2006.

13. On numerous dates after February 8, 2006, patent owner filed, in the '885 proceeding, Information Disclosure Statement (IDS) submissions under 37 CFR 1.555(a).

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."

The general policy of the Office is that an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. Pursuant to MPEP 2686.01:

> "If a second request for reexamination is filed where a certificate

> will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings."

The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. In the present instance,a complete examination can be given to both proceedings incorporating all of the issues raised in both proceedings. In the *ex parte* reexamination (control No. 90/007,885),a request for reexamination was filed by patent owner on January 25, 2006 and an order for reexamination was mailed on February 8, 2006. On January 25, 2006, the patent owner filed a statement in the *ex parte* reexamination pursuant to 37 CFR 1.565(a). An *inter partes* reexamination (Control No. 95/000,050) request was filed on September 14, 2004 and the order granting the reexamination was mailed on December 10, 2004. Accordingly, the two proceedings are ripe for a consolidated examination thereof. On January 25, 2006, the patent owner filed a notice pursuant to 37 CFR 1.985(a) apprising the Office of the *inter partes* reexamination (Control No. 95/000,050) filed on January 25, 2006.

In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a),the 95/000,050 and 90/007,885 reexamination proceedings <u>are merged</u>. 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

Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. Since the claims <u>are</u> 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. While the rights of any third party requester <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.

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, filed by the patent owner and filed by 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 by the third party requester are to be directed:

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

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

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

Patent owner and requester are reminded that every paper filed with the Office in the merged proceeding subsequent to this Decision must be served on the other party (in this instance, there are two parties, patent owner and requester), 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), 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, excess claim 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 (a) will review the files to insure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

F. Point in Prosecution That the Merged Proceeding Will Be Examined:

MPEP 2686.01 provides:

> "After the second reexamination proceeding is merged with the first reexamination proceeding, prosecution will be conducted at the most advanced point possible for the first proceeding. Thus, if a final rejection (a Right of Appeal Notice) has been issued in the first proceeding, prosecution will ordinarily be reopened to consider the substantial new question of patentability presented in the second request unless the examiner concludes that no new rejection or change of position is warranted. Also, the patent owner will be provided with an opportunity to respond to any new rejection in a merged reexamination proceeding prior to an Action Closing Prosecution (ACP) being issued."

Accordingly, the examination may be conducted at the more advanced stage of the present *inter partes* reexamination proceeding (as opposed to that of the *ex parte* reexamination proceeding), unless the examiner concludes that a new rejection or change of position is warranted.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,050 and *ex parte* Reexamination Control No. 90/007,885 are *sua sponte* merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination proceeding is being forwarded via the Central Reexamination Unit (CRU) to the examiner for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Kery A. Fries, Senior Legal Advisor, at (571)272-7757.

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

September 23, 2007
C:\kiva\petmerger\Reexreex\95_0050 + 7885 _most advanced stage_PO-EP-reex

Patent owner filed the EP request
Claims are the same in both proceedings
Both are IFW files

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 29 2007

CENTRAL REEXAMINATION UNIT

Finnegan, Henderson, Farabow
Garrett & Dunner
901 New York Avenue
Washington, DC 20001-4413

(For Patent Owner)

Louis T. Isaf, Esq.
Womble,Carlyle, Sandridge, & Rice PLLC
PO Box 7037
Atlanta, GA 30357-0037

(For *Inter Partes* Requester)

In re Weber et al. *Ex parte* Reexamination Proceeding Control No. 90/007,885 Filed: January 20,2006 For: U.S. Patent No. 6,688,280	DECISION TO MERGE REEXAMINATION PROCEEDINGS
In re Weber et al. *Inter partes* Reexamination Proceeding Control No. 95/000,050 Filed: September 17, 2004 For: U.S. Patent No. 6,688,280	

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 the time.

This decision is being re-mailed to correct the correspondence address of the third party requester. The proper law firm representing the third party requester is Womble, Carlyle, Sandridge & Rice PLLC.

REVIEW OF THE FACTS

1. United States Patent Number 6,688,280 issued February 10, 2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,885 was filed January 20, 2006, by the patent owner.

3. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,050 was filed September 14, 2004,by Clyde C. Bryant for Entec Engine Corporation, the real party in interest.

Number 90/007,885 was mailed on February 8, 2006.

5. On numerous dates after February 8, 2006, patent owner filed, in the '885 proceeding, an IDS submission under 37 CFR 1.555(a).

6. On January 25, 2006, patent owner filed, in the '885 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

7. An order and an office action for reexamination of *inter partes* reexamination Control Number 95/000,050 was mailed on December 10, 2004.

8. On January 24, 2005, patent owner filed, in the '050 proceeding, a response to the Office action.

9. On February 25, 2005, requester filed, in the '050 proceeding, a response to the patent owner's comments.

10. On September 22, 2005, examiner mailed an Office action closing prosecution, in the '050 proceeding.

10. On October 24, 2005,patent owner filed, in the '050 proceeding, a response to the Office action closing prosecution.

11. On November 25, 2005, requester filed, in the '050 proceeding, a response to patent owner's comments after action closing prosecution.

12. On numerous dates after November 25, 2006, patent owner filed, in the '050 proceeding, an IDS submission under 37 CFR 1.933 and 37 CFR 1.555(a).

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."

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In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a),the 95/000,050 and 90/007,885 reexamination proceedings <u>are merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

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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. While the rights of any third party requester <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.

B. Papers mailed/filed:

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All papers filed by the patent owner and the third party requester should be directed:

By Mail to: **Mail Stop *Inter Partes* Reexam**
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: **(571) 273-0100**
Central Reexamination Unit

By hand: **Customer Service Window**
Randolph Building
401 Dulaney 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 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), 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.

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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.

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,050 and *ex parte* Reexamination Control No. 90/007,885 are *sua sponte* merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination proceedings are being forwarded via the Central Reexamination Unit and OPLA 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 Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at (571)272-7757.

Steve Marcus
Legal Advisor
Office of Patent Legal Administration

September 28, 2007

Patent owner filed the EP request
Claims are the same in both proceedings
Both are IFW files

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,052	09/23/04	6636021	

EXAMINER
Minh Nguyen

ART UNIT	PAPER
3992	

McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005-3096

DATE MAILED:

02/23/07

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

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Dickstein Shapiro
Morin & & Oshinsky LLP
1177 Avenue of Americans 6th Ave.
41th Floor
New York NY 10036-2714

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

REEXAMINATION CONTROL NUMBER *95/000,052*.

PATENT NUMBER *6,636021*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3992*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MCDERMOTT WILL AND EMERY 600 13TH ST NW WASHINGTON, DC 20005	:	For Patent Owner
		MAILED FEB 23 2007 CENTRAL REEXAMINATION UNIT
Steven Weisburd DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 Avenue of the Americas (6th Ave) 41st Floor New York, NY 10036-2714	:	For Requester
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.956]
In re: Schenkel *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/000,052 Filed: September 23, 2004 For: US Patent No. 6,636,021	:	

This is a decision on the February 22, 2007, patent owner "Request for Extension of Time Under 37 CFR 1.956 To Response To The Office Action Closing Prosecution in Inter Partes Reexamination Under 37 CFR 1.951," requesting that the time for responding to the Action Closing Prosecution mailed January 26, 2007, be extended by one month.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution mailed January 26, 2007, which set a one month date for filing a response thereto. The request for extension is the first request for an extension of time with respect to the Action Closing Prosecution. The petition for extension of time was timely filed on February 22, 2007, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR § 1.956 Patent owner extensions of time in inter partes reexamination.

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

MPEP 2665 Extension of Time for Patent Owner Response
States in part.

> "Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period."

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

The patent owner's unavoidable change in counsel could not have been anticipated and as such is considered to be sufficient cause for granting the one-month extension of time.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why the extension of time should be granted, when considered with the implications of Action Closing Prosecution. It is only reasonable to presume that patent owner is indicating that patent owner has, and will continue to, behave as a prudent individual concerned with his most important business, and will begin formalizing and engaging alternative contingencies well in advance of the deadline for filing a response to the outstanding Office action, as extended by one month.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Action Closing Prosecution dated February 22, 2007 is **granted**.

2. The Patent Owner's response is due March 26, 2007.

3. Response may be submitted as follows:

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

mar

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

Andrus, Sceales, Starke, & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, Wisconsin 53202

(For Patent Owner)

Faegre & Benson LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901

(For *Inter Partes* Requester)

In re Jones et al.
Ex Parte Reexamination Proceeding
Control No. 90/007170
Filed: August 12, 2004
For: U.S. Patent No. 6,425,407

In re Jones et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,053
Filed: September 30, 2004
For U.S. Patent No. 6,425,407

DECISION TO MERGE REEXAMINATION PROCEEDINGS

MAILED

APR 19 2005

REEXAM UNIT

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 the time.

REVIEW OF THE FACTS

1. United States Patent Number 6,425,407, issued July 30, 2002.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,170 was filed by the patent owner on August 12, 2004.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,053, was filed on September 30, 2004, by Faerge & Benson, LLP for Ryko Manufacturing Company, the real party in interest.

4. An order for reexamination of *ex partes* reexamination Control Number 90/007,170 was mailed on October 19, 2004.

5. An order for reexamination of *inter partes* reexamination Control Number 95/000,053 was mailed on December 14, 2004.

6. On December 23, 2004, patent owner filed, in the '170 proceeding, a patent owner's statement under 37 CFR 1.530.

7. On February 28, 2005, the third party requester filed, in the '053 proceeding, a petition under 37 CFR 1.181, which is being addressed in a decision being mailed on the same date as the present decision is being mailed.

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 the present instance, the patent owner has urged in the paper titled "STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530" that the proceedings should not be merged. The patent owner argues that the merger would be inappropriate, because "the later-filed *inter partes* request duplicates and unnecessarily complicates the information in this *ex parte* request, while not raising a substantial new question of patentability."

The patent owner's position is not persuasive. The general policy of the Office is that an ex parte reexamination proceeding and an inter partes reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. Pursuant to MPEP 2686.01:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings."

The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. In the present instances, both reexamination proceedings are in the early stages, and a complete examination can be given to both proceedings incorporating all of the issues raised in both proceedings. The patent owner filed a request for *ex parte* reexamination(Control No. 90/000,170) on August 12, 2004 and an order for reexamination was mailed on October 19, 2004. On December 23,2004 the patent owner filed a statement pursuant to 37 CFR 1.530. The *inter partes requester filed a* request

for *inter partes* reexamination on September 30, 2004. An order for reexamination was mailed on December 14, 2004. Accordingly, the two proceedings are ripe for a consolidated examination thereof.

In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a), the 95/000,053 and 90/007,170 reexamination proceedings are 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

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:

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Central Reexamination Unit

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401 Dulaney 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 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), 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 (a) will review the files to insure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,053 and *ex parte* Reexamination Control No. 90/007,170 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination proceedings 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 Kery A. Fries, Senior Legal Advisor, at (571)272-7757.

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

April 13, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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Frank Morris (For Patent Owner)
David Owens
FREESCALE SEMICONDUCTOR, INC.
Law Department
7100 W. Parmer Lane
MD: TX32/PL02
Austin, TX 78729

MAILED
MAY 12 2006
REEXAM UNIT

Cheryl L. Farine (For Requester)
Hudak, Shunk &Farine, Co., LPA
2020 Front Stree, Suite 307
Cuyahoga Falls, Ohio 44221

Motorola, Inc.
Intellectual Property Section Corp.
Law Dept.
Suite R3163
PO Box 10219
Scottsdale, AZ 85271-0219 (Courtesy Copy)

In re MacQueen et al.	:
Inter Partes Reexamination	: **DECISION**
Proceeding	: **GRANTING**
Control Number 95/000,054	: **PETITION**
Filed: October 13, 2004	:
For: U.S. Patent No. 6,303,978	:

This is a decision on the March 30, 2006 patent owner paper titled "PETITION UNDER 37 C.F.R. 1.182."

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

In view of the relief requested, the March 30, 2006 patent owner paper is taken as a petition under both 37 CFR 1.182 and 37 CFR 1.183.

The petition is granted.

REVIEW OF FACTS

1. U.S. patent No. 6,303,978 (the '978 patent) issued on October 16, 2001.

2. On May 5, 2004, Freescale Semiconductor, Inc. (Freescale) filed a batch document to establish Freescale as owner for all patents listed in an attached spreadsheet, as opposed to Motorola, the prior owner. This batch document included a revocation of the previous power of attorney, power of attorney appointing new counsel, and a request to change the correspondence address for all patents listed in the batch request spreadsheet. The present '978 patent is one the patents listed in the spreadsheet .

3. A request for *inter partes* reexamination of the '978 patent, assigned control No. 95/000,054 (the '054 proceeding), was filed by a third party requester on October 13, 2004.

4. On January 11, 2005, reexamination was ordered for the '054 proceeding. This order was mailed to Motorola.

5. On June 29, 2005, a first Office action was mailed (again to Motorola), in which action all the claims (claims 1-29) of the '978 patent were rejected.

6. On October 24, 2005 Marsha Twitty of the Central Reexamination Unit called Patricia S. Goddard, as one of the attorneys of record, after several failed attempts to contact other listed attorneys of record, in order to determine if "patent owner" Motorola planned to file a response. Ms. Goddard indicated that Freescale Semiconductor was the patent owner, not Motorola.

7. On November 9, 2005 Ms. Goodard faxed in a proffered proof of the assignment recorded to Freescale Semiconductor Inc and the change in correspondence address to Examiner Steven Rao.

8. On February 16, 2006 a Notice of Intent to Issue a Reexam Certificate was mailed by the Office, noting that no response to the June 29, 2005 Office action had been received from the "patent owner" (Motorola).

9. On March 30, 2006, Freescale filed the present petition, requesting that the entire reexamination procedure is in error and should never have been ordered since the third party requestor failed to notify the patent owner of record; or alternatively, even if the entire reexamination procedure is not canceled, the reexamination certificate should not issue.

DECISION ON PETITION

At page 4 of the petition, it is stated:

"The USPTO erred by mailing the reexamination correspondences to the wrong address."

In response, the following is to be noted:

The attempted May 5, 2004 batch revocation of the previous power of attorney and appointment of the practitioners associated with Customer Number 23125 in the patent file of the '978 patent was ineffective, because the *Notice of Elimination of Batch Update Practice to Change Power of Attorney*, 1272 *OG* 24 (July 1, 2003) eliminated the batch update practice for a change of a power of attorney.

The May 5, 2004 "batch update" to make a change to the correspondence address for a listing of issued patents on a spreadsheet was effective to change the correspondence address of the '978 patent to the "Freescale" address (though such was in fact inadvertently not carried out); however, it was not effective to establish the "Freescale" address as the correspondence address of any reexamination proceeding directed to the '978 patent.

37 CFR 1.33 (c) provides:

> c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 11.5 and 11.11 of this subchapter, or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of §1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

Since the revocation and new power of attorney submitted by Freescale was not effective, the correspondence address for the present reexamination proceeding was that of the "Motorola" attorney. Thus, the Office did indeed properly mail the office action to the appropriate party and address in accordance with 37 CFR 1.33 (c) .

It is observed, however, that the *Notice of Elimination of Batch Update Practice to Change Power of Attorney* of July 2003 states: "....To change the power of attorney for the applications on the list, the batch update requestor will be instructed to submit a separate request....." In this instance, the Office failed to follow the guideline of its Notice, to "instruct" the batch update requestor (here, Freescale) to submit a separate request to change the power of attorney (to the attorneys

associated with a Customer Number) in each application on the spreadsheet. Accordingly, it is deemed a matter of equity to now permit Freescale some form of relief for the current situation.

Because the revocation and new power of attorney was **not** correctly submitted by Freescale Semiconductor, Inc., the correspondence address for the present proceeding remained that of Motorola's counsel, and the correspondence in this instance was mailed to Motorola pursuant to 37 CFR 1.33(c) which requires that all communications for the patent owner "*..will be directed to the attorney or agent of record (see § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 11.5 and 11.11 of this subchapter....*" However, had the Office seasonably instructed Freescale to submit a separate revocation and new power of attorney for the '978 patent pursuant to the guideline of its notice, Freescale would have been in a position to rectify this situation, such that the Freescale address would have been entered as the correspondence address for the present proceeding. Accordingly, pursuant to 37 CFR 1.183, the provisions of 37 CFR 1.33(c) are waived, *nunc pro tunc*, to establish the Freescale address as the correspondence address for the present proceeding at the time the correspondence for this proceeding was mailed. This being the case, the January 11, 2005 order for the '054 proceeding, and the Office communications that followed, are now deemed as not having been mailed to the correct address. Thus, the following action is taken:

(1) A copy of each of the Order mailed on January 11, 2005, the June 29, 2005 first Office action, and the February 16, 2006 Notice of Intent to Issue a Reexam Certificate is being supplied to Freescale with this decision.

(2) The February 16, 2006 Notice of Intent to Issue a Reexam Certificate is hereby vacated. The Order mailed on January 11, 2005, remains in force. The June 29, 2005 first Office action is being remailed with this decision.

(3) The period for response to the first Office action is set to expire TWO MONTHS from the date of mailing of the instant decision.

In addition, Freescale is required to file a revocation of the previous power of attorney and a power of attorney appointing new counsel for the '978 patent and the present '054 proceeding within **one month** from the date of this decision.

It is to be noted that Freescale is now on notice that its batch revocation and new power of attorney was ineffective. Accordingly, all other patents listed in the improper batch request of May 5, 2004, should be addressed.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.182/1.183 is **granted.**

2. The February 16, 2006 Notice of Intent to Issue a Reexam Certificate is hereby **vacated**.

3. The Order mailed on January 11, 2005, remains in force. The June 29, 2005 first Office action is being remailed with this decision.

4. The period for response to the first Office action being remailed with decision is set to expire **two months** from the date of mailing of the instant decision.

5. Freescale is required to file a revocation of the previous power of attorney and a power of attorney appointing new counsel, for the '978 patent and the present '054 proceeding within **one month** from the date of this decision. A failure to do so will result in the "Motorola" correspondence address being reinstated.

6. The reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for mailing of this decision. The CRU will include a copy of the Order mailed on January 11, 2005, the June 29, 2005 first Office action, and the February 16, 2006 a Notice of Intent to Issue a Reexam Certificate with this decision.

7. Any questions regarding this decision should be directed to Karen M. Hastings, Legal Advisor, Office of Patent Legal Administration at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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

Andrus, Sceales, Starke, & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, Wisconsin 53202
(For Patent Owner)

Faegre & Benson LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901
(For *Inter Partes* Requester)

In re Jones et al.
Ex parte Reexamination Proceeding
Control No. 90/007,169
Filed: August 12 , 2004
For: U.S. Patent No. 6,769,440

In re Jones et al.
Inter partes Reexamination Proceeding
Control No. 95/000,057
Filed: October 18, 2004
For: U.S. Patent No. 6,769,440

DECISION TO MERGE REEXAMINATION PROCEEDINGS

MAILED
APR 19 2005
REEXAM UNIT

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 the time.

REVIEW OF THE FACTS

1. United States Patent Number 6,769,440, issued August 3, 2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,169, was filed August 12, 2004, by the patent owner.

3. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,057 was filed October 18, 2004, by Faerge & Benson, LLP for Ryko Manufacturing Company, the real party in interest.

4. An order for reexamination of *ex partes* reexamination Control Number 90/007,169 was mailed on October 18, 2004.

5. On November 4, 2004, patent owner filed, in the '169 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

6. An order for reexamination of *inter partes* reexamination Control Number 95/000,057 was mailed on January 12, 2005.

7. On December 23, 2004, patent owner filed, in the '169 proceeding, a patent owner's statement under 37 CFR 1.530.

8. On February 28, 2005, the third party requester filed, in the '057 proceeding, a petition under 37 CFR 1.181, which is being addressed in a decision being mailed on the same date as the present decision is being mailed.

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 the present instance, the patent owner has urged in the paper titled "STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530" that the proceedings should not be merged. The patent owner argues that the merger would be inappropriate, because "the later-filed *inter partes* request duplicates and unnecessarily complicates the information in this *ex parte* request, while not raising a substantial new question of patentability."

The patent owner's position is not persuasive. The general policy of the Office is that an ex parte reexamination proceeding and an inter partes reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. Pursuant to MPEP 2686.01:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings."

The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. In the present instances, both reexamination proceedings are in the early stages, and a complete examination can be given to both proceedings incorporating

all of the issues raised in both proceedings. In the *ex parte* reexamination (control No. 90/007,169),a request for reexamination was filed by patent owner on August 12, 2004 and an order for reexamination was mailed on October 18, 2004. On November 4, 2004, the patent owner filed a notice pursuant to 37 CFR 1.565(a) apprising the Office of the *inter partes* reexamination (Control No. 95/000,057) filed on October 18, 2004. On December 23, 2004, the patent owner filed a statement in the *ex parte* reexamination pursuant to 37 CFR 1.530. An *inter partes* reexamination (Control No. 95/000,057) request was filed on October 18, 2004 and the order granting the reexamination was mailed on January 12, 2005. Accordingly, the two proceedings are ripe for a consolidated examination thereof.

In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a),the 95/000,057 and 90/007,169 reexamination proceedings <u>are merged</u>. 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

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. While the rights of any third party requester <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.

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 <u>both</u> 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 <u>both</u> files, for entry into each file.

All papers filed by the patent owner and the third party requester should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam

Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: **(571) 273-0100**
Central Reexamination Unit

By hand: **Customer Service Window**
Randolph Building
401 Dulaney 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 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), 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 (a) will review the files to insure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,057 and *ex parte* Reexamination Control No. 90/007,169 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination proceedings 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 Kery A. Fries, Senior Legal Advisor, at (571)272-7757.

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

April 13, 2005
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Andrus, Sceales, Starke, & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, Wisconsin 53202 (For Patent Owner)

Faegre & Benson LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901 (For *Inter Partes* Requester)

In re Jones et al.
Ex parte Reexamination Proceeding
Control No. 90/007,171
Filed: August 12 , 2004
For: U.S. Patent No. 6,551,145

In re Jones et al.
Inter partes Reexamination Proceeding
Control No. 95/000,058
Filed: October 28, 2004
For: U.S. Patent No. 6,551,145

DECISION TO MERGE
REEXAMINATION PROCEEDINGS

MAILED
APR 19 2005
REEXAM UNIT

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 the time.

REVIEW OF THE FACTS

1. United States Patent Number 6,551,415, issued April 22. 2003.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,171, was filed August 12, 2004, by the patent owner.

3. An order for reexamination of *ex partes* reexamination Control Number 90/007,171 was mailed on October 18, 2004.

4. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,058 was filed October 28, 2004, by Faerge & Benson, LLP for Ryko Manufacturing Company, the real party in

interest.

5. On November 29, 2004, patent owner filed, in the '171 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

6. On December 23, 2004, patent owner filed, in the '171 proceeding, a patent owner's statement under 37 CFR 1.530.

7. An order for reexamination of *inter partes* reexamination Control Number 95/000,058 was mailed on January 12, 2005.

8. On February 28, 2005, the third party requester filed, in the '058 proceeding, a petition under 37 CFR 1.181, which is being addressed in a decision being mailed on the same date as the present decision is being mailed.

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 the present instance, the patent owner has urged in the paper titled "STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530" that the proceedings should not be merged. The patent owner argues that the merger would be inappropriate, because "the later-filed *inter partes* request duplicates and unnecessarily complicates the information in this *ex parte* request, while not raising a substantial new question of patentability."

The patent owner's position is not persuasive. The general policy of the Office is that an ex parte reexamination proceeding and an inter partes reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. Pursuant to MPEP 2686.01:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings."

The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision

on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. In the present instances, both reexamination proceedings are in the early stages, and a complete examination can be given to both proceedings incorporating all of the issues raised in both proceedings. In *inter partes* reexamination 95/000,058, filed October 28, 2004, the Office mailed an order for reexamination on January 12, 2004. In ex parte reexamination filed on August 12, 2004, the Office mailed an order for reexamination on October 18, 2004. On November 29, 2004, the patent owner filed a notice pursuant to 37 CFR 1.565(a) calling attention to inter partes reexamination filed October 28, 2004. On December 23, 2004, the patent owner filed a statement pursuant to 37 CFR 1.530 addressing the questions raised by the Office in determining that a substanial new question of patentability did in fact exist.

In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a), the 95/000,058 and 90/007,171 reexamination proceedings <u>are merged</u>. 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

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. While the rights of any third party requester <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.

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 <u>both</u> 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 <u>both</u> files, for entry into each file.

All papers filed by the patent owner and the third party requester should be directed:

By Mail to: **Mail Stop *Inter Partes* Reexam**
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: **(571) 273-0100**
Central Reexamination Unit

By hand: **Customer Service Window**
Randolph Building
401 Dulaney 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 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), 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 (a) will review the files to insure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,058 and *ex parte* Reexamination Control No. 90/007,171 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination proceedings 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 Kery A. Fries, Senior Legal Advisor, at (571)272-7757.

Kenneth M. Schor
Senior Legal Advisor

Office of Patent Legal Administration

April 13, 2005
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In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 95/000,059
Filed: November 2, 2004
For: U.S. Patent No.: 6,616,382

MAILED
AUG 1 8 2005
REEXAM UNIT

: DECISION TO
: DISMISS PETITION TO
: VACATE REEXAMINATION
: ORDER AND TERMINATE
: REEXAMINATION
:

This is a decision on the March 3, 2005 patent owner petition under 37 CFR 1.181(a)(3), to vacate the order granting the above-captioned *inter partes* reexamination proceeding. A requester opposition to the patent owner petition was received March 17, 2005.

The proceeding, the petition, and the opposition are before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is dismissed. The order granting *inter partes* reexamination and the first Office action in the 95/000,059 proceeding, both of which were mailed on January 28, 2005, remain intact.

REVIEW OF FACTS

1. U.S. Patent No. 6,616,382 (the '382 patent) issued on September 9, 2003.

2. A request for *inter partes* reexamination of the '382 patent was filed by a third party requester on November 2, 2004, and was assigned control No. 95/000,059 (the '059 proceeding).

3. On January 28, 2005, an order granting *inter partes* reexamination, accompanied by a first Office action on the merits, were mailed for the '059 proceeding.

4. A petition under 37 CFR 1.181(a)(3) to vacate the '059 *inter partes* reexamination order was received from the patent owner on March 3, 2005.

5. An opposition to the March 3, 2005 patent owner petition to vacate was received from the '059 requester on March 17, 2005.

6. An amendment was received from the patent owner on March 28, 2005.

7. Comments by the third party requester were received on April 27, 2005.

DECISION ON PETITION

35 U.S.C. 303 states, in pertinent part:

> "(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications....The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

MPEP 2642, Part II A., states, in pertinent part:

> "A 'substantial new question of patentability' is <u>not</u> raised by the prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester *was* previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker Co.*, 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998).
>
> In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-

> specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."

MPEP 2646, Part I, states, in pertinent part:

> "A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(E) the reexamination order is based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '382 patent claims on which the '059 order for *inter partes* reexamination was based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '059 order for *inter partes* reexamination of the '382 patent be vacated as an *ultra vires* action taken by the Office.

Review of the request for reexamination

The '059 Request for Reexamination, filed January 28, 2005, urges that the combination of U.S. Patent 2,313,363 (hereinafter, "Schmitt") and "Diamond Wall System Tech Spec" (hereinafter, "the Diamond reference") raise a substantial new question of patentability with respect to claims 1-2, 4-22, and 24-33 of the '382 patent. Specifically, the Request urges that the combination of Schmitt and the Diamond reference renders the claims obvious under 35 USC 103. The Request also urges that the combination of Schmitt, the Diamond reference, and U.S. Patent D296,007 (hereinafter, "Forsberg '007") raise a substantial new question of patentability with respect to dependent claims 3 and 23.

With respect to independent claims 34 and 41, and dependent claims 36-40, 42-53, the Request urges that the combination of Schmitt, the Diamond reference, and one or more of U.S. Patent 4,616,959 (hereinafter, "Hilfiker"), Forsberg '007, U.S. Patent 787,199 (hereinafter, "Lloyd") and U.S. Patent 4,335,549 (hereinafter, "Dean"), raise a substantial new question of patentability. Specifically, the Request urges that the combination of Schmitt, the Diamond reference, and one or more of Hilfiker, Forsberg

'007, Lloyd, and Dean, renders the claims obvious under 35 USC 103.

The '059 Request for Reexamination further urges that Keystone Garden Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) (hereinafter, "the Keystone reference") raises a substantial new question of patentability with respect to claims 1-2, 4-22, and 24-33 of the '382 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '382 patent's filing date.

The request alleges that the date of the Keystone reference is no later than March 1989, the date being established by a declaration by Al Pfannenstein, regional manager of Keystone Retaining Wall Systems.

Review of the Patent Owner's Argument for Vacatur

The petition states that the exact combination of Schmitt and the Diamond reference was made in the prosecution of application no. 07/413,400, which is an ancestor of the '382 patent. The petition presents numerous arguments that both Schmitt and the Diamond reference, either alone or in combination, were considered by the examiner during the prosecution of various applications which were ancestors of the '382 patent. It is urged that, for this reason, the Schmitt/Diamond combination cannot raise a substantial new question of patentability, even when further combined with additional references.

The petition also argues, as to the impropriety of Hilfiker, Forsberg '007, Dean, and the Keystone reference, that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues. The petition admits that the Lloyd reference was never cited during the prosecution of the '382 patent. The petition argues, however, that the Lloyd reference is cumulative to the Dean reference, which was listed on one of the information disclosure statements initialed by the examiner.

The petition admits that the Keystone reference would anticipate the indicated claims *if* the reference was prior art. The petition argues that the reference is undated and has never had a date of publication established. The petitioner alleges that the source of the reference pays substantial royalties to license the patented subject matter (of the '382 patent), and this is submitted to be evidence that the source of the reference does not believe it could antedate the patent.

Further, the petition states that the examiner "was also squarely presented with the issue of whether the Pfannenstein Declaration established the Garden Wall document as a prior printed publication to the '382 patent family. He concluded that it did not." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the 09/160,916 application on March 20, 2000.

Review of the Order for Reexamination and the First Office Action

In the order granting the *inter partes* request for reexamination, the examiner stated that Schmitt and the Diamond reference do not raise a substantial new question of patentability with respect to claims 1-33. In the first Office action, the examiner stated that **the combination of** Schmitt and the Diamond reference was previously used in the prosecution of application 07/413,400, which is an ancestor of the '382 patent.

With respect to claims 34-53, the examiner stated, in the order granting the request for reexamination, that Schmitt, the Diamond reference, and one or more of Hilfiker, Forsberg '007, Lloyd, and Dean, raise a substantial new question of patentability. In the first Office action, independent claim 34, and dependent claims 36, 38 and 39 were rejected over **the combination of** Schmitt, the Diamond reference, **and** Hilfiker. Dependent claims 35, 37, and 40 were rejected over **the combination of** Schmitt, the Diamond reference, **and** Hilfiker and Forsberg '007. Independent claim 41, and dependent claims 42-53 were rejected over **the combination of** Schmitt, the Diamond reference, **and** either Lloyd or Dean.

In the order granting the request for reexamination, the examiner also stated that the Keystone reference raises a substantial new question of patentability with respect to claims 1-2, 4-22, and 24-33. In the first Office action, these claims were rejected under 35 USC 102(a) as being anticipated by the Keystone reference.

Evaluation as to any prior consideration of the references

A review of the record reveals that (a) the **combination** of Schmitt, the Diamond reference **and** Hilfiker, (b) the **combination** of Schmitt, the Diamond reference, **and** Hilfiker and Forsberg '007, and (c) the **combination** of Schmitt, the Diamond reference, **and** either Lloyd or Dean, were never applied or discussed during the prosecution of the '382 patent. The record also reveals that the Keystone reference, which the order for reexamination cites as raising a substantial new questions of patentability, was cited in the '382 prosecution; however, it was never applied.

The petition urges that the fact that the examiner initialed the citations in the '382 prosecution evidences the examiner's consideration, such that those references cannot be the basis for a new question of patentability. The petition also urges that because the combination of Schmitt and the Diamond reference was previously applied in a rejection by the Office during the prosecution of the '382 patent, those references cannot be the basis for a new question of patentability, even when newly combined with additional references.

This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in pertinent part, "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." Furthermore, a substantial new question of patentability may be based solely on "old art" where the "old art" is being presented/viewed in a new light, or 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. See MPEP 2642. See also *Ex parte Chicago Rawhide Mfg. Co.,* 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

The use of additional references, when newly combined with Schmitt and the Diamond reference present the Schmitt/Diamond combination in a new light, as compared with the use of the Schmitt and Diamond reference combination alone in the earlier concluded examination of application no. 07/413,400, which is an ancestor of the '382 patent. Accordingly, Schmitt and the Diamond reference, when further combined with additional references such as Hilfiker, Forsberg '007, Lloyd, and Dean, raise a substantial new question of patentability.[1]

Regarding the Schmitt/Diamond/Lloyd combination, since Lloyd was never cited in the prosecution of the '382 patent, the combination of Schmitt, the Diamond reference and Lloyd raises a substantial new question of patentability. *See In re Hiniker Co.,* 150 F.3d 1362, 1367, 47 USPQ2d 1523,1527 (Fed. Cir. 1998), in which the Court held that the reexamination proceeding was supported by a substantial new question of patentability where the rejection before the court was based on a combination of art that had been before the examiner during the original prosecution, and art newly cited during the reexamination proceeding. The issue of whether the teaching of Lloyd is cumulative to the teaching of the Dean reference is not relevant, since the Dean reference was never applied in combination with the Schmitt and Diamond reference during the earlier concluded examination of the patent.

The petition further urges that the precise question of whether the Keystone reference was prior art was considered by the examiner. Petitioner cites as evidence of this, the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the

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[1] It appears that the combination of Schmitt, the Diamond reference, and Forsberg '007 are stated not to raise a substantial new question of patentability with respect to claims 3 and 23, as indicated in the first Office action, because these claims are dependent from independent claims 1 and 21, respectively. The requester, in the request for reexamination, proposed that claims 1 and 21, and the remainder of the claims dependent therefrom, be rejected over the Schmitt and Diamond reference combination alone. It further appears that the Schmitt/Diamond reference combination, taken alone, are indicated not to raise a substantial new question of patentability, since this combination was previously used in the prosecution of application 07/413,400, which is an ancestor of the '382 patent.

comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

> "All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary....No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

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

The Court went on to state:

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

After a review of the record, and based upon the above discussion, it is found that petitioner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office determination that the questions of patentability raised in the January 28, 2005 request were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the '059 *inter partes* reexamination proceeding will continue.

CONCLUSION

1. The petition under 37 CFR 1.181 is dismissed.
2. The reexamination file is being forwarded to the Technology Center for the issuance of an Office action in due course.
3. Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Legal Advisor, at (571) 272-7724, or in her absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

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

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MAILED

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CENTRAL REEXAMINATION UNIT

In re Michael E. Woolford et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,059
Filed: November 2, 2004
For: U.S. Patent No.: 6,616,382

: DECISION ON
: REQUEST FOR
: RECONSIDERATION

This is a decision on the October 18 2005 patent owner petition styled as "PETITION UNDER 37 CFR 1.181 SEEKING SUPERVISORY REVIEW AND FINAL AGENCY DECISION CONCERNING PETITION BY PATENT OWNER TO VACATE ORDER GRANTING REEXAMINATION." The petition is being considered as a request for reconsideration of the Decision dated August 18, 2005, which dismissed the original patent owner petition to vacate the order granting reexamination. On November 1, 2005, the third party requester filed an opposition to the patent owner petition.

The proceeding, the patent owner request for reconsideration and the third party requester opposition thereto are before the Office of Patent Legal Administration.

SUMMARY

The request for reconsideration is granted to the extent that the August 18, 2005 Decision dismissing the original patent owner petition to vacate this proceeding has been reconsidered, but the underlying relief requested by patent owner is denied for the reasons set forth below.

The order granting *inter partes* reexamination and the first Office action in the 95/000,059 proceeding, both of which were mailed on January 28, 2005, remain intact.

REVIEW OF FACTS

1. U.S. Patent No. 6,616,382 (the '382 patent) issued on September 9, 2003.

2. The '382 patent claims 35 U.S.C. § 120 benefit as a continuation of U.S. Patent 6,312,197, [1] which in turn claims 35. U.S.C. § 120 benefit as a continuation of U.S. Patent 6,182,168, which in turn claims 35 U.S.C. § 120 benefit as a continuation of U.S. Patent 6,142,713, which in turn claims 35 U.S.C. § 120 benefit as a continuation of U.S. Patent 5,827,015 which claims 35 U.S.C. § 120 benefit a file wrapper continuation [2] of abandoned application number 08/675,572 which in turn claims 35 U.S.C § 120 benefit as a continuation of U.S. Patent 5,589,124, which in turn claims 35 U.S.C § 120 benefit as a file wrapper continuation of abandoned application number 08/157,830, which in turn claims 35 U.S.C § 120 benefit as a divisional of U.S. Patent 5,294,216, which in turn claims 35 U.S.C § 120 benefit as a divisional of U.S. Patent 5,062,610, which in turn claims 35 U.S.C. § 120 benefit as a continuation-in-part of abandoned application numbers 07/413,050 and 07/413,400, the latter of which claims 35 U.S.C. § 120 benefit as a file wrapper continuation of application number 07/824,901. [3]

2. A request for *inter partes* reexamination of the '382 patent was filed by a third party requester on November 2, 2004, and was assigned control No. 95/000,059 (the '059 proceeding).

3. On January 28, 2005, an order granting *inter partes* reexamination, accompanied by a first Office action on the merits, were mailed for the '059 proceeding.

4. A petition under 37 CFR 1.181(a)(3) to vacate the '059 *inter partes* reexamination order was received from the patent owner on March 3, 2005.

5 An opposition to the March 3, 2005 patent owner petition to vacate was received from the '059 requester on March 17, 2005.

6. An amendment was received from the patent owner on March 28, 2005.

7. Comments by the third party requester were received on April 27, 2005.

8. On August 18, 2005, the Office issued a decision dismissing the patent owner petition to vacate the '059 *inter partes* reexamination order.

9. On October 18, 2005, the patent owner filed the present petition requesting reconsideration of the August 18, 2005 decision, and requesting a final agency decision on the matter.

10. On November 1, 2005, the third party requester filed an opposition to the patent owner's October 18, 2005 petition.

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[1] Where a patent is stated to be a continuation (for example) of another patent, this is a short-hand statement for the *application* for the patent being a continuation of the *application* for the other patent.

[2] A file wrapper continuation is an application filed under former 37 CFR 1.62 which provided for the filing of a continuation application by filing a request therefor in the file wrapper of the benefit (parent) application, which thereafter became abandoned by operation of the regulation.

[3] See page 7 of the present request for reconsideration.

APPLICABLE LAW AND PRACTICE

35 U.S.C. §312(a) states:

"Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. **The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."** [Emphasis added.]

MPEP § 609.05(b) states, in pertinent part:

"The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner **will consider the documents in the same manner as other documents in Office search files are considered by the examiner <u>while conducting a search of the prior art in a proper field of search</u>.** The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/ 08A and 08B or its equivalent mean that the information has been considered by the examiner **to the extent noted above."** [Emphasis added.]

MPEP § 2258.01 [4,5] states, in pertinent part:

"On November 2, 2002, 35 U.S.C. 303(a) was amended by the passage of Pub. L. No. 107-273, 13105, (116 Stat.) 1758, 1900, to add '[t]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office,' thereby overruling Portola Packaging. The following guidelines are provided for reviewing ongoing reexaminations ordered prior to November 2, 2002, for compliance with the Portola Packaging decision.

(1) General principles governing compliance with Portola Packaging for ongoing reexaminations ordered prior to November 2, 2002. If prior art was previously relied upon to reject a claim in a concluded prior related Office proceeding, the Office will not conduct reexamination based only on such prior art. 'Prior related Office proceedings' include the application which matured into the patent that is being reexamined, any reissue application for the patent, and any reexamination proceeding for the patent. If prior art was not relied upon to reject a claim, but was cited in the record of a concluded prior related Office proceeding, and its relevance to the patentability of any claim was actually discussed on the record, the Office will not conduct reexamination based only on such prior art. The relevance of the prior art to patentability may have been discussed by either the applicant, patentee, examiner, or any third party. However, **37 CFR 1.2 requires that all Office business be transacted in writing. Thus, the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a form PTO 1449, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms) submitted with an information disclosure statement. Thus, any specific discussion of prior art must appear on the record of a prior related Office proceeding. Generalized statements such as the prior art is 'cited to show the state of the art,' 'cited to show the background of the invention,' or 'cited of interest' would not preclude reexamination. The Office may conduct reexamination based on prior art that was cited but whose relevance to patentability of the claims was not discussed in any prior related Office proceeding."** [Emphasis added.]

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[4] MPEP §2258.01 is directed to *ex parte* reexamination proceedings. However MPEP § 2658, the analogous practice section directed to *inter partes* reexamination proceedings, references and makes applicable the discussion of the standards for determining the presence or absence of a substantial new question of patentability that appears in MPEP § 2258.01.

[5] The quoted material labeled (1) is the standard for determining a substantial new question of patentability in reexamination proceedings ordered **prior** to the November 2, 2002 amendments to 35 U.S.C. §§ 303(a) and 312(a) which apply, respectively to *ex parte* and *inter partes* reexamination proceedings. These amendments **liberalized** the standards for determining the existence of a substantial new question of patentability for reexamination proceedings filed on or after November 2, 2002.

MPEP § 2616 states, in pertinent part:

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

MPEP § 2642, Part II A., states, in pertinent part:

> "A 'substantial new question of patentability' is not raised by the prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker Co.*, 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998).
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> In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." [All emphasis in the original.]

MPEP § 2646, Part I, states, in pertinent part:

> "A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
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> ...
>
> "(F) the reexamination order is based **wholly** on the same question of patentability raised by the prior art *previously considered* in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding).
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> "As to (F), the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted." [All emphasis in the original.]

DECISION

I. Relief Requested By Patent Owner

In the present request for reconsideration, as in the original patent owner petition filed on March 3, 2005, patent owner petitioner urges that the Office has previously considered (in an

earlier concluded examination of the patent) the questions of patentability of the '382 patent claims upon which the order granting reexamination in the '059 *inter partes* reexamination proceeding was based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner again requests relief in the form of vacatur of the order granting *inter partes* reexamination of the '382 patent in the '059 *inter partes* reexamination proceeding.

II. Review Of The Request For Reexamination

In the request for reexamination, filed January 28, 2005, it was alleged that the combination of U.S. Patent 2,313,363 (hereinafter, "Schmitt") and "Diamond Wall System Tech Spec" (hereinafter, "the Diamond reference") raises a substantial new question of patentability with respect to claims 1-2, 4-22, and 24-33 of the '382 patent. Specifically, third party requester asserted that the combination of Schmitt and the Diamond reference renders the '382 patent claims obvious under 35 U.S.C. § 103. Third party requester further asserted that the combination of Schmitt, the Diamond reference, and U.S. Patent D296,007 (hereinafter, "Forsberg '007") raises a substantial new question of patentability with respect to dependent claims 3 and 23.

With respect to independent claims 34 and 41, and dependent claims 36-40, 42-53, third party requester alleged that the combination of Schmitt, the Diamond reference, and one or more of U.S. Patent 4,616,959 (hereinafter, "Hilfiker"), Forsberg '007, U.S. Patent 787,199 (hereinafter, "Lloyd") and U.S. Patent 4,335,549 (hereinafter, "Dean"), raises a substantial new question of patentability. Specifically, requester asserted that the combination of Schmitt, the Diamond reference, and one or more of Hilfiker, Forsberg '007, Lloyd, and Dean, renders claims 34, 41, 36-40 and 42-53 obvious under 35 U.S.C. § 103.

Third party requester for reexamination additionally alleged that Keystone Garden Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) (hereinafter, "the Keystone reference") raises a substantial new question of patentability with respect to claims 1-2, 4-22, and 24-33 of the '382 patent. Specifically, third party requester asserted that the Keystone reference has a publication date earlier than the '382 patent claims' filing date and anticipates claims 1-2, 4-22 and 24-33 under 35 U.S.C. § 102(a). It should be noted that, as support for the allegation that the Keystone reference was published not later than March 1989, the request includes and references a declaration by Al Pfannenstein, regional manager of Keystone Retaining Wall Systems. [6]

III. Review Of The Patent Owner's Argument For Vacatur

In the present request for reconsideration, patent owner again takes the position that the exact combination of Schmitt and the Diamond reference was made in the prosecution of application number 07/413,400, which is an ancestor of the '382 patent. Patent owner again presents numerous arguments that both Schmitt and the Diamond reference, either alone or in combination, were considered by the examiner during the prosecution of various applications which were ancestors of the '382 patent. It is urged that, for this reason, the Schmitt/Diamond combination cannot raise a substantial new question of patentability, even when further combined with additional references.

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[6] As indicated in MPEP § 2616, it is proper in inter partes reexamination proceedings to consider affidavits or declarations that explain the pertinent dates of prior patents or printed publications.

Patent owner also renews its argument presented in the March 5, 2005 petition that the Hilfiker, Forsberg '007, Dean, and the Keystone reference, are "old art" listed on information disclosure statements initialed by the examiner, that the order for reexamination of the '382 patent does not acknowledge that these patents and printed publications are "old art," and that all these references are secondary references for obviousness patentability issues. While patent owner again admits that the Lloyd reference was never cited during the prosecution of the '382 patent, patent owner continues to assert that the Lloyd reference is cumulative to the Dean reference, which was listed on one of the information disclosure statements initialed by the examiner in the prior prosecution.

While admitting that the Keystone reference would anticipate the indicated claims if the reference was prior art, patent owner continues to argue that the Keystone reference is undated and has never had a date of publication established. The petitioner patent owner alleges that the source of the reference pays substantial royalties to license the patented subject matter (of the '382 patent), and this is submitted to be evidence that the source of the reference does not believe it could antedate the patent.

Further, the petition states that the examiner "was also squarely presented with the issue of whether the Pfannenstein Declaration established the Garden Wall document as a prior printed publication to the '382 patent family. He concluded that it did not." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the 09/160,916 application file on March 20, 2000. The 09/160,916 application matured into U.S. Patent No. 6,142,713, and is the great-grandparent of the '382 patent.

IV. Review Of The Order For Reexamination And The First Office Action

In the order granting the *inter partes* request for reexamination, the examiner stated that Schmitt and the Diamond reference do not raise a substantial new question of patentability with respect to claims 1-33. In the first Office action, the examiner stated that the combination of Schmitt and the Diamond reference was previously used in the prosecution of application 07/413,400, which is an ancestor of the '382 patent.

In the order granting the request for *inter partes* reexamination, the examiner stated that Schmitt, the Diamond reference, and one or more of Hilfiker, Forsberg '007, Lloyd, and Dean, raises a substantial new question of patentability. In the first Office action, independent claim 34, and dependent claims 36, 38 and 39 are rejected over the combination of Schmitt, the Diamond reference, and Hilfiker. Dependent claims 35, 37, and 40 are rejected over the combination of Schmitt, the Diamond reference, and Hilfiker and Forsberg '007. Independent claim 41, and dependent claims 42-53 are rejected over the combination of Schmitt, the Diamond reference, and either Lloyd or Dean.

In the order granting the request for reexamination, the examiner also states that the Keystone reference raises a substantial new question of patentability with respect to claims 1-2, 4-22, and 24-33. In the first Office action, these claims are rejected under 35 USC 102(a) as being anticipated by the Keystone reference.

V. Evaluation As To Any Prior Consideration Of The References

a. In General

A review of the record reveals that (a) **the combination** of Schmitt, the Diamond reference and Hilfiker, (b) **the combination** of Schmitt, the Diamond reference, and Hilfiker and Forsberg '007, and (c) **the combination** of Schmitt, the Diamond reference, and either Lloyd or Dean, were never applied or discussed during the prosecution of the '382 patent. The record also reveals that the Keystone reference, which the order for reexamination cited as raising a substantial new questions of patentability, was **cited** in the '382 prosecution; however, it was never **applied**.

Patent owner argues that the examiner initialed the citations in the '382 prosecution evidences the examiner's consideration, such that these references cannot be the basis for a new question of patentability. Patent owner also argues that because the combination of Schmitt and the Diamond reference was previously applied in a rejection by the Office during the prosecution of the '382 patent, those references cannot serve as the basis for a new question of patentability, even when newly combined with additional references. These arguments are not persuasive.

Initially, it is to be noted that the placement of the examiner's initials adjacent one or more citations on a listing of prior art references submitted as part of a properly filed Information Disclosure Statement is **not** tantamount to a **detailed** consideration of those references, whether individually or in various combinations, with respect to the claims. As pointed out in MPEP § 609.05(b), the initials of the examiner placed adjacent to the citations on the listing of documents simply means that the information has been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. Consideration of documents that are being "flipped through," whether in a paper bundle of documents or as presented on a computer screen during a computerized search, is not an in depth consideration of the documents equivalent to an application of such documents to the claims of an application under examination, or a discussion of such documents on the record during the examination process. Even with respect to the more stringent standards for determining the existence of a substantial new question of patentability that apply to reexamination proceedings filed prior to November 2, 2002, MPEP § 2258.01 states "... the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a form PTO 1449, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms) submitted with an information disclosure statement." Therefore, patent owner's arguments with respect to the mere initialing of citations on a listing of prior art as being indicative of consideration of a particular citation by the examiner are not persuasive.

In addition, patent owner's reading of the law is incorrect. 35 U.S.C. 312(a) clearly states that "[T]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." [Emphasis added.] It is clear that a substantial new question of patentability may be

based solely on "old art" where the "old art" is being presented/viewed in a new light, or 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. [7]

The use of additional references, when newly **combined** with Schmitt and the Diamond reference present the Schmitt/Diamond combination in a new light, as compared with the use of the Schmitt and Diamond reference **combination** alone in the earlier concluded examination of application no. 07/413,400, which is an ancestor of the '382 patent. Accordingly, Schmitt and the Diamond reference, when further combined with additional references such as Hilfiker, Forsberg '007, Lloyd, and Dean, raise a substantial new question of patentability. [8]

Regarding the Schmitt/Diamond/Lloyd **combination**, since Lloyd was never cited in the prosecution of the '382 patent, the **combination** of Schmitt, the Diamond reference and Lloyd raises a substantial new question of patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1367, 47 USPQ2d 1523,1527 (Fed. Cir. 1998), in which the court held that the reexamination proceeding was supported by a substantial new question of patentability where the rejection before the court was based on a combination of art that had been before the examiner during the original prosecution, and art newly cited during the reexamination proceeding. [9] The issue of whether the teaching of Lloyd is cumulative to the teaching of the Dean reference is not relevant, since the Dean reference was never applied in **combination** with the Schmitt and Diamond reference during the earlier concluded examination of the patent.

b. The Keystone Publication

Patent owner again raises the issue of whether the examiner considered the question of the whether or not the Keystone reference that is now relied on in the present *inter partes* reexamination proceeding is prior art. Patent owner cites, as evidence that the examiner considered the status of the Keystone reference, the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file [10], in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

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[7] See *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984). See also MPEP §2642.

[8] It appears that the **combination** of Schmitt, the Diamond reference, and Forsberg '007 are stated not to raise a substantial new question of patentability with respect to claims 3 and 23, as indicated in the first Office action, because these claims are dependent from independent claims 1 and 21, respectively. In the request for reexamination, third party requester proposed that claims 1 and 21, and the remainder of the claims dependent therefrom, be rejected over the Schmitt and Diamond reference combination alone. It further appears that the Schmitt/Diamond reference **combination**, taken by itself, is indicated as not raising a substantial new question of patentability, since this combination was previously used in the prosecution of application 07/413,400, which is an ancestor of the '382 patent.

[9] This decision was issued under the stringent standards for determining the existence of a substantial new question of patentability that apply to reexamination proceedings filed prior to November 2, 2002.

[10] As noted, *supra*, this application matured into U.S. patent number 6,142,713, and is the great-grandparent of the '382 patent.

A review of the prosecution history of application number 08/921,481 (the '481 application), [11] which matured into U.S. Patent No. 5,827,015, [12] shows that:

1. Prior to the initial Office action, two Information Disclosure Statements had been filed in abandoned parent application 08/675,572 (the '572 application), filed (October 8, 1996 and November 4, 1996), neither of which cited the Keystone reference.

2. The initial Office action (November 29, 1996) in the '572 application neither cited nor relied upon the Keystone reference.

3. Two additional Information Disclosure Statements (February 26, 1997 and May 8, 1997) were thereafter filed in the '572 application. The latter cited two Keystone publications that were not the Keystone publication in question in the present *inter partes* reexamination proceeding.

4. Still another Information Disclosure Statement (June 6, 1997) was filed in the '572 application, but did not cite the Keystone publication.

5. A Notice of Allowability, mailed in the '572 application on June 10, 1997, and included a Statement of Reasons for Allowance by the examiner.

6. The June 10, 1997 examiner's Statement of Reasons for Allowance in the '572 application contains the following comment:

   "The large number of patents cited in Applicant's Information Disclosure statement have been noted. Since Applicant has cited the references, it is presumed that Applicant is familiar with the teaching of each of these references and has drawn the claims to avoid the teaching of each and everyone of these references or any reasonable combination thereof. Moreover, it is Applicant's responsibility to point out to the examiner any reference which is particularly pertinent to the claimed invention.

   Therefore, since it is Applicant's responsibility to draft the claims to avoid the teaching of any known prior art, it is assumed that the claims patentably define over the cited art. Rule 37 CFR 1.56(a) requires that Applicant state; I acknowledge the duty to disclose information of which I am aware which is material to the examination of this application. See MPEP 2004, paragraph 13. This statement does not end with just the citing of the prior art, but includes any passage in the reference(s) which would have a bearing upon the patentability of any claim."

7. The '572 application thereafter became abandoned in favor of the '481 application, which, as a file wrapper continuation of the '572 application, included all of the prosecution of the abandoned parent application and ultimately matured into U.S. Patent No. 5,827,015.

8. An Information Disclosure Statement was filed (November 13, 1997) in the '481 application, in which certain proceedings between the applicant for patent (now patent owner in the '059 *inter partes* reexamination proceeding) and Keystone were discussed,

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[11] Application number 08/921,481 was filed as a file wrapper continuation of abandoned parent application 08/675,572.

[12] U.S. Patent No. 5,827,015 is the great great grandparent of the '382 patent, i.e., the parent of U.S. patent number 6,142,713, - the great-grandparent of the '382 patent.

but no specific mention of the Keystone Publication of interest in the '059 *inter partes* reexamination proceeding appears.

9. A Notice of Allowability was thereafter mailed (July 30, 1998) in the '481 application.

10. An Information Disclosure Statement was filed (July 30, 1998) in the '481 application, but was not discussed on the record by the examiner.

While patent owner argues [13] that the '481 application was filed specifically for the purpose of apprising Examiner Taylor of this information" [14] and that Examiner Taylor specifically considered this information, the record of the '481 application does not clearly support this argument. In fact, Bremer Decl., Ex. 8 cited in support of this argument, is apparently the Information Disclosure Statement that was filed on July 30, 1998.

With respect to submission of the Keystone publication in application 09/160,916, the application that matured into U.S. Patent No. 6,142,713, the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor." The record, however, provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self-serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the Keystone reference, purportedly presenting a substantial new question of patentability, was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

> "All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary....No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

As to the examiner's not having commented on applicant's "Comments On Statement Of Reasons For Allowance" that appear in the Notice of Allowability mailed on March 20, 2006 for application number 09/160,916 (the great-grandparent of the '382 patent) which matured into U.S. Patent No. 6,142,713, it is to be noted that 37 C.F.R. 104(e) states:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

In summary: (1) The standard for establishing whether a given prior patent or printed publication previously of record is barred from serving as the basis for a substantial new question of patentability is whether the document was applied on the record in the same manner it is now being applied, and mere initialing of a list of documents cited does not equate to an application of such documents so as to preclude consideration of those documents in

[13] Pages 21-23 of the present request for reconsideration.
[14] "This information" is presumably the Keystone publication

order to establish a substantial new question of patentability; (2) the examiner of the '015 and the '713 ancestor patents has not been clearly established to have discussed or applied the Keystone publication on the **written** record; and (3) the record of the '382 patent itself contains no discussion or application of the Keystone publication on the record. Thus, it is clear that patent owner has not rebutted the inference that the Keystone publication is in fact a prior art publication available to raise a substantial new question of patentability in the '059 *inter partes* reexamination proceeding. As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, 143 F. Supp. 2d 593 (E.D.Va. 2001), where the court found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion also states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue of the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

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

The court went on to state:

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

After a review of the record, and based upon the above discussion, it is found that the order granting reexamination in the '059 *inter partes* reexamination proceeding is based in part on **combinations** of prior documents that patent owner has not shown to have been previously discussed or applied in the record of the '382 patent or of any prior patent that is related to the '382 as a "family member." It is further found that the order granting reexamination in the '059 *inter partes* reexamination proceeding is based in part on the Keystone publication which patent owner has not shown to have been clearly considered and discussed on the **written** record as to its publication date. Patent owner has not established that the Office has "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" by determining (1) that the **combinations** of prior art documents relied upon in the order granting reexamination in the in the '059 *inter partes* reexamination proceeding raise one or more substantial new questions of patentability, or (2) that the Keystone publication is available to raise a substantial new question of patentability, in the Office determination on the January 28, 2005 request. Rather, the Office has established that there is jurisdiction to conduct the '059 *inter partes* reexamination proceeding in accordance with 35 U.S.C. §311 *et seq.* Any disagreement

that patent owner has on this issue can be pursued and resolved as an appealable matter in due course during the further conducting of the '059 *inter partes* reexamination proceeding.

For all the forgoing reasons, as well as those set forth in the August 18, 2005 decision, the order granting the present *inter partes* reexamination remains intact, and the *inter partes* reexamination proceeding will continue in accordance with the procedure mandated by the *inter partes* reexamination statutes and implementing regulations.

CONCLUSION

1. The October 18, 2005 patent owner petition for reconsideration of the August 18, 2005 Decision on Petition has been granted to the extent that the August 18, 2005 Decision on Petition has been reconsidered, but is denied as to the underlying relief requested.

2. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

3. Jurisdiction over the '059 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit, for the issuance of an Office action in due course.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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9-26-06

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

Townsend and Townsend and Crew LLP
Two Embarcadero Center 8th Floor
San Francisco CA 94111-3834

(For Requestor)

Ex Parte Goldenberg
Inter Partes Reexamination Proceeding
Control No. 95/000,062
Filed: December 3, 2004
For: U.S. Patent No. 6,653,104

Petition Granted

MAILED
AUG 10 2005
REEXAM UNIT

The present reexamination proceeding is before the Office of Patent Legal Administration in view of the communication filed by patent owner on April 5, 2005, styled as a petition under 37 CFR 1.182, which is properly treated as a petition filed under the provisions of 37 CFR 10.130(b) to disqualify counsel for third party requestor.[1]

The petition is granted. The firm of Townsend and Townsend and Crew (Townsend) and Townsend partner Kenneth Weber are hereby disqualified from further representation of the *inter partes* reexamination requestor, the United States Government as represented by the Secretary, Department of Health and Human Services, National Institutes of Health (HHS). All correspondence relating to an *inter partes* reexamination proceeding should be directed:

by Mail to: Mail Stop Inter Partes Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to (571) 273-0100
Central Reexamination Unit

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

Any inquiries concerning this communication may be directed to Senior Legal Advisor Robert Clarke at (571) 272-7735.

Karin L. Ferriter
Acting Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] By its terms, 37 CFR 1.182 applies only where no other regulation speaks to the issue. 37 CFR 1.130(b) provides for the question raised herein.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,062	12/03/2004	6653104	IMMU:001	5745

37013 7590 02/04/2009

ROSSI, KIMMS & McDOWELL LLP.
20609 Gordon Park Square, Suite 150
Ashburn, VA 20147

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/04/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED
FEB 04 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000062
PATENT NO. : 6653104
TECHNOLOGY CENTER : 3999
ART UNIT : 3999

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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FEB 04 2009

CENTRAL REEXAMINATION UNIT

ROSSI, KIMMS & McDOWELL LLP
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For Patent Owner

WOODCOCK WASHBURN LLP
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For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,062
Filed: December 3, 2004
For: US Patent No. 6,653,104

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed January 8, 2009 to request reconsideration of the status of the Official Action dated December 5, 2008 styled as an Action Closing Prosecution.
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 contends that the amendment to claims 1, 51, and 92 did not necessitate a new ground of rejection and therefore the present Office action is not properly characterized as an Action Closing Prosecution. A review of the present rejection is requested.

37 CFR 1.949 states:

> 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.

MPEP 2671.02 states in part:

> The grounds of rejection and determination of patentability must (in the ACP) be clearly developed to such an extent that the patent owner and the third party requester may readily judge the advisability of filing comments after an ACP pursuant to 37 CFR 1.951(a) and (b), respectively.

Review of Salient Facts

1. December 3, 2004 Request for reexamination of USPN 6,653,104 was submitted.

2. February 28, 2005 The request for reexamination was granted.

3. March 17, 2005 A first, non-final office action was issued.

4. April 8, 2005 A petition for an extension of time for three (3) months was submitted.
5. April 27, 2005 The petition for an extension of time was granted for two (2) months.
6. July 15, 2005 Patent owner submitted a response and amendment.

7. August 15, 2005 Third party requester filed comments on patent owner response.

8. November 12, 2008 A second non-final (ACP) action was issued.

9. December 5, 2008 A supplemental ACP was issued to clarify cover sheet of previous ACP to indicate status as ACP and to correct paragraph numbers.
10. December 5, 2008 A petition for an extension of time for three (3) months was submitted.
11. December 22, 2008 The petition for extension of time was granted for one (1) month.

12. January 8, 2009 This petition for reconsideration of the status of the Official action was submitted.

Analysis and Findings

Patent owner's submission on July 15, 2005 included an amendment to claims 1, 51, and 92 limiting the cytotoxic reagent to comprising an antibody and a moiety having ribonucleolytic activity derived from a "non-human" ribonuclease to "frog" ribonuclease (emphasis added). As explained by the examiner, this was interpreted as not substantially limiting the scope of the moiety since "derived from" placed no specific limits on required similarities of differences in structure or function. However, "frog" ribonuclease is a new recitation in the claim and the art, which is of record, was introduced to specifically address that change. Therefore, the rejection was due to the amendment submitted by Patent owner and the Office action is properly an Action Closing Prosecution.

Conclusion

1. The Patent Owner's request for reconsideration of the status of the Official Action dated December 5, 2008 is **dismissed**.

2. The Patent Owner's response is due February 5, 2009.

3. Response may be submitted as follows:

By EFS to: Registered users may submit via EFS-Web at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

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

for Deborah Jones

Gregory Morse,.
Director, Central Reexamination Unit

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Cira Centre, 12th Floor
2929 Arch Street
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MAILED

SEP 30 2009

OFFICE OF PETITIONS

Inventor: Goldberg	: **DECISION ON**
Reexamination Proceeding	: **§ 1.181 PETITION**
95/ 000,062	:
Filed: December 3, 2004	:
For: U. S. Patent No. 6,653,104	:
Issued: November 23, 2003	:
Title: Immunotoxins, Comprising an Internalizing	:
Antibody, Directed Against Malignant and	:
Normal Cells	:

This is a decision on an August 31, 2005 § 1.182 petition to request Office verification of attorney work product. The § 1.182 petition is now before the Office of Patent Legal Administration for decision.

The § 1.182 petition is Dismissed.

Background

Status: A February 5, 2009 Patent Owner reply with an amendment was timely (a one month extension of time being granted on December 22, 2008) submitted in response to a December 5, 2008 supplemental Action Closing Prosecution, rejecting all claims.

A § 1.182 petition by the Patent Owner seeking disqualification of counsel for the Third Party Protester was filed on April 5, 2005.

The Office granted the § 1.182 petition on August 10, 2005.

The Patent Owner, in view of the grant of the § 1.182 petition, has filed a second § 1.182 petition seeking a verification by the Office that an August 12, 2005 [August 15, 2005], reply by the Third Party Requester does not include the work product of the disqualified counsel. A review of the file record does not reveal any subsequent filings by disqualified counsel. It is argued that there is no provision in the rules relating to the present proceeding which would enable the Patent Owner to discover if the response of August 15, 2005 incorporated any work from disqualified counsel. There is no allegation that any work

product of disqualified counsel was used. The Office is requested to require an affidavit or declaration to the effect that work product from disqualified counsel was not used, particularly as a patent agent rather than a patent attorney is involved.

Decision

The rules set forth in Parts 10 and Part 11 of 37 CFR govern representation of others before the Office and make it unnecessary for the Office to require an oath or declaration as is suggested by Petitioner.

Contact

Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or in his absence, to the undersigned at (571) 272-5047.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

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Inventor: Goldberg	: **DECISION ON**
Reexamination Proceeding	: **§ 1.181 PETITION**
95/ 000,062	:
Filed: December 3, 2004	: **MAILED**
For: U. S. Patent No. 6,653,104	:
Issued: November 23, 2003	: SEP 30 2009
Title: Immunotoxins, Comprising an Internalizing Antibody, Directed Against Malignant and Normal Cells	: OFFICE OF PETITIONS

This is a decision on an October 6, 2005 § 1.181 petition seeking review of an August 10, 2005 Decision granting an April 5, 2005 § 1.182 petition by the Patent Owner to disqualify Third Party counsel based on a conflict of interest under §§ 10.56, 10.57, 10.61 and 10.66. The § 1.181 petition is now before the Office of Patent Legal Administration for decision.

The § 1.181 petition is Dismissed.

Introduction

A request for reexamination was filed on December 3, 2004.

An Order Granting Request for Inter Partes Reexamination was mailed on February 28, 2005.

A first Office action on the merits was mailed March 17, 2005.

Counsel for the Third Party Requester was disqualified due to a conflict of interest. One of the inventors in a prior application executed a power of attorney to counsel who then prosecuted the prior application. Counsel was then disqualified when counsel later represented the Third Party Requester for a reexamination based on a continuation-in-part application having a benefit claim to the prior application. Disqualified counsel seeks review of the disqualification arguing that: (1) a bare power of attorney without the existence of legal advise or exchange of confidential information does not amount to a conflict of interest, and (2) there was an insufficient relationship between the prior application involving the bare

power of attorney to later disqualified counsel and a continuation-in-part application leading to the patent currently being reexamined at the request of a Third Party originally represented by disqualified counsel.

Background

Status: A February 5, 2009 patent owner reply with an amendment was timely (a one month extension of time being granted on December 22, 2008) submitted in response to a December 5, 2008 supplemental Action Closing Prosecution, rejecting all claims.

Chain of applications:

1. Original application, 09/071,672, the '672 parent application (now patent number 6,395,276).

2. Divisional application, 09/918,887, the '887 division, now abandoned[1] (from which a continuation was filed).

3. Continuation-in-part application, 09/986,119 (now patent number 6,653,104), the '104 (CIP) patent in reexamination.

Applications - inventors, and assignees:

The inventors and assignees of the applications in issue are:

'672 parent application: Inventors Goldenberg (assignee Immunomedics), and Rybak and Newton (assignee HHS).

'887 division: Inventors Goldenberg (assignee Immunomedics), Rybak and Newton (assignee HHS).

'104 (CIP) patent in reexamination): Inventor Goldenberg (assignee Immunomedics).

Power of Attorney:

For the '672 parent application:

PALM shows that there is no associated customer number, but a list of practitioners with a correspondence address of Townsend and Townsend and Crew.

A § 1.63 declaration was executed by inventor Goldenberg (of Immunomedics) that included a power of attorney in favor of practitioners associated with Townsend and Townsend and Crew.[2]

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[1] October 6, 2005 § 1.181 petition at page 4.
[2] October 4, 2005 § 1.181 petition, Appendix A (Declaration of Ellen Lauver) , Exhibit 5.

For divisional application 09/918,887:

The divisional application was filed with a copy of the executed declaration from parent application 09/071,672, and a transmittal letter setting forth as the correspondence address the firm of Townsend and Townsend and Crew. As the copy of the declaration included a power of attorney to Townsend and Townsend and Crew, the power of attorney in the § 1.63 copy, such as from Goldenberg of Immunomedics to Townsend and Townsend and Crew, would carry over to the divisional application.[3]

For the '104 (CIP) patent in reexamination:

The patent currently shows (in the Office's PALM data base) a power of attorney for customer number 37013 (attorneys associated with Rossi, Kimms & McDowell LLP).

A review of the power of attorney history in the application reveals:

- a November 7, 2001 Application Data Sheet identifying Representative information as Customer Number 22428 (practitioners associated with Foley & Lardner);

- a May 20, 2002 § 1.63 declaration, page 2, appointing the registered attorneys and agents at Customer Number 22428.[4] An Application Data Sheet identifying Customer Number 22428 as the Representative information was concomitantly filed;

- a March 31, 2005 revocation and power of attorney appointment by the sole inventor appointed practitioners associated with Customer No. 37013 (attorneys associated with Rossi, Kimms & McDowell LLP.). A March 13, 2008 paper submitted a power similar to the March 31, 2005 power, which new power was executed by the sole inventor as Chairman of the assignee, and (resubmission of) a § 3.73(b) statement identified as earlier submitted with the March 31, 2005 power, but not present in the record; and

- an August 11, 2008 acceptance by the Office of the March 31, 2008 power.

A review of the application prosecution papers, *e.g.*, a June 24, 2003 reply to the only rejection, and an August 1, 2003 payment of the issue fee reveals that the papers were submitted by practitioners associated with Foley and Lardner.

Inter partes reexamination: The instant *Inter Partes* reexamination was filed on December 3, 2004 by Kenneth Weber of the law firm of Townsend and Townsend and Crew LLP. The real party in interest is The Government of the United States of

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[3] MPEP 201.06(c), II.

[4] At page 3 of the declaration the following disclaimer was made:

I UNDERSTAND AND AGREE THAT the foregoing attorneys and agents appointed by me to prosecute this application do not personally represent me or my legal interests, but instead represent the interests of the legal owner of the invention described in this application. (emphasis in original).

America, as represented by the Secretary, Department of Health and Human Services, National Institutes of Health.[5]

Petition under § 1.182 seeking to disqualify opposing counsel: On April 5, 2005 a petition under 37 CFR 1.182 was submitted by the patent owner to disqualify opposing counsel (counsel for the Third Party Requester) and the law firm of opposing counsel who had represented the Third Party Requester in filing the inter partes reexamination request. A conflict of interest was alleged based on:

- opposing counsel having prosecuted a parent application and was currently prosecuting a division of the parent that are both substantially related to the instant patent for which reexamination is being requested, which instant patent is a CIP of the parent, and

- the patent owner of the instant patent in reexamination had given a power of attorney to opposing counsel in the identified other substantially related applications thereby creating an attorney-client relationship.

The § 1.182 petition was accompanied by:

Appendix A – Excerpt from CRADA, an agreement between the owner of the patent for which reexamination was requested (Immunomedics) and the Third Party Requestor (HHS) relating to filing and prosecution of inventions subject to the CRADA, such as the parent and divisional applications.

Appendix B – A graphical representation of the relationships of the three applications in issue.

Appendix C – A redline comparison of the applications in issue.

Decision on § 1.182 petition: The April 5, 2005 § 1.182 petition was granted in an absence of any opposition to the § 1.182 petition by the Third Party Requester thereby disqualifying the firm of Townsend and Townsend and Crew and a partner thereof, Kenneth Weber, from "further representation of the *inter partes* reexamination requestor.

Petition under 37 CFR 1.181: On October 6, 2005 the Third Party Requester filed a petition under 37 CFR 1.181, requesting the Office to vacate the grant of the § 1.182 petition that disqualified its counsel.

Standard for Disqualification of Opposing Counsel.

The Office does not have a specific rule which governs submission of a petition to disqualify opposing counsel and such matters are therefore handled under § 1.182.[6] Decisions on such

[5] December 13, 2004 office paper.

[6] 35 U.S.C. 32 is directed towards exclusion of a practitioner shown to be "incompetent, or disreputable, or guilty of gross misconduct ...." 37 CFR 10.130(b) states "[p]etitions to disqualify a practitioner in *ex parte* or *inter partes* cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-

petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts.[7]

The § 1.182 petitioner (patent owner) urged the Office to apply two tests used by the federal courts in California as counsel Weber and the Townsend firm are California attorneys:

- The first test, based on client confidentiality, applies to a subsequent representation of a second client that would be adverse to the interests of a former first client. A per se disqualification would exist where there is a substantial relationship between the subjects of the former and subsequent representations.

- The second test, based on loyalty to a client, applies where there is a simultaneous representation of adverse clients. A substantial relationship between the subjects is not required.[8]

The § 1.181 petitioner (requester) recognizes that disqualification of a registered practitioner in a proceeding before the Office is "discretionary and is primarily the responsibility" of the Director.[9]

37 CFR 10.56 provides that a "practitioner should preserve the confidences and secrets of a client." 37 CFR 10.61 states that a "practitioner should exercise independent professional judgment on behalf of a client." More particularly, §§ 10.66(a) provides that proffered employment shall be declined "if it would be likely to involve the practitioner in representing different interests ...."

The Office has utilized the following standard in regard to representations of patent matters[10]:

An attorney should be disqualified if a party can show that the:
(1) attorney was its former attorney,
(2) attorney now represents an adverse party, and
(3) subject matter embraced by the present representation is "substantially related" to the subject matter where the attorney previously represented the first party.

The § 1.181 petitioner accepts such standard, while noting the recognition by the Office in *Anderson v. Eppstein* that the moving party should "bear a heavy burden of proving facts showing that disqualification is necessary," and that it is "necessary to balance the interest of a party's right to retain counsel of its choice."[11]

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case basis under such conditions as the Commissioner deems appropriate. The MPEP does not generally address Part 10, and in particular §10.130(b).

[7] *Anderson, et al., Junior Party (Patent 5,399,346) v. Eppstein et al., Senior Party (Application 08/609,702),* Disqualification Case No. 98-1, Board of Patent Appeals and Interferences, 2001 Pat App. Lexis 1.

[8] Petition at page 8.

[9] Petition at page 14. See also *SCM Corporation v. Aktieselskabet Niro Atomizer*, 212 USPQ 93 (Commissioner of Patents and Trademarks 1981) (Practitioner Cole worked for a law firm filing protests in two reissue application where Cole was not responsible for filing the protests, but had a conversation with the practitioner Stout who filed the protests. Cole now working for the law firm prosecuting the reissue applications was disqualified (notwithstanding any lack of participation by Cole in the reissue prosecution), but the law firm was not disqualified).

[10] SCM v. Aktieselskabet Niro Atomizer.

[11] At page14.

The assumption will be made where the standard is met that confidences were disclosed an inquiry will not be made into their nature and extent.[12] The Office has chosen a narrow interpretation of the expression "substantially related" to mean 'identical or essentially the same."[13]

Decision

(I) Preliminarily, Petitioner has raised the issue that a decision granting disqualification of counsel to the Third Party Protester was issued without the Office first issuing a Notice to Show Cause giving the third party an opportunity to respond to the § 1.182 petition requesting disqualification of the third party's counsel. It is noted that the decision granting the § 1.182 petition was rendered on August 10, 2005 some four months after the April 5, 2005 § 1.182 petition was filed and served on the third party. There was no requirement that the third party wait for a show cause order to issue or indeed any basis for the third party to reasonably expect that a show cause order would need to be issued prior to rendering a decision on the § 1.182 petition. Rights that are not exercised may be waived. The third party made no effort to alert the Office that it believed that there was basis to object to disqualification of its counsel and would present argument to that effect.

It is also noted that all claims have been rejected and an Action Closing Prosecution has been mailed. It would not seem useful to permit reentry of disqualified counsel for the Third Party Requester at this point in the reexamination proceeding, particularly as all claims are rejected. Additionally, there has been no showing made in the § 1.181 petition of specific harm to the Third Party Requester.

Accordingly, the instant § 1.181 petition is deemed moot.

(II) The standard identified above for disqualification is applied to the instant facts as follows (for purposes of this decision, the law firm to be disqualified and the particular partner of the law firm will be treated as a single entity identified, e.g., as disqualified counsel for the § 1.181 petitioner):

(1) Was disqualified counsel for the § 1.181 petitioner sought at one time counsel for the § 1.182 petitioner.

There were two assignees of the '672 parent application. One of the assignees, Immunomedics, is the only assignee of the (CIP) patent upon which the reexamination is directed. The other assignee of the '672 parent application, HHS, has filed the instant reexamination utilizing the counsel that prosecuted the '672 application. It is undisputed that a power of attorney was executed by an employee/inventor the § 1.182 petitioner, Immonomedics, in the '672 parent application to disqualified counsel of the § 1.181 petitioner, HHS.[14]

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[12] *Anderson v Eppstein*
[13] *Id.*
[14] Section 1.181 petition, pages 5 and 6, paragraph 19: " a power of attorney from both the HHS and Immunomedics permitting Townsend to lead the prosecution."

The § 1.181 petition although recognizing that prosecution was handled by the § 1.181 petitioner based on a power of attorney from both assignees, insists that the § 1.182 petitioner had its own counsel, and that a power of attorney does not *ipso facto* create an attorney relationship. Reference is made to *Sun Studs Inc. v. Applied Theory Assoc., Inc.*[15] and the rationales presented therein to support a finding that a power of attorney did not lead to an attorney-client relationship. The grant of the power of attorney is described as a means of facilitating communication between the § 1.181 petitioner controlling prosecution of the '672 parent application and the Office.

The § 1.181 petition exhaustively presents the details the prosecution of the '672 application to show lack of participation by the § 1.182 petitioner. Additionally, Petitioner notes that the power of attorney was given by the inventor working for the assignee and not the assignee itself.

Petitioner concludes that there are none of the usual indicia of an attorney-client relationship, such as:

- No evidence there was communication in order to obtain legal counsel or advice:
  - The § 1.182 petitioner did not allege that there was communication but only that the § 1.181 petitioner was in a position to become aware of information considered secret or confidential.
- There is no contract or memoranda or representation and no payment of fees nor was there ever a charge rendered for fees.
- The § 1.182 petitioner had their own counsel and an example provided whereby advice was given by the § 1.181 petitioner to the § 1.182 petitioner to obtain approval of their own counsel.
- There is no applied attorney-client relationship.
- There is no continuing representation.

Whether the § 1.182 petitioner was represented by counsel other than counsel for the § 1.181 petitioner is not conclusive. A party may be represented by more than one counsel in any given matter. The review of prosecution as presented by the § 1.181 petition establishes a pattern of constant consultation with the § 1.182 petitioner by the § 1.181 petitioner. For example, paragraphs 41 and 42 show the forwarding of a § 1.132 declaration and an amendment prior to submission to the Office. Prosecution of the '672 parent application was done on behalf of both assignees. An amendment affects the scope of the rights of both assignees. 35 U.S.C. 116 permits inventors to apply for a patent jointly even though each did not make a contribution to the subject matter of every claim. It is therefore conceivable that the § 1.181 petitioner was, in fact, representing only the § 1.182 petitioner in regard to one or more claims. While it is argued that the '672 application and the § 1.132 declaration were drafted by the § 1.181 petitioner, it has not been established where the information came from that was used to draft the application and declaration. It is not readily apparent why some information, even if not ultimately used in the submitted draft could not have come from the § 1.182 petitioner. Moreover, the CIP patent undergoing reexamination, contains a benefit claim to the prior '672 application. While each claim in a CIP application is independently evaluated for support before being entitled to the benefit date, the

[15] *Sun Studs Inc. v. Applied Theory Assoc., Inc.*[15] 772 F.2d 1557 (Fed. Cir. 1985); 227 U.S.P.Q. 81

specification of the CIP patent contains a substantial amount of information found in the prior patent.[16]

On balancing the rights of the § 1.181 petitioner to be represented by counsel of choice and the § 1.182 petitioner's rights not to have secret or confidential information used against it, the § 1.181 petitioner has not bolstered its case by establishing a special need to utilize counsel that was disqualified, given that disqualified counsel had a power of attorney and prosecuted patent rights in an arguably related matter.

Sun Studs Inc. v. Applied Theory Assoc., Inc does not aid the § 1.181 petitioner. The Federal Circuit held that there was only one party with an attorney-client relationship only after recognizing that there was only one assignee and it was that assignee which had the attorney-client relationship. In the instant circumstances there are two assignees with one of the assignees now seeking to attack the CIP application. Secondly, the cause of action in *Sun Studs Inc. v. Applied Theory Assoc., Inc* was an infringement suit where the issue was an infringing action and not validity of the patent claims. Defending against an infringement charge would not involve the potential for abuse of secret or confidential information as would an attack on validity of the patent in a reexamination. The ability to become aware of secret and confidential information is not insignificant under the instant circumstances. That such did not occur is only attested to by the § 1.181 petitioner without any corroborating evidence, such as agreement by the § 1.182 petitioner.

Accordingly, counsel disqualified was former counsel for the party requesting disqualification.

(2) Was the disqualified counsel representing an adverse party.

Disqualified counsel filed a request for reexamination which seeks to extinguish patent rights from the § 1.182 petitioner.

Accordingly, the disqualified counsel was representing an adverse party.

(3) Is the subject matter from which counsel was disqualified the same as or identical from to the subject matter previously represented by the currently disqualified counsel.

The § 1.182 petition notes that the specifications of the '672 parent application and the instant patent in reexamination are very similar. The claims in the parent application relate to chemical conjugates and the claims in the reexamination patent relate to fusion proteins.[17] However, both chemical conjugates and recombinant fusion proteins are disclosed in each of the application's specifications.[18] Since fusion proteins were first mentioned in the '672 application, the § 1.181 petitioner was in a position to receive valuable insight into fusion protein claims that it petitioner would not otherwise have received.[19]

The § 1.181 petition argues that there are significant differences relating to the presence of preferred antigens and antibodies in the specification of the CIP patent that are not in the

[16] Section 1.182 petition, Appendix C.
[17] Section 1,182 petition, page 10.
[18] Section 1.182 petition, page 3 and page 4 paragraph 8.
[19] Section 1.182 petition, page 10

specification of the prior patent.[20] One should not focus on the differences but on the similarities that can lead to breaches of secrets and confidential information.

In *Anderson v. Epstein* a relationship was not found between applications in a chain of benefit claims where most of the applications are continuations-in-part. It was held that an earlier application in the chain failed to essentially describe the subject matter in interference of a later application in the chain. Therefore, similar facts and legal issues were not found to be involved. Such holding cannot be translated to the instant situation where a reexamination has been filed against a patent containing some of the exact information found in the disclosure of the prior application.

Accordingly, the same subject matter is found to be present.

Based on the presence of all three elements of the standard, the original decision granting the § 1.182 petition was correct and the § 1.181 petition is dismissed.

Contact

Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or in his absence, to the undersigned at (571) 272-5407.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

[20] Section 1.191 petition, pages 25 and 26.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,062	12/03/2004	6653104	IMMU-0001	5745

37013 7590 05/07/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/07/2010

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

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Date:
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MAY 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000062
PATENT NO. : 6653104
TECHNOLOGY CENTER : 3999
ART UNIT : 3999

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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MAY 07 2010

CENTRAL REEXAMINATION UNIT

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In re Goldenberg
Inter Partes Reexamination Proceeding
Control No. 95/000,062
Filed: December 3, 2004
For: U.S. Patent No. 6,653,104

: **DECISION DISMISSING**
: **PETITION**
: **TO WAIVE PAGE**
: **LIMIT FOR**
: **APPELLANT'S BRIEF**

This is a decision on the March 25, 2010 patent owner petition entitled "PETITION UNDER 37 CFR 1.183 TO REQUEST WAIVER OF 37 CFR 1.1943(c) BRIEF LENGTH REQUIREMENT." The petition requests waiver of the 37 CFR 1.943(c) requirement that appellant's brief in an *inter partes* reexamination proceeding not exceed 30 pages or 14,000 words in length.

The proceeding and the patent owner petition are before the Office of Patent Legal Administration.

The patent owner request to waive the restrictions under 37 CFR 1.943(c) is dismissed. Patent owner's brief shall not exceed 30 pages (thirty) pages.[1]

PETITION FEE

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been charged to patent owner's Deposit Account No. 18-2056 pursuant to the authorization on page 1 of the petition.

[1] The instant decision, in section III *infra*, provides guidance on which portions of the brief are counted towards the page limit.

REVIEW OF THE RELEVANT FACTS

1. On 25 November 2003, U.S. Patent No. 6,653,104 (the '104 patent) was granted to Goldenberg.

2. On 03 December 2004, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,062 ("the '062 proceeding").

3. On 28 February 2005, an Order was granted for *inter partes* reexamination of claims 1-140 of the '104 patent.

4. The '062 proceeding has progressed to the point where, on 28 January 2010, a Right of Appeal Notice (RAN) was mailed in the '062 proceeding.

5. On 01 March 2010, patent owner filed a Notice of Appeal.

6.. On 25 March 2010 patent owner filed the instant petition under 37 CFR 1.183 entitled "PETITION UNDER 37 CFR 1.183 TO REQUEST WAIVER OF 37 CFR 1.1943(c) BRIEF LENGTH REQUIREMENT," requesting waiver of the page limit requirements of 37 CFR 1.943(c) for patent owner's appeal brief ("the petition under 37 CFR 1.183").

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

MPEP § 2667 I.B.2 provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

DECISION

I. Patent Owner's Petition of March 25, 2010

/////

In the instant petition, petitioner requests waiver of 37 CFR 1.943(c), which limits patent owner's appeal brief to thirty (30) pages or 14,000 words in length. This waiver is being requested to permit the patent owner to file an appeal brief not to exceed one hundred and thirty pages (130) pages or 84,000 words.[2] In support of waiver of the rule, patent owner submits that:

> "In the Right of Appeal Notice (RAN) in this case, the Examiner has refused entry of an amendment to incorporate a dependent claim into each of the two independent claims, which amendment would have drastically reduced the issues for appeal in this case. Patent owner's introduction of the recitation of claim 151 into claim 1, and the recitation of claim 156 into claim 2, and the cancellation of claims 51-140, 151, 156, 160 and 164-166 would have obviated 59 of the 61 pending rejections in this case. M ore particularly, it removed 28 of 30 Rejections by the examiner, and all of the 31 Third Party Requestor rejections that were adopted by the examiner in the RAN, none of which included claims 151 or 156."

Patent owner also states that the waiver is needed in this case as demonstrated by the length of the Official Actions in the case, including the length of the present RAN, which is 85 pages, and the number of references cited by the Examiner in the First Action and the ACP.[3] Moreover, patent owner states that "[p]atent owner would have to address 61 rejections and 69 documents in the Brief in only 9-12 pages."[4] Finally, patent owner identifies another reexamination proceeding where the Office has granted similar relief to other parties similarly situated.[5]

II. Analysis and findings

The instant petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. In this instance, petitioner has requested a waiver of the 30-page limit of 37 CFR 1.943(c) by

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[2] Petition under 37 CFR 1.183 at page 3.
[3] Petition under 37 CFR 1.183 at page 2.
[4] Petition under 37 CFR 1.183 at page 2.
[5] Petition under 37 CFR 1.183 at page 3 (citing *inter partes* reexamination proceeding control nos. 95/000,160).

discussing the length, number of rejections and the number of references presented in the January 28, 2010 RAN. However, an appeal brief has not been submitted concurrently with present petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c). It is to be noted that the length of the Examiner's treatment of issues is not a *per se* indication of how much length patent owner and/or requester will need. In some instances, a long examiner discussion can be rebutted by simply showing a flaw in one or more points of the discussion, using a few sentences or paragraphs to do so.

A concrete showing which petitioner could have made in support of a request for waiver of the 30-page limit of 37 CFR 1.943(c) would be an attempt to draft an appellant brief in compliance with the 30-page limit followed by submission of the resulting appellant brief that is in excess of 30 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c). Such a submission could be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner could have relied on the proposed appeal brief as justification that more pages are needed to complete the appeal brief and to set forth an accurate determination of how many additional pages are needed to complete the appeal brief.

In this instance, patent owner has provided arguments in support of why more pages are deemed necessary to complete the appeal brief, but patent owner has failed to provide a concrete basis for an accurate determination of how many additional pages are needed to complete the appeal brief. Rather, it appears patent owner is simply requesting that it be permitted to file an appeal brief with a length that has arbitrarily been selected[6], which is not a persuasive argument for the reason stated in the previous paragraph. The arbitrarily selected one hundred and thirty pages (130) pages is much greater than the eighty five (85) page RAN.

A review of the record in the '062 proceeding, including the prior patent owner responses, indicates that patent owner's previous responses in the '062 proceeding appear to be presentable within a 50-page limit of 37 CFR 1.943(b). For example, the Feb. 5, 2009 response included 29 pages of argument in response to the 82 page Dec. 5, 2008 ACP. Therefore, it is reasonable that the issues to be addressed in patent owner's appeal brief could be addressable by a brief of no more than 30 pages, as required by 37 CFR 1.943(c).

Based on the specific facts set forth in the petition under 1.183 and the particular circumstances of the '062 proceeding, patent owner has not presented sufficient evidence to show that this is an extraordinary case requiring a waiver of the 30-page limit of 37 CFR 1.943(c). Patent owner's petition under 37 CFR 1.183 is **dismissed**. Patent owner's appeal brief shall not exceed **thirty (30) pages** in length.

III. What is included or excluded from the page limit

The provisions of 37 CFR 1.943(c) have been waived to the extent that certain content, including the table of contents pages, table of case law pages, and the pages of the claims, are not counted toward the 30 page limit. *See* MPEP 2667(I)(A)(2). By its terms, 37 CFR 1.943(c) excludes

[6] *See* petition under 37 CFR 1.183 at page 3.

from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Furthermore, the sections of the appellant's briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[7] are deemed to be included in "reference materials" that do not count toward the page limits. If any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

It is to be noted, that the "Related Proceedings" appendix required by 37 CFR 41.67(c)(x) is considered "reference materials," and is excluded from the page count only insofar as it includes documents that are formally required in the appendix. Note that this requirement only covers copies of decisions rendered by a court or the Board as identified in the "Related appeals and interferences" section of the brief. Any documents that are not required to be submitted (such as Office actions, requests for reexamination, etc.) are counted toward the page limit of the brief.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is dismissed. Patent owner's appeal brief shall not exceed thirty (30) pages.

2. Pursuant to 37 CFR 41.66(b), once patent owner's appellant's brief has been properly filed, any respondent brief must be filed by respondent within one month from the date of service of the appellant's brief. By rule, the time for filing a respondent's brief may not be extended.

3. Jurisdiction over the '062 reexamination proceeding is hereby returned to the Central Reexamination Unit.

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.

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

5-6-10
Kenaapeal/length

[7] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix, and* (xi) *Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

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Alexandria, VA 22313-1450
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Rossi Kimms & McDowell, LLP
20609 Gordon Park Square
Suite 150
Ashburn, VA 20147

(For Patent Owner)

MAILED

JUN 07 2010

CENTRAL REEXAMINATION UNIT

Woodcock Washburn, LLP
Cira Centre, 12th Floor
2929 Arch St.
Philadelphia, PA 19104-2891

(For Third Party Requester)

In re Goldenberg
Inter Partes Reexamination Proceeding
Control No. 95/000,062
Filed: December 3, 2004
For: U.S. Patent No. 6,653,104

: **DECISION GRANTING**
: **PETITION**
: **TO WAIVE PAGE**
: **LIMIT FOR**
: **APPELLANT'S BRIEF**

This is a decision on the patent owner's 18 May 2010 petition entitled "RENEWED PETITION UNDER 37 CFR 1.183 TO REQUEST WAIVER OF 37 CFR 1.1943(c) BRIEF LENGTH REQUIREMENT". The petition requests waiver of the 37 CFR 1.943(c) requirement that appellant's brief in an *inter partes* reexamination proceeding not exceed 30 pages or 14,000 words in length.

The proceeding and patent owner petition are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been charged to patent owner's Deposit Account No. 18-2056 pursuant to the EFS Transmittal sheet as discussed on page 1 of the petition.

The patent owner request to waive the restrictions under 37 CFR 1.943(c) is granted, rendering patent owner's brief of May 3, 2010 page- length compliant.

REVIEW OF THE RELEVANT FACTS

1. On 25 November 2003, U.S. Patent No. 6,653,104 (the '104 patent) was granted to Goldenberg.

2. On 03 December 2004, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,062 ("the '062 proceeding").

3. On 28 February 2005, an Order was granted for *inter partes* reexamination of claims 1-140 of the '104 patent.

4. The '062 proceeding has progressed to the point where, on 28 January 2010, a Right of Appeal Notice (RAN) was mailed in the '062 proceeding.

5. On 01 March 2010, patent owner filed a Notice of Appeal.

6.. On 25 March 2010 patent owner filed a petition under 37 CFR 1.183 entitled "PETITION UNDER 37 CFR 1.183 TO REQUEST WAIVER OF 37 CFR 1.1943(c) BRIEF LENGTH REQUIREMENT", requesting waiver of the page limit requirements of 37 CFR 1.943(c) for patent owner's appeal brief ("the petition under 37 CFR 1.183").

7. On 3 May 2010, patent owner filed an appeal brief, along with a "Claim Appendix," a "Related Proceeding Appendix" and an "Evidence Appendix."

8. On 7 May 2010, the Office dismissed the 25 March 2010 petition under 37 CFR 1.183.

9. On 18 May 2010, patent owner filed the instant petition under 37 CFR 1.183 entitled "RENEWED PETITION UNDER 37 CFR 1.183 TO REQUEST WAIVER OF 37 CFR 1.1943(c) BRIEF LENGTH REQUIREMENT," requesting waiver of the page limit requirements of 37 CFR 1.943(c) for patent owner's appeal brief ("the renewed petition under 37 CFR 1.183").

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed

fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

MPEP § 2667 I.B.2 provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

DECISION

I. Patent Owner's Petition of March 25, 2010

On 7 May 2010, the Office mailed a decision dismissing patent owner's 25 March 2010 petition under 37 CFR 1.183, stating that "an appeal brief has not been submitted concurrently with present petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c). It is to be noted that the length of the examiner's treatment of issues is not a *per se* indication of how much length patent owner and/or requester will need. In some instances, a long examiner discussion can be rebutted by simply showing a flaw in one or more points of the discussion, using a few sentences or paragraphs to do so."[1] The 7 May 2010 decision also stated that "[a] concrete showing which petitioner could have made in support of a request for waiver of the 30-page limit of 37 CFR 1.943(c) would be an attempt to draft an appeal brief in compliance with the 30-page limit followed by submission of the resulting appeal brief that is in excess of 30 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c). Such a submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner could have relied on the proposed appeal brief for justification that more pages are needed to complete the appeal brief and to set forth an accurate determination of how many additional pages are needed to complete the appeal."[2]

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft a brief in compliance with the 30-page limit, and submitting the resulting brief, which is in excess of 30 pages. Further, in the renewed petition under 1.183, patent owner has substantiated its request for waiver of the 30 page limit of 37 CFR 1.943(c) with specific facts justifying an increase in the number of pages available for

[1] *See* May 7, 2010, decision at page 3.
[2] *See* May 7, 2010 decision at page 4.

patent owner to prepare a brief in response to the RAN of 28 January 2010.[3] Additionally, patent owner has provided detailed explanations of how the submitted appeal brief excludes extraneous material, and is arranged so as not to repeat information already of record, while devoting less than a quarter of a page per rejection on appeal[4]

Based on the specific facts and explanations set forth in the renewed petition under 1.183, patent owner's showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appeal brief in compliance with the 30-page limit and submitting the resulting brief, which is in excess of 30 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. In particular, the 30-page limit of 37 CFR 1.943(c) is waived to the extent that the appeal brief of 3 May 2010 exceeds the 30-page limit by 31 pages.

Accordingly, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(c) is waived as to 31 pages of the appeal brief of the patent owner's May 3, 2010 submission that exceed the 30-page limit.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is granted. The page limit of 37 CFR 1.943(c) submission is waived as to the 31 pages of the appeal brief of the patent owner's 3 May 2010 submission that exceed the 30-page limit.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit.

3. Pursuant to 37 CFR 41.66(b), since patent owner's appellant's brief is now (in view of the waiver provided via this decision) deemed properly filed, any respondent brief must be filed by respondent within one month from the date of this decision. The time for filing a respondent's brief may not be extended.

4. Jurisdiction over the '062 reexamination proceeding is hereby returned to the Central Reexamination Unit.

5. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.

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

6-7-10

[3] *See* renewed petition under 1.183 at pages 2-4
[4] *See* renewed petition under 1.183 at pages 3-6.

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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.
95/000,063	12/03/2004	6573875	8E07.7-020	7456

7590 04/08/2009

EXAMINER

Welsh & Katz, Ltd.
Attention: Eric D. Cohen, Esq.
120 South Riverside Plaza 22nd Floor
Chicago, IL 60606

ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MEHRMAN LAW OFFICE, P.C.
ATTN: MICHAEL J. MEHRMAN
5605 GLENRIDGE DRIVE, SUITE 795
ATLANTA, GA 30342

Date: MAILED

APR 0 8 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000063
PATENT NO. : 6573875
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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APR 08 2009

CENTRAL REEXAMINATION UNIT

Walter J Kawula, Jr Welsh & Katz, Ltd. Attention: Eric D. Cohen, Esq. 120 South Riverside Plaza 22nd Floor Chicago IL 60606	: : : : :	(For Patent Owner)
Michael J Mehrman MEHRMAN LAW OFFICE, P.C. P.O. BOX 420797 ATLANTA, GA 30342	: : : :	For Third Party Requester)
	: : : : :	DECISION GRANTING PETITION TO EXCERCISE SUPERVISORY AUTHORITY 37 CFR § 1.181 (a)(3) & § 1.949
In re Zimmerman *et alia* *Inter partes* Reexamination Proceeding Control No. 95/000,063 Deposited on: 3 December 2004 For: U.S. Patent No. 6,573,875	: : : : :	

This is a decision on the 23 February 2009 patent owner "Petition Pursuant to Rule 1.181" The instant petition seeks to have the Action Closing Prosecution mailed on 23 January 2009 withdrawn.

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

The petition is granted for the reasons set forth below.

CITATION OF RELEVANT FACTS

1. On 3 June 2003 US Patent No. 6,573,875 was granted to Zimmerman *et alia.*

2. On 3 December 2004 a request identified as control number 95/000,063 was deposited for *inter partes* reexamination.

3. On 28 February 2005 the order granting inter partes reexamination was mailed.

4. On 23 January 2009 an Action Closing Prosecution Office action was mailed.

5. On 23 February 2009 the instant petition was submitted.

DISCUSSION

The patent owner petitioned the Office on 23 February 2009 seeking to have the Action Closing Prosecution mailed on 23 January 2009 to be withdrawn. The petition was timely filed with a proper certificate of service. The petition is granted

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.181 Petition to the Director.

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

37 CFR § 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.

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.

DECISION REGARDING EXCERCISING SUPERVIRORY AUTHORITY

The patent owner seeks to have the Director exercise his supervisory authority pursuant to 37 CFR § 1.181 to withdraw the Action Closing Prosecution Office action mailed on 23 January 2009. Further the determination as to whether an Office action is designated as an Action Closing Prosecution is guided by 37 CFR § 1.949. According to 37 CFR § 1.949 "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."

With consideration of the relevant authority as well as the actions taken by the examiner in charge of the proceeding, the designation of the Office action mailed on 23 January 2009 as an Action Closing Prosecution is determined to be premature.

The patent owner's petition requesting the Director of the Central Reexamination Unit to exercise authority is hereby granted.

Following the time for the third party requester to once comment on the response submitted by the patent owner pursuant to 37 CFR § 1.947, the proceeding will be returned to the examiner in charge. The examiner will treat the Office action mailed on 23 January 2009 as a non-final Office action and will respond accordingly.

The designation of Action Closing Prosecution of the action mailed 23 January 2009 is hereby withdrawn

CONCLUSION

1. The patent owner's petition requesting the director of the Central Reexamination Unit to exercise authority is hereby **granted.**

2. The designation of Action Closing Prosecution of the action mailed 23 January 2009 is hereby withdrawn.

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, Supervisory Patent Examiner, in the absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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Toler, Larson & Abel, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, TX 78746

(Courtesy copy)

MAILED

AUG 1 8 2005

REEXAM UNIT

In re Amanda May
Reexamination Proceeding
Control No.: 95/000,065
Filed: May 2, 2000
For: U.S. Patent No.: 6,155,906

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

This is a decision on the June 15, 2005 patent owner petition entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)."

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

The petition fee of $1500.00 set forth in 37 CFR 1.17(m) for the instant petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 50-2469, in accordance with petitioner's authorization in the "Fee Transmittal" page submitted with the instant petition.

The petition is dismissed for the reasons set forth below.

Any request for reconsideration of this decision must be submitted within ONE (1) MONTH from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by the following:

(1) a proper response to the outstanding Office action, unless previously filed;
(2) the petition fee set forth by 37 CFR 1.17(m); and
(3) a proper statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional.

Petitioner has supplied items (2) and (3). Petitioner has **not**, however, satisfied item (1), because petitioner has **not** provided a proper response to the outstanding Office action, as will now be discussed.

A proper response (to an outstanding Office action) that includes any amendments to the claims must conform to 37 CFR 1.941, 37 CFR 1.530, and 37 CFR 1.943.

Under 37 CFR 1.941:

> "Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943."

Under 37 CFR 1.530(f) :

> "*Changes shown by markings.* Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:
> (1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and
> (2) The matter to be added by the reexamination proceeding must be underlined. "

A review of the "Reply to Office Action" included with the instant petition indicates that the claim amendments submitted by petitioner do not comply with 37 CFR 1.530(f)(1) and (f)(2). For example, the matter to be omitted in claims 9, 11, and 13-14 appears to be shown using strikethrough ,whereas subsection (f)(1) of the rule requires the matter to be enclosed in brackets. Additionally, newly added claims 15-34 are not underlined, as is required by subsection (f)(2) of the rule.

OTHER MATTERS

1. Although this petition appears to be submitted on behalf of Patent Owner by Mr. Jeffrey Toler, Mr. Toler does not currently appear in Office records as Patent Owner's representative. Although a courtesy copy of this decision is being provided to Mr. Toler, a proper authorization appointing Mr. Toler with a change of address would be required in order for Mr. Toler to receive future Office communications regarding this proceeding.

2. A brief review of the "Reply to Office Action" included with the instant petition indicates that the "Reply to Office Action" includes color illustrations. Petitioner is advised that these illustrations will not be scanned in color into the Image File Wrapper (IFW).

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **dismissed**.

2. For granting of the present petition, it is required that patent owner file a submission that provides the proper response to the Office action dated March 15, 2005.

3. If petitioner desires to make the required submission in order that the present petition be granted, the submission should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

4. Any renewed petition must be filed within **ONE (1) MONTH** of the mail date of this decision. Extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings.

5. All correspondence relating to the petition in this *inter partes* reexamination proceeding should be directed to:

By U.S. Postal Service Mail:	Central Reexamination Unit Office of Patent Legal Administration United States Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-0100 Central Reexamination Unit
By hand:	Central Reexamination Unit Randolph Building 401 Delany St. Alexandria, VA 22314

6. Telephone inquiries related to this decision should be directed to Samuel Broda, Legal Advisor, at (571) 272-7711.

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

SB
August 9, 2005

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McLean, VA 22102

(For Third Party Requestor)

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REEXAM UNIT

In re Amanda May
Reexamination Proceeding
Control No.: 95/000,065
Filed: May 2, 2000
For: U.S. Patent No.: 6,155,906

: DECISION
: GRANTING
: PETITION

This is a decision on the September 9, 2005 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR 1.137(b)."

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

The petition under 37 CFR 1.137(b) is granted.

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The renewed petition under 37 CFR 1.137(b) was filed with a Revised Reply to Office Action, thereby providing the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). This Revised Reply contains claim amendments purported to conform to 37 CFR 1.941, 37 CFR 1.530, and 37 CFR 1.943. Further, the required petition fee was previously charged to petitioner's deposit account as authorized in the original 37 CFR 1.137(b) petition filed June 15, 2005, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2).

The renewed petition under 37 CFR 1.137(b) does not include the appropriate statement pursuant to 37 CFR 1.137(b)(3) 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 37 CFR 1.137(b) was unintentional. Since this statement was included in the original 37 CFR 1.137(b) petition filed June 15, 2005, this prior statement is being construed as the statement required by 37 CFR 1.137(b)(3) in the renewed petition, and petitioner must notify the Office if this is not a correct interpretation.

Accordingly, the petition under 37 CFR 1.137(b) is granted.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is granted.

2. Jurisdiction over the reexamination proceeding is being returned to Technology Center 3700 for consideration, in due course, of the Revised Reply to Office Action filed September 9, 2005, with the renewed petition.

3. Third Party Requestor has **THIRTY (30) days** from the mailing date **of this decision** to file comments pursuant to 37 CFR 1.947, responsive to the Revised Reply to Office Action.

4. Telephone inquiries related to this decision should be directed to Samuel Broda at (571) 272-7711.

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

SB
November 8, 2005

mas

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Womble, Carlyle, Sandridge
& Rice PLLC
P.O. Box 7037
Atlanta, GA 30357-0037

MAILED

MAR 14 2005

REEXAM UNIT

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,066
Filed: December 17, 2004
For: U.S. Patent No. 6,789,673

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,069
Filed: December 3, 2004
For: U.S. Patent No. 6,789,673

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 6,789,673 (the '673 patent) issued to Lingamfelter et al on September 14, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,066 ('066), was filed December 17, 2004, by third party requester Graphic Packaging, International.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,069 ('069), was filed December 3, 2004, by third party requester MeadWestvaco Packaging Systems LLC.

4. An order granting reexamination was mailed for both of the reexamination proceedings on February 28, 2005.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '066 and reexamination proceeding are currently pending. The order to reexamine has been mailed for both 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 rational for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,066 and 95/000,069 reexamination proceedings would address these considerations. **Thus, pursuant to 37 CFR 1.989(a), the 95/000,066 and 95/000,069 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 *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-0100
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that <u>every</u> paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required <u>and are not to be submitted</u>; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to 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. 95/000,066 and *inter partes* Reexamination Control No. 95/000,069 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 for the merged proceeding.

3. Any questions concerning this communication should be directed to Anton W. Fetting in the Office of Patent Legal Administration, at (571)272-7717.

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

March 9, 2005
C:\kiva\kenpetmerger\reexreex\95_00066&69_1st_IP&IP_merger.wpd

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.
95/000,066	12/17/2004	6789673	04965.0039	7863

7590 02/26/2007

Daniel D. Chapman, Esq.
JACKSON WALKER, LLP
Suite 2100
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San Antonio, TX 78205-1521

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/26/2007

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

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Alexandria, VA 22313-1450
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FEB 26 2007

CENTRAL REEXAMINATION UNIT

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

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,066
Filed: December 17, 2004
For: U.S. Patent No. 6,789,673

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,069
Filed: December 3, 2004
For: U.S. Patent No. 6,789,673

DECISION GRANTING
PETITION UNDER
PROCEEDINGS
37 CFR 1.183

This is a decision on the February 20, 2007 patent owner petition under 37 CFR 1.183 titled "EXPEDITED PETITION TO SUSPEND RULE 37 CFR 1.943(c) PURSUANT TO THE PROVISIONS OF 37 CFR 1.183." The petition requests waiver of the 37 CFR 1.943(c) requirement that appellant briefs in an *inter partes* reexamination proceeding not exceed 30 pages, or 14000 words, in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent requested, i.e., to the extent that the page limit for the patent owner's appellant brief is extended to not exceed 45 pages, or 21,000 words, in length.

Pursuant to 37 CFR 1.17(f), the petition fee for filing a petition under 37 CFR 1.183 is $400.00. The $400.00 petition fee is being charged to petitioner's Deposit Account No. 07-2400, as authorized by the petition, on page 1, second paragraph.

REVIEW OF FACTS

1. United States Patent Number 6,789,673 (the '673 patent) issued to Lingamfelter et al on September 14, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,066 (the '066 proceeding), was filed December 17, 2004, by third party requester Graphic Packaging, International.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,069 (the '069 proceeding), was filed December 3, 2004, by third party requester Mead Westvaco Packaging Systems LLC.

4. An order granting reexamination was mailed for both of the reexamination proceedings on February 28, 2005.

5. A decision merging the '066 and '069 proceedings was mailed March 14, 2005.

6. Prosecution has progressed to the point where appellant briefs are due from parties.

7. On February 20, 2007 patent owner filed the present petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) requirement that appellant briefs in an *inter partes* reexamination proceeding not exceed 30 pages, or 14000 words, in length.

DECISION

37 CFR 1.943(c) prohibits a party in an *inter partes* reexamination proceeding from filing an appellant brief exceeding 30 pages, or 14000 words, in length. In the instant petition, the patent owner requests relief from such limitation when filing a forthcoming appellant brief. Accordingly, the petition is being addressed as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.943(c).

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(c) based, on the averments that:

> "In a 57 page non-final Action, the Examiner rejected all claims on 19 specific grounds. Some of the Requestors' grounds for rejection were accepted, some were not, and some new ones made by the Examiner that were not proposed by the Requestors."
>
> "The Examiner's rejections were maintained in an action closing prosecution, which was 180 pages in length, and extended to 19 separate grounds for rejection. Appeal was taken from a 104 page Right of Appeal Notice, reasserting the grounds for rejection set forth in the ACP."
>
> "A timely Notice of Appeal was filed by the Patent Owner and timely Notices of Cross-Appeal were filed by both third party Requestors."
>
> "There are over a dozen declarations and exhibits, many of which are referenced in the body of the brief, including exhibits relating to secondary considerations."

Petitioner asserts that it is in the interest of justice to allow the patent owner fair opportunity to address all the issues in the present merged proceeding, which can only be accomplished by suspending the appellant brief limit of 37 CFR 1.943(c).

The petition specifically states how many additional pages, beyond the permitted length, that petitioner is requesting to address the issues, i.e., that the appellant brief not exceed 45 pages, or 21,000 words, in length.

After a review of the record, and given the numerous and extensive issues in the present merged proceeding, the patent owner's requested relief is deemed reasonable. Accordingly, the Office will grant the present petition to waive 37 CFR 1.943(c) to the extent requested, as follows:

(A) The waiver is granted for <u>only</u> the patent owner's appellant brief which is presently due, and

(B) Patent owner is authorized to provide as much as forty five (45) pages or 21,000 words, for patent owner's appellant brief. The Office will enforce compliance with this new limit, and a strict review of the length of patent owner's appellant brief will be made upon its receipt.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(c) is granted to the extent requested, i.e., to the extent that the page limit for the patent owner's appellant brief is extended to not exceed 45 pages, or 21,000 words, in length.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

2-26-07
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James F. Vaughan (For 95/000,069 Requester)
Womble, Carlyle, Sandridge
& Rice PLLC
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Atlanta, GA 30357-0037

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,066
Filed: December 17, 2004
For: U.S. Patent No. 6,789,673

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,069
Filed: December 3, 2004
For: U.S. Patent No. 6,789,673

DECISION GRANTING
PETITION UNDER
PROCEEDINGS
37 CFR 1.183

This is a decision on requester Graphic Packaging's February 26, 2007 petition under 37 CFR 1.183 titled "RESPONSE OF REQUESTER II TO PATENT OWNER'S EXPEDITED PETITION TO SUSPEND RULE 37 CFR 1.943(c) PURSUANT TO THE PROVISIONS OF 37 CFR 1.183." The petition requests waiver of the 37 CFR 1.943(c) requirement that respondent briefs in an *inter partes* reexamination proceeding not exceed 15 pages, or 7000 words, in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent that the page limit for requester Graphic Packaging's respondent brief is extended to not exceed 23 pages, or 10,500 words, in length.

Pursuant to 37 CFR 1.17(f), the petition fee for filing a petition under 37 CFR 1.183 is $400.00. The $400.00 petition fee is being charged to petitioner's Deposit Account No. 09-0528, as authorized by the last paragraph of requester Graphic Packaging's petition.

REVIEW OF FACTS

1. United States Patent Number 6,789,673 (the '673 patent) issued to Lingamfelter et al on September 14, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,066 (the '066 proceeding), was filed December 17, 2004, by third party requester Graphic Packaging, International.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,069 (the '069 proceeding), was filed December 3, 2004, by third party requester Mead Westvaco Packaging Systems LLC.

4. An order granting reexamination was mailed for both of the reexamination proceedings on February 28, 2005.

5. A decision merging the '066 and '069 proceedings was mailed March 14, 2005.

6. Prosecution has progressed to the point where appellant briefs are due from parties.

7. On February 20, 2007 patent owner filed a petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) requirement that appellant briefs in an *inter partes* reexamination proceeding not exceed 30 pages, or 14000 words, in length.

8. In "response," on February 26, 2007, requester Graphic Packaging filed the present petition, pursuant to 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(c) requirement that respondent briefs in an *inter partes* reexamination proceeding not exceed 15 pages, or 7000 words, in length.

8. A decision has been issued granting patent owner's February 20, 2007 petition under 37 CFR 1.183, to the extent requested by patent owner, i.e., to the extent that the page limit for the patent owner's appellant brief has been extended to not exceed 45 pages, or 21,000 words, in length.

DECISION

37 CFR 1.943(c) prohibits a party in an *inter partes* reexamination proceeding from filing a respondent brief exceeding 15 pages, or 7000 words, in length. In the instant petition, requester Graphic Packaging requests relief from such limitation when filing a forthcoming respondent brief. The relief is requested for both of the third party requesters of record in this merged reexamination proceeding. [1] Accordingly, the petition is being addressed as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.943(c).

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(c) based, on the argument that, if patent owner's petition for waiver is granted, then, "in the interest of fairness," requester Graphic Packaging's petition for waiver should likewise be granted. Petitioner points out that requester must address the same extensive record that patent owner must address, and must address patent owner's longer (by virtue of the waiver) brief. While it is not yet established that patent owner will take advantage of the waiver to lengthen the brief, it is reasonable to assume that patent owner will do so (since patent owner would not have incurred the expenses of its waiver petition otherwise). Further, the record is, in fact, equally extensive for both parties. Accordingly, it is appropriate to grant a length-extension to requester Graphic Packaging for its respondent brief.

The petition does not specifically state how many additional pages, beyond the permitted length, that petitioner is requesting; however, it does request (in the penultimate paragraph) that "the limit on the length of the Respondent Briefs be **correspondingly** waived." [Emphasis added.] Patent owner asked for, and received, authorization to provide as much as 45 pages, or 21,000 words, for patent owner's appellant brief. This represents a factor of 1.5 times the 30-page or 14000-word limit set in 37 CFR 1.943(c) for appellant briefs. In like manner, **requester Graphic Packaging** will receive authorization to provide as much as 23 pages, or 10,500 words, in length for its respondent brief. This too represents a factor of 1.5 times the limit set in 37 CFR 1.943(c) for respondent briefs, i.e., 15 pages or 7000 words.[2]

Requester Mead Westvaco Packaging Systems has not filed petition for waiver of 37 CFR 1.943(c) for respondent briefs, and has not paid the $400.00 petition fee to address the additional resources expended by the Office if a waiver would be granted. Accordingly, it is not appropriate to grant a length-extension to requester Mead Westvaco Packaging Systems for any forthcoming respondent brief.

In view of the above, and the facts and circumstances of the present merged proceeding, the Office will grant the present petition to waive 37 CFR 1.943(c) as follows:

(A) The waiver is granted for only the **requester Graphic Packaging's** respondent brief which may be filed, should patent owner file an appellant brief in this proceeding, and

[1] At page 2 of the petition (line 7), reference is made to "Requesters' Respondent Briefs."
[2] For pages: 15 x 1.5 = 22.5, which rounds to 23. For words, 7000 x 1.5 = 10,500.

(B) Requester Graphic Packaging is authorized to provide as much as twenty three (23) pages or 10,500 words, for its respondent brief, in the event such is filed. The Office will enforce compliance with this new limit, and a strict review of the length of any such respondent brief will be made upon its receipt. It is to be noted, that pursuant to 37 CFR 1.943(c), if the page limit for any brief is exceeded, "a certificate is required stating the number of words contained in the brief."

(C) Requester Mead Westvaco Packaging Systems will be held to the regulatory 15-page or 7000-word limit.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(c) is granted to the extent that the length of any forthcoming requester Graphic Packaging respondent brief is extended to not exceed 23 pages, or 10,500 words, in length.

2. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(c) is dismissed as to providing any waiver with respect to any requester Mead Westvaco Packaging Systems respondent brief that may be filed.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

4. Telephone inquiries with regard to this 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
Office of the Deputy Commissioner
for Patent Examining Policy

3-5-07
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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.
95/000,067	12/20/2004	6554446	108-0184	8558

7590 08/29/2008

EXAMINER

Gordon E. Gray, III
GRAY LAW FIRM
4401 N. Atlantic Avenue
Suite 223
Long Beach, CA 90807

ART UNIT	PAPER NUMBER

DATE MAILED: 08/29/2008

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

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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
KLEIN, O'NEILL & SINGH, LLP
43 CORPORATE PARK
SUITE 204
IRVINE, CA 92606

Date:
MAILED
AUG 29 2008
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000067
PATENT NO. : 6554446
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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AUG 29 2008

CENTRAL REEXAMINATION UNIT

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Long Beach, California 90807

(For Patent Owner)

Howard Klein
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43 Corporate Park
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Irvine, California 92606

(For Requester)

In re Walsh et al.
Reexamination Proceeding
Control No.: 95/000,067
Filed: January 3, 2000
For: U.S. Patent No.: 6,544,446

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

This is a decision on the August 20, 2008 patent owner petition entitled "PETITION FOR REVIVAL OF AN INTER PARTES PATENT REEXAMINATION PROSECUTION UNDER 37 CFR 1.137(B). " The petition is being treated as a petition under 37 CFR 1.958(b) to revive the *inter partes* reexamination prosecution, and under 37 CFR 1.137(b) to accept the response to the May 20, 2008 Office Action as having been unintentionally delayed.

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

The petition is granted.

DECISION

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, this proceeding ceased to be pending because its prosecution became "terminated" within the meaning of 37 CFR 1.957(b) after July 20, 2008, for failure of petitioner to timely file a proper response within the meaning of 37 CFR 1.113 to the non-final Office action of May 20, 2008. [1]

37 CFR 1.958(b) incorporates the requirements of 37 CFR 1.137(b) for revival of an *inter partes* reexamination proceeding that was terminated (or limited) due to an unintentionally delayed

[1] In all *inter partes* reexamination proceedings, examination is conducted in accordance with §§ 1.104 through 1.116 of Title 37 of the Code of Federal Regulation. See 37 CFR 1.937(b).

response by patent owner. The present petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the response (which is equivalent to the reply in an application) has been received in the form of a paper entitled "RESPONSE TO OFFICE ACTION IN INTER PARTES REEXAMINATION"; (2) the petition fee of $1540 has been paid; and (3) the required statement of unintentional delay has been made in the petition. Accordingly, the response to the Office Action of May 20, 2008 is accepted as having been unintentionally delayed.

CONCLUSION

1. The petition under 37 CFR 1.958(b) and 37 CFR 1.137(b) is **granted**.

2. Patent owner's response to the May 20, 2008 Office action is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947.

3. Accordingly, third party requester may file comments to patent owner's response as per 37 CFR 1.947 **within 30 days** of the mailing date **of this decision**.

4. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for entry of the patent owner response and to await the third party requester's comments under 37 CFR 1.947, or the expiration of the time for filing the comments.

5. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

Kenneth M. Schor

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

08-28-08
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(For Patent Owner)

MAILED

FEB 28 2007

CENTRAL REEXAMINATION UNIT

Kenneth C. Booth
Schmeiser, Olsen & Watts, LLP
18 E. University Dr., #101
Mesa, AZ 85201

(For Third Party Requester)

In re Reexamination Proceeding	:
Friel et al.	:
Control No. 95/000,068	: DECISION WAIVING 37 CFR 1.52
Filed: December 27, 2004	: AND
U.S. Patent No. 6,531,537	: DENYING REQUEST FOR REFUND
Attorney Docket No. MICR-10420	:

This is a decision on the Request For Refund filed January 17, 2007, by Third Party Requester requesting a refund of the petition fee paid for the petition under 37 CFR 1.183 regarding papers filed via EFS-Web.

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

DECISION

37 CFR 1.183 Suspension of rules.

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1:17(f).

Legal Framework for EFS-Web (http://www.uspto.gov/ebc/portal/efs/legal.htm) states, in part, the following:

> *EFS-Web*
>
> *Improper Use of Web Pages*
>
> The published waiver of 37 CFR 1.52 mentioned in the Official Gazette notice (240 OG 45, 14 November 2000) is contingent on applicant's conformance to the instructions for use of EFS-Web. Use of EFS-Web in a manner significantly in violation of the instructions may result in non-entry of the submission or failure to accord a filing date (e.g. attempted submission of documents specifically proscribed by the instructions) in the event the USPTO does not fully, successfully, and officially receive all of the elements necessary to obtain a filing date for an intended submission once the applicant clicks the SUBMIT button on the Confirm

> and Submit screen.
>
> . . .
>
> *Documents Policy*
>
> EFS-Web will allow registered users to file both new submissions and follow-on documents. **The following is a list of submission types that are not allowed to be filed using EFS-Web:**
>
> . . .
>
> 3) **A request for reexamination under 37 CFR § 1.510 or §1.913 and any other documents related to reexaminations. See, e.g., 37 CFR § 1.6(d)(5).**
>
> **[Emphasis Added]**

On December 28, 2006, "Comments On Response To Action Closing Prosecution" (correspondence) were filed via EFS-Web.

On January 16, 2007 (confirmed in a telephone communication on January 17, 2007), counsel, Lori Cuomo for the Third Party Requester authorized the charging of a $400.00 petition fee to her deposit account for a petition under 37 CFR 1.183 to waive 37 CFR 1.52 regarding the correspondence filed December 28, 2006, via EFS-Web.

Thereafter, on January 17, 2007, the present Request For Refund was filed by the Third Party Requester stating that the correspondence was filed via EFS-Web on December 28, 2006, per the instructions of the EFS Help Desk. Accordingly, petitioner alleges that there was no error on counsel's part, and requests that the correspondence filed via EFS-Web on December 28, 2007, be treated as being properly filed. Petitioners request a refund of the $400.00 petition fee.

A review of the record reveals that on December 28, 2006, reexamination proceeding correspondence was submitted to the Office via EFS-Web. Reexamination proceeding papers, however, are not permitted to be submitted to the Office by EFS-Web (Note the portion of the Legal Framework for EFS-Web reproduced above). Thus, the reexamination proceeding papers are not in compliance with 37 CFR 1.52.

In order to avoid loss of any patent rights and in view of processing delays by the Office, justice requires, in this instance and based on the present facts, that 37 CFR 1.52 be waived pursuant to 37 CFR 1.183, to the extent that the above-identified reexamination proceeding papers submitted by EFS-Web be considered as being properly submitted to the Office.

Parties are put on notice that further reexamination proceeding papers submitted to the Office by EFS-Web, will not be accepted, and such may result in loss of rights.

CONCLUSION

1. 37 CFR 1.52 is hereby <u>waived</u> to accept the correspondence filed December 28, 2006, as being properly submitted.

2. The request for refund is <u>denied</u>, as the present petition and petition fee were necessitated by the Third Party Requester's filing error.

3. The reexamination proceeding papers submitted by EFS-Web on December 28, 2006, are now accepted as being properly submitted to the Office.

4. $400.00 has been charged to counsel's deposit account no. 19-0513 in accordance with the January 16, 2007, authorization.

5. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) 3991.

6. The reexamination proceeding papers (correspondence) submitted by EFS-Web on December 28, 2006, will be considered in due course.

6. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Alan Diamond, in CRU Art Unit 3991, who can be reached at 571-272-1338.

7. Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor

Conferee: Kenneth M. Schor, Senior Legal Advisor

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

MAILED

MAR 14 2005

REEXAM UNIT

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,066
Filed: December 17, 2004
For: U.S. Patent No. 6,789,673

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,069
Filed: December 3, 2004
For: U.S. Patent No. 6,789,673

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 6,789,673 (the '673 patent) issued to Lingamfelter et al on September 14, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,066 ('066), was filed December 17, 2004, by third party requester Graphic Packaging, International.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,069 ('069), was filed December 3, 2004, by third party requester MeadWestvaco Packaging Systems LLC.

4. An order granting reexamination was mailed for both of the reexamination proceedings on February 28, 2005.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '066 and reexamination proceeding are currently pending. The order to reexamine has been mailed for both 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 rational for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,066 and 95/000,069 reexamination proceedings would address these considerations. **Thus, pursuant to 37 CFR 1.989(a), the 95/000,066 and 95/000,069 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 *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-0100
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that <u>every</u> paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required <u>and are not to be submitted</u>; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to 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. 95/000,066 and *inter partes* Reexamination Control No. 95/000,069 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 for the merged proceeding.

3. Any questions concerning this communication should be directed to Anton W. Fetting in the Office of Patent Legal Administration, at (571)272-7717.

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

March 9, 2005
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,069	12/03/2004	6789673	RO297004	8092

7590 02/26/2007

Daniel. D. Chapman, Esq.
JACKSON WALKER, LLP
112 E. Pecan Street
Suite 2100
San Antonio, TX 78205-1521

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/26/2007

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

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CENTRAL REEXAMINATION UNIT

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In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,066
Filed: December 17, 2004
For: U.S. Patent No. 6,789,673

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,069
Filed: December 3, 2004
For: U.S. Patent No. 6,789,673

DECISION GRANTING
PETITION UNDER
PROCEEDINGS
37 CFR 1.183

This is a decision on the February 20, 2007 patent owner petition under 37 CFR 1.183 titled "EXPEDITED PETITION TO SUSPEND RULE 37 CFR 1.943(c) PURSUANT TO THE PROVISIONS OF 37 CFR 1.183." The petition requests waiver of the 37 CFR 1.943(c) requirement that appellant briefs in an *inter partes* reexamination proceeding not exceed 30 pages, or 14000 words, in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent requested, i.e., to the extent that the page limit for the patent owner's appellant brief is extended to not exceed 45 pages, or 21,000 words, in length.

Pursuant to 37 CFR 1.17(f), the petition fee for filing a petition under 37 CFR 1.183 is $400.00. The $400.00 petition fee is being charged to petitioner's Deposit Account No. 07-2400, as authorized by the petition, on page 1, second paragraph.

REVIEW OF FACTS

1. United States Patent Number 6,789,673 (the '673 patent) issued to Lingamfelter et al on September 14, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,066 (the '066 proceeding), was filed December 17, 2004, by third party requester Graphic Packaging, International.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,069 (the '069 proceeding), was filed December 3, 2004, by third party requester Mead Westvaco Packaging Systems LLC.

4. An order granting reexamination was mailed for both of the reexamination proceedings on February 28, 2005.

5. A decision merging the '066 and '069 proceedings was mailed March 14, 2005.

6. Prosecution has progressed to the point where appellant briefs are due from parties.

7. On February 20, 2007 patent owner filed the present petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) requirement that appellant briefs in an *inter partes* reexamination proceeding not exceed 30 pages, or 14000 words, in length.

DECISION

37 CFR 1.943(c) prohibits a party in an *inter partes* reexamination proceeding from filing an appellant brief exceeding 30 pages, or 14000 words, in length. In the instant petition, the patent owner requests relief from such limitation when filing a forthcoming appellant brief. Accordingly, the petition is being addressed as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.943(c).

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(c) based, on the averments that:

> "In a 57 page non-final Action, the Examiner rejected all claims on 19 specific grounds. Some of the Requestors' grounds for rejection were accepted, some were not, and some new ones made by the Examiner that were not proposed by the Requestors."
>
> "The Examiner's rejections were maintained in an action closing prosecution, which was 180 pages in length, and extended to 19 separate grounds for rejection. Appeal was taken from a 104 page Right of Appeal Notice, reasserting the grounds for rejection set forth in the ACP."
>
> "A timely Notice of Appeal was filed by the Patent Owner and timely Notices of Cross-Appeal were filed by both third party Requestors."
>
> "There are over a dozen declarations and exhibits, many of which are referenced in the body of the brief, including exhibits relating to secondary considerations."

Petitioner asserts that it is in the interest of justice to allow the patent owner fair opportunity to address all the issues in the present merged proceeding, which can only be accomplished by suspending the appellant brief limit of 37 CFR 1.943(c).

The petition specifically states how many additional pages, beyond the permitted length, that petitioner is requesting to address the issues, i.e., that the appellant brief not exceed 45 pages, or 21,000 words, in length.

After a review of the record, and given the numerous and extensive issues in the present merged proceeding, the patent owner's requested relief is deemed reasonable. Accordingly, the Office will grant the present petition to waive 37 CFR 1.943(c) to the extent requested, as follows:

(A) The waiver is granted for <u>only</u> the patent owner's appellant brief which is presently due, and

(B) Patent owner is authorized to provide as much as forty five (45) pages or 21,000 words, for patent owner's appellant brief. The Office will enforce compliance with this new limit, and a strict review of the length of patent owner's appellant brief will be made upon its receipt.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(c) is granted to the extent requested, i.e., to the extent that the page limit for the patent owner's appellant brief is extended to not exceed 45 pages, or 21,000 words, in length.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

2-26-07
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In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,066
Filed: December 17, 2004
For: U.S. Patent No. 6,789,673

In re Lingamfelter et al
Inter partes Reexamination Proceeding
Control No. 95/000,069
Filed: December 3, 2004
For: U.S. Patent No. 6,789,673

DECISION GRANTING
PETITION UNDER
PROCEEDINGS
37 CFR 1.183

This is a decision on requester Graphic Packaging's February 26, 2007 petition under 37 CFR 1.183 titled "RESPONSE OF REQUESTER II TO PATENT OWNER'S EXPEDITED PETITION TO SUSPEND RULE 37 CFR 1.943(c) PURSUANT TO THE PROVISIONS OF 37 CFR 1.183." The petition requests waiver of the 37 CFR 1.943(c) requirement that respondent briefs in an *inter partes* reexamination proceeding not exceed 15 pages, or 7000 words, in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent that the page limit for requester Graphic Packaging's respondent brief is extended to not exceed 23 pages, or 10,500 words, in length.

Pursuant to 37 CFR 1.17(f), the petition fee for filing a petition under 37 CFR 1.183 is $400.00. The $400.00 petition fee is being charged to petitioner's Deposit Account No. 09-0528, as authorized by the last paragraph of requester Graphic Packaging's petition.

REVIEW OF FACTS

1. United States Patent Number 6,789,673 (the '673 patent) issued to Lingamfelter et al on September 14, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,066 (the '066 proceeding), was filed December 17, 2004, by third party requester Graphic Packaging, International.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,069 (the '069 proceeding), was filed December 3, 2004, by third party requester Mead Westvaco Packaging Systems LLC.

4. An order granting reexamination was mailed for both of the reexamination proceedings on February 28, 2005.

5. A decision merging the '066 and '069 proceedings was mailed March 14, 2005.

6. Prosecution has progressed to the point where appellant briefs are due from parties.

7. On February 20, 2007 patent owner filed a petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) requirement that appellant briefs in an *inter partes* reexamination proceeding not exceed 30 pages, or 14000 words, in length.

8. In "response," on February 26, 2007, requester Graphic Packaging filed the present petition, pursuant to 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(c) requirement that respondent briefs in an *inter partes* reexamination proceeding not exceed 15 pages, or 7000 words, in length.

8. A decision has been issued granting patent owner's February 20, 2007 petition under 37 CFR 1.183, to the extent requested by patent owner, i.e., to the extent that the page limit for the patent owner's appellant brief has been extended to not exceed 45 pages, or 21,000 words, in length.

DECISION

37 CFR 1.943(c) prohibits a party in an *inter partes* reexamination proceeding from filing a respondent brief exceeding 15 pages, or 7000 words, in length. In the instant petition, requester Graphic Packaging requests relief from such limitation when filing a forthcoming respondent brief. The relief is requested for both of the third party requesters of record in this merged reexamination proceeding. [1] Accordingly, the petition is being addressed as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.943(c).

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(c) based, on the argument that, if patent owner's petition for waiver is granted, then, "in the interest of fairness," requester Graphic Packaging's petition for waiver should likewise be granted. Petitioner points out that requester must address the same extensive record that patent owner must address, and must address patent owner's longer (by virtue of the waiver) brief. While it is not yet established that patent owner will take advantage of the waiver to lengthen the brief, it is reasonable to assume that patent owner will do so (since patent owner would not have incurred the expenses of its waiver petition otherwise). Further, the record is, in fact, equally extensive for both parties. Accordingly, it is appropriate to grant a length-extension to requester Graphic Packaging for its respondent brief.

The petition does not specifically state how many additional pages, beyond the permitted length, that petitioner is requesting; however, it does request (in the penultimate paragraph) that "the limit on the length of the Respondent Briefs be **correspondingly** waived." [Emphasis added.] Patent owner asked for, and received, authorization to provide as much as 45 pages, or 21,000 words, for patent owner's appellant brief. This represents a factor of 1.5 times the 30-page or 14000-word limit set in 37 CFR 1.943(c) for appellant briefs. In like manner, **requester Graphic Packaging** will receive authorization to provide as much as 23 pages, or 10,500 words, in length for its respondent brief. This too represents a factor of 1.5 times the limit set in 37 CFR 1.943(c) for respondent briefs, i.e., 15 pages or 7000 words.[2]

Requester Mead Westvaco Packaging Systems has not filed petition for waiver of 37 CFR 1.943(c) for respondent briefs, and has not paid the $400.00 petition fee to address the additional resources expended by the Office if a waiver would be granted. Accordingly, it is not appropriate to grant a length-extension to requester Mead Westvaco Packaging Systems for any forthcoming respondent brief.

In view of the above, and the facts and circumstances of the present merged proceeding, the Office will grant the present petition to waive 37 CFR 1.943(c) as follows:

(A) The waiver is granted for only the **requester Graphic Packaging's** respondent brief which may be filed, should patent owner file an appellant brief in this proceeding, and

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[1] At page 2 of the petition (line 7), reference is made to "Requesters' Respondent Briefs."
[2] For pages: 15 x 1.5 = 22.5, which rounds to 23. For words, 7000 x 1.5 = 10,500.

(B) Requester Graphic Packaging is authorized to provide as much as twenty three (23) pages or 10,500 words, for its respondent brief, in the event such is filed. The Office will enforce compliance with this new limit, and a strict review of the length of any such respondent brief will be made upon its receipt. It is to be noted, that pursuant to 37 CFR 1.943(c), if the page limit for any brief is exceeded, "a certificate is required stating the number of words contained in the brief."

(C) Requester Mead Westvaco Packaging Systems will be held to the regulatory 15-page or 7000-word limit.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(c) is granted to the extent that the length of any forthcoming requester Graphic Packaging respondent brief is extended to not exceed 23 pages, or 10,500 words, in length.

2. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(c) is dismissed as to providing any waiver with respect to any requester Mead Westvaco Packaging Systems respondent brief that may be filed.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

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

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

3-5-07
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SEP 14 2005
REEXAM UNIT

Christopher C. Campbell (For Requester)
Hunton & Williams LLP
1751 Pinnacle Drive
Suite 1700
McLean, VA 22102-3836

In re Allan, et al.	:
Reissue Application No.: 11/117,774	:
Filed: April 29, 2005	: DECISION GRANTING PETITION
For: U.S. Patent No. 6,553,611	: UNDER 37 CFR 1.182 FOR STAY OF
	: REISSUE, AND DISMISSING PETITION
	: UNDER 37 CFR 1.182 FOR MERGER
In re Huebsch, et al.	: OF REISSUE APPLICATION AND
Inter Partes Reexamination Proceeding	: *INTER PARTES* REEXAMINATION
Control No. 95/000,070	: PROCEEDING
Filed: January 7, 2005	:
For: U.S. Patent No. 6,553,611	:

This is a decision on the third party requester's June 22, 2005 petition titled "PETITION PURSUANT TO 37 CFR § 1.182 AND MPEP § 2686.03(V) FOR STAY OF CO-PENDING REISSUE APPLICATION EXAMINATION," in which it is requested that the Office suspend the proceedings in reissue application no. 11/117,774, which is co-pending with *inter partes* reexamination proceeding control no. 95/000,070.

This is also a decision on the patent owner's June 30, 2005 petition titled "PETITION PURSUANT TO 37 CFR § 1.182 AND MPEP § 2686.03(V) FOR MERGER OF CO-PENDING REISSUE APPLICATION CLAIMS 1-4", in which it is requested that the Office merge the 11/117,774, reissue application with the 95/000,070 *inter partes* reexamination proceeding.

A third party requester paper was filed July 1, 2005, in opposition to the patent owner's June 30, 2005 petition for merger of co-pending reissue application claims 1-4.

The third party requester's petition to suspend the reissue, the patent owner's petition to merge the reissue with the *inter partes* reexamination proceeding, the third party requester's opposition to the patent owner's petition, and the record as a whole, are before the Director of the Office of Patent Legal Administration.

SUMMARY

- The third party requester's June 22, 2005 petition for suspension of the copending reissue application examination is granted.
- The patent owner's June 30, 2005 petition for merger of the copending reissue application with the *inter partes* reexamination proceeding is dismissed.
- The prosecution of patent owner's reissue application no. 11/117,774 is hereby suspended pending the conclusion of the *inter partes* reexamination proceeding control no. 95/000,070 by the issuance of a reexamination certificate.
- The patent owner's provisional election of claims 1-4 in copending reissue application no. 11/117,774 has been placed in the file, but action has not been taken as to the election as it is premature.

REVIEW OF FACTS

1. On April 29, 2003, U.S. Patent No. 6,553,611 (the '611 patent) issued to Huebsch et al.
2. On January 7, 2005, a request for *inter partes* reexamination of the '611 patent was filed by a third party requester, [1] and the resulting reexamination proceeding was assigned control number 95/000,070 (the '070 proceeding).
3. On February 15, 2005, notice of the filing of the *inter partes* reexamination was published in the *Official Gazette*.
4. On March 15, 2005, the Office mailed, for the '070 proceeding, an order granting the reexamination request, accompanied by a first Office action on the merits.
5. On April 29, 2005, the patent owner filed a "broadening" reissue application for reissue of the '611 patent. The application was assigned application number 11/117,774 (the '774 application). New claims 3-16 [2] are provided in the reissue application.

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[1] Portage Electric Products is identified as the real party in interest.

[2] Claims 3-16 are not present in the '611 patent.

6. On June 15, 2005, the patent owner filed a response to the March 15, 2005 non-final Office action issued for the '070 *inter partes* reexamination proceeding. None of the '611 patent claims were amended, and no new claims were added.

7. On June 22, 2005, the third party requester filed the instant petition under 37 CFR 1.182 requesting the Office to suspend the examination of the '774 reissue application, pending completion of the '070 *inter partes* reexamination proceeding.

8. On June 28, 2005, notice of the filing of the '774 reissue application was published in the *Official Gazette.*

9. On June 30, 2005, the patent owner filed the instant petition under 37 CFR 1.182 requesting the Office to merge the '774 copending reissue application claims 1-4 with the '070 *inter partes* reexamination proceeding.

10. Also on June 30, 2005, the patent owner filed a provisional election of claims 1-4 in the '774 co-pending reissue application, in anticipation of a restriction requirement.

11. On July 1, 2005, the third party requester filed a paper, entitled "Third Party Requester's Response to Patent Owner's Petition for Merger of Co-Pending Reissue Application Claims 1-4." This paper was filed as an opposition to the patent owner's June 30, 2005 petition under 37 CFR 1.182 in the '070 *inter partes* reexamination proceeding.

12. On July 14, 2005, the third party requester filed comments on the March 15, 2005 non-final Office action and the June 15, 2005 patent owner's response in the '070 *inter partes* reexamination proceeding.

DECISION

I. Petition by Patent Owner for Merger of Co-Pending Reissue Application Claims 1-4 and Third Party Requester's Response to Patent Owner's Petition for Merger

The patent owner requests a merger of the examination of claims 1-4 of the '774 reissue application with the copending '070 *inter partes* reexamination proceeding.

In presenting patent owner's position, the patent owner admits that newly added claims 3 and 4 are broader in scope than the claims of the issued patent. The patent owner, however, argues that the issues raised by newly added (broadened) claims 3 and 4 of the reissue application are substantially the same as those raised by the claims of the issued patent, except for the omitted limitation of the location of the "thermal cutoff assembly" feature. The patent owner urges that this feature would not be considered suitable for vacuum cleaner applications, regardless of where it is located, for the reasons provided in the patent owner's response to the March 15, 2005 non-final Office action in the '070 *inter partes* reexamination proceeding. Consequently, the patent owner believes that it would be proper to consider the issues raised by claims 3 and 4 of the '774 copending reissue

application in the '070 *inter partes* reexamination proceeding (if the two proceedings are merged).

To counter the patent owner's position, the third party requester, in response to patent owner's petition for merger, draws attention to MPEP § 2686.03 II C, which states, in pertinent part:

> "In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination third party requester. If such issues are raised, merger would ordinarily **not** be ordered, and one of the two proceedings stayed. In addition, consideration will also be given to the status of the reexamination proceeding."

The third party requester requests that patent owner's petition not be granted, since patent owner seeks relief which is precluded by law. The third party requester points to 35 U.S.C. 314(a), which provides, in pertinent part:

> "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).

The third party asserts that the requested merger of the instant reissue and *inter partes* reexamination proceedings would include the scope-enlarging claims of the reissue application for consideration in the *inter partes* reexamination proceeding, and that would be contrary to 35 U.S.C. 314(b).

After a review of the arguments, and the record as a whole, the patent owner's position is not persuasive, and the requested merger will not be granted.

Pursuant to 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."

The decision to merge, or not to merge, the *inter partes* reexamination and reissue proceedings **is discretionary**. Looking at the present situation, the following is noted:

The merger proposed by the patent owner would permit a third party (the *inter partes* reexamination requester) to comment on broadened claims, and to participate in the appeal process as to such claims,[3] while the reissue and reexamination statutes do not provide such a right of third

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[3] The rights of the *inter partes* reexamination requester to comment during the merged proceeding and to participate in the appeal process cannot be annulled, since they are required by statute, i.e., 35 U.S.C. 314(b) and 35 U.S.C. 315(b) respectively.

party comment and participation. Further, the effect and intent of the *inter partes* reexamination statue (35 U.S.C. 314(a)) is to preclude any third party requester comment and participation as to the broadened claims. Third party requester input as to the broadened claims presented by the '774 reissue application, and Office consideration of that input, is, accordingly, not within the scope of *inter partes* reexamination nor is it provided for elsewhere by statute. Rather, combining the instant *inter partes* reexamination with the broadening '774 reissue application would be in violation of the statute.

The main (focal) point here is that third party requester input, and Office consideration of same, as to the broadened claims *per se* is not within the scope of *inter partes* reexamination, since the *inter partes* reexamination statute precludes same. The merger of the *inter partes* reexamination with the reissue proceeding would permit and provide for such input and consideration as to claims 3-16 of the reissue application, in violation of the statute; [4] thus, the patent owner's June 30, 2005 petition for merger must be dismissed.

As an additional point of discussion, the third party requester asserts that the requested merger is inappropriate in light of the patent owner's addition, by way of preliminary amendment in the reissue proceeding, of an entirely new set of claims (claims 5-16) directed to subject matter (i.e., a "vacuum cleaner filter assembly") other than that which is claimed in the issued patent. The third party requester asserts that requester "has nothing to say about th[e] newly added set of claims in the reissue application relating to a 'vacuum cleaner filter assembly'." In actuality, the patent owner states that patent owner seeks to "streamline the examination of [r]eissue [a]pplication claims 1-4 by provisionally electing claims 1-4 in the [r]eissue [a]pplication and merging them into this reexamination." In an effort to accomplish this, patent owner provides a provisional election of claims 1-4 of the '774 copending reissue application (in anticipation of a restriction requirement). Thus, the patent owner is apparently seeking to eliminate the presence of the new set of claims 5-16 as an issue for consideration as to the question of merger. For the reasons stated in Part III below, however, claims 5-16 are not withdrawn from consideration in the reissue proceeding, and any response by the patent owner as to an Office position taken adverse to claims 5-16 would be open to comment by the third party requester.

II. Petition by Third Party Requester for Suspension of Copending Reissue Application Examination

The third party requester petitions for a suspension of the examination of copending reissue application no. 11/117,774, pending completion of the '070 *inter partes* reexamination proceeding.

The third party requester asserts that consideration of the broadened newly added claims 3 and 4 of the '774 copending reissue application creates the risk that both the Office and the patent owner may take inconsistent positions in the reissue application and the *inter partes* reexamination proceeding. The third party requester urges that inconsistency can be avoided by permitting the reexamination proceeding to proceed with special dispatch, while suspending action in the reissue proceeding.

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[4] Even if broadening claims were not presently included in the reissue application, the applicant/patent owner could provide same at some future point in the prosecution.

The requester's petition will be granted, based on the following:

It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '611 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 addition, in the present instance, 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 would run contrary to the intent of the *inter partes* reexamination statute.

Given that the examination of the instant reissue and reexamination proceedings will not be conducted separately and at the same time, and will not be merged for the reasons stated above, the question remains as to which of the two proceedings should proceed, and which should be suspended.

To answer to this question, it is initially observed that the reexamination proceeding may not be suspended. The reexamination proceeding must proceed at this time, since there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceeding (pursuant to 35 U.S.C. 314(c)). The patent owner argues, in its petition for merger, that the suspension of the reissue application sought by the third party requester would defeat the "special" status accorded to reissue applications, referring to 37 CFR 1.176 and MPEP § 1440. In response, while a "special" status is accorded to reissue applications by rule, such is not provided by statute. On the other hand, 35 U.S.C. 314(c) does provide the *statutory* requirement that reexamination proceedings must be conducted with special dispatch. The examination of the reexamination proceeding therefore must take precedence. See also MPEP 2661.

In addition, in this instance, the *inter partes* reexamination is the first-filed proceeding (prior to the filing of the reissue application). It would not be equitable to permit a reissue proceeding filed after a reexamination request to delay the resolution of that reexamination request.

It is observed that the later-filed reissue application was filed for the purpose of broadening the patent prior to the expiration of the statutory period for broadening the patent claims, i.e., two years from the patent grant. A suspension of the reissue application will not interfere with that purpose, since the patent owner's right to have the broadened claims considered by the Office will be preserved. At the same time, the broadened claims in the suspended reissue application will be kept beyond the reach of the third party requester's comments.

The patent owner further urges, in its petition to merge, that if an order to stay (suspend) the reissue application is granted, the Office will necessarily have to revisit the issues presented by claims 1-4 of the reissue application at the conclusion of the *inter partes* reexamination proceeding. Once the *inter partes* reexamination has concluded and the suspension of the examination of the reissue application is lifted, however, the patent owner is required to amend the reissue application to reflect

any changes made to the original patent via the reexamination certificate. [5]

In view of the above, it is deemed appropriate that the reexamination proceeding continue with special dispatch (as required by 35 U.S.C. 314(c)) to its conclusion with the issuance of a reexamination certificate, and that the reissue proceeding be suspended. Accordingly, the third party requester's June 22, 2005 petition under 37 CFR 1.182 for suspension of the copending reissue application examination is granted. The prosecution of reissue application number 11/117,774 is hereby suspended pending the conclusion of the reexamination proceeding, control number 95/000,070, by the issuance of a reexamination certificate.

III. Patent Owner's Provisional Election of Claims 1-4 of the Copending Reissue Application

In the petition for merger, the patent owner states that patent owner seeks to "streamline the examination of [r]eissue [a]pplication claims 1-4 by provisionally electing claims 1-4 in the [r]eissue [a]pplication and merging them into this reexamination." For this reason, the patent owner states that a provisional election of claims 1-4 of the '774 copending reissue application was filed in anticipation of a restriction requirement.

While the patent owner's provisional election of claims 1-4 of the reissue application will be placed in the file history, it cannot be entered since a restriction requirement has not been made. Under 37 CFR 1.176, restriction between subject matter of the original patent claims and previously unclaimed subject matter "may be required." Such a restriction requirement is not mandatory, and an election with respect to an anticipated restriction requirement is premature until the requirement is actually made.

Patent owner's provisional election of claims 1-4 of the '774 copending reissue application has not been entered.

CONCLUSION

1. The third party requester's June 22, 2005 petition for a suspension of the copending reissue application examination is granted.

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[5] See MPEP 1453, under part (B) of the section entitled "Additional Examples," which states, in pertinent part:

> "For a reissue application, where the patent was previously reexamined and a reexamination certificate has issued for the patent: An amendment in the reissue application must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Thus, all italicized text of the reexamination certificate is presented in the amendment (made in the reissue application) without italics. Further, any text found in brackets in the reexamination certificate is omitted in the amendment (made in the reissue application)."

2. The patent owner's June 30, 2005 petition for merger of copending reissue application claims 1-4 with the *inter partes* reexamination is dismissed.

3. The prosecution of patent owner's reissue application no. 11/117,774 is hereby suspended under 37 CFR 1.103(e), pending the conclusion of the *inter partes* reexamination proceeding control no. 95/000,070 by the issuance of the reexamination certificate.

4. After the reexamination certificate for the '070 reexamination proceeding has issued, an Office action will be mailed for the reissue application.

5. The patent owner is advised to, at the time that a reexamination certificate is issued for the '070 reexamination, call the issuance of the certificate to the attention of the Office, and request a resumption of examination of the reissue application. The patent owner may include an amendment of the reissue application claims at that time, if such is deemed appropriate based upon the results of the reexamination proceeding.

6. The patent owner's provisional election of claims 1-4 in copending reissue application no. 11/117,774 has been placed in the file, but has not been entered.

7. A copy of this decision is being placed in both the 11/117,774 reissue file and the 95/000,070 reexamination file.

8. The reexamination proceeding is being forwarded to the Central Reexamination Unit for processing, after which it will be forwarded via the Group Director of Technology Center 1700 to the examiner for the issuance of an Office action. [6]

9. Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Legal Advisor, at (571) 272-7724, or in her absence, Kenneth M. Schor, Senior Legal Advisor, at (271) 272-7710.

Kenneth M. Schor

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

September 9, 2005
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[6] The Office action will address patent owner's June 15, 2005, response and requester's July 14, 2005, comments to patent owner's response

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,070	01/07/2005	6553611	06337/8200569-000	9512

70813 7590 02/05/2010

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/05/2010

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

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Peter C. Schechter
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P.O. BOX 55874
BOSTON, MA 02205

Date:

MAILED

FEB 05 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000070
PATENT NO. : 6553611
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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(For Requester)

MAILED

FEB 05 2010

CENTRAL REEXAMINATION UNIT

In re John A. Huebsch et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,070
Filed: January 7, 2005
For: U.S. Patent No. 6,553,611

DECISION GRANTING PETITION

This is a decision on the June 29, 2009 patent owner petition under 37 CFR 1.183 requesting waiver of the page limit provisions of 37 CFR 1.943(b) ("the June 29, 2009 patent owner petition").

The June 29, 2009 patent owner petition under 37 CFR 1.183, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee required by 37 CFR 1.183 and 37 CFR 1.17(f) for the June 29, 2009 patent owner petition to waive the page limit provisions of 37 CFR 1.943(b) will be charged to deposit account no. 50-4494, as authorized by the patent owner in the last paragraph of page 1 of the instant petition.

SUMMARY

The June 29, 2009 patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page length requirement of 37 CFR 1.943(b) is waived as to the additional **29 pages** of the June 29, 2009 revised patent owner's response that exceed the 50-page limit.

BACKGROUND

- On April 29, 2003, U.S. Patent No. 6,553,611 ("the '611 patent") issued to Huebsch et al.
- On January 7, 2005, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,070 ("the '0070 proceeding").

- On March 15, 2005, an order granting *inter partes* reexamination, and a first Office action on the merits, were mailed by the Office.

- On May 3, 2005, the patent owner filed a request for a one-month extension of time.

- On June 15, 2005, the patent owner filed a response, including a declaration under 37 CFR 1.132 by Francis Finnegan ("the June 15, 2005 "first" Finnegan declaration).

- On June 17, 2005, the May 3, 2005 request for a one-month extension of time was granted.

- The proceeding progressed until, on March 23, 2007, a nonfinal Office action was mailed by the Office.

- On May 5, 2007, a request for an extension of time under 37 CFR 1.956 was filed by the patent owner.

- On May 23, 2007, a decision granting the May 5, 2007 request for extension of time was mailed by the Office, setting a due date of June 23, 2007, for the timely receipt of patent owner's response to the March 23, 2007 Office action.

- On June 25, 2007, a response to the March 23, 2007 Office action was timely filed by the patent owner (June 23, 2007 was a Saturday).

- On July 25, 2007, comments to the June 25, 2007 patent owner response were timely filed by the third party requester.

- On June 12, 2008, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed by the Office, informing the patent owner that the June 25, 2007 amendment fails to comply with 37 CFR 1.530(e), and that the June 25, 2007 patent owner response fails to comply with 37 CFR 1.943(b) because the response is over 50 pages long ("the June 12, 2008 notice").

- On July 14, 2008, a revised patent owner response was timely filed in response to the June 12, 2008 notice (July 12, 2008 was a Saturday) ("the July 14, 2008 revised patent owner response").

- On August 13, 2008, comments to the July 14, 2008 revised patent owner response were timely filed by the third party requester.

- On June 12, 2009, a decision expunging the July 14, 2008 revised patent owner response, as exceeding the 50-page length requirement of 37 CFR 1.943(b), was mailed. The June 12, 2009 decision also notified the third party requester that any comments previously submitted in response to the July 14, 2008 revised patent owner response (such as the August 13, 2008 requester comments) will not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

- On June 29, 2009, the patent owner filed the present petition under 37 CFR 1.183 requesting waiver of the page limit provisions of 37 CFR 1.943(b) ("the June 29, 2009 patent owner petition").

- Also on June 29, 2009, the patent owner filed a second revised response to the March 23, 2007 nonfinal Office action, in response to the June 12, 2009 decision. The second revised response was accompanied by a declaration entitled "Joint Declaration Under 37 CFR 1.132 of Francis Finnegan and Thomas Keim Regarding Term Interpretation and the Understanding Of One of Ordinary Skill in the Art" and accompanying exhibits 1 - 10 ("the revised Finnegan and Keim I declaration"), and a declaration entitled "Joint Declaration Under 37 CFR 1.132 of Francis Finnegan and Thomas Keim Supporting Patentability of U.S. Patent No. 6,553,611 and Traversing Rejections in Office Action Dated March 23, 2007" (the revised Finnegan and Keim II declaration").

- On July 14, 2009, the third party requester filed comments in response to the June 29, 2009 revised patent owner response ("the July 14, 2009 requester comments").

DECISION

The June 29, 2009 second revised patent owner response includes 35 pages of remarks, which is subject to the 50 page length requirement, as well as a signature page and an eight-page chart submitted for the purpose of supporting the amendment to the claims, which are not subject to the 50 page length requirement, as discussed in detail in the third full paragraph of page 5 of the June 12, 2009 decision. Furthermore, as admitted by the patent owner on page 4 of the present petition, the revised Finnegan and Keim I and the Finnegan and Keim II declarations are extensions of the arguments of counsel, which causes both declarations to be subject to the 50-page length requirement. The June 29, 2009 revised Finnegan and Keim II declaration consists of 16 pages. Because the signature page is not subject to the 50 page length requirement, 15 pages of the revised Finnegan and Keim II declaration are subject to the 50 page length requirement. The June 29, 2009 second revised Finnegan and Keim I declaration consists of 29 pages and one signature page. The signature page is not subject to the 50 page length requirement.[1] Contrary to patent owner's arguments, however, the revised Finnegan and Keim I declaration contains legal analysis and legal conclusions throughout the declaration that subject it to the 50 page length requirement. For example, the declarants argue:

> It is unreasonable to conclude from these statements that: "[A]ccording to the Patent Owner's own written description, the ***only distinction*** between the prior art and the claims of the '611 patent is that the disclosed and claimed temperature sensor and motor switching circuit, i.e., the claimed "thermal cutoff assembly," has the additional feature of being self-holding". . . Nothing in the specification states or implies that this is the

[1] Exhibits 1-10 consist of a curriculum vitae and various references, which are not subject to the 50 page length requirement.

> ***only*** distinction between the claims and the prior art – it is, at most ***a*** (one) distinction (emphasis in original).[2]

As expressly stated on page 8 of the June 12, 2009 decision, the above passage is clearly an argument that is directed to how, in the opinion of the declarants, an outstanding rejection may be overcome, and provides no further definition or explanation of a term of art.

In summary, therefore, the 35 pages of remarks, 15 pages of the June 29, 2009 revised Finnegan and Keim II declaration, and 29 pages of the June 29, 2009 revised Finnegan and Keim I declaration, **totaling 79 pages**, are subject to the 50-page length requirement.

In the paragraph bridging pages 4 and 5 of the present petition, however, the patent owner argues that the arguments found in the 35 pages of remarks, the 15 pages of the revised Finnegan and Keim II declaration, and "the 19 pages of Sections III-IV of the revised Finnegan and Keim I declaration", "are necessary to fully and concisely respond to the 79-page March 23, 2007, Office Action", which "asserts 16 different grounds of rejection against the claims under reexamination".

In view of the present facts and circumstances, the Office finds that 29 pages of arguments in excess of the 50 page length requirement to complete the patent owner's response are not unreasonable.

37 CFR 1.183 permits waiver of the page limit requirement of 37 CFR 1.943(b) in an extraordinary situation, when justice requires such a waiver. Under the facts and circumstances of record in the present *inter partes* reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b), to the extent that the June 29, 2009 revised patent owner response is permitted to consist of 79 pages in length, is appropriate in the interest of justice.

Accordingly, the June 29, 2009 patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page length requirement of 37 CFR 1.943(b) is waived as to the additional **29 pages** of the June 29, 2009 revised patent owner's response that exceed the 50-page limit.

A detailed discussion of the passages of the revised Finnegan and Keim I declaration and the revised Finnegan and Keim II declarations, which are determined to be extensions of the arguments of counsel, is not included in this decision, in view of the fact that the present decision grants a waiver of the page length requirement as to the additional 29 pages of the June 29, 2009 revised patent owner's response that exceed the 50-page limit.

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[2] See, for example, the top of page 19 and the bottom of page 23 of the June 29, 2009 revised Finnegan and Keim I declaration.

CONCLUSION

- The June 29, 2009 patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page length requirement of 37 CFR 1.943(b) is waived as to the additional **29 pages** of the June 29, 2009 second revised patent owner's response that exceed the 50-page limit. This waiver makes the June 29, 2009 second revised patent owner's response to the March 23, 2007 Office action **page-length compliant**.

- Jurisdiction for this reexamination proceeding is returned to the Central Reexamination Unit (CRU), for processing of the June 29, 2009 second revised patent owner's response, and of the July 14, 2009 requester comments.

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

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.
95/000,071	01/26/2005	6330941	790063.00072	7134

7590 06/09/2005

McKenna Long & Aldridge LLP
1900 K Street, NW
Washington, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/09/2005

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

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Paper No. __

Matthew T. Bailey
MCKENNA LONG & ALDRIDGE LLP
1900 K Street NW
Washington DC 20006

(For Patent Owner)

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JUN 09 2005

REEXAM UNIT

Daniel G. Radler
QUARLES & BRADY LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202

(For Requester)

In re Dieter Guldenfels
Reexamination Proceeding
Control No.: 95/000,071
Filed: January 26, 2005
For: U.S. Patent No.: 6,330,941

: DECISION DISMISSING
: PETITION TO SUSPEND
: REEXAMINATION
: PROCEEDINGS

The above reexamination proceeding is before the Office of Patent Legal Administration for consideration of the April 21, 2005 petition by the patent owner to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987.

REVIEW OF FACTS

1. U.S. Patent No. 6,330,941 (hereinafter, the '941 patent) issued on December 18, 2001.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJK) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '941 patent by offering to sell radius belt articles of manufacture whose design meets the claims of the '941 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for reexamination, assigned control No. 90/000,071, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. Reexamination was ordered for the '0071 reexamination proceeding on April 5, 2005.

7. A non-final Office action was mailed in the '0071 reexamination proceeding on April 5, 2005.

8. The present petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was received on April 21, 2005.

9. A petition for extension of time was received from the patent owner on June 1, 2005.

10. A denial of extension of time in response to the petition for extension of time was mailed on June 6, 2005.

11. The trial in the United States District Court for the District of Delaware remains in progress.

DECISION DISMISSING THE PETITION TO SUSPEND THE *INTER PARTES* REEXAMINATION PROCEEDING

1. 37 CFR 1.987 provides that "[I]f a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding." Thus, 37 CFR 1.987 provides authority for suspension of an *inter partes* reexamination proceeding where the patent being reexamined "is or becomes involved in litigation." The mechanism for requesting such a suspension, however, is not provided by the rules. Accordingly, the present petition is taken as a petition under 37 CFR 1.182.

The fee set forth in 37 CFR 1.17(f) for a §1.182 petition is $400, while the Office fee records (and the Fee Transmittal form submitted with the petition) show a payment of $130. The additional required fee of $270 is being charged to petitioner's Deposit Account 50-0911 pursuant to the authorization for same in the Fee Transmittal form submitted with the petition.

2. While there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 CFR 1.103 provides such a mechanism for requesting a suspension of action in a application. Accordingly, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a).

3. 37 CFR 1.103(a) provides that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding." Also, MPEP 2686.01 provides, for a suspension based upon the existence of a proceeding as to the patent being reexamined other than the reexamination, that a "[s]uspension will not be granted when there is an outstanding Office action." In the present instance, the patent owner is requesting suspension based on a litigation proceeding as to the '941 patent; yet, the patent owner has not responded to the non-final Office action of April 5, 2005. Thus, a response to the non-final Office action is still outstanding, and the petition must be dismissed.

4. 37 CFR 1.103(a)(1) requires that "a showing of good and sufficient cause for suspension of action" must be provided for the grant of a petition to suspend. Petitioner argues that there is good cause for the Director to suspend the reexamination proceedings because:

A) The Delaware court is the best forum to evaluate the deposition of the inventor on one of the prior art references.

B) The patent owner is entitled to a jury trial to decide the many factual issues not available in a reexamination proceeding.

C) The litigation has advanced significantly, and the jury trial is at too late a stage for a separate parallel reexamination to begin.

The first two reasons for suspension proffered by the petitioner are that the Delaware District Court proceedings should proceed to provide the best evaluation of evidence and to decide factual issues outside the province of reexamination. In response, it is first observed that the patent owner does not lose the right to the evaluation and decision by the District Court. The reexamination proceedings do not terminate or suspend the ongoing proceedings in the Delaware court; rather, the reexamination and litigation proceeding continue concurrently. It is true that the Office may address factual issues prior to the jury trial doing so; however, the statute recognizes the propriety of the Office addressing issues prior to a federal court doing so. This result is a natural consequence of 35 U.S.C. 318 which permits (in a situation where "the interests of justice" would be served) the patent owner of a patent undergoing *inter partes* reexamination to "obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the *inter partes* reexamination order."

As to the absence of the jury trial in the reexamination proceeding, *Joy Technologies Inc. v. Manbeck* , 959 F.2d 226, 22 USPQ2d 1153 (Fed. Cir. 1992) has sanctioned the absence of a right to a jury with respect to a determination of patent validity in a reexamination proceeding. The Federal Circuit stated in *Joy*:

> "We conclude... that the *Granfinanciera* decision affirms the basic underpinning of *Patlex*, viz, that cases involving 'public rights' may constitutionally be adjudicated by legislative courts and administrative agencies without implicating the Seventh Amendment right to jury trial. The *Patlex* court stated that the issuance of a valid patent is primarily a public concern and involves a 'right that can only be conferred by the government' even though validity often is brought into question in disputes between private parties. 758 F.2d at 604, 225 USPQ at 250."

With respect to what is the best forum to evaluate the evidence, it is to be noted that the Office possesses a combination of legal and technical expertise unique to patents. In addition, the standards of review differ for the Office forum and the litigation forum, such that the two forums are not duplicative, and, further, claim construction may vary. It is thus in the public interest that both reexamination and litigation continue at the same time for a patent. In *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Office provided a suspension of a reexamination proceeding in the face of ongoing litigation in a federal court, and the Federal Circuit voided that attempt. The Federal Circuit noted:

> "The district court thought that one of the purposes of the legislation was to avoid duplication of efforts by the PTO and the courts. *5 USPQ2d at 1141.* Nothing in the statute or legislative history supports this and the Commissioner suggests no other authority for the proposition. **In the first place, the PTO's expertise does not exist elsewhere**. Secondly, precise duplication of effort does not occur because the PTO and the courts employ **different standards of proof** when considering validity..." [849 F.2d at 1427, 7 USPQ2d at 1155][Emphasis added]

The *Ethicon* court noted that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a district court must be shown by

"clear and convincing" evidence, whereas in the Office, it is sufficient to show nonpatentability by a "preponderance of evidence." Since the "clear and convincing" standard is more difficult to satisfy than the "preponderance" standard, claims held valid by the courts may be rejected in reexamination, were sufficient basis is present.

There is also a difference in claim construction. Because a patent owner can amend (the claims, the overall specification, and the drawings) in reexamination, the Office can make use of a broader claim interpretation in applying the patents and printed publications than that employed by the courts. This can be observed from the Federal Circuit's decision *in In re American Academy of Science Tech Center*, 70 USPQ2d 1827 (Fed. Cir. 2004), where the Court rejected *American Academy's* arguments for a narrow claim interpretation in a reexamination proceeding. The Federal Circuit took into account the specification and prosecution history, but said claims should be given "their broadest reasonable interpretation" during examination and reexamination in the Office "because the applicant has the opportunity to amend the claims to obtain more precise claim coverage."[1]

Thus, as to the best forum to evaluate the evidence, both the Office and the courts possess advantages and disadvantages, and it is in the public interest that both continue at the same time.

As to petitioner's specific argument that the Delaware District Court is the best forum to evaluate the deposition of the inventor on one of the prior art references and the conflicting testimony on the issue of validity, the *Ethicon* decision is to be noted. The *Ethicon* Court noted that four reasons were presented as to why the reexamination should be suspended in the face of the ongoing litigation. The second reason was "because a trial includes live testimony and cross-examination, the court's decision will generally be based on a more complete record."[2] The Court found all four arguments not to be persuasive. The added flexibility provided to parties by resort to both forums at the same time outweighed the four reasons considered by the *Ethicon* Court.

Petitioner quotes MPEP 2686.04 that "[a] "good cause" might be present, for example, where there is an issue that cannot be decided in the reexamination proceeding but affects the resolution of the proceeding. Another example is where there is an issue common to the litigation and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power (e.g., an issue heavily dependent on presentation of conflicting/contested evidence by the two parties)."[3] Neither the order for reexamination nor the first Office action identify or suggest the presence of any issue that cannot be decided in the reexamination proceeding but affects the resolution of the proceeding, nor any an issue common to the litigation and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power.

Petitioner's argument that the court proceedings are at too late a stage for reexamination proceedings to commence is at odds with the statutes governing inter partes reexamination. 35 USC 317 marks the final decision as the point that reexamination proceedings may no longer be commenced or maintained. Pursuant to 37 U.S.C. 317:

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[1] See also *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (the manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during prosecution of a pending application before the Office).

[2] *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156

[3] See petition at pages 5-6.

> "**Once a final decision has been entered** against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues **may not thereafter be maintained** by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." [Emphasis added]

From the statute, it is clear that an *inter partes* reexamination proceeding was legislated to continue until a final decision (pursuant to 35 U.S.C. 317) has been entered, in a civil action, against the *inter partes* reexamination requester. In the present instance, no such final decision has been entered. Further, even if such a final decision were to be entered, the reexamination could be continued based upon an "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings," and that issue would need to be addressed.

Accordingly, good and sufficient reasons to suspend the reexamination proceeding have not been provided and the petition to suspend the instant reexamination proceeding is dismissed. The time period for response to the outstanding Office action on the merits remains two months.

PENDENCY CONSIDERATION

It is to be noted that the time period for response to the outstanding Office action on the merits has <u>not</u> been extended by the present decision, and it remains as set (in the Office action) at two months from the date of mailing of the action. It cannot be ascertained at the time of issuance of this decision, whether a timely response has been filed, and simply not matched with the file. In the event that the instant reexamination proceeding ceases to be, or has ceased to be, pending based on a failure to timely respond to the outstanding Office action, relief may be available under 37 CFR 1.137, should the fact situation be appropriate for same.

CONCLUSION

1. The petition to suspend the instant *inter partes* reexamination proceeding is <u>dismissed</u>.

2. The proceeding of reexamination control No. 95/000,071 continues to proceed. The time period for response to the outstanding Office action on the merits remains as set (in the Office action) at two months from the date of mailing of the action.

3. The reexaminations files are being forwarded to the examiner via the Director of Technology Center 3600.

4. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, the undersigned at (571) 272-7710.

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

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June _8, 2005

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Washington DC 20006

(For Patent Owner)

MAILED

SEP 0 8 2005

REEXAM UNIT

Daniel G. Radler
QUARLES & BRADY LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202

(For Requester)

In re Dieter Guldenfels	:	DECISION DISMISSING
Reexamination Proceeding	:	SECOND PETITION
Control No.: 95/000,071	:	TO SUSPEND
Filed: January 26, 2005	:	REEXAMINATION
For: U.S. Patent No.: 6,330,941	:	PROCEEDINGS
	:	

This is a decision on the June 29, 2005 patent owner petition titled SECOND PETITION FOR SUSPENSION OF INTER PARTES REEXAMINATION. In the last paragraph of page 2 of the present petition, the petition is stated to be filed under 37 CFR 1.182. The $400 fee set forth in 37 CFR 1.17(f) for a §1.182 petition has been received.

In response to the patent owner's petition, the requester filed, on July 8, 2005, a paper titled THIRD PARTY REQUESTER COMMENTS REGARDING THE PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181. This requester paper is taken as an opposition to patent owner's petition.

The petition and opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is DISMISSED.

REVIEW OF FACTS

1. U.S. Patent No. 6,330,941 (hereinafter, the '941 patent) issued on December 18, 2001.

2. The patent owner, Habasit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination),

willfully infringed the '941 patent by offering to sell radius belt articles of manufacture whose design meets the claims of the '941 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,071, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. Reexamination was ordered for the '0071 reexamination proceeding on April 5, 2005.

7. A non-final Office action was mailed in the '0071 reexamination proceeding on April 5, 2005.

8. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was received on April 21, 2005.

9. A petition for extension of time was received from the patent owner on June 1, 2005.

10. A denial of extension of time in response to the petition for extension of time was mailed on June 6, 2005.

11. A response to the non-final Office action was received on June 6, 2005. [1]

12. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was dismissed on June 9, 2005.

13. The patent owner's second petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 (i.e., the present petition being decided) was received on June 29, 2005. In this petition, the patent owner alleges that the on-going litigation and the reexamination proceeding are duplicative, that the District Court is better equipped to deal with all relevant evidence, and that the third party requester delayed in submitting its request.

14. Third party requester Rexnord's comments after the non-final Office action were received July 1, 2005.

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[1] June 5, 2005 was a Sunday, making this response timely.

15. The patent owner's supplemental response after the non-final Office action was received July 6, 2005.

16. Third party requester Rexnord's comments regarding the patent owner's second petition to suspend the instant *inter partes* reexamination were received July 8, 2005.

17. The litigation in the United States District Court for the District of Delaware remains in progress.

DECISION DISMISSING THE SECOND PETITION TO SUSPEND THE *INTER PARTES* REEXAMINATION PROCEEDING

As set forth in paragraph 2 on page 2 of the Decision Dismissing Petition to Suspend Reexamination Proceedings of June 9, 2005, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a).

37 CFR 1.103(a)(1) requires that "a showing of good and sufficient cause for suspension of action" must be provided for the grant of a petition to suspend. Petitioner argues that there is good cause for the Director to suspend the reexamination proceedings because:

1. The on-going litigation and the reexamination proceeding are duplicative.

2. The District Court is better equipped than the Office to deal with all relevant evidence.

3. The third party requester delayed in submitting its request.

Petitioner asserts that the litigation proceeding at the District Court and the reexamination proceeding underway at the Office are duplicative. According to Petitioner, permitting both proceedings to continue establishes a race between the District Court and the Office. Petitioner points out that under the applicable estoppel provisions (see 35 U.S.C. § 317(b)), a final decision in either forum precludes a third party requester from asserting invalidity in the other forum on the basis of issues which were raised, or could have been raised, in the first-deciding forum.

Although Petitioner correctly notes the estoppel effect of the proceedings, it does not follow that the two forums are carrying out redundant reviews of the patent in question. First, claims may be amended during an *inter partes* reexamination proceeding under 35 U.S.C. § 314(a), but not before the District Court. Thus, while a trial in District Court is an all-or-nothing inquiry with regard to the patentability of a given claim, a reexamination proceeding before the Office affords the patent owner the possibility of obtaining patent protection of a narrower scope if the patentability of a claim as originally issued cannot be upheld.

Second, the two inquiries into claim validity are not duplicative, because claim construction may properly differ between the court and the Office. Although it is noted that, in this instance, the examiner states that he has adopted a "similar" claim construction to that announced by the District Court in the Markman Order (see page 2, paragraph 2, of the non-final Office action mailed April 5, 2005), the examiner was not required to do so, should the examiner's review call for a different result. "[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). See also *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989). The purpose of allowing for differing claim interpretation within the Office and in a court is to "serve[] the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Yamamoto* , 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Third, the instant reexamination proceeding is not duplicate of the litigation proceeding in the district court, because of the differing evidentiary standards for the two proceedings. Invalidity in a district court must be shown by clear and convincing evidence, while the Office may demonstrate unpatentability by the lower preponderance of the evidence standard. *Ethicon v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1155 (Fed. Cir. 1988). Thus the two forums may properly reach different conclusions on the question of patentability of a given claim.

Finally, as pointed out on page 3 of the Decision Dismissing Petition to Suspend Reexamination Proceedings of June 9, 2005, 35 U.S.C. § 318 authorizes the patent owner to request a stay of the ongoing litigation proceeding until the reexamination proceeding is concluded. The Office notes that the third party requester Rexnord has requested such a stay on May 5, 2005.[2] If Petitioner wishes to avoid what it perceives to be duplicative proceedings, it may wish to join Rexnord's motion for a stay.

With respect to what is the best forum to evaluate the evidence, it is to be noted that the Office possesses a combination of legal and technical expertise unique to patents. In a discussion of the advantages of reexamination proceedings, the House of Representatives Committee on the Judiciary stated that the Office is "an agency with expertise in both the patent law and technology." H.R. Rep. No. 107-120, at *3 (2001). The Federal Circuit stated in *Ethicon v. Quigg*, also with respect to reexamination, that "the PTO's expertise does not exist elsewhere." *Ethicon*, 849 F.2d at 1427, 7 USPQ2d at 1155. As a result of this expertise, the Office would be expected to have less need than a district court to rely on expert testimony in order to answer the factual question of what a reference teaches. "When the patent is concurrently involved in litigation, an auxiliary function [of a reexamination proceeding] is to free the court from any need to consider prior art without the benefit of the PTO's initial consideration." *In re Etter*, 756

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[2]As of the mailing of this decision, it does not appear that the District Court has ruled on the motion to stay.

F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985). Nevertheless, if the parties believe such expert testimony to be important to the reexamination proceeding, they are not precluded from presenting it to Office in declaration/affidavit form.

The *Ethicon* decision is also to be noted with regard to Petitioner's argument that the district court is better suited to evaluate the evidence. One of the arguments offered as to why the reexamination proceeding at issue in *Ethicon* should be suspended in the face of the ongoing litigation was that "because a trial includes live testimony and cross-examination, the court's decision will generally be based on a more complete record." *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156. The Federal Circuit found this argument, as well as the others presented, not to be persuasive. According to the *Ethicon* Court, the advantages of a reexamination proceeding before the Office outweighed any perceived disadvantage regarding consideration of evidence.

Petitioner's argument that the reexamination proceeding should not continue due to the late stage of the litigation is at odds with the statutes governing *inter partes* reexamination. 35 U.S.C. § 317 marks the final decision as the point that reexamination proceedings may no longer be commenced or maintained. Pursuant to 37 U.S.C. § 317:

> "**Once a final decision has been entered** against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues **may not thereafter be maintained** by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." (emphasis added).

From the statute, it is clear that an *inter partes* reexamination proceeding was legislated not to be bound by the relevant estoppel until a final decision (pursuant to 35 U.S.C. § 317) has been entered, in a civil action, against the *inter partes* reexamination requester. Stated another way, the section 317(b) estoppel provision was not written to estop any and all validity challenges to a patent after a final validity decision has been reached in the litigation regarding at least some of the patent's claims. In the present instance, no such final decision has been entered by the court adverse to the third party requester. Such a final decision would not exist until the district court issues such a decision and requester's appeal route is exhausted, or the time for such appeal has expired. [3] In the present instance, it is far from clear as to when, and if, that point may

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[3] The legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states: Sec. 4604. Optional *inter partes* Reexamination Procedure *****. . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity...

be reached, and it would run contrary to the statutory requirement for "special dispatch" in a reexamination proceeding [4] to suspend the instant reexamination proceeding until that point *might* be reached. [5]

As a final point, neither the order for reexamination nor the first Office action identify or suggest the presence of any issue that cannot be decided in the instant reexamination proceeding but affects the resolution of the proceeding, nor any an issue common to the litigation and the reexamination proceeding that can best be decided in court due to the availability in court of discovery and subpoena power. Accordingly, good and sufficient reasons to suspend the reexamination proceeding have not been provided and the patent owner's second petition to suspend the instant reexamination proceeding is dismissed.

ANY RECONSIDERATION OF THE PRESENT DECISION

The present petition is the first petition filed after a response to the outstanding Office action. Accordingly, the issue of suspension is squarely presented to the Office for the first time in the proceeding. Thus, the present dismissal is a not final agency action within the meaning of 5 U.S.C 704. Any request for reconsideration of this decision must be filed as a petition under 37 CFR 1.181(a) (3) to invoke the supervisory authority of the Director, and must be filed within two months of the present decision. If an Office action is issued prior to the filing of any such petition under 37 CFR 1.181(a) (3), then any such petition under 37 CFR 1.181(a) (3) must be accompanied by, or preceded by, a timely response to the issued Office action.

CONCLUSION

1. The second petition to suspend the instant *inter partes* reexamination proceeding is dismissed.

2. Any request for reconsideration of this decision must be filed as a petition under 37 CFR 1.181(a) (3) to invoke the supervisory authority of the Director, and must be filed within **TWO (2) MONTHS** of the present decision.

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after any appeals, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised .... [145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added)].

[4] 35 U.S.C. § 314(c).

[5] Even if a final decision were to be entered adverse to the requester, the reexamination could be continued based upon an "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." That issue would need to be addressed, with appropriate briefing on the issue by parties.

3. The instant reexamination proceeding is being forwarded to the examiner via the Director of Technology Center 3600.

4. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754 or to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717; and in their absence, to the undersigned, at (571) 272-7710.

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

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September 1, 2005

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UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
MAR 23 2006
REEXAM UNIT

In re Dieter Guldenfels	:	
Reexamination Proceeding	:	DECISION ON PETITION TO
Control No.: 95/000,071	:	INVOKE THE SUPERVISORY
Filed: January 26, 2005	:	AUTHORITY OF THE DIRECTOR
For: U.S. Patent No.: 6,330,941	:	

This is a decision on a petition filed by the patent owner on November 8, 2005. The petition is entitled PETITION UNDER 37 C.F.R. § 1.181(a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR, and is a request for reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings issued September 8, 2005.

The petition is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.181(a)(3) for reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005 is (a) granted to the extent that the prior decision has been fully reconsidered, and (b) denied with respect to making any change to the prior decision.

REVIEW OF FACTS

1. U.S. Patent No. 6,330,941 (hereinafter, the '941 patent) issued on December 18, 2001.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '941 patent by offering to sell radius belt articles of manufacture having a design which meets the claims of the '941 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,071, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. *Inter partes* reexamination was ordered for the '0071 reexamination proceeding on April 5, 2005.

7. Also on April 5, 2005, a non-final Office action was mailed in the '0071 reexamination proceeding

8. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was filed on April 21, 2005.

9. A petition for extension of time was received from the patent owner on June 1, 2005.

10. A denial of extension of time in response to the petition for extension of time was mailed on June 6, 2005.

11. A response to the non-final Office action was filed by the patent owner on June 6, 2005.[1]

12. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was dismissed in the June 9, 2005 decision of Senior Legal Advisor Schor.

13. The patent owner then, on June 29, 2005, filed a second petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987.

14. On July 8, 2005, the third party requester, Rexnord, filed comments in opposition to the patent owner's second petition to suspend the instant *inter partes* reexamination.

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[1]June 5, 2005 was a Sunday, making this response timely.

15. The patent owner's second petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was dismissed in the September 8, 2005 decision of Senior Legal Advisor Schor.

16. The United States District Court for the District of Delaware ordered a stay in the litigation (Civil Action No. 03-185JJF) on September 22, 2005, pending conclusion of the instant *inter partes* reexamination proceeding.

17. The patent owner appealed the District Court's order to stay the litigation to the Court of Appeals for the Federal Circuit on October 21, 2005. That appeal is currently pending.

18. On November 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) requesting reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005.

19. It is noted that the third party requester Rexnord filed comments in opposition to the patent owner's third petition to suspend the *inter partes* reexamination in the related reexamination proceeding 95/000,072; however, no such comments have been found present in the file for the instant proceeding.

DECISION DENYING PETITION UNDER 37 CFR 1.181(a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR

The patent owner renews its petition for suspension of *inter partes* reexamination proceeding control number 95/000,071, reasserting the arguments presented in its June 29, 2005 petition titled Second Petition for Suspension of Inter Partes Reexamination. In brief, the patent owner again states that "good and sufficient cause" to suspend the proceedings in accordance with 37 CFR 1.103(a)(1) and MPEP 2686.04 exists because the litigation in district court is duplicative of the *inter partes* reexamination proceeding in the Office, and because the district court is better suited than the Office to consider all evidence relevant to the issues at hand. The patent owner has presented no new arguments in support of the petition to suspend. Thus, while the issues have been reconsidered in their entirety, the suspension relief requested is denied for the reasons set forth in the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005. These reasons will now be reiterated:

1. The reexamination and litigation forums do not carry out redundant reviews of the patent in question, but rather complement one another. It is for this reason that the 35 U.S.C. 317(b) estoppel provision was written so as not to estop any and all validity challenges to a patent via reexamination until after a final validity decision has

been reached in the litigation regarding the patent claims. The difference in the nature of review can be observed as follows:

First, claims may be amended during an *inter partes* reexamination proceeding under 35 U.S.C. § 314(a), but not before the District Court. Thus, while a trial in District Court is an all-or-nothing inquiry with regard to the patentability of a given claim, a reexamination proceeding before the Office affords the patent owner the possibility of obtaining patent protection of a narrower scope if the patentability of a claim as originally issued cannot be upheld.

Second, claim construction may properly differ between the courts and the Office. Although, in this instance, the examiner states that he has adopted a "similar" claim construction to that announced by the District Court in the Markman Order (see page 2, paragraph 2, of the non-final Office action mailed April 5, 2005), the examiner was not required to do so, should the examiner's review call for a different result. "[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). See also *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989). The purpose of allowing for differing claim interpretation within the Office and in a court is to "serve[ ] the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Yamamoto* , 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Third, there are differing evidentiary standards for the two proceedings. Invalidity in a district court must be shown by <u>clear and convincing evidence</u>, while the Office may demonstrate unpatentability by the lower <u>preponderance of the evidence</u> standard. *Ethicon v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1155 (Fed. Cir. 1988). Thus the two forums may properly reach different conclusions on the question of patentability of a given claim.

2. With respect to what is the best forum to evaluate the evidence, it is to be noted that the Office possesses a combination of legal and technical expertise unique to patents. In a discussion of the advantages of reexamination proceedings, the House of Representatives Committee on the Judiciary stated that the Office is "an agency with expertise in both the patent law and technology." H.R. Rep. No. 107-120, at *3 (2001). The Federal Circuit stated in *Ethicon v. Quigg*, also with respect to reexamination, that "the PTO's expertise does not exist elsewhere." *Ethicon*, 849 F.2d at 1427, 7 USPQ2d at 1155. As a result of this expertise, the Office would be expected to have less need than a district court to rely on expert testimony in order to answer the factual question of what a reference teaches. "When the patent is concurrently involved in litigation, an

auxiliary function [of a reexamination proceeding] is to free the court from any need to consider prior art without the benefit of the PTO's initial consideration." *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985). Nevertheless, if the parties believe such expert testimony to be important to the reexamination proceeding, they are not precluded from presenting it to Office in declaration/affidavit form. The *Ethicon* decision is also to be noted with regard to Petitioner's argument that the district court is better suited to evaluate the evidence. One of the arguments offered as to why the reexamination proceeding at issue in *Ethicon* should be suspended in the face of the ongoing litigation was that "because a trial includes live testimony and cross-examination, the court's decision will generally be based on a more complete record." *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156. The Federal Circuit found this argument, as well as the others presented, not to be persuasive. According to the *Ethicon* Court, the advantages of a reexamination proceeding before the Office outweighed any perceived disadvantage regarding consideration of evidence.

3. Petitioner's argument that the reexamination proceeding should not continue due to the late stage of the litigation is at odds with the governing *inter partes* reexamination statute. 35 U.S.C. § 317 marks the final decision as the point that reexamination proceedings may no longer be commenced or maintained. Pursuant to 37 U.S.C. § 317:

> **Once a final decision has been entered** against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues **may not thereafter be maintained** by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings. (emphasis added).

From the statute, it is clear that an *inter partes* reexamination proceeding was legislated not to be bound by the relevant estoppel until a final decision (pursuant to 35 U.S.C. § 317) has been entered, in a civil action, against the *inter partes* reexamination requester. In the present instance, no such final decision has been entered by the court adverse to the third party requester. Such a final decision would not exist until the district court issues such a decision and requester's appeal route is exhausted, or the

time for such appeal has expired.[2] In the present instance, it is far from clear as to when, and if, that point may be reached, and it would run contrary to the statutory requirement for "special dispatch" in a reexamination proceeding [3] to suspend the instant *inter partes* reexamination proceeding until that point *might* be reached.[4]

4. Neither the order for reexamination nor the first Office action identifies or suggests the presence of any issue that would be pertinent to the instant reexamination proceeding and cannot be decided during this proceeding, nor any issue common to the litigation and the reexamination proceeding that can best be decided in court due to the availability in court of discovery and subpoena power.

In addition, a further consideration as to why the suspension relief requested must be denied has come to light since the September 8, 2005 decision was issued by the Office.

5. It is no longer true that there are two distinct proceedings directed toward determining patentability of the claims at issue, because the litigation at the District Court has been stayed by order of the court dated September 22, 2005. The stay pending the conclusion of the instant *inter partes* reexamination proceeding will afford the District Court the benefit of the Office's patentability determinations when the litigation is resumed. Thus, to grant a petition to suspend at this stage would thwart the purpose of the District Court's stay.

Accordingly, good and sufficient reasons to suspend the reexamination proceeding have not been provided and the patent owner's petition, as it relates to suspending the instant reexamination proceeding, is denied.

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[2] The legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states: Sec. 4604. Optional *inter partes* Reexamination Procedure *****. . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity... **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised .... [145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added)].

[3] 35 U.S.C. § 314(c).

[4] Even if a final decision were to be entered adverse to the requester, the reexamination could be continued based upon an "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." That issue would need to be addressed, with appropriate briefing on the issue by parties.

CONCLUSION

1. The petition under 37 CFR 1.181(a)(3) for reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005 is (a) granted to the extent that the prior decision has been fully reconsidered, and (b) denied with respect to making any change to the prior decision.

2. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to either await the filing of any party papers if the time for filing same has not expired, or to process any and all party papers if there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

4. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754, or in her absence, to Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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February 28, 2006

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In re Dieter Guldenfels	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,071	:	UNDER 37 CFR 1.181
Filed: January 26, 2005	:	TO INVOKE THE SUPERVISORY
For: U.S. Patent No.: 6,330,941	:	AUTHORITY OF THE DIRECTOR

This is a decision on a petition filed by the patent owner on July 7, 2006. The petition is entitled PETITION UNDER 37 C.F.R. § 1.181(A) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR, and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and reopen prosecution by withdrawing the Action Closing Prosecution issued on June 7, 2006.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated July 7, 2006 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,071.

REVIEW OF FACTS

1. U.S. Patent No. 6,330,941 (hereinafter, the '941 patent) issued on December 18, 2001.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '941 patent by offering to sell radius belt articles of manufacture having a design which meets the claims of the '941 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,071, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. *Inter partes* reexamination was ordered for the '0071 reexamination proceeding on April 5, 2005.

7. Also on April 5, 2005, a non-final Office action was mailed in the '0071 reexamination proceeding.

8. A response to the non-final Office action was filed by the patent owner on June 6, 2005.[1]

9. The patent owner filed a first supplemental response on July 5, 2005.

10. The patent owner then, on November 4, 2005, filed a second supplemental response.

11. On November 17, 2005, the patent owner filed a third supplemental response.

12. On June 7, 2006, the Office issued an Action Closing Prosecution, which addressed the initial response of June 6, 2005 and the first supplemental response of July 5, 2005. The action stated that the second and third supplemental responses were not entered because the response still did not comply with 37 CFR 1.111(a)(2).

13. On July 7, 2006, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened, a petition under 37 CFR 1.183 for suspension of the rules, and a response to the Action Closing Prosecution.

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[1]June 5, 2005 was a Sunday, making this response timely.

14. On August 3, 2006, the third party filed comments opposing patent owner's petition under 37 CFR 1.181, comments opposing patent owner's petition under 37 CFR 1.181, and comments on patent owner's response to the Action Closing Prosecution.

DECISION

The patent owner (petitioner) states that the Action Closing Prosecution dated June 7, 2006 "prematurely" cuts off prosecution, and does not provide the patent owner and the third party requester with a complete and thorough action. Because of these two grounds, petitioner requests that prosecution be reopened.

1) In response to petitioner's allegations that the Action Closing Prosecution (ACP) fails to show all the elements of the claims that have been rejected, petitioner's arguments are not persuasive. The petition makes many general allegations that the ACP fails to meet the guidelines set forth in the MPEP, and states that the ACP "...ignor[es] large segments of the claimed invention." Petitioner states only one specific example (on page 4 of the petition) that set forth claim limitations that the examiner allegedly failed to address. Based on these allegations, petitioners states that prosecution should be reopened.

The third party argues that the examiner has complied with the rules and procedures, and has clearly "... set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor" as required by 37 CFR 1.949. The third party states that the "[e]xaminer issued a proper ACP which includes all rejections and the grounds therefore. All proposed rejections not adopted by the Examiner were previously addressed in the initial Office Action, and there were no new rejections proposed that required mention in the ACP."

In regards to the claim limitations (set forth on page 4 of the petition) that the patent owner advanced as not addressed by the examiner, pages 5 to 7 of the ACP clearly address these limitations. For example, the ACP sets forth for claims 1 and 25:

1) Intermediate section (Figs. 1-5) having opposed first and second walls, the intermediate section comprising a web portion (90) extending across the intermediate width between first and second walls and from one of the upper and lower surfaces
2) the corrugated portion has a sinusoidal shape comprising a series of regularly spaced ridges (98) and valleys (98) extending substantially across a lateral width of the module (Fig. 2)
3) first plurality of link ends (40).
4) second plurality of link ends (20).

In addition, the corrugated portion including the web portion and first and second link ends are further discussed on pages 5 and 6 of the ACP. It is not a requirement that the examiner reproduce the claim language verbatim in making a rejection. The rejections set forth in the ACP clearly identify each corresponding element in the reference being applied against the claims in the rejection.

2) In regards to the statement that the Action Closing Prosecution "prematurely" cuts off prosecution, petitioner further argues that the supplemental responses of November 4 and 17, 2005 should be entered and considered. Patent owner argues that he has met the requirements of 37 CFR 1.111(a)(2)(i) for entry of the supplemental replies because the response "...clearly indicates how the amendments would distinguish the claimed invention from the prior art, and accordingly put the case in condition for allowance."

The third party argues that the patent owner incorrectly asserts that the supplemental amendments satisfy 37 C.F.R. §1.11 l(a)(2)(i)(C) and should have been entered. The third party argues that the patent owner's "conclusory" statement in both Responses that "the Patent Owner clearly indicates how the amendments would distinguish the claimed invention from the prior art" is insufficient. The third party further states that merely indicating that the amendments put the case in condition for allowance "... ignores the requirements of 37 C.F.R. 1.111." Accordingly, the third party concludes that the Examiner properly refused entry of the supplemental responses for failing to comply with 37 C.F.R. 1.111.

At the time of the filing of the November 2005 supplemental responses, 37 CFR 1.111(a)(2)(i) stated that:

> *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
> (A) Cancellation of a claim(s);
> (B) Adoption of the examiner suggestion(s);
> (C) Placement of the application in condition for allowance;
> (D) Reply to an Office requirement made after the first reply was filed;
> (E) Correction of informalities (*e.g.*, typographical errors); or
> (F) Simplification of issues for appeal.

MPEP 2666 further explains that "[p]ursuant to 37 CFR 1.111(a)(2), a response that is supplemental to a response that is in compliance with 37 CFR 1.111(b) will not be entered as a matter of right. The Office may enter a supplemental response if the supplemental response is clearly limited to: (A) cancellation of a claim(s); (B) adoption of the examiner suggestion(s); (C) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (D) a response to an Office

requirement made after the first response was filed; (E) correction of informalities (e.g., typographical errors); or (F) simplification of issues for appeal. When a supplemental response is filed in sufficient time to be entered into the reexamination proceeding before the examiner considers the prior response, the examiner may approve the entry of a supplemental response if, after a cursory review, the examiner determines that the supplemental response is limited to meeting one or more of the conditions set forth in 37 CFR 1.111(a)(2)(i)."

The supplemental responses of November 4 and 17, 2005 clearly do not meet the requirements of 37 CFR 1.111(a)(2)(i). As explained by the examiner in the Action Closing Prosecution dated June 7, 2006, these supplemental responses do not show how they comply with 37 CFR 1.111(a)(2)(i). The supplemental responses added a total of 50 new claims without canceling any of the 25 claims in the original patent. The supplemental responses do not adopt examiner's suggestions. The supplemental responses are not responses to Office requirements made after the first response was filed, do not merely correct informalities, and do not simplify issues for appeal. In contrast to patent owner's statements in the above-mentioned petition, the supplemental responses do not place the reexamination proceeding in condition for a Notice of Intent to Issue *Ex Parte* Reexamination Certificate to issue. Instead, the supplemental replies expands the issues for consideration in the reexamination proceeding by the addition of 50 new claims for which the examiner must determine if there is proper support for the added claims (e.g., new matter issues), whether the new claims comply with the requirements of 35 U.S.C. 112, 2nd paragraph, and whether the new claims are patentable over the prior art of record. Accordingly, the examiner properly denied entry of the November 4, and 17, 2005 supplemental responses.

As stated in MPEP 2666, "[a] supplemental response, which has not been approved for entry, will not be entered when a response to a subsequent Office action is filed, even if there is a specific request for its entry in the subsequent response. If a patent owner wishes to have the unentered supplemental response considered by the examiner, the patent owner must include the contents of the unentered supplemental response in a proper response to a subsequent Office action." Accordingly, patent owner could have included the contents of the unentered supplemental responses in the response to the Action Closing Prosecution but failed to do so. Such an amendment would be subject to the requirements of 37 CFR 1.116.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding and entry of the November 4 and 17, 2005 supplemental responses, is <u>denied</u>.

Other Matters

The third party comments dated August 3, 2006 appear to contain subject matter that goes beyond issues covered by the Office action or the patent owner's response (e.g., the comments pertaining to the patent owner delaying the proceedings and the filing of "frivolous petitions" on pages 5, 7, and 8 of the comments). The third party is reminded that papers containing comments to issues that are not covered by the Office action or patent owner's response will not be entered by the Office in accordance with 37 CFR 1.957(a). See MPEP 2666.05 for more information. Due to the fact that most of the comments did pertain to issues covered in the Office action or patent owner's response, and in the interest of special dispatch, the third party comments were entered, but only those comments covering issues in the Office action or the patent owner's response were considered in this decision. The third party must only make comments pertaining to issues covered by the Office action or the patent owner's response in future communications to avoid refusal to enter such papers in the proceeding.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated June 7, 2006 and reopening of prosecution of the '071 reexamination proceeding denied.

2. Jurisdiction over this proceeding is being forwarded to the Office of Patent Legal Administration to decide the petition filed under 37 CFR 1.183.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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In re Dieter Guldenfels	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,071	:	UNDER 37 CFR 1.183
Filed: January 26, 2005	:	FOR SUSPENSION OF THE
For: U.S. Patent No.: 6,330,941	:	RULES

This is a decision on the July 7, 2006 patent owner petition entitled PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF THE RULES.

The petition is before the Office of Patent Legal Administration (OPLA).

The petition under 37 CFR 1.183 is dismissed for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 6,330,941 (hereinafter, the '941 patent) issued on December 18, 2001.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '941 patent.

3. Patent owner Hasabit entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,071, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. *Inter partes* reexamination was ordered for the '0071 reexamination proceeding on April 5, 2005.

7. Also on April 5, 2005, a non-final Office action was mailed in the '0071 reexamination proceeding.

8. On June 6, 2005, patent owner Hasabit filed a response to the non-final Office action. [1]

9. The patent owner then filed a *first supplemental response* on July 5, 2005.

10. The United States District Court for the District of Delaware ordered a stay in the litigation (Civil Action No. 03-185JJF) on September 22, 2005, pending conclusion of the instant *inter partes* reexamination proceeding.

11. On November 4, 2005, patent owner Hasabit filed a *second supplemental response*, to add new claims 26-37.

12. On November 17, 2005, the patent owner then filed a *third supplemental response*, canceling some of the claims added on November 4, 2005 and adding new claims 38-83.

13. On June 7, 2006, the Office issued an Action Closing Prosecution, which addressed the initial response of June 6, 2005 and the first supplemental response of July 5, 2005. The action stated that the second and third supplemental responses were not entitled to entry, because those supplemental responses did not satisfy 37 CFR 1.111(a)(2), and the Office did not enter the second and third supplemental responses.

14. On July 7, 2006, the patent owner filed:

    (a) A petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened,
    (b) A response to the Action Closing Prosecution; and
    (c) A petition under 37 CFR 1.183 for suspension of the rules, which is being addressed by the present decision.

15. On August 3, 2006, the third party requester filed (a) comments opposing patent owner's petition under 37 CFR 1.181, (b) comments on patent owner's response to the Action Closing Prosecution, and (c) comments opposing patent owner's petition under 37 CFR 1.181.

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[1] June 5, 2005 was a Sunday, making this response timely.

16. On April 27, 2007, the Office mailed a decision of the Central Reexamination (CRU) Director denying the petition filed under 37 CRF 1.181 to invoke the supervisory authority of the Director and reopen the prosecution of *Inter Partes* reexamination proceeding 95/000,071.

DECISION

At the time of the filing of the two November 2005 supplemental responses, 37 CFR 1.111(a)(2)(i) stated that:

> *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
> (A) Cancellation of a claim(s);
> (B) Adoption of the examiner suggestion(s);
> (C) Placement of the application in condition for allowance;
> (D) Reply to an Office requirement made after the first reply was filed;
> (E) Correction of informalities (*e.g.*, typographical errors); or
> (F) Simplification of issues for appeal.

MPEP 2666 further explains:

> "Pursuant to 37 CFR 1.111(a)(2), a response that is supplemental to a response that is in compliance with 37 CFR 1.111(b) will not be entered as a matter of right. The Office may enter a supplemental response if the supplemental response is clearly limited to: (A) cancellation of a claim(s); (B) adoption of the examiner suggestion(s); (C) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (D) a response to an Office requirement made after the first response was filed; (E) correction of informalities (e.g., typographical errors); or (F) simplification of issues for appeal. When a supplemental response is filed in sufficient time to be entered into the reexamination proceeding before the examiner considers the prior response, the examiner may approve the entry of a supplemental response **if, after a cursory review, the examiner determines that the supplemental response is limited to meeting one or more of the conditions set forth in 37 CFR 1.111(a)(2)(i)**." [Emphasis added.]

The patent owner (petitioner) argues that the June 7, 2006 Action Closing Prosecution "prematurely" cut off prosecution, and did not provide the patent owner and the third party requester with a complete and thorough action. Based on these two grounds, petitioner requests that 37 CFR 1.111(a)(2) be waived to allow consideration of the supplemental amendments of November 4, 2005 and November 17, 2005, and that prosecution be reopened.

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."

Accordingly, the issue to be addressed is whether the present fact situation provides an extraordinary situation, when justice requires waiver of 37 CFR 1.111(a)(2). It has been determined that the present fact situation does not provide an extraordinary situation, justifying such a waiver.

1. Initially, it is noted that 35 U.S.C. § 314(c) mandates that all *inter partes* reexamination proceedings "shall be conducted with special dispatch within the Office" unless "otherwise provided by the Director for good cause." Given that the patent under reexamination is subject to the Delaware litigation, the need for special dispatch is underscored. Given that the District Court has ordered a stay in the litigation, pending conclusion of the instant *inter partes* reexamination proceeding, the need for special dispatch is even further elevated to the point where MPEP 2686.04 provides:

> "Where a request for reexamination indicates that it is filed as a result of an order by a court, or that litigation is stayed for the purpose of reexamination, all aspects of the proceeding will be expedited to the extent possible....Action on such a proceeding will take precedence to any other action taken by the examiner in the Office.

In this instance, the patent owner filed a response to the April 5, 2005 non-final Office action on June 6, 2005, the last day of the response period, to prevent termination of the prosecution of the proceeding. The patent owner then proceeded to file three supplemental responses on July 5, 2005, November 4, 2005, and November 17, 2005. The entry of the November 4, 2005 and November 17, 2005 supplemental responses by patent owner would serve to complicate and retard the handling of the present proceeding with special dispatch. The November 4, 2005 and November 17, 2005 supplemental responses would add two new sets of claims, i.e., claims 26-37 and claims 38-83, requiring extensive additional consideration (as will be discussed) and delaying the proceeding. Such clearly would run counter to the District Court stay of the litigation, pending conclusion of the instant proceeding.

In addition, a reexamination proceeding is for the purpose of resolving questions of patentability of the existing patent claims; it is not for the purpose of re-prosecuting the patent by the addition of entirely new sets of claims. Yet, the November 4, 2005 and November 17, 2005 supplemental responses were not directed to amending the existing patent claims to address the prior art of record, but rather added two new sets of claims to "round out" the claim coverage. Also, the patent owner waited over 5 months after the filing of the initial June 6, 2005 response before submitting 50 new claims, without canceling any of the 25 claims in the original patent.

Accordingly, the equities do not call for waiving the rules to enter and consider the November 4, 2005 and November 17, 2005 supplemental responses.

2. Petitioner has alleged that the Action Closing Prosecution (ACP) fails to show all the elements of the claims that have been rejected, and it "...ignor[es] large segments of the claimed invention." The Central Reexamination (CRU) Director's April 27, 2007 decision responds to patent owner's allegation in detail. If patent owner feels that the explanation of how the art is applied to the claims in the Office action and the April 27, 2007 decision is not sufficient, patent owner may challenge this explanation by appealing the claims to the Board of Patent Appeals

and Interferences. The Board is the proper forum to decide whether the art does, or does not, meets the claim limitations as explained by the Office action and the April 27, 2007 decision. Reopening the prosecution to obtain consideration of two new sets of claims will not address patent owner's desire to ascertain whether the art meets the claims or not; rather, patent owner can simply argue that certain limitation are not shown, and it will be for the Board to decide whether that argument is persuasive or not.

3. As to petitioner's statement that the Action Closing Prosecution "prematurely" cuts off prosecution, an amendment solely limited to presenting claims defining over the art applied in the Action Closing Prosecution could be obtained via a § 1.182 petition, as will be discussed below. Thus, the patent owner has not been prematurely cut off from revising the claims to protect the invention claimed in the patent, and a waiver of the rules is not needed for patent owner's concern. On the other hand, the supplemental responses of November 4 and 17, 2005 go far beyond addressing the existing claims as the art is applied to them. It is to be noted that the November supplemental responses do not adopt examiner's suggestions, they are not responses to Office requirements made after the first response was filed, they do not merely correct informalities, and they do not simplify issues for appeal. Rather, the November supplemental responses would add a total of 50 new claims without canceling any of the 25 claims in the original patent. The addition of 50 new claims would expand the issues for consideration in the reexamination proceeding such that the examiner would need to determine whether the new 50 claims enlarge the scope of the claims of the patent in contravention of the prohibition of same in 35 U.S.C. § 314(c); this would require a limitation-by-limitation comparison of the 50 new claims to the existing patent claims. The examiner would further need to determine if there is proper original disclosure support for the added claims (e.g., new matter and description issues), whether the new claims comply with the requirements of 35 U.S.C. 112, 2nd paragraph, and whether the new claims are patentable over the prior art of record. The November supplemental responses thus do not provide a *bona fide* effort to define the issues for appeal, or for the issuance of a reexamination certificate, in an effort reducing pendency of the reexamination proceeding. Waiver of the rules is not justified (as required by 37 CFR 1.183) to enter an amendment for purposes of re-prosecuting the proceeding, or "rounding out" patent owner's scope of claim protection.

4. In view of the above, an extraordinary situation, when justice requires waiver of 37 CFR 1.111(a)(2) does not exist. Thus, the patent owner's petition, to waive the requirements of 37 CFR 1.111(a)(2), in order to reopen prosecution of the instant reexamination proceeding and enter of the November 4 and 17, 2005 supplemental responses, is dismissed.

ALTERNATIVE RELIEF MAY BE AVAILABLE

Alternative relief in the form of a continuation of the reexamination prosecution (after a final rejection) may be available via a 37 CFR 1.182 petition in appropriate circumstances. The patent owner may wish to consider filing a petition under 37 CFR 1.182 (with an appropriate submission) to request for continued reexamination. This will be referred to herein as "a § 1.182 petition." As is the case with a Request for Continued Examination (RCE) in an application, such a § 1.182 petition and accompanying submission must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. The patent owner must make a *bona fide*

effort to define the issues for appeal, or for the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Entry of an amendment solely limited to presenting claims defining over the art applied in the Action Closing Prosecution could be obtained via such a § 1.182 petition, as such an amendment can define the issues for appeal, or for the issuance of a reexamination certificate. Entry of an amendment re-prosecuting the proceeding, or "rounding out" patent owner's scope of claim protection will not be granted.

In further explanation, note as follows: 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. Where an amendment and/or evidence to define patentability of the existing claims is denied entry after an action closing prosecution in an *inter partes* reexamination proceeding, a patent owner can obtain entry of that amendment and/or evidence under 37 CFR 1.182 in appropriate circumstances. The reason for such is that the patent owners treatment of the existing claims would further "special dispatch" by resolving issues. Where, however, the patent owner provides a new set of claims, that requires an entirely new evaluation of the new set of claims, and it would be contrary to the public interest in providing a speedy resolution of the question of patentability raised by a request for reexamination to newly address the new set of claims.

Thus, patent owner may wish to consider filing an appropriate 37 CFR 1.182 petition, with an appropriate submission. For example, an amendment presenting claims defining over the art applied in the Action Closing Prosecution dated June 7, 2006 while deleting the broader claims rejected in the ACP would be an appropriate submission. If such a petition is filed and granted, the prosecution would then be reopened for entry into the record of the response, the proceeding would be forwarded to the examiner for consideration of the response, and the examiner would issue an Office action treating the response as a response received after a first Office action.[2]

ADDITIONAL INFORMATION

As stated in the April 27, 2007 decision, the third party comments dated August 3, 2006 appear to contain subject matter that goes beyond issues covered by the Office action or the patent owner's response (e.g., the comments pertaining to the patent owner delaying the proceedings and the filing of "frivolous petitions" on pages 5, 7, and 8 of the comments). The third party is reminded that papers containing comments directed to issues that are not covered by either the Office action or the patent owner's response are not entitled to entry in accordance with 37 CFR 1.957(a). See MPEP 2666.05 for more information. Since most of the comments did pertain to issues covered in the Office action or patent owner's response, and in the interest of special dispatch, the third party comments were entered (and the rules are waived to that extent), but only those comments covering issues in the Office action or the patent owner's response may be

[2] If patent owner chooses to employ this option, all amendments needed to deal with the prior art should be carefully considered, since, after the granting of the first such § 1.182 petition, no further continuation of the reexamination proceeding would be granted under 37 CFR 1.182, absent a showing of extraordinary circumstances.

considered. To avoid a refusal to enter future papers in the proceeding, the third party requester must only make comments pertaining to issues covered by the Office action and/or the patent owner's response in future communications.

CONCLUSION

1. The petition under 37 CFR 1.183 to suspend the rules is dismissed.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

3. Telephone inquiries related to this decision should be directed to Karen M. Hastings, at (571) 272-7717, or in her absence to Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

kmh
June 1 , 2007

6-1-07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,072	01/26/2005	6523680	790063.00073	7136

7590 06/09/2005

MCKENNA LONG & ALDRIDGE LLP
1900 K Street, NW
Washington, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/09/2005

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

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Paper No. __

Matthew T. Bailey
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(For Patent Owner)

MAILED
JUN 09 2005
REEXAM UNIT

Daniel G. Radler
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(For Requester)

In re Dieter Guldenfels
Reexamination Proceeding
Control No.: 95/000,072
Filed: January 26, 2005
For: U.S. Patent No.: 6,523,680

: DECISION DISMISSING
: PETITION TO SUSPEND
: REEXAMINATION
: PROCEEDINGS

The above reexamination proceeding is before the Office of Patent Legal Administration for consideration of the April 21, 2005 petition by the patent owner to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987.

REVIEW OF FACTS

1. U.S. Patent No. 6,523,680 (hereinafter, the '680 patent) issued on February 25, 2003.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJK) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '680 patent by offering to sell radius belt articles of manufacture whose design meets the claims of the '680 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for reexamination, assigned control No. 90/000,072, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. Reexamination was ordered for the '0072 reexamination proceeding on April 18, 2005.

7. A non-final Office action was mailed in the '0072 reexamination proceeding on April 18, 2005.

8. The present petition to suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR 1.987 was received on May 5, 2005.

9. An opposition to the petition to suspend re-examination proceedings was received from the requester on May 11, 2005.

10. The trial in the United States District Court for the District of Delaware remains in progress.

DECISION DISMISSING THE PETITION TO SUSPEND THE *INTER PARTES* REEXAMINATION PROCEEDING

1. 37 CFR 1.987 provides that "[I]f a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding." Thus, 37 CFR 1.987 provides authority for suspension of an *inter partes* reexamination proceeding where the patent being reexamined "is or becomes involved in litigation." The mechanism for requesting such a suspension, however, is not provided by the rules. Accordingly, the present petition is taken as a petition under 37 CFR 1.182.

The fee set forth in 37 CFR 1.17(f) for a §1.182 petition is $400, while the Office fee records (and the Fee Transmittal form submitted with the petition) show a payment of $130. The additional required fee of $270 is being charged to petitioner's Deposit Account 50-0911 pursuant to the authorization for same in the Fee Transmittal form submitted with the petition.

2. While there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 CFR 1.103 provides such a mechanism for requesting a suspension of action in a application. Accordingly, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a).

3. 37 CFR 1.103(a) provides that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding." Also, MPEP 2686.01 provides, for a suspension based upon the existence of a proceeding as to the patent being reexamined other than the reexamination, that a "[s]uspension will not be granted when there is an outstanding Office action." In the present instance, the patent owner is requesting suspension based on a litigation proceeding as to the '680 patent; yet, the patent owner has not responded to the non-final Office action of April 5, 2005. Thus, a response to the non-final Office action is still outstanding, and the petition must be dismissed.

4. 37 CFR 1.103(a)(1) requires that "a showing of good and sufficient cause for suspension of action" must be provided for the grant of a petition to suspend. Petitioner argues that there is good cause for the Director to suspend the reexamination proceedings because:

A) The Delaware court is the best forum to evaluate the deposition of the inventor on one of the prior art references.

B) The patent owner is entitled to a jury trial to decide the many factual issues not available in a reexamination proceeding.

C) The litigation has advanced significantly, and the jury trial is at too late a stage for a separate parallel reexamination to begin.

The first two reasons for suspension proffered by the petitioner are that the Delaware District Court proceedings should proceed to provide the best evaluation of evidence and to decide factual issues outside the province of reexamination. In response, it is first observed that the patent owner does not lose the right to the evaluation and decision by the District Court. The reexamination proceedings do not terminate or suspend the ongoing proceedings in the Delaware court; rather, the reexamination and litigation proceeding continue concurrently. It is true that the Office may address factual issues prior to the jury trial doing so; however, the statute recognizes the propriety of the Office addressing issues prior to a federal court doing so. This result is a natural consequence of 35 U.S.C. 318 which permits (in a situation where "the interests of justice" would be served) the patent owner of a patent undergoing *inter partes* reexamination to "obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the *inter partes* reexamination order."

As to the absence of the jury trial in the reexamination proceeding, *Joy Technologies Inc. v. Manbeck*, 959 F.2d 226, 22 USPQ2d 1153 (Fed. Cir. 1992) has sanctioned the absence of a right to a jury with respect to a determination of patent validity in a reexamination proceeding. The Federal Circuit stated in *Joy*:

> "We conclude... that the *Granfinanciera* decision affirms the basic underpinning of *Patlex*, viz, that cases involving 'public rights' may constitutionally be adjudicated by legislative courts and administrative agencies without implicating the Seventh Amendment right to jury trial. The *Patlex* court stated that the issuance of a valid patent is primarily a public concern and involves a 'right that can only be conferred by the government' even though validity often is brought into question in disputes between private parties. 758 F.2d at 604, 225 USPQ at 250."

With respect to what is the best forum to evaluate the evidence, it is to be noted that the Office possesses a combination of legal and technical expertise unique to patents. In addition, the standards of review differ for the Office forum and the litigation forum, such that the two forums are not duplicative, and, further, claim construction may vary. It is thus in the public interest that both reexamination and litigation continue at the same time for a patent. In *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Office provided a suspension of a reexamination proceeding in the face of ongoing litigation in a federal court, and the Federal Circuit voided that attempt. The Federal Circuit noted:

> "The district court thought that one of the purposes of the legislation was to avoid duplication of efforts by the PTO and the courts. *5 USPQ2d at 1141.* Nothing in the statute or legislative history supports this and the Commissioner suggests no other authority for the proposition. **In the first place, the PTO's expertise does not exist elsewhere**. Secondly, precise duplication of effort does not occur because the PTO and the courts employ **different standards of proof** when considering validity..." [849 F.2d at 1427, 7 USPQ2d at 1155][Emphasis added]

The *Ethicon* court noted that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a district court must be shown by

"clear and convincing" evidence, whereas in the Office, it is sufficient to show nonpatentability by a "preponderance of evidence." Since the "clear and convincing" standard is more difficult to satisfy than the "preponderance" standard, claims held valid by the courts may be rejected in reexamination, were sufficient basis is present.

There is also a difference in claim construction. Because a patent owner can amend (the claims, the overall specification, and the drawings) in reexamination, the Office can make use of a broader claim interpretation in applying the patents and printed publications than that employed by the courts. This can be observed from the Federal Circuit's decision *in In re American Academy of Science Tech Center*, 70 USPQ2d 1827 (Fed. Cir. 2004), where the Court rejected *American Academy's* arguments for a narrow claim interpretation in a reexamination proceeding. The Federal Circuit took into account the specification and prosecution history, but said claims should be given "their broadest reasonable interpretation" during examination and reexamination in the Office "because the applicant has the opportunity to amend the claims to obtain more precise claim coverage."[1]

Thus, as to the best forum to evaluate the evidence, both the Office and the courts possess advantages and disadvantages, and it is in the public interest that both continue at the same time.

As to petitioner's specific argument that the Delaware District Court is the best forum to evaluate the deposition of the inventor on one of the prior art references and the conflicting testimony on the issue of validity, the *Ethicon* decision is to be noted. The *Ethicon* Court noted that four reasons were presented as to why the reexamination should be suspended in the face of the ongoing litigation. The second reason was "because a trial includes live testimony and cross-examination, the court's decision will generally be based on a more complete record."[2] The Court found all four arguments not to be persuasive. The added flexibility provided to parties by resort to both forums at the same time outweighed the four reasons considered by the *Ethicon* Court.

Petitioner quotes MPEP 2686.04 that "[a] "good cause" might be present, for example, where there is an issue that cannot be decided in the reexamination proceeding but affects the resolution of the proceeding. Another example is where there is an issue common to the litigation and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power (e.g., an issue heavily dependent on presentation of conflicting/contested evidence by the two parties)."[3] Neither the order for reexamination nor the first Office action identify or suggest the presence of any issue that cannot be decided in the reexamination proceeding but affects the resolution of the proceeding, nor any an issue common to the litigation and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power.

Petitioner's argument that the court proceedings are at too late a stage for reexamination proceedings to commence is at odds with the statutes governing inter partes reexamination. 35 USC 317 marks the final decision as the point that reexamination proceedings may no longer be commenced or maintained. Pursuant to 37 U.S.C. 317:

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[1] See also *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (the manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during prosecution of a pending application before the Office).

[2] *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156

[3] See petition at pages 5-6.

> "**Once a final decision has been entered** against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues **may not thereafter be maintained** by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." [Emphasis added]

From the statute, it is clear that an *inter partes* reexamination proceeding was legislated to continue until a final decision (pursuant to 35 U.S.C. 317) has been entered, in a civil action, against the *inter partes* reexamination requester. In the present instance, no such final decision has been entered. Further, even if such a final decision were to be entered, the reexamination could be continued based upon an "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings," and that issue would need to be addressed.

Accordingly, good and sufficient reasons to suspend the reexamination proceeding have not been provided and the petition to suspend the instant reexamination proceeding is dismissed. The time period for response to the outstanding Office action on the merits remains two months.

PENDENCY CONSIDERATION

It is to be noted that the time period for response to the outstanding Office action on the merits has <u>not</u> been extended by the present decision, and it remains as set (in the Office action) at two months from the date of mailing of the action. It cannot be ascertained at the time of issuance of this decision, whether a timely response has been filed, and simply not matched with the file. In the event that the instant reexamination proceeding ceases to be, or has ceased to be, pending based on a failure to timely respond to the outstanding Office action, relief may be available under 37 CFR 1.137, should the fact situation be appropriate for same.

CONCLUSION

1. The petition to suspend the instant *inter partes* reexamination proceeding is <u>dismissed</u>.

2. The proceeding of reexamination control No. 95/000,072 continues to proceed. The time period for response to the outstanding Office action on the merits remains set (in the Office action) at two months.

3. The reexaminations files are being forwarded to the examiner via the Director of Technology Center 3600.

4. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, the undersigned at (571) 272-7710.

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

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June _8, 2005

4. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, the undersigned at (571) 272-7710.

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

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June _8, 2005

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In re Dieter Guldenfels	:	DECISION DISMISSING
Reexamination Proceeding	:	SECOND PETITION
Control No.: 95/000,072	:	TO SUSPEND
Filed: January 26, 2005	:	REEXAMINATION
For: U.S. Patent No.: 6,523,680	:	PROCEEDINGS
	:	

This is a decision on the June 29, 2005 patent owner petition titled SECOND PETITION FOR SUSPENSION OF INTER PARTES REEXAMINATION. In the last paragraph of page 2 of the present petition, the petition is stated to be filed under 37 CFR 1.182. The $400 fee set forth in 37 CFR 1.17(f) for a §1.182 petition has been received.

In response to the patent owner's petition, the requester filed, on July 8, 2005, a paper titled THIRD PARTY REQUESTER COMMENTS REGARDING THE PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181. This requester paper is taken as an opposition to patent owner's petition.

The petition and opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is DISMISSED.

REVIEW OF FACTS

1. U.S. Patent No. 6,523,680 (hereinafter, the '680 patent) issued on February 25, 2003.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '680 patent by offering to sell radius belt articles of

manufacture whose design meets the claims of the '680 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for reexamination, assigned control No. 95/000,072, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. Reexamination was ordered for the '0072 reexamination proceeding on April 18, 2005.

7. A non-final Office action was mailed in the '0072 reexamination proceeding on April 18, 2005.

8. The patent owner's first petition to suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR 1.987 was received on April 29, 2005.

9. A response to the non-final Office action was received on June 20, 2005.

10. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was denied on June 9, 2005.

11. The patent owner's second petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 (i.e., the present petition being decided) was received on June 29, 2005. In this petition, the patent owner alleges that the on-going litigation and the reexamination proceeding are duplicative, that the District Court is better equipped to deal with all relevant evidence, and that the third party requester delayed in submitting its request.

12. Third party requester Rexnord's comments regarding the patent owner's second petition to suspend the instant *inter partes* reexamination were received July 8, 2005.

13. The litigation in the United States District Court for the District of Delaware remains in progress.

DECISION DISMISSING THE SECOND PETITION TO SUSPEND THE *INTER PARTES* REEXAMINATION PROCEEDING

As set forth in paragraph 2 on page 2 of the Decision Dismissing Petition to Suspend Reexamination Proceedings of June 9, 2005, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a).

37 CFR 1.103(a)(1) requires that "a showing of good and sufficient cause for suspension of action" must be provided for the grant of a petition to suspend. Petitioner argues that there is good cause for the Director to suspend the reexamination proceedings because:

1. The on-going litigation and the reexamination proceeding are duplicative.

2. The District Court is better equipped than the Office to deal with all relevant evidence.

3. The third party requester delayed in submitting its request.

Petitioner asserts that the litigation proceeding at the District Court and the reexamination proceeding underway at the Office are duplicative. According to Petitioner, permitting both proceedings to continue establishes a race between the District Court and the Office. Petitioner points out that under the applicable estoppel provisions (see 35 U.S.C. § 317(b)), a final decision in either forum precludes a third party requester from asserting invalidity in the other forum on the basis of issues which were raised, or could have been raised, in the first-deciding forum.

Although Petitioner correctly notes the estoppel effect of the proceedings, it does not follow that the two forums are carrying out redundant reviews of the patent in question. First, claims may be amended during an *inter partes* reexamination proceeding under 35 U.S.C. § 314(a), but not before the District Court. Thus, while a trial in District Court is an all-or-nothing inquiry with regard to the patentability of a given claim, a reexamination proceeding before the Office affords the patent owner the possibility of obtaining patent protection of a narrower scope if the patentability of a claim as originally issued cannot be upheld.

Second, the two inquiries into claim validity are not duplicative, because claim construction may properly differ between the court and the Office. Although it is noted that, in this instance, the examiner states that he has adopted a "similar" claim construction to that announced by the District Court in the Markman Order (see page 2, paragraph 2, of the non-final Office action mailed April 18, 2005), the examiner was not required to do so, should the examiner's review call for a different result. "[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). See also *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989). The purpose of allowing for differing claim interpretation within the Office and in a court is to "serve[] the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Yamamoto* , 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Third, the instant reexamination proceeding is not duplicate of the litigation proceeding in the district court, because of the differing evidentiary standards for the two

proceedings. Invalidity in a district court must be shown by clear and convincing evidence, while the Office may demonstrate unpatentability by the lower preponderance of the evidence standard. *Ethicon v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1155 (Fed. Cir. 1988). Thus the two forums may properly reach different conclusions on the question of patentability of a given claim.

Finally, as pointed out on page 3 of the Decision Dismissing Petition to Suspend Reexamination Proceedings of June 9, 2005, 35 U.S.C. § 318 authorizes the patent owner to request a stay of the ongoing litigation proceeding until the reexamination proceeding is concluded. The Office notes that the third party requester Rexnord has requested such a stay on May 5, 2005.[1] If Petitioner wishes to avoid what it perceives to be duplicative proceedings, it may wish to join Rexnord's motion for a stay.

With respect to what is the best forum to evaluate the evidence, it is to be noted that the Office possesses a combination of legal and technical expertise unique to patents. In a discussion of the advantages of reexamination proceedings, the House of Representatives Committee on the Judiciary stated that the Office is "an agency with expertise in both the patent law and technology." H.R. Rep. No. 107-120, at *3 (2001). The Federal Circuit stated in *Ethicon v. Quigg*, also with respect to reexamination, that "the PTO's expertise does not exist elsewhere." *Ethicon*, 849 F.2d at 1427, 7 USPQ2d at 1155. As a result of this expertise, the Office would be expected to have less need than a district court to rely on expert testimony in order to answer the factual question of what a reference teaches. "When the patent is concurrently involved in litigation, an auxiliary function [of a reexamination proceeding] is to free the court from any need to consider prior art without the benefit of the PTO's initial consideration." *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985). Nevertheless, if the parties believe such expert testimony to be important to the reexamination proceeding, they are not precluded from presenting it to Office in declaration/affidavit form.

The *Ethicon* decision is also to be noted with regard to Petitioner's argument that the district court is better suited to evaluate the evidence. One of the arguments offered as to why the reexamination proceeding at issue in *Ethicon* should be suspended in the face of the ongoing litigation was that "because a trial includes live testimony and cross-examination, the court's decision will generally be based on a more complete record." *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156. The Federal Circuit found this argument, as well as the others presented, not to be persuasive. According to the *Ethicon* Court, the advantages of a reexamination proceeding before the Office outweighed any perceived disadvantage regarding consideration of evidence.

Petitioner's argument that the reexamination proceeding should not continue due to the late stage of the litigation is at odds with the statutes governing *inter partes* reexamination. 35 U.S.C. § 317 marks the final decision as the point that reexamination

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[1]As of the mailing of this decision, it does not appear that the District Court has ruled on the motion to stay.

proceedings may no longer be commenced or maintained. Pursuant to 37 U.S.C. § 317:

> "**Once a final decision has been entered** against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues **may not thereafter be maintained** by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." (emphasis added).

From the statute, it is clear that an *inter partes* reexamination proceeding was legislated not to be bound by the relevant estoppel until a final decision (pursuant to 35 U.S.C. § 317) has been entered, in a civil action, against the *inter partes* reexamination requester. Stated another way, the section 317(b) estoppel provision was not written to estop any and all validity challenges to a patent after a final validity decision has been reached in the litigation regarding at least some of the patent's claims. In the present instance, no such final decision has been entered by the court adverse to the third party requester. Such a final decision would not exist until the district court issues such a decision and requester's appeal route is exhausted, or the time for such appeal has expired.[2] In the present instance, it is far from clear as to when, and if, that point may be reached, and it would run contrary to the statutory requirement for "special dispatch" in a reexamination proceeding [3] to suspend the instant reexamination proceeding until that point *might* be reached. [4]

As a final point, neither the order for reexamination nor the first Office action identify or suggest the presence of any issue that cannot be decided in the instant reexamination proceeding but affects the resolution of the proceeding, nor any an issue common to the litigation and the reexamination proceeding that can best be decided in court due to the

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[2] The legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states: Sec. 4604. Optional *inter partes* Reexamination Procedure *****. . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity... **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised .... [145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added)].

[3] 35 U.S.C. § 314(c).

[4] Even if a final decision were to be entered adverse to the requester, the reexamination could be continued based upon an "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." That issue would need to be addressed, with appropriate briefing on the issue by parties.

availability in court of discovery and subpoena power. Accordingly, good and sufficient reasons to suspend the reexamination proceeding have not been provided and the patent owner's second petition to suspend the instant reexamination proceeding is dismissed.

ANY RECONSIDERATION OF THE PRESENT DECISION

The present petition is the first petition filed after a response to the outstanding Office action. Accordingly, the issue of suspension is squarely presented to the Office for the first time in the proceeding. Thus, the present dismissal is a not final agency action within the meaning of 5 U.S.C 704. Any request for reconsideration of this decision must be filed as a petition under 37 CFR 1.181(a) (3) to invoke the supervisory authority of the Director, and must be filed within two months of the present decision. If an Office action is issued prior to the filing of any such petition under 37 CFR 1.181(a) (3), then any such petition under 37 CFR 1.181(a) (3) must be accompanied by, or preceded by, a timely response to the issued Office action.

CONCLUSION

1. The second petition to suspend the instant *inter partes* reexamination proceeding is dismissed.

2. Any request for reconsideration of this decision must be filed as a petition under 37 CFR 1.181(a) (3) to invoke the supervisory authority of the Director, and must be filed within **TWO (2) MONTHS** of the present decision.

3. The instant reexamination proceeding is being forwarded to the examiner via the Director of Technology Center 3600.

4. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754 or to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717; and in their absence, to the undersigned, at (571) 272-7710.

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

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September 1, 2005

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Chad C. Anderson
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(For Patent Owner)

MAILED
MAR 23 2006
REEXAM UNIT

Daniel G. Radler
QUARLES & BRADY LLP
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(For Requester)

In re Dieter Guldenfels Reexamination Proceeding Control No.: 95/000,072 Filed: January 26, 2005 For: U.S. Patent No.: 6,523,680	DECISION GRANTING PETITION FOR SUSPENSION OF RULES, AND DENYING PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR

This is a decision on two petitions filed by the patent owner on November 9, 2005. The first petition is titled PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES, and is a request to suspend the rules in order to consider the second petition, which was filed one day late. The second petition is titled PETITION UNDER 37 C.F.R. § 1.181(a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR and is a request for reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings issued September 8, 2005.

In opposition to the patent owner's petitions, the requester filed, on November 29, 2005, a paper titled THIRD PARTY REQUESTER COMMENT REGARDING PATENT OWNER'S THIRD PETITION FOR SUSPENSION OF INTER PARTES REEXAMINATION.

The petitions and opposition are before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 for suspension of the rules, to permit consideration of the instant 37 CFR 1.181(a)(3) petition, is granted.

The petition under 37 CFR 1.181(a)(3) for reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005 is (a) granted to the extent that the prior decision has been fully reconsidered, and (b) denied with respect to making any change to the prior decision.

REVIEW OF FACTS

1. U.S. Patent No. 6,523,680 (hereinafter, the '680 patent) issued on February 25, 2003.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '680 patent by offering to sell radius belt articles of manufacture having a design which meets the claims of the '680 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,072, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. *Inter partes* reexamination was ordered for the '0072 reexamination proceeding on April 18, 2005.

7. Also on April 18, 2005, a non-final Office action was mailed in the '0072 reexamination proceeding

8. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was filed on April 29, 2005.

9. A response to the non-final Office action was filed by the patent owner on June 20, 2005.

10. The patent owner's first petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was dismissed in the June 9, 2005 decision of Senior Legal Advisor Schor.

11. The patent owner then, on June 29, 2005, filed a second petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987.

12. On July 8, 2005, the third party requester, Rexnord, filed comments in opposition to the patent owner's second petition to suspend the instant *inter partes* reexamination.

13. The patent owner's second petition to suspend the instant *inter partes* reexamination proceeding pursuant to 37 CFR 1.987 was dismissed in the September 8, 2005 decision of Senior Legal Advisor Schor.

14. The United States District Court for the District of Delaware ordered a stay in the litigation (Civil Action No. 03-185JJF) on September 22, 2005, pending conclusion of the instant *inter partes* reexamination proceeding.

15. The patent owner appealed the District Court's order to stay the litigation to the Court of Appeals for the Federal Circuit on October 21, 2005. That appeal is currently pending.

16. On November 9, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) requesting reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005. The patent owner also filed on November 9, 2005, a petition under 37 CFR 1.183 to suspend the rules to permit consideration of the petition under 37 CFR 1.181(a)(3).

17. On November 29, 2005, the third party requester, Rexnord, filed comments in opposition to the patent owner's third petition to suspend the instant *inter partes* reexamination.

DECISION GRANTING PETITION UNDER 37 CFR 1.183 FOR SUSPENSION OF RULES

The patent owner has filed a petition under 37 CFR 1.183 for suspension of the rules, and provided the petition fee set forth in 37 CFR 1.17(f). The patent owner requests that the rules be suspended so that the concurrently-filed Petition Under 37 C.F.R. § 1.181(a)(3) to Invoke the Supervisory Authority of the Director may be considered, even though that petition was filed one day after the two-month deadline set in the Decision Dismissing Second Petition to Suspend Reexamination Proceedings of September 8, 2005. In this instance, the patent owner filed a timely petition under 37 CFR 1.181(a)(3)

in companion proceeding 95/000,071, which will be decided based upon the same considerations as will be the 37 CFR 1.181(a)(3) petition in the present proceeding. In addition, the importance of the question of concurrent jurisdiction to address patentability issues by both a district court and the Office is noted. Accordingly, and based upon the facts of the present situation, the petition for suspension of the rules under 37 CFR 1.183 is granted.

DECISION DENYING PETITION UNDER 37 CFR 1.181(a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR

The patent owner renews its petition for suspension of *inter partes* reexamination proceeding control number 95/000,072, reasserting the arguments presented in its June 29, 2005 petition titled Second Petition for Suspension of Inter Partes Reexamination. In brief, the patent owner again states that "good and sufficient cause" to suspend the proceedings in accordance with 37 CFR 1.103(a)(1) and MPEP 2686.04 exists because the litigation in district court is duplicative of the *inter partes* reexamination proceeding in the Office, and because the district court is better suited than the Office to consider all evidence relevant to the issues at hand. The patent owner has presented no new arguments in support of the petition to suspend. Thus, while the issues have been reconsidered in their entirety, the suspension relief requested is denied for the reasons set forth in the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005. These reasons will now be reiterated:

1. The reexamination and litigation forums do not carry out redundant reviews of the patent in question, but rather complement one another. It is for this reason that the 35 U.S.C. 317(b) estoppel provision was written so as not to estop any and all validity challenges to a patent via reexamination until after a final validity decision has been reached in the litigation regarding the patent claims. The difference in the nature of review can be observed as follows:

First, claims may be amended during an *inter partes* reexamination proceeding under 35 U.S.C. § 314(a), but not before the District Court. Thus, while a trial in District Court is an all-or-nothing inquiry with regard to the patentability of a given claim, a reexamination proceeding before the Office affords the patent owner the possibility of obtaining patent protection of a narrower scope if the patentability of a claim as originally issued cannot be upheld.

Second, claim construction may properly differ between the courts and the Office. Although, in this instance, the examiner states that he has adopted a "similar" claim construction to that announced by the District Court in the Markman Order (see page 2, paragraph 2, of the non-final Office action mailed April 5, 2005), the examiner was not required to do so, should the examiner's review call for a different result. "[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). See also *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989). The purpose of allowing for differing claim interpretation within the Office and in a court is to "serve[ ] the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Yamamoto* , 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Third, there are differing evidentiary standards for the two proceedings. Invalidity in a district court must be shown by clear and convincing evidence, while the Office may demonstrate unpatentability by the lower preponderance of the evidence standard. *Ethicon v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1155 (Fed. Cir. 1988). Thus the two forums may properly reach different conclusions on the question of patentability of a given claim.

2. With respect to what is the best forum to evaluate the evidence, it is to be noted that the Office possesses a combination of legal and technical expertise unique to patents. In a discussion of the advantages of reexamination proceedings, the House of Representatives Committee on the Judiciary stated that the Office is "an agency with expertise in both the patent law and technology." H.R. Rep. No. 107-120, at *3 (2001). The Federal Circuit stated in *Ethicon v. Quigg*, also with respect to reexamination, that "the PTO's expertise does not exist elsewhere." *Ethicon*, 849 F.2d at 1427, 7 USPQ2d at 1155. As a result of this expertise, the Office would be expected to have less need than a district court to rely on expert testimony in order to answer the factual question of what a reference teaches. "When the patent is concurrently involved in litigation, an auxiliary function [of a reexamination proceeding] is to free the court from any need to consider prior art without the benefit of the PTO's initial consideration." *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985). Nevertheless, if the parties believe such expert testimony to be important to the reexamination proceeding, they are not precluded from presenting it to Office in declaration/affidavit form. The *Ethicon* decision is also to be noted with regard to Petitioner's argument that the district court is better

suited to evaluate the evidence. One of the arguments offered as to why the reexamination proceeding at issue in *Ethicon* should be suspended in the face of the ongoing litigation was that "because a trial includes live testimony and cross-examination, the court's decision will generally be based on a more complete record." *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156. The Federal Circuit found this argument, as well as the others presented, not to be persuasive. According to the *Ethicon* Court, the advantages of a reexamination proceeding before the Office outweighed any perceived disadvantage regarding consideration of evidence.

3. Petitioner's argument that the reexamination proceeding should not continue due to the late stage of the litigation is at odds with the governing *inter partes* reexamination statute. 35 U.S.C. § 317 marks the final decision as the point that reexamination proceedings may no longer be commenced or maintained. Pursuant to 37 U.S.C. § 317:

> **Once a final decision has been entered** against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues **may not thereafter be maintained** by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings. (emphasis added).

From the statute, it is clear that an *inter partes* reexamination proceeding was legislated not to be bound by the relevant estoppel until a final decision (pursuant to 35 U.S.C. § 317) has been entered, in a civil action, against the *inter partes* reexamination requester. In the present instance, no such final decision has been entered by the court adverse to the third party requester. Such a final decision would not exist until the district court issues such a decision and requester's appeal route is exhausted, or the time for such appeal has expired.[1] In the present instance, it is far from clear as to

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[1] The legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states: Sec. 4604. Optional *inter partes*

when, and if, that point may be reached, and it would run contrary to the statutory requirement for "special dispatch" in a reexamination proceeding [2] to suspend the instant *inter partes* reexamination proceeding until that point *might* be reached.[3]

4. Neither the order for reexamination nor the first Office action identifies or suggests the presence of any issue that would be pertinent to the instant reexamination proceeding and cannot be decided during this proceeding, nor any issue common to the litigation and the reexamination proceeding that can best be decided in court due to the availability in court of discovery and subpoena power.

In addition, a further consideration as to why the suspension relief requested must be denied has come to light since the September 8, 2005 decision was issued by the Office.

5. It is no longer true that there are two distinct proceedings directed toward determining patentability of the claims at issue, because the litigation at the District Court has been stayed by order of the court dated September 22, 2005. The stay pending the conclusion of the instant *inter partes* reexamination proceeding will afford the District Court the benefit of the Office's patentability determinations when the litigation is resumed. Thus, to grant a petition to suspend at this stage would thwart the purpose of the District Court's stay.

Accordingly, good and sufficient reasons to suspend the reexamination proceeding have not been provided and the patent owner's petition, as it relates to suspending the instant reexamination proceeding, is denied.

Reexamination Procedure *****. . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity... **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised .... [145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added)].

[2] 35 U.S.C. § 314(c).

[3] Even if a final decision were to be entered adverse to the requester, the reexamination could be continued based upon an "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." That issue would need to be addressed, with appropriate briefing on the issue by parties.

CONCLUSION

1. The petition under 37 CFR 1.183 for suspension of the rules, to permit consideration of the instant 37 CFR 1.181(a)(3) petition, is granted.

2. The petition under 37 CFR 1.181(a)(3) for reconsideration of the Decision Dismissing Second Petition to Suspend Reexamination Proceedings dated September 8, 2005 is (a) granted to the extent that the prior decision has been fully reconsidered, and (b) denied with respect to making any change to the prior decision.

3. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to either await the filing of any party papers if the time for filing same has not expired, or to process any and all party papers if there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

5. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754, or in her absence, to Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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February 28, 2006

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APR 30 2007

Daniel G. Radler (For Requester)
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In re Dieter Guldenfels	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,072	:	UNDER 37 CFR 1.181
Filed: January 26, 2005	:	TO INVOKE THE SUPERVISORY
For: U.S. Patent No.: 6,523,680	:	AUTHORITY OF THE DIRECTOR

This is a decision on a petition filed by the patent owner on July 7, 2006. The petition is entitled PETITION UNDER 37 C.F.R. § 1.181(A) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR, and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and reopen prosecution by withdrawing the Action Closing Prosecution issued on June 7, 2006.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated July 7, 2006 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,072.

REVIEW OF FACTS

1. U.S. Patent No. 6,523,680 (hereinafter, the '680 patent) issued on February 25, 2003.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), infringed the '680 patent.

3. The patent owner entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,072, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. *Inter partes* reexamination was ordered for the '0072 reexamination proceeding on April 18, 2005.

7. Also on April 18, 2005, a non-final Office action was mailed in the '0072 reexamination proceeding.

8. A response to the non-final Office action was filed by the patent owner on June 20, 2005.[1]

9. The patent owner filed a first supplemental response on July 22, 2005.

10. The patent owner then, on November 4, 2005, filed a second supplemental response.

11. On November 28, 2005, the patent owner filed a third supplemental response.

12. On June 7, 2006, the Office issued an Action Closing Prosecution, which addressed the initial response of June 6, 2005 and the first supplemental response of July 5, 2005. The action stated that the second and third supplemental responses were not entered because the response still did not comply with 37 CFR 1.111(a)(2).

13. On July 7, 2006, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened, a petition under 37 CFR 1.183 for suspension of the rules, and a response to the Action Closing Prosecution.

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[1]June 18, 2005 was a Saturday, making this response timely.

14. On August 3, 2006, the third party filed comments opposing patent owner's petition under 37 CFR 1.181, comments opposing patent owner's petition under 37 CFR 1.181, and comments on patent owner's response to the Action Closing Prosecution.

DECISION

The patent owner (petitioner) states that the Action Closing Prosecution dated June 7, 2006 "prematurely" cuts off prosecution, and does not provide the patent owner and the third party requester with a complete and thorough action. Because of these two grounds, petitioner requests that prosecution be reopened.

1) In response to petitioner's allegations that the Action Closing Prosecution (ACP) fails to show all the elements of the claims that have been rejected, petitioner's arguments are not persuasive. The petition makes many general allegations that the ACP fails to meet the guidelines set forth in the MPEP, and states that the ACP "...ignor[es] large segments of the claimed invention." Petitioner states two examples (on pages 4-6 of the petition) that set forth claim limitations that the examiner allegedly failed to address. Based on these allegations, petitioners states that prosecution should be reopened.

The third party argues that the examiner has complied with the rules and procedures, and has clearly "... set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor" as required by 37 CFR 1.949. The third party states that the "[e]xaminer issued a proper ACP which includes all rejections and the grounds therefore. All proposed rejections not adopted by the Examiner were previously addressed in the initial Office Action, and there were no new rejections proposed that required mention in the ACP."

In regards to the claim limitations (set forth on page 4 of the petition) that the patent owner advanced as not addressed by the examiner, pages 5 to 14 of the ACP clearly address ~~the~~ those limitations. For example, the ACP on pages 5-7 sets forth for claim 1: "first and second link ends being offset, the plurality of link ends having a slot 32, 33 transverse to the direction of travel for receiving a pivot rod 31", and that "[f]ig. 7 of the '680 clearly shows space 200 that is closed because it is bounded by sides 110, 113, parallel sides 98 and 101 and outer ends 104 of link ends 41 and upper wall 89."

In regards to the claim limitations (set forth on page 4 of the petition) that the patent owner advanced as not addressed by the examiner, pages 5 to 14 of the ACP clearly address ~~the~~ those limitations. For example, the ACP on pages 8-10 sets forth: "first and second link ends being offset, the plurality of link ends having a slot 40, 41 transverse to the direction of travel for receiving a pivot rod, wherein the web 51 on the cross-rib

extends in the direction of belt travel such that, when the belt is at its maximum extension in the direction of travel, a space bounded by the web, an outer end of the first link end and the sidewalls of second link ends has a diameter less than 10 mm in that the space is completely closed as shown in figure 11; a drive sprocket having teeth for engaging the belt to drive the belt as is commonly known in the art;" and "the web 51 and corrugated portion 27 form a multilevel surface defining the end space between adjacent link ends."

It is not a requirement that the examiner reproduce the claim language verbatim in making a rejection. The rejections set forth in the ACP clearly identify each corresponding element in the reference being applied against the claims in the rejection. In addition, the rejections explicitly state that the examiner is adopting the proposed rejection set forth in the request. The record is clear as to the grounds of the rejection. Accordingly, the patent owner had the opportunity to reasonably judge the strength of the rejections.

2) In regards to the statement that the Action Closing Prosecution "prematurely" cuts off prosecution, petitioner further argues that the supplemental responses of November 4 and 28, 2005 should be entered and considered. Patent owner argues that he has met the requirements of 37 CFR 1.111(a)(2)(i) for entry of the supplemental replies because the response "...clearly indicates how the amendments would distinguish the claimed invention from the prior art, and accordingly put the case in condition for allowance."

The third party argues that the patent owner incorrectly asserts that the supplemental amendments satisfy 37 C.F.R. §1.111(a)(2)(i)(C) and should have been entered. The third party argues that the patent owner's "conclusory" statement in both responses that "the Patent Owner clearly indicates how the amendments would distinguish the claimed invention from the prior art" is insufficient. The third party further states that merely indicating that the amendments put the case in condition for allowance "... ignores the requirements of 37 C.F.R. 1.111." Accordingly, the third party concludes that the Examiner properly refused entry of the supplemental responses for failing to comply with 37 C.F.R. 1.111.

At the time of the filing of the November 2005 supplemental responses, 37 CFR 1.111(a)(2)(i) stated that:

> *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
>
> (A) Cancellation of a claim(s);
>
> (B) Adoption of the examiner suggestion(s);
>
> (C) Placement of the application in condition for allowance;
>
> (D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (*e.g.*, typographical errors); or
(F) Simplification of issues for appeal.

MPEP 2666 further explains that "[p]ursuant to 37 CFR 1.111(a)(2), a response that is supplemental to a response that is in compliance with 37 CFR 1.111(b) will not be entered as a matter of right. The Office may enter a supplemental response if the supplemental response is clearly limited to: (A) cancellation of a claim(s); (B) adoption of the examiner suggestion(s); (C) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (D) a response to an Office requirement made after the first response was filed; (E) correction of informalities (e.g., typographical errors); or (F) simplification of issues for appeal. When a supplemental response is filed in sufficient time to be entered into the reexamination proceeding before the examiner considers the prior response, the examiner may approve the entry of a supplemental response if, after a cursory review, the examiner determines that the supplemental response is limited to meeting one or more of the conditions set forth in 37 CFR 1.111(a)(2)(i)."

The supplemental responses of November 4 and 28, 2005 clearly do not meet the requirements of 37 CFR 1.111(a)(2)(i). As explained by the examiner in the Action Closing Prosecution dated June 7, 2006, these supplemental responses do not show how they comply with 37 CFR 1.111(a)(2)(i). The supplemental responses added a total of 10 new claims without canceling any of the 25 claims in the original patent. The supplemental responses do not adopt examiner's suggestions. The supplemental responses are not responses to Office requirements made after the first response was filed, do not merely correct informalities, and do not simplify issues for appeal. In contrast to patent owner's statements in the above-mentioned petition, the supplemental responses do not place the reexamination proceeding in condition for a Notice of Intent to Issue *Ex Parte* Reexamination Certificate to issue. Instead, the supplemental replies expand the issues for consideration in the reexamination proceeding by the addition of 10 new claims for which the examiner must determine if there is proper support for the added claims (e.g., new matter issues), whether the new claims comply with the requirements of 35 U.S.C. 112, 2nd paragraph, and whether the new claims are patentable over the prior art of record. Accordingly, the examiner properly denied entry of the November 4, and 28, 2005 supplemental responses.

As stated in MPEP 2666, "[a] supplemental response, which has not been approved for entry, will not be entered when a response to a subsequent Office action is filed, even if there is a specific request for its entry in the subsequent response. If a patent owner wishes to have the unentered supplemental response considered by the examiner, the patent owner must include the contents of the unentered supplemental response in a proper response to a subsequent Office action." Accordingly, patent owner could have included the contents of the unentered supplemental responses in the response to the

Action Closing Prosecution but failed to do so. Such an amendment would be subject to the requirements of 37 CFR 1.116.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding and entry of the November 4 and 28, 2005 supplemental responses, is denied.

Other Matters

The patent owner is notified that the maintenance fees due at 3.5 years have not been paid for the '680 patent according to Office records.

The third party comments dated August 3, 2006 appear to contain subject matter that goes beyond issues covered by the Office action or the patent owner's response (e.g., the comments pertaining to the patent owner delaying the proceedings and the filing of "frivolous petitions" on pages 5, 7, and 8 of the comments). The third party is reminded that papers containing comments to issues that are not covered by the Office action or patent owner's response will not be entered by the Office in accordance with 37 CFR 1.957(a). See MPEP 2666.05 for more information. Due to the fact that most of the comments did pertain to issues covered in the Office action or patent owner's response, and in the interest of special dispatch, the third party comments were entered, but only those comments covering issues in the Office action or the patent owner's response were considered in this decision. The third party must only make comments pertaining to issues covered by the Office action or the patent owner's response in future communications to avoid refusal to enter such papers in the proceeding.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated June 7, 2006 and reopening of prosecution of the '072 reexamination proceeding denied.

2. Jurisdiction over this proceeding is being forwarded to the Office of Patent Legal Administration to decide the petition filed under 37 CFR 1.183.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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In re Dieter Guldenfels	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,072	:	UNDER 37 CFR 1.183
Filed: January 26, 2005	:	FOR SUSPENSION OF THE
For: U.S. Patent No.: 6,523,680	:	RULES

This is a decision on the July 7, 2006 patent owner petition entitled PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF THE RULES.

The petition is before the Office of Patent Legal Administration (OPLA).

The petition under 37 CFR 1.183 is dismissed for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 6,523,680 (hereinafter, the '680 patent) issued on February 25, 2003.

2. The patent owner, Hasabit Belting, filed suit (Civil Action No. 03-185JJF) in the United States District Court for the District of Delaware, alleging that Rexnord Industries (the real party in interest for the instant request for reexamination), willfully infringed the '680 patent.

3. Patent owner Hasabit entered a demand for trial by jury with the District Court against Rexnord on December 22, 2003.

4. A Markman claim construction order was issued by the District Court on October 15, 2004.

5. A request for *inter partes* reexamination, assigned control No. 95/000,072, was filed by a third party requester on behalf of Rexnord on January 26, 2005.

6. *Inter partes* reexamination was ordered for the '0072 reexamination proceeding on April 18, 2005.

7. Also on April 18, 2005, a non-final Office action was mailed in the '0072 reexamination proceeding.

8. On June 20, 2005, patent owner Hasabit filed a response to the non-final Office action. [1]

9. The patent owner then filed a *first supplemental response* on July 22, 2005.

10. The United States District Court for the District of Delaware ordered a stay in the litigation (Civil Action No. 03-185JJF) on September 22, 2005, pending conclusion of the instant *inter partes* reexamination proceeding.

11. On November 4, 2005, patent owner Hasabit filed a *second supplemental response*, to add new claims 15-20.

12. On November 28, 2005, the patent owner then filed a *third supplemental response*, adding more new claims 21-24.

13. On June 7, 2006, the Office issued an Action Closing Prosecution, which addressed the initial response of June 6, 2005 and the first supplemental response of July 5, 2005. The action stated that the second and third supplemental responses were not entitled to entry, because those supplemental responses did not satisfy 37 CFR 1.111(a)(2), and the Office did not enter the second and third supplemental responses.

14. On July 7, 2006, the patent owner filed:

    (a) A petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened,
    (b) A response to the Action Closing Prosecution; and
    (c) A petition under 37 CFR 1.183 for suspension of the rules, which is being addressed by the present decision.

15. On August 3, 2006, the third party requester filed (a) comments opposing patent owner's petition under 37 CFR 1.181, (b) comments on patent owner's response to the Action Closing Prosecution, and (c) comments opposing patent owner's petition under 37 CFR 1.183.

---

[1] June 18, 2005 was a Saturday, making this response timely.

16. On April 30, 2007, the Office mailed a decision of the Central Reexamination (CRU) Director denying the petition filed under 37 CRF 1.181 to invoke the supervisory authority of the Director and reopen the prosecution of *Inter Partes* reexamination proceeding 95/000,072.

DECISION

At the time of the filing of the two November 2005 supplemental responses, 37 CFR 1.111(a)(2)(i) stated that:

> *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
> (A) Cancellation of a claim(s);
> (B) Adoption of the examiner suggestion(s);
> (C) Placement of the application in condition for allowance;
> (D) Reply to an Office requirement made after the first reply was filed;
> (E) Correction of informalities (*e.g.*, typographical errors); or
> (F) Simplification of issues for appeal.

MPEP 2666 further explains:

> "Pursuant to 37 CFR 1.111(a)(2), a response that is supplemental to a response that is in compliance with 37 CFR 1.111(b) will not be entered as a matter of right. The Office may enter a supplemental response if the supplemental response is clearly limited to: (A) cancellation of a claim(s); (B) adoption of the examiner suggestion(s); (C) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (D) a response to an Office requirement made after the first response was filed; (E) correction of informalities (e.g., typographical errors); or (F) simplification of issues for appeal. When a supplemental response is filed in sufficient time to be entered into the reexamination proceeding before the examiner considers the prior response, the examiner may approve the entry of a supplemental response **if, after a cursory review, the examiner determines that the supplemental response is limited to meeting one or more of the conditions set forth in 37 CFR 1.111(a)(2)(i)**." [Emphasis added.]

The patent owner (petitioner) argues that the June 7, 2006 Action Closing Prosecution "prematurely" cut off prosecution, and did not provide the patent owner and the third party requester with a complete and thorough action. Based on these two grounds, petitioner requests that 37 CFR 1.111(a)(2) be waived to allow consideration of the supplemental amendments of November 4, 2005 and November 28, 2005, and that prosecution be reopened.

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."

Accordingly, the issue to be addressed is whether the present fact situation provides an extraordinary situation, when justice requires waiver of 37 CFR 1.111(a)(2). It has been determined that the present fact situation does not provide an extraordinary situation, justifying such a waiver.

1. Initially, it is noted that 35 U.S.C. § 314(c) mandates that all *inter partes* reexamination proceedings "shall be conducted with special dispatch within the Office" unless "otherwise provided by the Director for good cause." Given that the patent under reexamination is subject to the Delaware litigation, the need for special dispatch is underscored. Given that the District Court has ordered a stay in the litigation, pending conclusion of the instant *inter partes* reexamination proceeding, the need for special dispatch is even further elevated to the point where MPEP 2686.04 provides:

> "Where a request for reexamination indicates that it is filed as a result of an order by a court, or that litigation is stayed for the purpose of reexamination, all aspects of the proceeding will be expedited to the extent possible....Action on such a proceeding will take precedence to any other action taken by the examiner in the Office.

In this instance, the patent owner filed a response to the April 18, 2005 non-final Office action on June 20, 2005, the last day of the response period, to prevent termination of the prosecution of the proceeding. The patent owner then proceeded to file three supplemental responses on July 22, 2005, November 4, 2005, and November 28, 2005. The entry of the November 4, 2005 and November 28, 2005 supplemental responses by patent owner would serve to complicate and retard the handling of the present proceeding with special dispatch. The November 4, 2005 and November 28, 2005 supplemental responses would add two new sets of claims, i.e., claims 15-20 and claims 21-24, requiring extensive additional consideration (as will be discussed) and delaying the proceeding. Such clearly would run counter to the District Court stay of the litigation, pending conclusion of the instant proceeding.

In addition, a reexamination proceeding is for the purpose of resolving questions of patentability of the existing patent claims; it is not for the purpose of re-prosecuting the patent by the addition of entirely new sets of claims. Yet, the November 4, 2005 and November 28, 2005 supplemental responses were not directed to amending the existing patent claims to address the prior art of record, but rather added two new sets of claims to "round out" the claim coverage. Also, the patent owner waited 5 months after the filing of the initial June 20, 2005 response before submitting 10 new claims, without canceling any of the 14 claims in the original patent.

Accordingly, the equities do not call for waiving the rules to enter and consider the November 4, 2005 and November 22, 2005 supplemental responses.

2. Petitioner has alleged that the Action Closing Prosecution (ACP) fails to show all the elements of the claims that have been rejected, and it "...ignor[es] large segments of the claimed invention." The Central Reexamination (CRU) Director's April 27, 2007 decision responds to patent owner's allegation in detail. If patent owner feels that the explanation of how the art is applied to the claims in the Office action and the April 30, 2007 decision is not sufficient, patent owner may challenge this explanation by appealing the claims to the Board of Patent Appeals

and Interferences. The Board is the proper forum to decide whether the art does, or does not, meets the claim limitations as explained by the Office action and the April 30, 2007 decision. Reopening the prosecution to obtain consideration of two new sets of claims will not address patent owner's desire to ascertain whether the art meets the claims or not; rather, patent owner can simply argue that certain limitation are not shown, and it will be for the Board to decide whether that argument is persuasive or not.

3. As to petitioner's statement that the Action Closing Prosecution "prematurely" cuts off prosecution, an amendment solely limited to presenting claims defining over the art applied in the Action Closing Prosecution could be obtained via a § 1.182 petition, as will be discussed below. Thus, the patent owner has not been prematurely cut off from revising the claims to protect the invention claimed in the patent, and a waiver of the rules is not needed for patent owner's concern. On the other hand, the supplemental responses of November 4 and 28, 2005 go far beyond addressing the existing claims as the art is applied to them. It is to be noted that the November supplemental responses do not adopt examiner's suggestions, they are not responses to Office requirements made after the first response was filed, they do not merely correct informalities, and they do not simplify issues for appeal. Rather, the November supplemental responses would add a total of 10 new claims without canceling any of the 14 claims in the original patent. The addition of 10 new claims would expand the issues for consideration in the reexamination proceeding such that the examiner would need to determine whether the new 10 claims enlarge the scope of the claims of the patent in contravention of the prohibition of same in 35 U.S.C. § 314(c); this would require a limitation-by-limitation comparison of the 10 new claims to the existing patent claims. The examiner would further need to determine if there is proper original disclosure support for the added claims (e.g., new matter and description issues), whether the new claims comply with the requirements of 35 U.S.C. 112, 2nd paragraph, and whether the new claims are patentable over the prior art of record. The November supplemental responses thus do not provide a *bona fide* effort to define the issues for appeal, or for the issuance of a reexamination certificate, in an effort reducing pendency of the reexamination proceeding. Waiver of the rules is not justified (as required by 37 CFR 1.183) to enter an amendment for purposes of re-prosecuting the proceeding, or "rounding out" patent owner's scope of claim protection.

4. In view of the above, an extraordinary situation, when justice requires waiver of 37 CFR 1.111(a)(2) does not exist. Thus, the patent owner's petition, to waive the requirements of 37 CFR 1.111(a)(2), in order to reopen prosecution of the instant reexamination proceeding and enter of the November 4 and 28, 2005 supplemental responses, is dismissed.

ALTERNATIVE RELIEF MAY BE AVAILABLE

Alternative relief in the form of a continuation of the reexamination prosecution (after a final rejection) may be available via a 37 CFR 1.182 petition in appropriate circumstances. The patent owner may wish to consider filing a petition under 37 CFR 1.182 (with an appropriate submission) to request for continued reexamination. This will be referred to herein as "a § 1.182 petition." As is the case with a Request for Continued Examination (RCE) in an application, such a § 1.182 petition and accompanying submission must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. The patent owner must make a *bona fide*

effort to define the issues for appeal, or for the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Entry of an amendment solely limited to presenting claims defining over the art applied in the Action Closing Prosecution could be obtained via such a § 1.182 petition, as such an amendment can define the issues for appeal, or for the issuance of a reexamination certificate. Entry of an amendment re-prosecuting the proceeding, or "rounding out" patent owner's scope of claim protection will not be granted.

In further explanation, note as follows: 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. Where an amendment and/or evidence to define patentability of the existing claims is denied entry after an action closing prosecution in an *inter partes* reexamination proceeding, a patent owner can obtain entry of that amendment and/or evidence under 37 CFR 1.182 in appropriate circumstances. The reason for such is that the patent owners treatment of the existing claims would further "special dispatch" by resolving issues. Where, however, the patent owner provides a new set of claims, that requires an entirely new evaluation of the new set of claims, and it would be contrary to the public interest in providing a speedy resolution of the question of patentability raised by a request for reexamination to newly address the new set of claims.

Thus, patent owner may wish to consider filing an appropriate 37 CFR 1.182 petition, with an appropriate submission. For example, an amendment presenting claims defining over the art applied in the Action Closing Prosecution dated June 7, 2006 while deleting the broader claims rejected in the ACP would be an appropriate submission. If such a petition is filed and granted, the prosecution would then be reopened for entry into the record of the response, the proceeding would be forwarded to the examiner for consideration of the response, and the examiner would issue an Office action treating the response as a response received after a first Office action.[2]

ADDITIONAL INFORMATION

As stated in the April 30, 2007 decision, the third party comments dated August 3, 2006 appear to contain subject matter that goes beyond issues covered by the Office action or the patent owner's response (e.g., the comments pertaining to the patent owner delaying the proceedings and the filing of "frivolous petitions" on pages 5, 7, and 8 of the comments). The third party is reminded that papers containing comments directed to issues that are not covered by either the Office action or the patent owner's response are not entitled to entry in accordance with 37 CFR 1.957(a). See MPEP 2666.05 for more information. Since most of the comments did pertain to issues covered in the Office action or patent owner's response, and in the interest of special dispatch, the third party comments were entered (and the rules are waived to that extent), but only those comments covering issues in the Office action or the patent owner's response may be

[2] If patent owner chooses to employ this option, all amendments needed to deal with the prior art should be carefully considered, since, after the granting of the first such § 1.182 petition, no further continuation of the reexamination proceeding would be granted under 37 CFR 1.182, absent a showing of extraordinary circumstances.

considered. To avoid a refusal to enter future papers in the proceeding, the third party requester must only make comments pertaining to issues covered by the Office action and/or the patent owner's response in future communications.

CONCLUSION

1. The petition under 37 CFR 1.183 to suspend the rules is dismissed.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

3. Telephone inquiries related to this decision should be directed to Karen M. Hastings, at (571) 272-7717, or in her absence to Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

kmh
June 4 , 2007

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Stephen J. Gaudet, Ph.D
Perkins Smith & Cohen LLP
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(For Requester)

In re Chang et al
Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

DECISION ON PETITIONS AND DENYING ENTRY OF AMENDMENT

This is a decision on the following December 23, 2005 patent owner petitions:

(1) Petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.324 for a statement from an inventor to be added on the above-identified patent,[1] that the error in inventorship occurred without any deceptive intent on his part.

(2) The underlying petition under 37 CFR 1.324, to remove Vodek Sasak from, and to add David Platt to, the inventorship entity of the patent being reexamined.

(3) Petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 that the June 13, 2005 declaration under 37 CFR 1.131 of Yan Chang be signed by all of the inventors.

In addition, this decision notifies the patent owner that the paper filed on December 23, 2005, entitled "Reply to an Office Action" is defective.

The petitions and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.324 is **dismissed**.

The underlying petition under 37 CFR 1.324 is **dismissed**.

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

The paper filed on December 23, 2005, entitled "Reply to an Office Action" is found to be **defective** because the amendment fails to satisfy 37 CFR 1.941 and 37 CFR 1.530.

[1] David Platt

REVIEW OF FACTS

- On January 20, 2004, U.S. Patent No. 6,680,306 (the '306 patent) issued to Yan Chang and Vodek Sasak.

- On January 31, 2005, a request for *inter partes* reexamination was filed by the third party requester,[2] and the resulting reexamination proceeding was assigned control number 95/000,074 (the '074 proceeding).

- On April 12, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.

- On June 13, 2005, the patent owner filed a response to the April 12, 2005 Office action. A declaration under 37 CFR 1.131 by Yan Chang, also filed on June 13, 2005, accompanied the response.

- On June 20, 2005, a supplemental response was filed by the patent owner in response to the April 12, 2005 Office action.

- On July 15, 2005, the third party requester filed written comments directed to the April 12, 2005 Office action and the patent owner's June 13, 2005 response to that Office action.

- On October 18, 2005, a second non-final Office action on the merits was mailed.

- On December 22, 2005, the Office received a response filed by patent owner entitled "supplemental submission," including a certificate of mailing dated December 20, 2005. The supplemental submission includes a statement under 37 CFR 3.73(b).

- On December 23, 2005, the patent owner filed the instant (above-identified) petitions under 37 CFR 1.324, and 37 CFR 1.183. The petitions included a certificate of mailing dated December 19, 2005.

- Also on December 23, 2005, the Office received the patent-owner-filed initial response to the October 18, 2005 Office action, including a certificate of mailing dated December 19, 2005. December 18, 2005 was a Sunday.

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[2] The request for *inter partes* reexamination was filed by Pro-Pharmaceuticals, Inc., the real party in interest.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 256 provides, in pertinent part (emphasis added):

Whenever through error a person is named in an issued patent as the inventor, **or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part**, the Director may, **on application of all the parties and assignees**, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

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

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.

37 CFR 1.530(f) provides:

Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

37 CFR 1.183 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.

37 CFR 1.941 provides:

Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943.

37 CFR 1.324 provides, in pertinent part (emphasis added):

(a) Whenever through error a person is named in an issued patent as the inventor, **or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256**, may, **on application of all the parties and assignees**, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors . . .

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

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. Further, **where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection.** *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

MPEP 1481.02 provides, in pertinent part (emphasis added):

The petition to correct inventorship under 37 CFR 1.324 must include the statements and fee required by 37 CFR 1.324(b) . . . The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C.

256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48 . . . **Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted . . . This is not possible under 35 U.S.C. 256 and 37 CFR 1.324.** In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, **correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived.**

MPEP 2658 IV. provides, in pertinent part:

F. Correction of Inventorship

Correction of inventorship may also be made during reexamination. See 37 CFR 1.324 and MPEP § 1481 for petition for correction of inventorship in a patent . . .

G. Affidavits in Reexamination

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding.

DECISION

Petition Under 37 CFR 1.183 To Waive the Requirements of 37 CFR 1.324

The petitioner urges the Office, under 37 CFR 1.183, to waive the requirement of 37 CFR 1.324 for a statement from an inventor, David Platt, to be added to the above-identified patent, that the error in inventorship occurred without any deceptive intent on his part.

This requirement of the rule, however, tracks that of the statute (see 35 U.S.C. 256, quoted above), and a statutory provision cannot be waived. As stated by 37 CFR 1.183, any requirement of the regulations . . . which is not a requirement of the statutes may be suspended or waived. See also MPEP 1481.02, also quoted above.

For the reasons given above, the petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.324 for a statement from David Platt is dismissed.

Petition Under 37 CFR 1.324

The petitioner urges, in his petition under 37 CFR 1.324, that Vodek Sasak be removed from the inventorship entity of the '306 patent, and that David Platt be added as an inventor in the '306 patent.

The petition, however, lacks a statement from David Platt that the error in inventorship occurred without any deceptive intent on his part. This requirement is statutory and cannot be waived, as discussed immediately above.

Since the above-identified petition under 37 CFR 1.183 to waive the statutory requirement under 37 CFR 1.324 is dismissed, the petition under 37 CFR 1.324 requesting the addition of David Platt and the deletion of Vodek Sasak as an inventor is dismissed.

Petitioner also urges: "In the event that the present submission is deemed insufficient to add David Platt as an inventor, Patentee requests that this petition be treated as a petition to remove Vodek Sasak as an inventor." Petition under 37 CFR 1.324, at page 2.

The instant petition, however, also lacks a statement pursuant to 37 CFR 3.73(b) from all of the assignees of Vodek Sasak agreeing to the change of inventorship, as required by 37 CFR 1.324 (b)(3). While the instant petition includes a statement agreeing to the addition of David Platt **and** the deletion of Vodek Sasak, the instant petition lacks a statement pursuant to 37 CFR 3.73(b) from the all assignees of Vodek Sasak agreeing **only** to the removal of Vodek Sasak (without adding David Platt).

For the reasons given above, the petition under 37 CFR 1.324, to the extent that it requests only the deletion of Vodek Sasak as an inventor, is **dismissed**.

Petition Under 37 CFR 1.183 To Waive the Requirements of 37 CFR 1.131

The petitioner urges, under 37 CFR 1.183, to waive the requirement of 37 CFR 1.131 to consider the declaration under 37 CFR 1.131 of Yan Chang, a named inventor, even though the declaration filed on June 13, 2005, is signed only by Yan Chang, and is not signed by all of the inventors.

The extraordinary relief of waiving a rule will not normally be considered if the rules provide an alternative avenue for obtaining the relief sought - *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, patent owner may pursue an alternative avenue that complies with the rules to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination. . .* may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). The rule permits an assignee or other party in interest to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is the case here. See MPEP 715.04 I. In this instance, the petitioner submitted, on December 22, 2005, a statement under 37 CFR 3.73(b) providing evidence of assignment of the patent under reexamination to GlycoGenesys, Inc. Thus, there appears to be an assignee available to execute the declaration under 37 CFR 1.131.

Because the petitioner has not provided evidence of any inability to submit a declaration under 37 CFR 1.131 signed by the assignee of the entire interest in the patent under reexamination, the

present situation is not deemed to be extraordinary. For this reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.[3]

The petitioner also urges consideration of the "two declarations under 37 CFR 1.131 of Yan Chang" (see the sentence bridging pages 2 and 3 of the instant petition.) Office records, however, reveal that only one declaration under 37 CFR 1.131 by Yan Chang, filed on June 13, 2005, has been received.

Regarding the issue of inventorship, the petitioner has stated, in his December 19, 2005 petition under 37 CFR 1.324, that "in the event that the present submission is deemed insufficient to add David Platt as an inventor . . . Patentee will file a separate reissue proceeding to correct the inventorship by adding David Platt as an inventor." Assuming that the reissue application is filed by the assignee of the entire interest in the present patent, a reissue application would be an appropriate vehicle for the correction of inventorship, if the reissue application otherwise complies with all applicable statutes and regulations, including those concerning reissue. See MPEP 1412.04.

For the reasons given above, the petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 to consider the June 13, 2005 declaration under 37 CFR 1.131 by Yan Chang, even though the June 13, 2005 declaration is not signed by all of the inventors, is **dismissed**.

Paper Filed December 23, 2005 Entitled "Reply to Office Action"

The paper filed on December 23, 2005, entitled "Reply to an Office Action" is **defective** because the amendment fails to satisfy 37 CFR 1.941 and 37 CFR 1.530. Pursuant to 37 CFR 1.530(f), any changes must be made relative to the patent under reexamination. In the instant case, new claims 24-44, which were added by the amendment filed June 13, 2005, must be underlined. See 37 CFR 1.530(f)(2). The underlining must be maintained in addition to any bracketing in the present response which is used to delete subject matter previously added in the June 13, 2005 amendment.

For the reasons given above, the amendment filed December 23, 2005 **will not be entered**.

---

[3] If the petitioner later submits sufficient evidence of an inability to submit a 37 CFR 1.131 declaration signed by an assignee of the entire interest in the '306 patent under reexamination, the petitioner should note that Office records indicate that the joint inventors of the '306 patent are Yan Chang and Vodek Sasak. The petitioner presents a copy of a signed statement by Vodek Sasak, which accompanied the above-discussed December 19, 2005 petition under 37 CFR 1.324, and which states: "I, Vodek Sasak . . . hereby state that I do not disagree with the removal of myself as an inventor in the above-identified patent [no. 6,680,306]." The petitioner requests, in the paragraph bridging pages 2 and 3 of the petition, that the Office waive the requirement for Dr. Sasak's signature for consideration of the declaration under 37 CFR 1.131, because Dr. Sasak "does not believe [that] he is an inventor ." MPEP 715.04 states: ". . . [W]here it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient." In view of the petitioner's showing that Dr. Sasak does not regard himself as an inventor (and would thus not sign the declaration as such), the requirement for Dr. Sasak's signature for consideration of the June 13, 2005 declaration under 37 CFR 1.131 of Yan Chang could be waived if the petitioner later submits sufficient evidence of an inability to submit a 37 CFR 1.131 declaration signed by an assignee of the entire interest in the '306 patent under reexamination.

CONCLUSION

1. The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.324 is **dismissed**. The underlying petition under 37 CFR 1.324 is likewise **dismissed**.

2. The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 to consider the June 13, 2005 declaration under 37 CFR 1.131 by Yan Chang, even though the June 13, 2005 declaration is not signed by all of the inventors, is **dismissed**.

3. The paper filed on December 23, 2005, entitled "Reply to an Office Action" is **defective** because the amendment fails to satisfy 37 CFR 1.941 and 37 CFR 1.530. The amendment filed December 23, 2005, **will not be entered**.

4. **The patent owner is given a time period of 30 days or one month from the date of this decision, whichever is later, to correct the defective amendment**. If the defect is not timely corrected, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case). The amendment will not be entered, although the argument will be considered as it applies to the proceeding without the amendment, should the prosecution be limited under 37 CFR 1.957(c).

5. Any response to this notice by the patent owner must be served on the third party requester pursuant to 37 CFR 1.908 and 37 CFR 1.248.

6. The third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response to this notice, pursuant to 37 CFR 1.947. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended.

7. If no response from the patent owner is received in response to this notice, any previously-submitted comments by the third party requester, that were filed in response to the previously-submitted improper response by the patent owner, would be considered moot, and would not be considered on the merits.

SUBMISSION OF CORRESPONDENCE

All correspondence relating to this *inter partes* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Inter Partes* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

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

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

cn
September 11, 2006

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September 12, 2006

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MAILED

OCT 18 2007

CENTRAL REEXAMINATION UNIT

Greenberg Traurig, LLP
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200 Park Avenue
New York, NY 10166

(Courtesy Copy)

In re Chang et al
Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

: **DECISION ON PETITIONS**
: **AND DENYING ENTRY**
: **OF PATENT OWNER'S**
: **ARGUMENTS**

This is a decision on the following petitions:

(1) Patent owner's October 12, 2006 petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the December 23, 2005 declaration under 37 CFR 1.131 of Dr. Yan Chang be signed by all of the inventors, including a request for reconsideration of the September 12, 2006 decision (this petition will be referred to hereinafter as "the October 12, 2006 patent owner petition").

(2) Third party requester's December 4, 2006 petition under 37 CFR 1.183, which is taken as a petition under 37 CFR 1.182, to strike specified portions of the documents filed by the patent owner on October 12, 2006 (hereinafter, "the December 4, 2006 third party requester petition").

This decision also addresses the documents designated by the third party requester as "the 1/18/06 response" and the power of attorney for the third party requester, copies of which are attached as "Exhibit A" to the December 4, 2006 third party requester petition.

The October 12, 2006 patent owner petition, the December 4, 2006 third party requester petition, and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The October 12, 2006 patent owner petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**.

The December 4, 2006 third party requester petition under 37 CFR 1.182 to strike specified portions of the documents filed by the patent owner on October 12, 2006 is:

- **granted in part.** Specifically, the arguments and appendices included in the October 12, 2006 paper filed by the patent owner, entitled "Amendment and Response" with accompanying appendices (hereinafter, "the October 12, 2006 patent owner response) are **improper** and **will not be entered**. **The Office will redact** the October 12, 2006 patent owner response by removing the arguments and appendices improperly included in the October 12, 2006 patent owner response.

- **dismissed in part**. Specifically, the entire October 12, 2006 patent owner petition, including paragraph no. 3 of the petition, has been treated by this decision.

The amendment included in the October 12, 2006 patent owner response is found to be **proper** and **will be entered**.

REVIEW OF FACTS

- On January 20, 2004, U.S. Patent No. 6,680,306 (the '306 patent) issued to Dr. Yan Chang and Dr. Vodek Sasak.

- On January 31, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,074 (the '074 proceeding).

- On April 12, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.

- On June 13, 2005, the patent owner filed a response to the April 12, 2005 Office action. A declaration under 37 CFR 1.131 by Dr. Yan Chang (hereinafter, "the June 13, 2005 Chang declaration under 37 CFR 1.131") accompanied the response.

- On June 20, 2005, a supplemental response was filed by the patent owner in response to the April 12, 2005 Office action.

[1] The request for *inter partes* reexamination was filed by Pro-Pharmaceuticals, Inc., the real party in interest.

- On July 15, 2005, the third party requester filed written comments directed to the April 12, 2005 Office action and the patent owner's June 13, 2005 response to that Office action.

- On October 18, 2005, a second non-final Office action on the merits was mailed.

- On December 22, 2005, the Office received a response filed by patent owner entitled "supplemental submission," including a certificate of mailing dated December 20, 2005. The supplemental submission includes a statement under 37 CFR 3.73(b).

- On December 23, 2005, the patent owner filed (1) a petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.324 for a statement from an inventor to be added on the above-identified patent,[2] that the error in inventorship occurred without any deceptive intent on his part; (2) a petition under 37 CFR 1.324, to remove Dr. Vodek Sasak from, and to add Dr. David Platt to, the inventorship entity of the patent being reexamined; and (3) a petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 that the June 13, 2005 declaration under 37 CFR 1.131 of Dr. Yan Chang be signed by all of the inventors (hereinafter, "the December 23, 2005 petitions"). The December 23, 2005 petitions included a certificate of mailing dated December 19, 2005.

- Also on December 23, 2005, the Office received the "initially-filed" patent owner response to the October 18, 2005 Office action, accompanied by attachments (hereinafter, "the December 23, 2005 patent owner response") including a declaration under 37 CFR 1.131 of Dr. Yan Chang (hereinafter, "the December 23, 2005 declaration under 37 CFR 1.131 of Dr. Yan Chang"), and by a certificate of mailing dated December 19, 2005. December 18, 2005 was a Sunday.

- On September 12, 2006, a decision was mailed dismissing the December 23, 2005 petitions under 37 CFR 1.183 and under 37 CFR 1.324, and holding as defective the amendment included in the December 23, 2005 patent owner response.

- On October 12, 2006, the patent owner filed (1) a petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the December 23, 2005 declaration under 37 CFR 1.131 of Dr. Yan Chang be signed by all of the inventors, and a request for reconsideration of the December 23, 2005 petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the June 13, 2005 Chang declaration under 37 CFR 1.131 of Dr. Yan Chang be signed by all of the inventors (the October 12, 2006 patent owner petition); (2) a paper entitled "Amendment and Response" with accompanying appendices (the October 12, 2006 patent owner response); and (3) a certificate of service. (The above-described documents (1), (2), and (3) are hereinafter collectively designated as "the patent owner documents filed on October 12, 2006").

---

[2] Dr. David Platt

- On December 4, 2006, the third party requester filed a petition under 37 CFR 1.183, which is taken as a petition under 37 CFR 1.182, to strike specified portions of the patent owner documents filed on October 12, 2006 (the December 4, 2006 third party requester petition).

- On September 25, 2007, the patent owner filed a certificate of service stating that the October 12, 2006 patent owner petition and the October 12, 2006 patent owner response were served on the third party requester on October 26, 2006.

- Also on September 25, 2007, the patent owner filed a change of power of attorney and correspondence address, and accompanied by a statement under 37 CFR 3.73(b), in the instant reexamination proceeding.

- On September 26, 2007, the patent owner filed a certificate of service stating that service on the third party requester of the papers filed on September 25, 2007 (i.e., the September 25, 2007 certificate of service, the change of power of attorney and correspondence address, and accompanying statement under 37 CFR 3.73(b)) was made on September 26, 2007.

- On October 9, 2007, the patent owner filed a certificate of service stating that the September 26, 2007 service on the third party requester of the papers filed on September 25, 2007 was unsuccessful, and that the papers filed on September 25, 2007 were again served on the third party requester on October 9, 2007, at a new address.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 256 provides, in pertinent part:

> Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

35 U.S.C. 314 provides, in pertinent part:

> (b) RESPONSE. —
>
> (1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.
>
> (2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner 's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner 's response.

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.3 provides, in pertinent part:

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy.

37 CFR 1.8(b) provides, in pertinent part:

(b) In the event that correspondence is considered timely filed by being mailed . . . in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing. . . of the correspondence, . . . or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing. . .of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed . . . correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing . . .

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

37 CFR 1.111 provides, in pertinent part:

(a)

(1) If the Office action after the first examination . . . is adverse in any respect, the . . . patent owner, if he or she persists in his or her . . . reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment . . .

(2) Supplemental replies.

(i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the application in condition for allowance;
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (e.g., typographical errors); or
(F) Simplification of issues for appeal . . .

(b) In order to be entitled to reconsideration or further examination, the. . . patent owner must reply to the Office action. The reply by the. . . patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. . . The. . .patent owner's reply must appear throughout to be a bona fide attempt to advance the. . . reexamination proceeding to final action. . .

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

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.

37 CFR 1.181(f) provides, in pertinent part:

Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.182 provides, in pertinent part:

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 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.

37 CFR 1.324 provides, in pertinent part:

(a) Whenever through error a person is named in an issued patent as the inventor, **or** through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors . . .

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

37 CFR 1.530(f) provides:

Changes shown by markings. Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed

in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

37 CFR 1.903 provides, in pertinent part:

After filing of a request for inter partes reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

37 CFR 1.937(b) provides:

The inter partes reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.939(a) provides, in pertinent part:

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.

37 CFR 1.941 provides:

Amendments by patent owner in inter partes reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943.

37 CFR 1.945 provides:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.957(c) provides:

If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an inter partes reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

37 CFR 3.73 provides, in pertinent part:

(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 . . .

(b)

(1) In order to request or take action in a patent . . . matter, the assignee must establish its ownership of the patent . . . 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) . . . the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

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

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

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

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

(c) For patent matters only:

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

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

MPEP 324 IX provides, in pertinent part:

Generally, where there are two or more conflicting 37 CFR 3.73(b) statements in an application, the ownership entity that filed that application will be permitted to conduct the prosecution . . .

MPEP 503 provides, in pertinent part:

If a receipt for any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item . . .

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted.

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application . . . or missing portions (e.g., pages . . .) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

MPEP 505 provides, in pertinent part:

The United States Patent and Trademark Office (Office) stamps papers . . . with the date of their receipt in the Office. The stamp is referred to as the "Office Date" stamp.

MPEP 715.04 I provides, in pertinent part:

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.

MPEP 1412.04 II provides, in pertinent part (emphasis added):

Where the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, a reissue application is the appropriate vehicle to correct inventorship . . . Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee **of the entire interest** under 37 CFR 1.172. **An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding**. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995). See 35 U.S.C. 251, third paragraph. Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee **of the entire interest** signs the reissue oath/declaration. Accordingly, an assignee of **the entire interest** can add or delete the name of an inventor by reissue (e.g., correct inventorship from inventor A to inventors A and B) without the original inventor's consent. See also 37 CFR 3.71(a) ("One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.") . . . Thus, the assignee **of the entire interest** can file a reissue to change the inventorship to one which the assignee believes to be correct, even though an inventor might disagree. The protection of the assignee's property rights in the application and patent are statutorily based in 35 U.S.C. 118.

MPEP 1481.02 provides, in pertinent part:

The petition to correct inventorship under 37 CFR 1.324 must include the statements and fee required by 37 CFR 1.324(b) . . . The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C. 256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48 . . . Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted . . . This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of

inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived.

MPEP 2658 IV provides, in pertinent part:

F. Correction of Inventorship

Correction of inventorship may also be made during reexamination. See 37 CFR 1.324 and MPEP § 1481 for petition for correction of inventorship in a patent . . .

G. Affidavits in Reexamination

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding.

MPEP 2666 III provides, in pertinent part:

Pursuant to 37 CFR 1.111(a)(2), a response that is supplemental to a response that is in compliance with 37 CFR 1.111(b) will not be entered as a matter of right. The Office may enter a supplemental response if the supplemental response is clearly limited to: (A) cancellation of a claim(s); (B) adoption of the examiner suggestion(s); (C) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (D) a response to an Office requirement made after the first response was filed; (E) correction of informalities (e.g., typographical errors); or (F) simplification of issues for appeal. When a supplemental response is filed in sufficient time to be entered into the reexamination proceeding before the examiner considers the prior response, the examiner may approve the entry of a supplemental response if, after a cursory review, the examiner determines that the supplemental response is limited to meeting one or more of the conditions set forth in 37 CFR 1.111(a)(2)(i).

MPEP 2666.06 provides, in pertinent part:

Where no proof of service is included, the Central Reexamination Unit (CRU) may contact the party making the submission by telephone to see whether the indication of proof of service was inadvertently omitted from the party's submission (however, there was actual service) . . . If the party making the submission cannot be contacted, a Notice of Defective Paper (PTOL-2069) will be mailed to the party, providing the party with a time period of one month or 30 days, whichever is longer, to complete the paper via a supplemental paper indicating the manner and date of service.

If it is known that service of a submission was not made, form paragraph 26.68 should be used to give notice to the party that made the submission of the requirement for service under 37 CFR 1.903.

MPEP 2666.60 provides, in pertinent part:

The patent owner . . . will be given a time period of one month or thirty days, whichever is longer, from the mailing date of the notice of defective paper . . . to correct the defect in a submission . . . After the patent owner or the third party requester has provided a submission directed solely to correcting the defect, the other party is not permitted to comment on the submission correcting the defect, since the submission correcting the defect is directed to form and does not go to the merits of the case. This would be the case, for example, where the failure to provide a signature or a certificate of service is corrected . . . In the case of correcting a defective amendment, however, other issues come into play. Where for example, new claims 10-20 are improperly presented in a patent owner response (e.g., not properly underlined), they generally will not be entered . . . Until the defect is corrected, claims 10-20 do not yet exist in the proceeding for the third party requester to comment on. Likewise, any argument that was directed to such claims is not truly ripe for the third party requester comment. After the patent owner corrects the defect, claims 10-20 come into existence in the proceeding, and the argument presented by the patent owner becomes relevant. At this point, the third party requester has a right to provide comments in response to the patent owner's argument, whether or not the argument that was included in the original patent owner submission is re-presented with the paper correcting the defect. Thus, any third party requester comments submitted either in response to the patent owner's initial paper (presenting the informal claims) or in response

to the patent owner's supplemental paper (correcting the informality) will be considered by the examiner.

Any submission correcting the defect which provides a discussion of the merits should (A) set forth that discussion separately from the portion of the response that corrects the defect, and (B) clearly identify the additional discussion as going to the merits. The additional discussion going to the merits must, in and of itself, have an entry right, or the entire submission will be returned to the party that submitted it, and one additional opportunity (30-days or one month, whichever is longer) will be provided, to correct the defect without a discussion of the merits. If the portion directed to the merits is not clearly delineated and identified, the entire submission may be returned to the party that submitted it, and one additional opportunity (30-days or one month, whichever is longer) is then given for that party to correct the defect without intermixed discussion of the merits.

MPEP 2667 II A 3 provides, in pertinent part:

Where patent owner has filed a paper which was filed after the period for response set by the Office, the paper will be retained in the file but will not be considered.

DECISION

Proof of Service and Timelines of the Patent Owner Documents Filed on October 12, 2006

Proof of Service

The patent owner documents filed on October 12, 2006, i.e., the October 12, 2006 patent owner petition and the October 12, 2006 patent owner response, were filed with a certificate of service certifying that the October 12, 2006 patent owner documents were served on the third party requester via first class mail on October 12, 2006. The October 12, 2006 certificate of service, however, omitted the street address of the third party requester. David P. Halstead, attorney for the patent owner, was contacted by Cynthia L. Nessler, Senior Legal Advisor, Office of Patent Legal Administration, and Patricia Volpe, Paralegal, Central Reexamination Unit, on September 25 and 26, 2007, to obtain proper proof of service pursuant to MPEP 2666.06.[3] A power of attorney was also required.[4]

On September 25, 2007,[5] the patent owner filed a certificate of service, indicating that while service was attempted on October 12, 2006, the patent owner documents filed on October 12, 2006, were not served on the third party requester until October 26, 2006.[6]

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[3] The Office had the option of mailing a notice of defective paper to the patent owner, notifying him of the defect due to the lack of service, and setting a one month period for reply, pursuant to MPEP 2666.06. 35 U.S.C. 314(c), however, requires the Office to conduct all *inter partes* reexamination proceedings with special dispatch. In view of the Office's prolonged delay in reviewing the documents filed on October 12, 2006, the Office exercised its option to contact the patent owner on this procedural matter in order to obtain proper proof of service. See MPEP 2666.06, which states, in pertinent part: "Where no proof of service is included, the Central Reexamination Unit (CRU) may contact the party making the submission by telephone to see whether the indication of proof of service was inadvertently omitted from the party's submission (however, there was actual service)."

[4] A power of attorney was signed by the present assignee on February 8, 2007, appointing the practitioners associated with Customer Number 28120 (including David P. Halstead) as their legal representatives. This power of attorney has been made of record in the patent file (Application no. 10/176,235) as of September 25, 2007.

[5] The certificate of service was filed on September 25, 2007; however, a copy of the certificate of service was not served on the third party requester until September 26, 2007.

The patent owner is reminded of the requirement to provide proof of actual service on the third party requester. If the original certification was bona fide, but it is later discovered that service was unsuccessful, the patent owner is required not only to re-serve the third party requester, but also to notify the Office by filing a corrected certificate of service. See 37 CFR 1.903 and 37 CFR 10.18(b).

Timeliness

The September 12, 2006 decision gave the patent owner a time period of 30 days or one month, whichever is later, from the date of the decision to correct the defective amendment filed on December 23, 2005.[7] The due date for filing a corrected amendment was therefore October 12, 2006.

The October 12, 2006 patent owner response, which contained the corrected amendment, was filed by the October 12, 2006 due date. Because the October 12, 2006 patent owner response was not served on the third party requester by the October 12, 2006 due date, however, the Office had the option of refusing consideration of this response pursuant to 37 CFR 1.903, 37 CFR 1.939(a), and MPEP 2667 II A 3.

In view of the Office's prolonged delay in reviewing the documents filed on October 12, 2006, and in view of the statutory requirement to conduct inter partes reexamination proceedings with special dispatch,[8] however, the Office is exercising its option to address the October 12, 2006 patent owner response.

The September 12, 2006 decision also dismissed three December 23, 2005 patent owner petitions, including the December 23, 2005 petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 that the June 13, 2005 Chang declaration under 37 CFR 1.131 be signed by all of the inventors. To be considered timely, any response to the dismissal of the December 23, 2005 petitions had to be filed within two months of the September 12, 2006 mail date of the decision, i.e., by November 13, 2006.[9] November 12 was a Sunday.

Since the October 12, 2006 patent owner petition was served on the third party requester on October 26, 2006, which was before the November 13, 2006 due date, the October 12, 2006 patent owner petition is timely filed.

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[6] As indicated in the certificate of service filed by the patent owner on September 25, 2007, the documents filed on October 12, 2006, were returned in the mail due to the omission of the third party requester's street address. Consequently, the documents filed on October 12, 2006 were later served on the third party requester on October 26, 2006.

[7] See item no. 4 on page 8 of the September 12, 2006 decision.

[8] See 35 U.S.C. 314(c).

[9] See 37 CFR 1.181(f).

The October 12, 2006 Patent Owner Petition

The patent owner apparently urges, under 37 CFR 1.183, that the Office waive the 37 CFR 1.131 requirement that the December 23, 2005 Chang declaration under 37 CFR 1.131 be signed by all of the inventors.[10] The patent owner also apparently requests reconsideration of the December 23, 2005 petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the June 13, 2005 Chang declaration under 37 CFR 1.131 be signed by all of the inventors.[11] The December 23, 2005 patent owner petition was dismissed for lack of evidence of any inability to submit a declaration under 37 CFR 1.131 signed by the assignee of the entire interest in the patent under reexamination.

The patent owner points out that Dr. Vodek Sasak, a named inventor of the '306 patent, has asserted that he is not a co-inventor of the claimed subject matter. The patent owner draws attention to a statement signed by Dr. Sasak previously submitted with the December 23, 2005 petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.324,[12] assenting to the removal of Dr. Sasak's name as a co-inventor. The patent owner is apparently requesting the Office to waive the 37 CFR 1.131 requirement for Dr. Sasak's signature for consideration of the June 13, 2005 and December 23, 2005 Chang declarations under 37 CFR 1.131.[13]

The patent owner further urges that the "[a]ssignee per se cannot now execute a [d]eclaration because the company is with a bankruptcy trustee, and hence lack corporate officers." [14] In such a case, however, the bankruptcy trustee is the legal assignee. The petitioner has not provided

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[10] See the title "Petition under 37 C.F.R. 1.183 regarding an extraordinary situation and a Declaration." See also paragraph no. 6 appearing on page 2 of the October 12, 2006 patent owner petition, in which the patent owner requests that the Office "enter" the December 23, 2005 declaration under 37 CFR 1.131 of Dr. Yan Chang. The December 23, 2005 Chang declaration under 37 CFR 1.131 was attached to the defective amendment filed December 23, 2005. Note that the arguments and attachments filed with the defective amendment of December 23, 2005 were entered, but because the amendment to the new claims did not yet exist until the defect (i.e., the lack of underlining of the new claims) was corrected, the arguments and attachments to the defective amendment of December 23, 2005 were not "ripe", either for treatment by the Office or for comment by the third party requester. See MPEP 2666.60.

[11] See paragraph nos. 1 and 4 of the October 12, 2006 patent owner petition, stating that the "assignee per se cannot now execute a Declaration", which is in apparent response to the sentence bridging pages 6 and 7 of the September 12, 2006 decision, stating that the Office will not consider the extraordinary relief of waiving a rule [37 CFR 1.131] because the petitioner had not provided evidence of any inability to submit a 37 CFR 1.131 declaration signed by the assignee of the entire interest in the '306 patent. See also paragraph no. 5 of the October 12, 2006 patent owner petition, stating that Dr. Vodek Sasak asserts that he is not a co-inventor of the subject matter, which is in apparent response to footnote 3 appearing on page 7 of the September 12, 2006 decision, indicating that the 37 CFR 1.131 requirement for Dr. Sasak's signature may be waived if the petitioner provided evidence of an inability to submit an 37 CFR 1.131 declaration signed by the assignee of the entire interest in the '306 patent. Finally, see paragraph no. 2 of the October 12, 2006 patent owner petition, stating that a copy of the June 13, 2005 declaration under 37 CFR 1.131 of Dr. Chang was attached.

[12] The September 12, 2006 decision dismissed the December 23, 2005 petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.324.

[13] See footnote 12 above. If a grantable petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 for Dr. Sasak's signature is later filed, however, please note that, given the facts of this case, a 37 CFR 1.131 declaration signed by Dr. Yan Chang alone cannot establish prior invention of the claimed subject matter without a correction of inventorship to add Dr. Platt, as discussed *infra*.

[14] See paragraph no. 4 appearing on the first page of the October 12, 2006 patent owner petition.

evidence of any inability to submit a declaration under 37 CFR 1.131 signed by the bankruptcy trustee as the assignee of the entire interest in the '306 patent under reexamination. In any event, however, Office records reveal that a later assignment has been recorded with the Office on February 20, 2007, indicating that an interest in the '306 patent under reexamination has been assigned by the bankruptcy trustee ultimately to Prospect Therapeutics, Inc. of Woburn, Massachusetts, the present assignee of record. Thus, there appears to be an assignee available to execute the declaration under 37 CFR 1.131.

The extraordinary relief of waiving a rule will not normally be considered if the rules provide an alternative avenue for obtaining the relief sought. See *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). Because the patent owner has not provided evidence of any inability to submit a declaration under 37 CFR 1.131 signed by an assignee of the entire interest in the patent under reexamination, the present situation is not deemed to be extraordinary. For this reason, the October 12, 2006 patent owner petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

The patent owner also apparently argues that the declaration of Dr. David Platt filed on January 31, 2005, can be construed as a declaration under 37 CFR 1.131 establishing prior invention of the claimed subject matter.[15] The January 31, 2005 declaration of Dr. David Platt, however, cannot be construed as a declaration under 37 CFR 1.131 for reasons including, but not limited to: (1) the declaration is not signed by all of the named inventors, and (2) Dr. Platt is not a named inventor of claimed subject matter **of the patent**. See MPEP 715.04 I.

For the reasons given above, the October 12, 2006 patent owner petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the December 23, 2005 Chang declaration under 37 CFR 1.131 be signed by all of the inventors, and request for reconsideration of the September 12, 2006 decision on the December 23, 2005 petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the June 13, 2005 Chang declaration under 37 CFR 1.131 be signed by all of the inventors, is **dismissed**.

Prior Invention Cannot Be Established via a 37 CFR 1.131 Declaration Without Correction of Inventorship To Add Dr. David Platt

A declaration under 37 CFR 1.131 executed either by the present assignee, or by Dr. Chang alone (assuming that a grantable petition under 37 CFR 1.183 to waive the requirement under 37 CFR 1.131 for Dr. Sasak's signature is later filed), cannot establish prior invention of the claimed subject matter of the '306 patent without a correction of inventorship to add Dr. Platt as an inventor.

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[15] Paragraph no. 3 appearing on the first page of the October 12, 2006 patent owner petition states: "While co-inventor Dr. David Platt refused to sign the aforementioned [37 CFR 1.131] Declaration, however he has signed his own Declaration, evidencing date of his invention prior to March 27, 2001 . . ."

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

> "When any claim of . . . a patent under reexamination is rejected, the **inventor of the subject matter** of the rejected claim, the owner of the patent under reexamination, . . .may submit an appropriate . . . declaration to establish **invention of the subject matter** of the rejected claim . . ."

The patent owner has agreed on the record that Dr. David Platt should be named as an inventor of the claimed subject matter.[16] Dr. Platt, however, has not been named an inventor of the '306 patent. Consequently, the record now shows that the present inventive entity, i.e., Dr. Yan Chang and Dr. Vodek Sasak, did not invent the subject matter of the rejected claims.[17] As a result, neither Dr. Chang alone, nor the present assignee, can establish prior invention (by the presently named inventors of the'306 patent) pursuant to 37 CFR 1.131, since the presently named inventive entity did not invent the claimed subject matter.

Even if a grantable petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement for Dr. Sasak's signature is later filed, the June 13, 2005 and December 23, 2005 declarations under 37 CFR 1.131 signed by Dr. Chang alone would still be ineffective, since **Dr. Chang is not the sole inventor of the subject matter of the claims under rejection**. See MPEP 715.04 I B, which states (emphasis added):

> "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**."

Furthermore, if it can be shown that a named inventor of the claimed subject matter refuses to sign,[18] the signature of the remaining named inventors may be accepted. Any showing that Dr. Platt refused to sign the June 13, 2005 and December 23, 2005 declarations cannot aid the patent owner, however, because Dr. Platt is not a named inventor of the claimed subject matter.

For the reasons given above, the June 13, 2005 and December 23, 2005 declarations under 37 CFR 1.131, signed by Dr. Chang alone (assuming that a grantable 37 CFR 1.183 petition to waive the 37 CFR 1.131 requirement for Dr. Sasak's signature is later filed), cannot establish prior invention of the claimed subject matter of the '306 patent, in the absence of a correction of inventorship to add Dr. Platt as an inventor.

Furthermore, according to the record, the present assignee is not a successor in title to the inventive entity that invented the claimed subject matter. Consequently, the present assignee

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[16] See, e.g., patent owner's petition under 37 CFR 1.324, filed December 23, 2005, to add Dr. David Platt as an inventor and to delete Dr. Vodek Sasak as an inventor; see also the accompanying letter dated December 8, 2005, from David P. Halstead, Ph.D. attorney of record for the patent owner, to Stephen J. Gaudet, Ph.D., attorney of record for the third party requester, designated as "Exhibit A", stating ". . . we conclude that Dr. Platt should be named as an inventor of this application."

[17] The patent owner has also presented evidence that Dr. Vodek Sasak does not consider himself to be inventor of the claimed subject matter, as discussed *supra*.

[18] Such a showing should be presented in a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131.

cannot establish prior invention of the claimed subject matter of the '306 patent via a 37 CFR 1.131 declaration without a correction of inventorship to add Dr. Platt.

An assignee of the patent, by definition, is a successor in title to the patentees, i.e., to the *named* inventors of the patent.

> " . . . '[L]egal title holder' is synonymous with 'patentee' as defined by 35 U.S.C. § 100(d): 'The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.' " *Arachnid v. Merit Industries*, 939 F.2d 1574, 19 USPQ2d 1513 (Fed. Cir. 1991), quoting G. Curtis, *A Treatise on the Law of Patents* § 168 (4th ed. 1873).

In order for a single assignee to properly execute a declaration under 37 CFR 1.131, the assignee must establish ownership of the <u>entire</u> interest in the claimed subject matter by submitting documentary evidence establishing a chain of title from the original owner to the assignee, pursuant to 37 CFR 3.73(b). See MPEP 324, Section II. The named inventors of the patent are the original owners.

> "**The entity to whom the grant of a patent is made by the PTO** [or that entity's successor in title] holds the 'legal title' to the patent. The legal title holder may or may not be the inventor, according to whether provision has been made by the inventor for issuance to an assignee." *Arachnid* at 1578 (emphasis added).

Dr. Platt, however, has not been named as an inventor of the '306 patent, and therefore does not have original ownership rights to the claimed subject matter. Any assignment by Dr. Platt to the present assignee of purported rights to the invention of the '306 patent would be ineffective, therefore, because Dr. Platt cannot assign ownership rights that he does not have (in the absence of evidence of an assignment by the original owners to Dr. Platt). Consequently, the present assignee cannot properly establish on the record a transfer of ownership rights to the '306 patent from Dr. Platt, an unnamed inventor, to the present assignee, pursuant to 37 CFR 3.73(b).

For the reasons given above, any declaration under 37 CFR 1.131 signed by the present assignee would be ineffective to establish prior invention of the claimed subject matter of the '306 patent, in the absence of a correction of inventorship to add Dr. Platt as an inventor.

The solution, in this instance, is to correct the inventorship by adding Dr. Platt and by removing Dr. Sasak. The patent owner, however, has been unable to add Dr. Platt as an inventor pursuant to the provisions of 35 U.S.C. 256 and 37 CFR 1.324. In such a case, a reissue application filed by the assignee of the entire interest in the '306 patent would be an appropriate vehicle for the correction of inventorship, if the reissue application otherwise complies with all applicable statutes and regulations, including those concerning reissue. The assignee, however, must show ownership of the **entire** interest in the present patent (even that of Dr. Platt). See MPEP 1412.04 II. The Office does not settle assignment disputes. If there is a conflict regarding the ownership of the patent, the remedy of the parties must be with the courts.

The above discussion of the June 13, 2005 and December 23, 2005 declarations under 37 CFR 1.131 signed by Dr. Yan Chang, and of any later-filed declaration under 37 CFR 1.131 signed by the present assignee, is limited to the discussion of the execution of these declarations by the

inventor(s) or by the assignee. **If the inventorship of the '306 patent is later corrected to add Dr. Platt and to delete Dr. Sasak as an inventor, any further determination of the persuasiveness of these declarations, and, for that matter, any other declaration filed in the instant proceeding, remains subject to substantive review by the examiner in charge of the proceeding.**

The Amendment Included in the October 12, 2006 Patent Owner Response

The October 12, 2006 patent owner response is in reply to the September 12, 2006 decision notifying the patent owner that the amendment filed with the December 23, 2005 patent owner response is defective.[19] Specifically, the December 23, 2005 amendment failed (contrary to the provisions of 37 CFR 1.941 and 37 CFR 1.530(f)) to underline new claims 24-44, which were previously added by an earlier amendment filed June 13, 2005.[20]

The amendment included in the October 12, 2006 patent owner response, which includes the underlining of new claims 24-44, is **proper** and **will be entered**.

The December 4, 2006 Third Party Requester Petition

The December 4, 2006 third party requester petition under 37 CFR 1.183, which is construed as a petition under 37 CFR 1.182, urges the Office to strike specified portions of the patent owner documents filed on October 12, 2006. Specifically, the third party requester urges the Office to strike the arguments included with the October 12, 2006 patent owner response, and to strike paragraph no. 3 of the October 12, 2006 patent owner petition.

The Arguments Included in the October 12, 2006 Patent Owner Response

The third party requester calls upon the Office to strike the arguments included in the October 12, 2006 patent owner response.[21] Specifically, the third party requester urges that the September 12, 2006 decision only required the patent owner to correct the December 23, 2005 amendment, and that any additional argument filed with the corrected amendment was improper. The third party requester urges that the arguments included in the October 12, 2006 patent owner response contain revised arguments, as well as supplemental arguments and appendices that were not included in the December 23, 2005 patent owner response.

A review of the record reveals that the October 12, 2006 patent owner response contains additional arguments and appendices directed to the merits of the invention, which were not presented in the arguments and appendices filed with the December 23, 2005 patent owner response. Specifically, all of the arguments included in the December 23, 2005 patent owner response appear to have been rewritten in the October 12, 2006 patent owner response with additional comments.[22] Furthermore, additional arguments have been directed, for example, to

[19] See item no. 3 on page 8 of the September 12, 2006 decision.
[20] See the penultimate paragraph on page 8 of the September 12, 2006 decision.
[21] See pages 2-4 of the December 4, 2006 third party requester petition.
[22] Compare, for example, the comments regarding the Napier declaration found on page 13 of the October 12, 2006 patent owner response with those found on page 9 of the December 23, 2005 patent owner response; compare also

the Rubin and Platt references, [23] and have also been newly directed to the Ros and Renard references. [24] Furthermore, newly added appendices E and F were not included in the appendices accompanying the arguments filed on December 23, 2005.

The patent owner appears to believe that the entire December 23, 2005 response "was not entered because of issues regarding the formalities of the claims."[25] Only the December 23, 2005 *amendment*, however, was not entered. [26] The arguments and appendices included with the December 23, 2005 response remain of record.[27] The September 12, 2006 decision specifically stated the while the amendment will not be entered, *the argument will be considered as it applies to the proceeding without the amendment*, should the proceeding be limited under 37 CFR 1.957(c).

The only defect discussed in the September 12, 2006 decision was the failure to underline new claims 24-44. Consequently, the only response that was required by the September 12, 2006 decision was a submission directed solely to correcting the underlining of new claims 24-44.[28]

Thus, the arguments and appendices included in the October 12, 2006 patent owner response are directed to the merits of the invention, and are, therefore, a supplemental response that will not be entered as a matter of right pursuant to 37 CFR 1.937(b) and 37 CFR 1.111(a)(2)(i).[29]

MPEP 2666 III provides for the Office to enter a supplemental response pursuant to 37 CFR 1.111(a)(2)(i) if the supplemental response is be clearly limited to:

(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the proceeding in condition for a Notice of Intent to Issue a Reexamination Certificate (NIRC);
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (e.g., typographical errors); or
(F) Simplification of issues for appeal.

The arguments included in the October 12, 2006 patent owner response are not in response to an Office requirement made after the first patent owner response was filed on December 23, 2005 (i.e., a requirement made in the September 12, 2006 decision), as discussed immediately above.

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the comments regarding whether interferon is a chemotherapeutic, found on pages 15-17 of the October 12, 2006 patent owner response with those found on pages 11-14 of the December 23, 2005 patent owner response.

[23] Compare, for example, pages 19-22 of the October 12, 2006 patent owner response with pages 16-18 of the December 23, 2005 patent owner response.

[24] Compare, for example, pages 25-29 of the October 12, 2006 patent owner response with page 20 of the December 23, 2005 patent owner response.

[25] See paragraph no. 2 appearing on the first page of the October 12, 2006 patent owner petition

[26] See item nos. 3 and 4 on page 8 of the September 12, 2006 decision, specifically stating that the *amendment* filed December 23, 2005, will not be entered, and set a time period for reply to correct *the defective amendment.*

[27] See item no. 4 on page 8 of the September 12, 2006 decision.

[28] See MPEP 2666.60, which states, in pertinent part (emphasis added): "After the patent owner . . . has provided a submission directed **solely** to correcting the defect . . ."

[29] See MPEP 2666.60 and MPEP 2666 III.

Nor do the October 12, 2006 arguments, in and of themselves, cancel claims, adopt the examiner's suggestions, place the proceeding in condition for a NIRC, correct informalities, or simplify the issues for appeal, as set forth in MPEP 2666 III, pursuant to 37 CFR 1.111(a)(2)(i).

Furthermore, the patent owner does not provide any reasons why the arguments included in the October 12, 2006 patent owner response are to be entered as a matter of right.

For the reasons given above, the December 4, 2006 third party requester petition is **granted in part**. Specifically, the arguments and appendices included in the October 12, 2006 patent owner response are **improper** and **will not be entered**. [30]

When the Office determines that a submission filed in response to a notice of defective paper contains additional arguments (and appendices) directed to the merits that are deemed to be improper under 37 CFR 1.111(a)(2)(i), the Office generally mails a decision "returning" the paper [31] and setting a 30-day or one month period for reply, whichever is longer, to correct the defect without a discussion on the merits. [32]

In view of the prolonged delay on the part of the Office in reviewing the October 12, 2006 patent owner response, however, and further in view of the statutory requirement for special dispatch, **the Office will redact the October 12, 2006 patent owner response by removing the arguments improperly included in the October 12, 2006 patent owner response**, rather than sending a notice of defective paper.

Paragraph No. 3 of the October 12, 2006 Patent Owner Petition

The third party requester urges that paragraph no. 3 of the October 12, 2006 patent owner petition [33] "should not be entered into the record," because the September 12, 2006 decision made no provision for submission of additional evidence re: any lack of deceptive intent on the part of Dr. David Platt.[34]

A petition, however, is not deemed to be a response to an Office action on the merits within the meaning of 37 CFR 1.945, nor is it considered to be a supplemental response on the merits within the meaning of 37 CFR 1.111. The petition in question did not go beyond the bounds of the relief requested.[35] The patent owner was permitted to file the petition under 37 CFR 1.183 to

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[30] Had the third party requester not filed a petition under 37 CFR 1.182 to strike, the Office would have, *sua sponte,* held the arguments and appendices included in the October 12, 2006 patent owner response to be improper.

[31] When an improper paper has been scanned into the Office's Image File Wrapper ("IFW") system, the Office "returns" the improper paper by removing the improper paper from view.

[32] See MPEP 2666.60.

[33] The patent owner states, in paragraph no. 3 of the October 12, 2006 petition: "While co-inventor Dr. David Platt refused to sign the aforementioned Declaration, however he has signed his own Declaration, evidencing date of his invention prior to March 27, 2001, which Declaration is of record in a Response dated January 31, 2005, a copy of which is attached as Exhibit B."

[34] See the bottom paragraph of page 5 of the December 4, 2006 third party requester petition.

[35] In any event, the October 12, 2006 patent owner petition makes no specific mention of a showing of any lack of deceptive intent on the part of Dr. David Platt, either in paragraph no. 3 or in any other part of the October 12, 2006 patent owner petition. Nor is the Platt declaration "additional evidence," since it was filed with the Office on

waive the requirements of 37 CFR 1.131, just as the third party requester was permitted to file a petition under 37 CFR 1.182 to strike in this proceeding.

The third party requester urges the Office to permit the filing of third party requester comments to "patentee's October 12, 2006 papers," should the "above-discussed material [be] entered into the record."[36] The issue is moot in view of the Office's present decision to redact the arguments and appendices included in the October 12, 2006 patent owner response, discussed *supra*. In any event, the thirty-day time period within which the third party requester is permitted to file comments on patent owner's response to an Office action on the merits is **statutory and cannot be waived**.[37]

For the reasons given above, the entire October 12, 2006 patent owner petition, including paragraph no. 3 of the petition, has been treated by this decision. Accordingly, the December 4, 2006 third party requester petition is **dismissed in part.**

Timeliness

The third party requester presents various arguments as to why the December 4, 2005 third party requester petition is timely filed.[38]

A petition under 37 CFR 1.182 filed by the third party requester, however, is not considered to be "comments" on the merits within the meaning of 35 U.S.C. 314(b)(2) and 37 CFR 1.947. Consequently, the 30-day statutory period for the third party requester to file written comments does not apply. Since there is no time period within which either party in an *inter partes* reexamination proceeding is required to file a petition to strike under 37 CFR 1.182, the issue of timeliness is not relevant.

Accordingly, the December 4, 2006 third party requester petition to strike specified portions of the patent owner documents filed on October 12, 2006 has been **granted in part**. Specifically, **the arguments and appendices** included in the October 12, 2006 patent owner response are **improper** and **will not be entered**. **The Office will redact** the October 12, 2006 patent owner response **by removing the arguments and appendices** improperly included in the October 12, 2006 patent owner response.

The third party requester's December 4, 2006 petition to strike specified portions of the patent owner documents filed on October 12, 2006 has been **dismissed in part**. Specifically, the entire October 12, 2006 patent owner petition, including paragraph no. 3, has been treated by this decision.

January 31, 2005. Finally, to clarify the record, the January 31, 2005 declaration of Dr. David Platt cannot be construed as a statement pursuant to 37 CFR 1.324(b), because the declaration fails to include a statement by Dr. Platt that the inventorship error in the '306 patent occurred without any deceptive intent on his part.

[36] See the penultimate paragraph of page 7 of the December 4, 2006 third party requester petition.

[37] Se 35 U.S.C.. 314(b).

[38] See page 6 of the December 4, 2005 third party requester petition.

Failure by the Office to Receive Third Party Requester Documents

In the December 4, 2006 third party requester petition, the third party requester refers to a "1/18/06 response" and a power of attorney for the third party requester appointing the law firm of Greenberg Traurig, LLP, of New York, New York, which the third party requester believes to have been filed with the Office on January 18, 2006.[39]

Office records, however, fail to reveal that a "1/18/06 response," and a power of attorney appointing the law firm of Greenberg Traurig, were filed with the Office. According to Office records, the attorney of record for the third party requester is Stephen J. Gaudet of Perkins, Smith & Cohen, of Boston, Massachusetts.

The third party requester further states: "[a] record from Patentee's counsel confirming the USPTO's receipt of the Power of Attorney is attached as Exhibit D."[40] This evidence, however, is insufficient to establish receipt by the Office of the "1/18/06 response" and the power of attorney for the third party requester.[41] To establish receipt by the Office of correspondence that includes a certificate of mailing pursuant to 37 CFR 1.8, as is the case here, the third party requester must notify the Office in writing pursuant to 37 CFR 1.8(b), and provide a statement pursuant to 37 CFR 1.8(b)(3). Additional evidence, such as a postcard receipt containing an official "Office Date" stamp by the Office [42] that itemizes the correspondence deposited with the Office, is recommended. If no showing of Office receipt of the "1/18/06 response" from the third party requester is received within a period of 30 days, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments (and attachments) by the third party requester on the December 23, 2005 patent owner response.

If the power of attorney, attached to the December 4, 2006 third party requester petition as the last page of "Exhibit A" is later filed with the Office, it will not be effective to change the correspondence address of the third party requester. The box authorizing the Office to change the correspondence address is not checked. This must be remedied. Note that a copy of a power of attorney, attached as an exhibit to a petition, is not considered to be an official filing of a power of attorney. To be effective, the third party requester must separately file a properly completed power of attorney and change of correspondence address.

A courtesy copy of this decision will be mailed to the law firm of Greenberg Traurig, LLP, of New York, New York, in order to notify Greenberg Traurig, LLP of the instant decision, even though the record does not establish Greenberg Traurig, LLP as the attorneys of record.

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[39] See pages 6 and 7 of the December 4, 2006 third party requester petition.
[40] See the first full sentence of page 7 of the December 4, 2006 third party requester petition.
[41] A copy of the "1/18/06 response" and the power of attorney for the third party requester is attached to the December 4, 2006 third party requester petition as "Exhibit A."
[42] See MPEP 503 and 505.

CONCLUSION

1. The October 12, 2006 patent owner petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the December 23, 2005 Chang declaration under 37 CFR 1.131 be signed by all of the inventors, including the request for reconsideration of the December 23, 2005 petition under 37 CFR 1.183 to waive the 37 CFR 1.131 requirement that the June 13, 2005 declaration under 37 CFR 1.131 by Dr. Yan Chang be signed by all of the inventors, is **dismissed**.

2. The December 4, 2006 requester petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182 to strike specified portions of the documents filed by the patent owner on October 12, 2006, is **granted in part and dismissed in part**. Specifically, the arguments and appendices included in the October 12, 2006 patent owner response are **improper** and **will not be entered**. **The Office will redact** the October 12, 2006 patent owner response **by removing the arguments and appendices** improperly included in the October 12, 2006 patent owner response. On the other hand, the entire October 12, 2006 patent owner petition, including paragraph no. 3, has been treated by this decision.

3. The amendment included in the October 12, 2006 patent owner response is **proper** and **will be entered**.

4. A power of attorney and change of correspondence address for the third party requester, to which the third party requester refers in the December 4, 2006 petition, have not been received the Office. A courtesy copy of this decision is being mailed to the law firm of Greenberg Traurig, LLP, New York, New York. **If the power of attorney, attached to the December 4, 2006 third party requester petition as the last page of "Exhibit A" is subsequently filed with the Office, it would not be effective to change the correspondence address of the third party requester, because the box authorizing the Office to change the correspondence address is not checked.**

5. The original documents entitled "the 1/18/06 response" to which the third party requester refers in the December 4, 2006 petition, also have not been received by the Office. **The third party requester is given a time period of 30 days or one month from the date of this decision, whichever is later**, to establish receipt by the Office of "the 1/18/06 response" pursuant to 37 CFR 1.8. The submission by the third party requester shall be limited to the establishment of receipt by the Office, shall be served on the patent owner pursuant to 37 CFR 1.908 and 37 CFR 1.248, and shall be submitted as a request for reconsideration of this decision. If no response from the third party requester is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of the written comments (and attachments) by the third party requester on the December 23, 2005 patent owner response.

6. The patent owner is given a time period of **30 days or one month from the date of this decision, whichever is later,** to file a request for reconsideration of this decision. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration pending response, or the expiration of the period for response.

7. Any response to this decision by the patent owner must be served on the third party requester pursuant to 37 CFR 1.908 and 37 CFR 1.248.

SUBMISSION OF CORRESPONDENCE

All correspondence relating to this *inter partes* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Inter Partes* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

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

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

cn

October 17, 2007
C:\kiva\kimpropa\IP\ 95_074-dismiss_assignee-sign-131+response-more-than-notice-required.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,074	01/31/2005	6680306	13192-127	8879

28120 7590 02/11/2008

ROPES & GRAY LLP
PATENT DOCKETING 39/41
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BARRY J. SCHINDLER
GREENBERG TRAURIG, LLP
200 PARK AVE., P.O. BOX 677
FLORHAM PARK, NJ 07932

Date:

FEB 11 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000074
PATENT NO. : 6680306
ART UNIT : 3991

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

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

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CENTRAL REEXAMINATION UNIT

Fish & Neave IP Group
Ropes and Gray LLP
One International Place
Boston, MA 02110-2624

(For Patent Owner)

Greenberg Traurig, LLP
200 Park Avenue
P.O. Box 677
Florham Park, NJ 07932

(For Requester)

In re Chang et al
Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

DECISION DISMISSING REQUEST FOR RECONSIDERATION

This decision addresses the third party requester's request for reconsideration, filed on November 13, 2007, entitled "Third Party Requester's Request for Reconsideration of the 10-18-07 Decision as to Establishment of Receipt by Office of Third Party Request[e]r's 1-18-06 Submission" (hereinafter, "the November 13, 2007 request for reconsideration").

This decision also notifies the third party requester that the power of attorney and change of correspondence address filed by the third party requester on November 13, 2007 has been entered.

The November 13, 2007 request for reconsideration, the November 13, 2007 third party requester power of attorney and change of correspondence address, and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The November 13, 2007 request for reconsideration is **dismissed**.

The November 13, 2007 power of attorney and change of correspondence address filed by the third party requester is **proper** and **has been entered**.

REVIEW OF FACTS

- On January 20, 2004, U.S. Patent No. 6,680,306 (the '306 patent) issued to Dr. Yan Chang and Dr. Vodek Sasak.

- On January 31, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,074 (the '074 proceeding).

[1] The request for *inter partes* reexamination was filed by Pro-Pharmaceuticals, Inc., the real party in interest.

- On April 12, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.

- Prosecution progressed to the point at which the Office mailed a second non-final action on the merits on October 18, 2005.

- On December 22, 2005, the Office received a response filed by the patent owner to the October 18, 2005 Office action entitled "supplemental submission," including a certificate of mailing dated December 20, 2005.

- On December 23, 2005, the Office received documents filed by the patent owner, including the "initially-filed" patent owner response to the October 18, 2005 Office action, accompanied by attachments, and a certificate of mailing dated December 19, 2005. December 18, 2005 was a Sunday.

- Prosecution progressed to the point at which the third party requester filed a petition on December 4, 2006,[2] which included a reference to a "1/18/06 response" and a power of attorney for the third party requester appointing the law firm of Greenberg Traurig, LLP, which the third party requester believes to have been filed on January 18, 2006. Office records, however, fail to reveal that a "1/18/06 response" and a power of attorney appointed the law firm of Greenberg Traurig, were filed with the Office.

- On October 18, 2007, a decision entitled "Decision on Petitions and Denying Entry of Patent Owner's Arguments" was mailed. The decision addressed, among other issues, the Office's lack of receipt of the original documents entitled "the 1/18/06 response" to which the third party requester referred in the December 4, 2006 petition, and provided the third party requester with a time period of 30 days or one month from the mail date of the October 18, 2007 decision, whichever was later, to establish receipt by the Office of the "1/18/06 response" pursuant to 37 CFR 1.8.

- On November 13, 2007, the third party requester filed the present request for reconsideration of the October 18, 2007 decision, entitled "Third Party Requester's Request for Reconsideration of 10.18.07 Decision as to Establishment of Receipt by Office of Third Party Requester's 1.18.06 Submission" (hereinafter, "the November 13, 2007 request for reconsideration"). The November 13, 2007 request for reconsideration contains a certificate of service appearing at the top of page 2, and is accompanied by a certificate of mailing as well as Exhibits A, B, and 1-8.

- Also on November 13, 2007, the third party requester filed a power of attorney and change of correspondence address.

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[2] The December 4, 2006 petition was entitled "37 CFR 1.183 Petition Not to Enter Improper Attorney Argument in Patentee's October 12, 2006 Submission."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

(b) RESPONSE. —

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner 's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner 's response.

37 CFR 1.8(b) provides, in pertinent part:

(a) . . . [C]orrespondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed . . . prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;

*
*

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit . . . The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed . . . on or before the date indicated.

*
*

(b) In the event that correspondence is considered timely filed by being mailed . . . in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing. . . of the correspondence, . . . or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing. . .of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed . . . correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing . . .

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 503 provides, in pertinent part (emphasis added):

If a receipt for any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item . . .

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. **A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.**

The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted.

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application . . . or missing portions (e.g., pages . . .) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

MPEP 505 provides, in pertinent part:

The United States Patent and Trademark Office (Office) stamps papers . . . with the date of their receipt in the Office. The stamp is referred to as the "Office Date" stamp.

MPEP 512 IV provides, in pertinent part (emphasis added):

37 CFR 1.8(b) permits a party to notify the Office of a previous mailing, or transmitting, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and **a statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission.** Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence.

DECISION

The requester requests the Office to consider the document, designated by the requester as the "1.18.06 Response," as being timely filed pursuant to 37 CFR 1.8(b).

Pursuant to 35 U.S.C. 314(b) and 37 CFR 1.947, the third party requester may once file written comments within a period of 30 days from the date of service of patent owner's response. In this instance, patent owner's December 23, 2005 response (certificate of mailing, December 19, 2005) to the October 18, 2005 Office action[3] was served on the third party requester on December 19, 2005. The third party requester, therefore, was required by statute to file comments by no later than January 19, 2006. Statutory requirements cannot be waived by the Office.

Office records fail to reveal that the Office received any correspondence from the third party requester in this reexamination proceeding during the month of January 2006.

Pursuant to 37 CFR 1.8(b), correspondence will be considered to be timely filed if the party who forwarded such correspondence:

> "(1) Informs the Office of the previous mailing . . . of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
>
> "(2) Supplies an additional copy of the previously mailed . . . correspondence and certificate; and
>
> "(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing . . . "

By mailing the November 13, 2007 request for reconsideration, the requester informed the Office of the previous mailing of the correspondence after becoming aware that the Office has no evidence of receipt of the correspondence, pursuant to 37 CFR 1.8(b)(1).

Furthermore, the November 13, 2007 request for reconsideration is accompanied by Exhibit A, which the requester states is a copy of "the 1.18.06 Response as filed." [4] Exhibit A contains a document entitled "Reply-A" and an attached, signed certificate of mailing dated January 18, 2006, pursuant to 37 CFR 1.8(a)(1). The requester has met the provisions of 37 CFR 1.8(b)(2), therefore, as to the document entitled "Reply-A."

The November 13, 2007 request for reconsideration, however, is also accompanied by additional documents designated as Exhibits 1-8. Neither the request for reconsideration, nor the certificate of mailing dated January 18, 2006 and attached to the document entitled "Reply-A," mentions Exhibits 1-8. Since each of Exhibits 1-8, however, are discussed within the body of the document entitled "Reply-A," [5] the documents designated as Exhibits 1-8 are considered to be

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[3] December 18, 2005 was a Sunday.

[4] See the first sentence of page 6 and the last sentence of page 8 of the November 13, 2007 request for reconsideration.

[5] See pages 4 and 29.

part of the document entitled "Reply-A" for the purposes of satisfying the provisions of 37 CFR 1.8(b)(2).[6]

Regarding the statement required by 37 CFR 1.8(b)(3), the requester states, on page 6 of the November 13, 2007 request for reconsideration: "the person signing the certificate (the undersigned) had a *reasonable basis to expect* that the correspondence would be mailed *or transmitted* on or before the date indicated" (emphasis added). 37 CFR 1.8(b)(3), however, requires a statement which *attests on a personal knowledge basis* (by the person signing the statement) to the previous timely *mailing* of the correspondence where, as here, the certificate of mailing states that the correspondence was mailed (not transmitted). This statement indicates that the correspondence could have been transmitted, contrary to what is stated in the certificate of mailing. Furthermore, the statement appears to indicate that Mr. Shindler, the person signing the statement under 37 CFR 1.8(b)(3), had a reasonable basis to expect, but apparently did not have firsthand personal knowledge of, the mailing.

The statement pursuant to 37 CFR 1.8(b)(3) must be signed by the person, such as a paralegal or other employee of the law firm, who actually mailed the documents, or by a person who can attest that he or she has firsthand, personal knowledge that the documents were, in fact, deposited with the United States Postal Service via first class mail and addressed to the Office on the date indicated in the certificate of mailing. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing. See MPEP 512 IV.

In the present case, the person making the statement pursuant to 37 CFR 1.8(b)(3), Mr. Barry Shindler, did sign the certificate of mailing, but fails to **attest that he has personal knowledge that the document entitled "Reply-A," which the requester states is "the 1.18.06 Response as filed," and accompanying exhibits were, in fact, "deposited with the United States Postal Service as first class mail addressed to [the Office]," as stated in the certificate of mailing, on the date indicated in the certificate of mailing, January 18, 2006**.

The requester further states, on page 9 of the November 13, 2007 request for reconsideration: "In addition and as discussed above, *third party request[e]rs* have personal knowledge of the previous timely mailing, and *reasonably expected* that the correspondence would be mailed *or transmitted* on or before the date indicated on the Certificate of Mailing." The third party requester in this reexamination proceeding is a corporation, Pro-Pharmaceuticals, Inc. A corporation is not a person that is capable of having "firsthand, personal knowledge" of the timing and manner of mailing a document. This statement also fails to attest, by a *person* who has *firsthand, personal knowledge* of the mailing, that document entitled "Reply-A," which the requester states is "the 1.18.06 Response as filed," and accompanying exhibits were, in fact, "deposited with the United States Postal Service as first class mail addressed to [the Office], as stated in the certificate of mailing, on the date indicated in the certificate of mailing, January 18,

[6] For the same reason, the documents designated as Exhibits 1-8 are considered to be part of the document entitled "Reply-A" for the purposes of the certificate of service dated January 18, 2006, which appears at the top of page 2 of the document entitled "Reply-A." The document entitled "Reply-A" is determined to be the same document to which the certificate of service refers as "Requester's Reply to GlycoGenesys' Response dated December 19, 2005 to an Office Action dated October 18, 2005" for the reasons discussed *infra*.

2006. Furthermore, this statement again indicates that the correspondence could have been transmitted, contrary to what is stated in the certificate of mailing.

The requester also states, on page 9 of the November 13, 2007 request for reconsideration: "third party request[e]rs respectfully submit that this statement satisfies the Director as to the previous timely mailing or transmission of the above-captioned application." It is the Office, however, that makes the determination as to whether the Director is satisfied. Again, this statement indicates that the correspondence could have been transmitted, contrary to what is stated in the certificate of mailing, and fails to attest, by a *person* who has *firsthand, personal knowledge* of the mailing, that document entitled "Reply-A," which the requester states is "the 1.18.06 Response as filed," and accompanying exhibits were, in fact, "deposited with the United States Postal Service as first class mail addressed to [the Office]," as stated in the certificate of mailing, on the date indicated in the certificate of mailing, January 18, 2006.

For the reasons given above, the requester has failed to provide a statement that satisfies the requirements of 37 CFR 1.8(b)(3) and consequently, has failed to satisfy all of the requirements of 37 CFR 1.8(b).

The requester also presents a postcard receipt stamped by the Office as evidence that the Office timely received "the 1.18.06 Response." [7]

MPEP 503 states, in pertinent part (emphasis added):

> "A postcard receipt **which itemizes and properly identifies the items** which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon **on the date stamped thereon by the USPTO**."

To provide evidence of *timely* receipt of the document entitled "Reply-A," which the requester states is "the 1.18.06 Response as filed," and accompanying exhibits, the postcard receipt must **1)** itemize and properly identify the document "Reply-A" and Exhibits 1-8, **2)** contain a date stamped by the Office that is on or before the statutorily required due date of January 19, 2007.

Exhibit B, which accompanied the November 13, 2007 request for reconsideration, is a copy of a postcard receipt which contains a typewritten date of "January 18, 2005" and a stamp applied by the Office indicating a date of January 23, 2006, and which itemizes, among other documents, a "Reply to Glycol Genesys' Response dated December 19, 2005 to an Office action dated October 18, 2005" (hereinafter, "the postcard"). The document which the requester states is "the 1.18.06 Response as filed," however, is entitled "Reply-A." No document entitled "Reply-A" is itemized and identified on the postcard. For this reason, the postcard, alone, fails as evidence that a document entitled "Reply-A" was ever received by the Office.

On page 2 of the document entitled "Reply-A" [8] immediately below the heading "Reply-A," however, the requester states that "[r]equester files this reply which addresses arguments

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[7] See pages 6-8 of the November 13, 2007 request for reconsideration.
[8] See the first sentence appearing immediately after the heading "Reply-A."

proffered by GlycoGenesys . . . in their response to the Office Action mailed October 18, 2005." Throughout the document entitled "Reply-A," [9] the requester specifically refers and responds to "Patentee's December 19th Reply." [10] Also, immediately above the heading "Reply-A" on page 2, the requester states that "a true copy of Requester's Reply to GlycoGenesys' Response dated December 19, 2005 to an Office Action dated October 18, 2005" was served on the patent owner.[11] These statements by the requester in the document entitled "Reply-A," when compared with the title of the document identified on the postcard as "Reply to Glycol Genesys' Response dated December 19, 2005 to an Office action dated October 18, 2005," provides sufficient evidence that the document entitled "Reply-A" is the document itemized and identified on the postcard as "Reply to Glycol Genesys' Response dated December 19, 2005 to an Office action dated October 18, 2005." The postcard, therefore, *in combination with* the statements by the requester in the document entitled "Reply-A," serve as sufficient evidence that the document entitled "Reply-A" was received by the Office.

The postcard fails to itemize and identify Exhibits 1-8. Since each of Exhibits 1-8, however, are discussed within the body of the document entitled "Reply-A," the documents designated as Exhibits 1-8 are considered to be part of the document entitled "Reply-A."

The postcard is stamped by the Office with a date of January 23, 2006. The Office's stamp dated January 23, 2006, however, only provides evidence that the documents itemized and identified on the postcard, including the document "Reply-A" identified on the postcard as "Reply to Glycol Genesys' Response dated December 19, 2005 to an Office action dated October 18, 2005," were received by the Office on January 23, 2006, which is later than the statutorily required due date of January 19, 2006. The "January 18, 2005" date, which is apparently typewritten on the postcard by the requester, cannot serve as evidence of receipt by the Office on that date because the January 18, 2005 date was not stamped or applied by the Office. In any event, the January 18, 2005 date appears to be in error in view of the dates provided in the title of the document listed on the postcard as "Reply to Glycol Genesys' Response dated *December 19, 2005* to an Office action dated *October 18, 2005*" (emphasis added), both of which are later than January 18, 2005. Consequently, the postcard fails to serve as evidence that the Office received any document on or before the statutorily required due date of January 19, 2006.

The certificate of service which appears at the top of page 2 of the document entitled "Reply-A" only provides proof of service *on the patent owner* on January 18, 2006. It does not provide evidence that the document identified in the certificate of service was mailed *to the Office* on that date.[12] The certificate of mailing dated January 18, 2006 cannot be relied upon to provide evidence of the timely mailing of the document entitled "Reply-A," either alone or in combination with the postcard, because the requester has failed to satisfy all of the requirements of 37 CFR 1.8(b) for the reasons previously discussed.

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[9] See, e.g., pages 22, 25, 28, 29, 30, 31, 34, 35, 36, 39 and 40.

[10] "Patentee's December 19th Reply" or "GlycoGenesys' Response dated December 19, 2005" are considered to be the patent owner's response which was received by the Office on December 23, 2005, and which included a certificate of mailing dated December 19, 2005.

[11] See the certificate of service appearing at the top of page 2 of the document entitled "Reply-A."

[12] If a certificate of service provided evidence of the date of mailing a document to the Office, then there would be no need for a certificate of mailing.

For the reasons given above, the postcard fails to serve as evidence that the Office timely received the document entitled "Reply-A," which the requester states is "the 1.18.06 Response as filed," and accompanying exhibits on or before the statutory due date of January 19, 2006.

Accordingly, the November 13, 2007 request for reconsideration is **dismissed**.

The November 13, 2007 power of attorney and change of correspondence address filed by the third party requester is **proper** and **has been entered**.

CONCLUSION

1. The November 13, 2007 request for reconsideration, entitled "Third Party Requester's Request for Reconsideration of the 10-18-07 Decision as to Establishment of Receipt by Office of Third Party Request[e]r's 1-18-06 Submission" is **dismissed**. Specifically, the requester has failed to provide a statement that satisfies the requirements of 37 CFR 1.8(b)(3). Furthermore, the postcard submitted by the requester as proof of receipt by the Office cannot serve as evidence that the Office received the document entitled "Reply-A" and accompanying exhibits on or before the statutory due date of January 19, 2006.

2. The November 13, 2007 power of attorney and change of correspondence address filed by the third party requester is **proper** and **has been entered**.

3. Any response to this decision by the third party requester must be: **1)** received **within thirty (30) days, or one month, whichever is later,** from the mail date of this decision, **2)** limited to the establishment of **timely** receipt by the Office of the document entitled "Reply-A" to which the requester refers as "the 1.18.06 Response as filed" and accompanying exhibits, and **3)** served on the patent owner pursuant to 37 CFR 1.908 and 37 CFR 1.248. Exhibits A, B, and 1-8, filed on November 13, 2007, should NOT be resubmitted.

4. If no response from the third party requester is received, the third party requester written comments (and attachments) on the December 23, 2005 patent owner response, to which the requester refers as "the 1.18.06 Response as filed" and accompanying exhibits, will remain in the file, but will not be entered or further treated on the merits.

5. Jurisdiction over this reexamination proceeding is being retained by the Office of Patent Legal Administration pending response, or the expiration of the period for response.

SUBMISSION OF CORRESPONDENCE

All correspondence relating to this *inter partes* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Inter Partes* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

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

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

cn

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,074	01/31/2005	6680306	13192-127	8879

28120 7590 05/12/2008

ROPES & GRAY LLP
PATENT DOCKETING 39/41
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2008

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

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MAILED
MAY 12 2008
CENTRAL REEXAMINATION UNIT

Greenberg Traurig, LLP
200 Park Avenue
P.O. Box 677
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(For Requester)

In re Chang et al
Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

DECISION GRANTING REQUEST FOR RECONSIDERATION

This decision addresses the third party requester's request for reconsideration, filed on March 11, 2008, entitled "Third Party Requester's Request for Reconsideration of the of 2/11/08 Decision Relating to Timely Receipt by the United States Patent and Trademark Office of the Document Entitled "Reply-A" to Which the Third Party Requester Refers To As "The 1/18/06 Response As Filed" (the March 11, 2008 requester request for reconsideration).

The March 11, 2008 request for reconsideration and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The March 11, 2008 request for reconsideration is **granted**.

REVIEW OF FACTS

- On January 20, 2004, U.S. Patent No. 6,680,306 (the '306 patent) issued to Dr. Yan Chang and Dr. Vodek Sasak.
- On January 31, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,074 (the '074 proceeding).
- On April 12, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.
- Prosecution progressed to the point at which the Office mailed a second non-final action on the merits on October 18, 2005.

[1] The request for *inter partes* reexamination was filed by Pro-Pharmaceuticals, Inc., the real party in interest.

- On December 22, 2005, the Office received a response filed by the patent owner to the October 18, 2005 Office action entitled "supplemental submission," including a certificate of mailing dated December 20, 2005.

- On December 23, 2005, the Office received documents filed by the patent owner, including the "initially-filed" patent owner response to the October 18, 2005 Office action, accompanied by attachments, and a certificate of mailing dated December 19, 2005. December 18, 2005 was a Sunday.

- Prosecution progressed to the point at which the third party requester filed a petition on December 4, 2006,[2] which included a reference to a "1/18/06 response" and a power of attorney for the third party requester appointing the law firm of Greenberg Traurig, LLP, which the third party requester believes to have been filed on January 18, 2006. Office records, however, fail to reveal that a "1/18/06 response" and a power of attorney appointed the law firm of Greenberg Traurig, were filed with the Office.

- On October 18, 2007, a decision entitled "Decision on Petitions and Denying Entry of Patent Owner's Arguments" was mailed. The decision addressed, among other issues, the Office's lack of receipt of the original documents entitled "the 1/18/06 response" to which the third party requester referred in the December 4, 2006 petition, and provided the third party requester with a time period of 30 days or one month from the mail date of the October 18, 2007 decision, whichever was later, to establish receipt by the Office of the "1/18/06 response" pursuant to 37 CFR 1.8.

- On November 13, 2007, the third party requester filed the present request for reconsideration of the October 18, 2007 decision, entitled "Third Party Requester's Request for Reconsideration of 10.18.07 Decision as to Establishment of Receipt by Office of Third Party Requester's 1.18.06 Submission" (hereinafter, "the November 13, 2007 request for reconsideration"). The November 13, 2007 request for reconsideration contains a certificate of service appearing at the top of page 2, and is accompanied by a certificate of mailing as well as Exhibits A, B, and 1-8.

- Also on November 13, 2007, the third party requester filed a power of attorney and change of correspondence address.

- On February 11, 2008, a decision dismissing the November 13, 2008 request for reconsideration was mailed. The November 13, 2007 power of attorney and change of correspondence address was entered.

- On March 11, 2008, the third party requester filed the present request for reconsideration of the February 11, 2008 decision, entitled "Third Party Requester's Request for Reconsideration of the of 2/11/08 Decision Relating to Timely Receipt by the United

[2] The December 4, 2006 petition was entitled "37 CFR 1.183 Petition Not to Enter Improper Attorney Argument in Patentee's October 12, 2006 Submission."

States Patent and Trademark Office of the Document Entitled "Reply-A" to Which the Third Party Requester Refers To As "The 1/18/06 Response As Filed" (the March 11, 2008 requester request for reconsideration). The March 11, 2008 requester request for reconsideration is accompanied by a signed statement under 37 CFR 1.8(b) entitled "Declaration of Barry Schindler".

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

(b) RESPONSE. —

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner 's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner 's response.

37 CFR 1.8(b) provides, in pertinent part:

(a) . . . [C]orrespondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed . . . prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;

*
*

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit . . . The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed . . . on or before the date indicated.

*
*

(b) In the event that correspondence is considered timely filed by being mailed . . . in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing. . . of the correspondence, . . . or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing. . .of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed . . . correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing . . .

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 503 provides, in pertinent part (emphasis added):

If a receipt for any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item . . .

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. **A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.**

The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted.

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application . . . or missing portions (e.g., pages . . .) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

MPEP 505 provides, in pertinent part:

The United States Patent and Trademark Office (Office) stamps papers . . . with the date of their receipt in the Office. The stamp is referred to as the "Office Date" stamp.

MPEP 512 IV provides, in pertinent part (emphasis added):

37 CFR 1.8(b) permits a party to notify the Office of a previous mailing, or transmitting, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and **a statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or**

transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission. Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence.

DECISION

In the present March 18, 2008 request for reconsideration, the requester requests reconsideration of the February 11, 2008 decision dismissing requester's November 13, 2007 request for reconsideration, which requested that the Office to consider the document, designated by the requester as the "1.18.06 Response," as being timely filed pursuant to 37 CFR 1.8(b).[3] The February 11, 2008 decision dismissed the November 13, 2007 request for reconsideration due to the failure to submit a proper statement under 37 CFR 1.8(b)(3), specifically, due to the failure to submit a statement which ***attests on a personal knowledge*** basis to the timely mailing of the correspondence, as required by 37 CFR 1.8(b)(3).[4]

The March 11, 2008 requester request for reconsideration is accompanied by a signed statement under 37 CFR 1.8(b) entitled "Declaration of Barry Schindler". The statement signed by Barry Schindler is not a declaration under 37 CFR 1.68, due to the failure to include the warning pursuant to 18 U.S.C. 1001 and the statements required by 37 CFR 1.68.[5] A statement pursuant to 37 CFR 1.8(b), however, is not required to be a declaration under 37 CFR 1.68, and the document entitled "Declaration of Barry Schindler," filed on March 11, 2008, is taken as a statement pursuant to 37 CFR 1.8(b)(3).

In the March 11, 2008 statement under 37 CFR 1.8(b)(3) of Barry Schindler, Mr. Schindler attests on a firsthand, personal knowledge basis that the documents entitled "Reply-A" and associated Exhibits 1-8[6] were deposited with the United States Postal Service as first-class mail and were addressed to the Office on January 18, 2006, and is in accordance with the provisions of 37 CFR 1.8(b).

The remaining requirements of 37 CFR 1.8 have been met, as stated in the February 11, 2008 decision.

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[3] Pursuant to 35 U.S.C. 314(b) and 37 CFR 1.947, the third party requester may once file written comments within a period of 30 days from the date of service of patent owner's response. In this instance, patent owner's December 23, 2005 response (certificate of mailing, December 19, 2005) to the October 18, 2005 Office action was served on the third party requester on December 19, 2005. The third party requester, therefore, was required by statute to file comments by no later than January 19, 2006. Statutory requirements cannot be waived by the Office. Office records fail to reveal that the Office received any correspondence from the third party requester in this reexamination proceeding during the month of January 2006.

[4] See pages 6, 7, and 9 of the February 11, 2008 decision.

[5] 37 CFR 1.68 provides, in pertinent part:

> "Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true."

[6] The copies of which were submitted with the November 13, 2007 request for reconsideration.

For the reasons given above, the March 11, 2008 request for reconsideration is **granted**. The copies of the document entitled "Reply-A", and accompanying Exhibits 1-8, which accompanied the November 13, 2007 request for reconsideration, will be entered into the file and will be considered.

CONCLUSION

1. The March 11, 2008 request for reconsideration, entitled "Third Party Requester's Request for Reconsideration of the of 2/11/08 Decision Relating to Timely Receipt by the United States Patent and Trademark Office of the Document Entitled "Reply-A" to Which the Third Party Requester Refers To As "The 1/18/06 Response As Filed" (the March 11, 2008 requester request for reconsideration) is **granted**.

2. The copies of the document entitled "Reply-A", and accompanying Exhibits 1-8, which accompanied the November 13, 2007 request for reconsideration, will be entered into the file and will be considered when the examiner takes up the case for action.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit.

Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

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

cn

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(For Requester)

In re Chang et al.
Reissue Application No. 12/004,076
Filed: December 18, 2007
For: U.S. Patent No. 6,680,306

In re Chang et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

DECISION *SUA SPONTE* MERGING REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDING, *SUA SPONTE* WAIVING RULES, AND GRANTING PETITION UNDER 37 CFR 1.183

Reissue application number 12/004,076 and *inter partes* reexamination control number 95/000,074 are before the Office of Patent Legal Administration for *sua sponte* consideration of action to be taken under 37 CFR 1.991 at this time.

This is also a decision on the patent owner's December 18, 2007 petition under 37 CFR 1.183, in reissue application number 12/004,076, to waive the requirement of 37 CFR 1.98(a)(2) that copies of foreign patent documents and non-patent references be provided with an information disclosure statement (the December 18, 2007 patent owner petition). The December 18, 2007 patent owner petition is also before the Office of Patent Legal Administration.

SUMMARY

Reissue application number 12/004,076 and *inter partes* reexamination control number 95/000,074 are **merged** into a single proceeding.

The December 18, 2007 petition under 1.183, in reissue application number 12/004,076, to waive the requirement of 37 CFR 1.98(a)(2) that copies of foreign patent documents and non-patent references be provided with an information disclosure statement, is **granted**.

BACKGROUND

- On January 20, 2004, U.S. Patent No. 6,680,306 (the '306 patent) issued to Dr. Yan Chang and Dr. Vodek Sasak.

- On January 31, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,074 (the '074 reexamination proceeding).

- On April 12, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed in the '074 reexamination proceeding.

- Prosecution in the '074 reexamination proceeding progressed to the point at which a second nonfinal action was mailed on October 18, 2005.

- A petition entitled "Third Party Requester's Request for Reconsideration of 10.18.07 Decision As To Establishment of Receipt by Office of Third Party Requester's 1.18.06 Submission," was received on November 13, 2007 (the November 13, 2007 requester petition).

- On December 18, 2007, the patent owner filed a reissue application based on the '306 patent, which was assigned application number 12/004,076 (the '076 reissue application).

- Concurrently with the filing of the '076 reissue application, original claims 1, 3, 7, 17 and 18 were amended, original claims 2, 4-6, 12-15, and 22-23 were cancelled, and new claims 24-37 were added.

- Also on December 18, 2007, the patent owner filed, in the '076 reissue application, the instant petition under 37 CFR 1.183 to waive the requirement under 37 CFR 1.98(a)(2) that copies of foreign patent documents and non-patent references be provided with an information disclosure statement (the December 18, 2007 patent owner petition).

- On February 11, 2008, a decision dismissing the November 13, 2007 requester petition was mailed in the '074 reexamination proceeding.

- On March 11, 2008, the requester filed a petition in the '074 reexamination proceeding entitled "Third Party Requester's Request for Reconsideration of 2/11/08 Decision Relating to Timely Receipt by the United States Patent and Trademark Office of the Document Entitled "Reply-A" to Which the Third Party Requester Refers to as 'The 1/18/06 Response As Filed'" (the March 11, 2008 requester petition).

- On March 30, 2008, the patent owner filed a request for corrected filing receipt in the '076 reissue application.

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[1] The request for *inter partes* reexamination was filed by Pro-Pharmaceuticals, Inc., the real party in interest.

- On April 1, 2008, the Office mailed a corrected filing receipt in the '076 reissue application.
- On May 12, 2008, a decision granting the March 11, 2008 requester petition was mailed.
- No Office action has been mailed in the '076 reissue application.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 251 provides, in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. 314(a) and (c) provide:

(a) IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. 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.

(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.

37 CFR 1.171 provides:

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 CFR 1.176(a) provides:

A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue

applications. Applications for reissue will be acted on by the examiner in advance of other applications.

37 CFR 1.906(b) provides:

Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

37 CFR 1.937 provides, in pertinent 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 Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.987 provides:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

37 CFR 1.991 provides:

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. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, 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. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

MPEP 1412.04 II provides, in pertinent part (emphasis added):

Where the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, a reissue application is the appropriate vehicle to correct inventorship . . . Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995). See 35 U.S.C. 251, third paragraph. Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee of the entire interest signs the reissue oath/declaration. Accordingly, an assignee of the entire interest can add or delete the name of an inventor by reissue (e.g., correct inventorship from inventor A to inventors A and B) without the original inventor's consent. See also 37 CFR 3.71(a) ("One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.") . . . Thus, the assignee of the entire interest can file a

reissue to change the inventorship to one which the assignee believes to be correct, even though an inventor might disagree. The protection of the assignee's property rights in the application and patent are statutorily based in 35 U.S.C. 118.

MPEP 1481.02 provides, in pertinent part:

The petition to correct inventorship under 37 CFR 1.324 must include the statements and fee required by 37 CFR 1.324(b) . . . The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C. 256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48 . . . Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted . . . This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived.

MPEP 2686.03 provides, in pertinent part:

The general policy of the Office is that the examination of a reissue application and an *inter partes* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both the reissue and the reexamination to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two files on behalf of the patent owner. Accordingly, if both a reissue application and a reexamination proceeding are pending concurrently on a patent, a decision will normally be made to merge the reissue application examination and the reexamination or to stay one of the two. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985). The decision as to whether the reissue application examination and the reexamination proceeding are to be merged, or which of the two (if any) is to be stayed, is made in the Office of Patent Legal Administration (OPLA) . . .

The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, will be made on a *case-by-case* basis. Where issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination third party requester, merger would ordinarily **not** be ordered, and one of the two proceedings stayed. A decision to stay the reexamination proceeding will **only** be issued in exceptional instances because of the statutory requirements that examination proceed with "special dispatch." Where there is "good cause" to stay the reexamination proceeding, the Director may do so pursuant to 35 U.S.C. 314(c). The status of the reissue application and the reexamination proceeding will also be taken into account in the decision as to whether merger will be ordered. (Emphasis by underlining added.)

I. DISCUSSION REGARDING MERGER

As evidenced by the above review of the facts, the '074 reexamination proceeding and the '076 reissue application are currently pending. The '074 *inter partes* reexamination proceeding is at a quasi-advanced stage of the prosecution. No action has been taken in the '076 reissue application, which was filed on December 18, 2007. Since reexamination has been ordered pursuant to 37 CFR 1.931 in the '074 *inter partes* reexamination proceeding, a decision under 37 CFR 1.991 is timely as to whether the '074 *inter partes* reexamination proceeding and the '076 reissue application should be merged.

It is the general policy of the Office that the examination of a reissue application and a concurrently pending *inter partes* reexamination proceeding 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.[2] 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. The decision to merge would be on a case-by-case basis.

The Office has previously considered the issue of whether to merge an *inter partes* reexamination proceeding with a copending reissue application for the same patent, in a situation where the reissue application was a broadening reissue application. See *In re Allan*, 71 USPQ2d 1751 (2004), a reported, but unpublished, decision that is designated as nonprecedential. In that decision, the Office declined to merge a broadening reissue application with a copending *inter partes* reexamination proceeding, and reversed its prior decision to merge (which is available in the Image File Wrapper of the reissue application 10/430,713 as paper PETDEC dated December 22, 2003).

In the *Allan* fact situation, the *inter partes* reexamination proceeding was the first-filed proceeding. The patent owner subsequently filed the reissue application, in order to preserve the right to broaden the patent claims within two years of the issue date of the patent, as provided by 35 U.S.C. § 251. The patent owner then filed a petition requesting that the copending reissue application and the *inter partes* reexamination not be merged, and that the *inter partes* reexamination proceeding be suspended pending completion of the reissue application. Alternatively, the patent owner requested that the reissue application be suspending pending completion of the *inter partes* reexamination proceeding.

It was explained in the *Allan* petition decision of December 22, 2003 that the effect of granting the relief initially requested by the patent owner, i.e., the suspension of the *inter partes* reexamination proceeding, would have potentially precluded the reexamination requester from obtaining a final resolution in the earlier-filed *inter partes* reexamination proceeding, because the patent owner could have theoretically filed a string of continuation applications based on the reissue application. The *inter partes* reexamination proceeding would remain suspended while each continuation was subsequently prosecuted. Further, the Office found that there was no good cause, as required by 35 U.S.C. 314(c), for suspending the *inter partes* reexamination proceeding, because the alternative options of suspending the reissue application and for merging the copending *inter partes* reexamination proceeding and the reissue application were both available. The Office decided, in the *Allan* December 22, 2003 decision, that it was appropriate to merge the copending reissue application and the *inter partes* reexamination proceeding, because the suspension of the reissue application would unduly delay the ability of the patent owner to obtain broader claims, and could lead to the possibility that the third party requester would have to file an additional reexamination proceeding with respect to any broader claims that were obtained. In addition, Office practice was (and is) to treat reissue applications as special, and suspension of the reissue application would have run counter to that policy.

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[2] In this instance, if the examination of the reissue and reexamination proceedings were conducted separately, the patent owner could place all of its responsive comments in the reissue application and not in the reexamination proceeding. The third party requester would thus be barred from responding in this *inter partes* reexamination proceeding to the argument presented in the reissue application, 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 intent of the *inter partes* reexamination statute to maintain a level playing field between the patent owner and the third party requester.

In the *Allan* decision reported at 71 USPQ2d 1751 (2004), the Office addressed the patent owner's request for reconsideration. The Office held that the December 22, 2003 decision to merge the proceedings was made in error. As pointed out by the patent owner petitioner in *Allan*, the December 23, 2003 merger decision provided that the "third party requester would have the right to reply to any rejections and any reasons for patentability with regard to the newly added broadened claims, since, in a merged case, they are added to both the reissue application and the reexamination proceeding."[3] This would have erroneously permitted the *inter partes* reexamination requester to comment, in the merged proceeding, on the propriety of the broadening in the broadened claims present in the reissue application, and to fully participate in the appeal process with respect to the broadened claims. Such a procedure would run counter to the *ex parte* nature of a reissue application as mandated by 35 U.S.C. § 251. Accordingly, the reported *Allan* decision reversed the December 22, 2003 merger decision. Based on the specific facts and circumstances of that case, the reissue application was suspended.

The suspension of the reissue application was the appropriate remedy in *Allan*, because the reissue application was filed after the reexamination request,[4] the patent owner had requested suspension of the reissue as one of the alternative methods of relief,[5] and the patent owner's stated objective, to preserve the right to broaden the patent claims within two years of the issue date of the patent[6] (as provided by 35 U.S.C. § 251), was achieved. The facts of the instant case are similar to those in *Allan* to the extent that the '076 reissue application was filed nearly two years after the filing of the request in the '074 *inter partes* reexamination proceeding.[7] Two nonfinal Office actions have been mailed in the '074 inter partes reexamination proceeding, and six petitions have been filed, to which the Office has responded by mailing four separate decisions. Because the '074 *inter partes* reexamination proceeding is at such an advanced stage of prosecution, the '076 reissue application could be suspended until the '074 *inter partes* reexamination proceeding has been concluded, as in the *Allan* decision.[8]

The circumstances of the instant case, however, are extraordinary. The patent owner's stated objective is to correct the inventorship of the '306 patent,[9] not to preserve the right to broaden the claims of the '306 patent, as in the *Allan* decision. **The patent owner, in fact, is prohibited under 35 U.S.C. § 251 from broadening the claims of the '306 patent, because the '076 reissue application was not filed within two years of the grant of the '306 patent.**[10] Both the

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[3] 71 USPQ2d at 1753.
[4] In *Allan*, the *inter partes* reexamination proceeding was filed four months prior to the filing of the reissue application, and had received an Office action on the merits of patentability.
[5] 71 USPQ2d at 1754.
[6] *Id.*
[7] The request for reexamination in the '074 *inter partes* reexamination proceeding was filed on January 31, 2005, nearly two years after the December 18, 2007 filing of the '076 reissue application.
[8] The '076 reissue application would normally be suspended even though the patent owner has not requested suspension of the '076 reissue application, contrary to the facts of *Allan*.
[9] See the reissue declaration filed on December 18, 2007; see also the third sentence on page 1 of the petition under 37 CFR 1.183, also filed on December 18, 2007, in the '076 reissue application.
[10] 35 U.S.C. § 251 provides, in pertinent part: "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." The '076 reissue application was filed on December 18, 2007, nearly three years after the grant of the '306 patent on January 20, 2004.

patent owner and the third party requester have agreed on the record that the inventorship of the '306 patent is incorrect, i.e., that Dr. David Platt, who is the president of third party requester Pro-Pharmaceuticals, Inc. (the real party in interest), should be named as an inventor of the '306 patent.[11] Inventorship of a patent may be corrected by filing a request to correct inventorship pursuant to 37 CFR 1.324. In the instant case, however, the patent owner has been unable to correct the inventorship of the '306 patent in this manner, because the patent owner has been unable to obtain Dr. Platt's signature on the statement required by 37 CFR 1.324(b)(1) that the error in inventorship occurred without any deception on his part.

Until a reissue application has been filed to correct the inventorship of the '306 patent, the patent owner cannot establish ownership of the entire interest in the '306 patent, because the patent owner cannot establish a chain of title from the original inventor(s) (including Dr. Platt), who are the original owner(s) of the '306 patent. In other words, until Dr. Platt is named as an inventor, Dr. Platt cannot assign rights to the '306 patent that have not yet been established for him. This impacts on the patent owner's participation in the prosecution of the '074 *inter partes* reexamination proceeding. In this instance, prosecution in the '074 *inter partes* reexamination proceeding cannot proceed appropriately until a reissue application to correct the inventorship of the '306 patent is addressed.

A reissue application is the appropriate vehicle to correct inventorship where, as here, the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply. See MPEP 1412.04 II. The failure to name the correct inventive entity is an error in the patent which is correctable under 35 U.S.C. § 251. As pointed out above, in the instant case the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, because the patent owner has been unable to obtain the signature of Dr. David Platt on a statement required by 37 CFR 1.324(b)(1) as discussed above.[12]

The '076 reissue application has been properly filed by the assignee of the entire interest of the '306 patent as issued [13] pursuant to 35 U.S.C. § 251,[14] because the patent owner does not seek to enlarge the scope of the claims of the original '306 patent. An assignment from Dr. Platt has also been recorded.[15] For these reasons, (a) the patent owner has established ownership in the entire interest of the '306 patent, (b) the signatures of the inventors are not needed on the declaration by the assignee of the '076 reissue application, and (c) the patent owner can add or delete the name of an inventor by reissue without the original inventor's consent. The protection

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[11] See pages 14-17 of the October 18, 2007 decision in the '074 *inter partes* reexamination proceeding.
[12] See particularly the last full paragraph of page 16 of the October 18, 2007 decision in the '074 *inter partes* reexamination proceeding.
[13] See the reissue declaration by the assignee, the consent of the assignee, and the statement under 37 CFR 3.73(b) (including the supplemental sheet), all filed on December 18, 2007 in the '076 reissue application.
[14] 35 U.S.C. § 251 provides, in pertinent part: "The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent."
[15] Again see the December 18, 2007 statement under 37 CFR 3.73(b), including the supplemental sheet, filed in the '076 reissue application. The Office does not settle assignment disputes. If there is a conflict regarding the ownership of the patent, the remedy of the parties must be with the courts.

of the assignee's property rights in the patent are statutorily based in 35 U.S.C. § 118.[16] Again see MPEP 1412.04 II.

As pointed out above, prosecution in the '074 *inter partes* reexamination proceeding cannot go forward appropriately until the reissue application to correct the inventorship of the '306 patent has been addressed. Suspension of the '074 *inter partes* reexamination proceeding until inventorship is corrected by the issuance of the reissue patent would not be in accordance with the statutory mandate for special dispatch, particularly due to the advanced stage of prosecution in the '074 *inter partes* reexamination proceeding. In addition, as in the *Allan* fact situation discussed *supra*, the suspension of the *inter partes* reexamination proceeding may unduly delay the reexamination requester from obtaining a final resolution in the earlier-filed *inter partes* reexamination proceeding, based on patent owner activity in the reissue application. because the patent owner can theoretically file a string of continuation applications based on the reissue application. The *inter partes* reexamination proceeding would remain suspended while each continuation was subsequently prosecuted. **Accordingly, given the extraordinary facts and circumstances of this case, merger of the '074 *inter partes* reexamination proceeding and the '076 reissue application is deemed to be not only appropriate but desirable to further the call for special dispatch set forth in 35 U.S.C. 314(c).**

II. DECISION MERGING THE '074 *INTER PARTES* REEXAMINATION PROCEEDING AND THE '076 REISSUE APPLICATION

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the '074 *inter partes* reexamination proceeding and the '076 reissue application **are merged**. A joint examination of both proceedings will be conducted in accordance with the guidelines and requirements that follow.

B. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the *inter partes* reexamination proceeding and in the reissue application, for purposes of the merged proceeding. In accordance with 37 CFR 1.991, the maintenance of identical amendments in both files is required as long as the proceedings remain merged.

2. Presently, the claims in the '074 *inter partes* reexamination proceeding are the not the same as the claims in the '076 reissue application. Specifically, in the '074 *inter partes* reexamination proceeding, claim 9 is dependent upon claim 7; while in the '076 reissue application; claim 9 is dependent upon claim 8. In addition, the reissue application omits new claims 24-44, which have been added (of which claims 25, 33, 34, and 41-44 have been cancelled) in the '074 *inter partes* reexamination proceeding. The recitations of claims 24-37 in the '076 reissue application

[16] See also 37 CFR 3.71(a), which states (emphasis added): "One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding **to the exclusion of** either **the inventive entity**, or the assignee(s) previously entitled to conduct prosecution."

are identical to the recitations of claims 24, 26-32, and 35-40 of the '074 *inter partes* reexamination proceeding, however, the claim numbers are not identical. Furthermore, the October 18, 2007 decision in the '074 *inter partes* reexamination proceeding erroneously stated that the patent owner's October 12, 2006 amendment in the '074 *inter partes* reexamination proceeding was proper. However, while the patent owner's October 12, 2006 amendment was entered, the patent owner's October 12, 2006 amendment is still defective because the amendment fails to satisfy 37 CFR 1.941 and 37 CFR 1.530. Pursuant to 37 CFR 1.530(f), any changes should have been made relative to the patent under reexamination. Now that the '074 *inter partes* reexamination proceeding and the '076 reissue application will be merged upon the mailing of this decision, all changes must be made relative to the patent pursuant to 37 CFR 1.173(d), which governs reissues, as will be discussed in detail below. In the instant case, the language "in inhibiting growth of a tumor" in line 2 of claim 1, the language "and comprises a polymeric backbone having side chains" in line 6 of claim 1, and the number 7 in line 1 of claim 9, should be underlined in the '074 *inter partes* reexamination proceeding, and the number 8 should be bracketed in line 1 of claim 9 in the '074 *inter partes* reexamination proceeding. Furthermore, the preliminary amendment filed on December 18, 2007 in the '076 reissue application fails to cause the claims, including the claim numbers, in the '076 reissue application to be identical with the claims of the '074 *inter partes* reexamination proceeding. **Accordingly, housekeeping amendments to cause the claims in each file**, i.e., in *inter partes* reexamination proceeding control number 95/000,074 and in reissue application number 12/004,076, **to be identical, are required within ONE (1) MONTH or thirty days of this decision, whichever is later.** The following housekeeping amendments will achieve this result: [17]

- **Housekeeping Amendment No. 1:** file an amendment as a single paper, in duplicate, to be placed in each file, adding new claims 38-44 to the '076 reissue application.[18] This amendment must comply with 37 CFR 1.173, as discussed in detail below.

- **Housekeeping Amendment No. 2:** file an amendment, **on the same day as housekeeping amendment no. 1**, as a second, separate paper, in duplicate, to be placed in each file, that causes original patent claims 1-23 in the '076 reissue application to be identical to original patent claims 1-23 in the '074 *inter partes* reexamination proceeding[19] (i.e., by causing the dependency of original claim 9 in the '076 reissue application to be identical to the current dependency of original claim 9 in the '074 *inter part*es reexamination proceeding, and by correcting the above-described missing underlining and bracketing in the '074 *inter partes*

[17] This bifurcated housekeeping amendment procedure is necessary to avoid confusion at the publication and printing stage of the prosecution.

[18] These claims are to be immediately cancelled by Housekeeping Amendment No. 2 (see above). The addition of new claims 38-44 in the '076 reissue application, and their immediate cancellation, is to cause the addition of new claims by Housekeeping Amendment No. 2 to begin with claim number 45 in both the '076 reissue application and the '074 *inter partes* reexamination proceeding.

[19] Original patent claims 2, 4-6, 12-15, 22, and 23 have been previously cancelled in both the '074 *inter partes* reexamination proceeding and in the '076 reissue application. Neither housekeeping amendment may alter the cancellation, or the claim numbering, of these original patent claims. For that matter, neither housekeeping amendment may alter the cancellation, or claim numbering, of claims 25, 33, 34, and 41-44 in the '074 *inter partes* reexamination proceeding.

reexamination proceeding). Housekeeping Amendment No. 2 must also cancel new claims 24-44 in the '076 reissue application and new claims 24, 26-32, and 35-40 in the '074 *inter partes* reexamination proceeding, and must add, **to both files,** new claims 45-58 that must be identical to new claims 24, 26-32, and 35-40 which were previously entered in the '074 *inter partes* reexamination proceeding. This amendment must comply with 37 CFR 1.173 (see below).

Any response to this requirement must be **strictly limited** to placing the same amendment in each file **so that the specification, claims, and drawings are identical in both cases**. The patent owner must **NOT** address in the housekeeping amendments any issues otherwise present in either of the proceedings. The housekeeping amendments should be submitted as a single paper that includes the identifying data for both files (i.e., the reissue application number and the *inter partes* reexamination proceeding control number) and a signature. The housekeeping amendments must be filed in duplicate for entry into each of the reissue application file and the *inter partes* reexamination file. The housekeeping amendments must comply with the provisions of 37 CFR 1.173 (the rule governing amendments filed in reissue applications.)[20] The patent owner is reminded that **any changes must be made relative to the patent pursuant to 37 CFR 1.173(d).** See MPEP 1453 for a complete discussion of amendment practice in reissue applications. 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 amendments are not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. § 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

4. **The submission of appropriate housekeeping amendments (i.e., limited to the bare presentation of claims) will not create a comment right for the third party requester.** The regulations governing the filing of written comments by the third party requester, 37 CFR 1.947 and 1.951(b), which are based on 35 U.S.C. § 314(b)(2), provide for the filing of requester comments **only** if the written comments are directed to a patent owner paper filed in response to "an Office action." A merger decision is not an Office action on the merits of patentability. If the patent owner files a response to an Office action, the third party requester will then have an opportunity to comment on the claims as amended by the housekeeping amendments, as to issues within the scope of reexamination, because the *inter partes* reexamination regulations provide for the third party requester to file such comments whenever a patent owner files a response to an Office action. If the patent owner does not file any response to an Office action, and at least one claim added or amended by the housekeeping amendments has been indicated as patentable, the third party requester may appeal the issues that the examiner decided in favor of the patent owner.

Any comments filed by the third party requester in direct response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper

[20] Note that a "clean copy" of the amendment is not required by 37 CFR 1.173, and is not to be provided.

submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. The merged examination will be conducted on the basis of the rules relating to the reissue application examination, *to the extent that it is permissible and practical to do so*. Accordingly, the examiner will apply the reissue statute, rules, and case law to the examination of the merged proceeding, *except* as directed in this decision. In addition, the third party requester in the '074 *inter partes* reexamination proceeding may participate in the merged proceeding to the extent provided for in paragraphs 14 and 15 below.

2. Each Office action issued by the examiner will take the form of a single action which jointly applies to the '074 *inter partes* reexamination proceeding and the '076 reissue application. Each action will contain identifying data for both of the proceedings, i.e., the '074 *inter partes* reexamination proceeding and the '076 reissue application. Each action will be entered into the Image File Wrapper (IFW) for each file. The IFW for each file will be maintained as separate files.

3. Any paper filed by the reissue applicant/patent owner, or by the third party requester, *must* consist of a **single** paper, **with a copy being filed for entry into *each* of the IFW files**, with ***each*** of the copies bearing a signature, and ***each*** copy containing identifying data for both of the proceedings (i.e., the *inter partes* reexamination proceeding control number and the reissue application number.)

4. **All amendments** which are submitted during the prosecution of the merged proceeding **must be submitted in accordance with the practice under 37 CFR 1.173 governing reissue applications.** See MPEP 1453 for a complete discussion of amendment practice in a reissue application. **37 CFR 1.121 does NOT apply to amendments in a reissue application**. See 37 CFR 1.121(i). 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 cancelled 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 the 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.**

5. There will be **no** interviews in the merged proceeding, as the rules provide that *inter partes* reexamination will be conducted solely on the written record.[21]

[21] 37 CFR 1.955 prohibits interviews in *inter partes* reexamination in order to establish and maintain a level playing field between the patent owner and the requester. This will be implemented in the merged proceeding by not permitting interviews, which is the intent of the *inter partes* reexamination statute. The right to an interview in a reissue application is **not** a statutory right. In this instance, carrying out the legislative intent is of paramount

6. If the reissue application ultimately matures into a reissue patent, the *inter partes* reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the *inter partes* reexamination certificate under 37 CFR 1.997. See 37 CFR 1.991 and 1.997(e).

7. If the reissue applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. Thereafter, with respect to the '074 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (i.e., 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, but will be limited to the claims found patentable at the time of the failure to timely and appropriately respond, and to any claims added thereafter which do no expand the scope of the claims which were found patentable at that time. See 37 CFR 1.957(c). Prosecution will continue in the reexamination proceeding until the appeal rights of all parties have been exhausted.

8. If the reissue applicant/patent owner files an express abandonment of the '076 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 '074 *inter partes* reexamination proceeding.

9. Where the merged proceeding is dissolved based on the abandonment of the reissue application, and the '074 *inter partes* reexamination proceeding continues, any grounds of rejection which are not applicable under reexamination practice (e.g., a rejection based on public use or sale) would be withdrawn, and any new grounds of rejection which are applicable under *inter partes* reexamination practice would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions or 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 practice pursuant to 37 CFR 1.906(c).

10. If the merged proceeding is dissolved based on the abandonment of the '076 reissue application and the '074 *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application of the '076 reissue application will be merged with the '074 *inter partes* reexamination proceeding. Any continuation reissue application may be stayed pending conclusion of the '074 *inter partes* reexamination proceeding.

11. If the reissue applicant/patent owner files a Request for Continued Reexamination (RCE) of the reissue application under 37 CFR 1.114, the reissue application will not be considered to have been expressly abandoned. Rather, the finality of the Office action would be withdrawn,

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importance. A petition under 37 CFR 1.183 may be submitted to request an interview in the rare circumstance that an interview is deemed to be indispensable.

and the merged proceeding could continue, because an RCE is not an abandonment of any application, whether it is a reissue or a non-reissue application. In the event, however, that the reissue applicant/patent owner files a Request for Continued Reexamination (RCE) of the reissue application under 37 CFR 1.114, the merger may be severed, and the reissue application stayed pending conclusion of the '074 *inter partes* reexamination proceeding.

12. Clerical processing for the merged reissue/*inter partes* reexamination proceeding, 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 proceeding.

13. Prior to issuing an Office action in the merged proceeding, the examiner in the merged proceeding will consult with the legal advisor of the Office of Patent Legal Administration (OPLA) who is assigned to the '074 *inter partes* reexamination proceeding, in the same manner as he or she would consult with the OPLA legal advisor in an *inter partes* reexamination proceeding that is not merged.

14. Scope of the Third Party Requester's Participation in the Merits of the Merged Proceeding

37 CFR 1.991 provides that "In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, except that such participation shall be limited to issues within the scope of *inter partes* reexamination." 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. However, third party requester participation in the merged proceeding must be *strictly limited* to issues within the scope of *inter partes* reexamination. Thus, **as to all issues appropriate for reissue, but not appropriate for reexamination**, the third party requester is precluded from (a) providing comments after patent owner responses pursuant to the *inter partes* reexamination rules, (b) appealing, and (c) participating in a patent owner appeal.[22] **Examples** of such issues that the third party requester is precluded from addressing are:

a) The acceptability of any reissue declaration;

b) Assignee assent;

c) The recapture doctrine; and

d) In the present instance, the propriety of the addition and/or deletion of the named inventors of the '306 patent. As pointed out above, because the patent owner was unable to obtain the signature of Dr. Platt on the statement required by 37 CFR 1.324(b)(1), correction of the inventorship in the '074 *inter partes* reexamination

[22] This does not, in any way, preclude the third party requester from participating in the reissue aspect of this merged proceeding in the capacity of a 37 CFR 1.291 protester. More particularly, the third party requester is not precluded from protesting (where appropriate) under 37 CFR 1.291 pursuant to the guidelines set forth in MPEP Chapter 1900, with respect to the reissue application that is merged within the present merged proceeding. Thus, the third party requester's rights have been retained as to both individual proceedings, while permitting concurrent reexamination that does not contravene the reexamination and reissue statutes.

proceeding is not possible. The issue of the propriety of the correction of the inventorship of the'306 patent can only be addressed by reissue. For this reason, the issue of correction of the inventorship of the '306 patent is specific to the '076 reissue application, and the third party requester is precluded from arguing in the merged proceeding that the addition or the deletion of an inventor by the assignee of the entire interest[23] is impermissible, or that the inventor(s) named by the assignee of the entire interest did or did not invent the claimed subject matter. The *inter partes* reexamination statute does not provide authority for a third party requester to comment on the propriety of the addition and/or deletion of the named inventors of a patent in any *inter partes* reexamination proceeding.

The third party requester is **not** precluded from arguing that the presentation of any broadened patent claims in the merged proceeding is impermissible under 35 U.S.C. § 314(a), because in the instant case, claim broadening is not permitted by 35 U.S.C. § 251 (because the '076 reissue application was filed by the assignee, and was not filed within two years of the grant of the '306 patent), and thus, the reissue-nature of the merger will not separately accommodate (permit) broadening.

The third party requester's comments in all pre-appeal and appeal papers must be limited to matters appropriate to *inter partes* reexamination.[24] Comments by the third party requester on such issues, and those on any other patentability or procedural issue that is *solely* authorized for reissue application practice and procedure, will result in a holding that the paper containing such comments is an improper paper that will not be entered into the record.[25] Any such improper paper would be returned to the third party requester as an improper submission under 37 CFR 1.939, or expunged, if the paper is entered prior to the discovery of the defect.

15. Procedural Participation in the Merged Proceeding

a) The reissue applicant/patent owner and the third party requester must serve each other with all correspondence filed with the Office in the merged proceeding. Copies of all Office actions will be provided by the Office to the reissue applicant/patent owner and to the requester of the reexamination.

b) Prior to the issuance of any Notice of Allowability (form PTO-37), the procedure for issuing Office actions, the forms used for Office actions, and the procedure regarding any response by the reissue applicant/patent owner and any comments by the third party requester, will all be governed by the provisions of 37 CFR 1.943 through 37 CFR 1.953. Likewise, the appeal provisions of 37 CFR 41.60 through 41.81 will govern appeals by

[23] The present assignee has submitted a statement pursuant to 37 CFR 3.73(b) establishing a chain of title from the currently named inventors. The statement under 37 CFR 3.73(b) also includes an assignment from Dr. Platt. Should any assignment be in dispute, the parties are again advised that the Office does not settle assignment disputes. If there is a conflict regarding the ownership of the patent, the remedy of the parties must be with the courts.
[24] No appeal can be advanced by the third party requester with respect to issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed above.
[25] Thus, for example, where an issue of "public use" is raised in the merged proceeding due to the presence of the reissue application, the third party requester's responsive papers must not comment on that issue.

the patent owner and the third party requester to the Board of Patent Appeals and Interferences (Board), and to the Court of Appeals for the Federal Circuit. If the case is placed in condition for the issuance of a notice of allowability, form PTO-37 will be used to so advise the parties, and to inform the 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 above, the present *inter partes* reexamination proceeding would be concluded, if a notice of allowability is issued, by the grant of a reissue patent, and the reissue patent would serve as the reexamination certificate under 37 CFR 1.997.

c) Inherent in the procedures set forth in the immediately preceding paragraph is that the patent owner may not appeal to the Board, until a final Office action is issued, in the form of a right of appeal notice (final action) under 37 CFR 1.953. In order to preserve the appeal rights of the third party *inter partes* reexamination requester, the requester rights of appeal provisions of 37 CFR 41.60 through 37 CFR 41.81 will govern.

d) In view of the provisions of 37 CFR 1.953(c), any filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114, including a proper submission as required by 37 CFR 1.114, must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of the RCE and the submission required by 37 CFR 1.114 as a proper response to the final action, which, in the present merged proceeding, is taken as an equivalent to the right of appeal notice under 37 CFR 1.953.

III. WAIVER OF REGULATIONS

The present decision constitutes a 37 CFR 1.183 waiver, *sua sponte*, of any provision of the rules that would preclude the conduct of the merged proceedings in accordance with the guidelines set forth in this decision. For example, 37 CFR 1.991 states:

> "Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179 . . ."

And, 37 CFR 1.176(a) provides:

> "A reissue application will be examined in the same manner as a non-reissue, non-provisional application . . ."

The present decision (see above) directs that:

> ". . . the procedure for issuing Office actions, the forms used for actions, and the procedure regarding any response by the reissue applicant/patent owner and any comments by the third party requester, will be governed by the provisions of 37 CFR 1.943 through 37 CFR 1.953."

This clearly is not examination "in the same manner as a non-reissue, non-provisional application"; however, that provision must be waived in order to make the present merger feasible.

IV. THE DECEMBER 18, 2007 PATENT OWNER PETITION UNDER 37 CFR 1.183

The patent owner requests under 37 CFR 1.183 that the Office waive the requirement under 37 CFR 1.98(a)(2) that copies of foreign patent documents and non-patent references be provided with an information disclosure statement in the '076 reissue application. The patent owner argues that copies of all such documents have been provided in pending reexamination control number 95/000,074 (the '074 *inter partes* reexamination proceeding).

The present merger of the '076 reissue application and the '074 *inter partes* reexamination proceeding renders unnecessary the filing, in the'076 reissue application, of additional copies of the same documents present in the '074 inter partes reexamination proceeding.

Accordingly, the December 18, 2007 patent owner petition under 37 CFR 1.183 is **granted**.

A petition fee of $400 has been charged to deposit account no. 18-1945, as authorized by the patent owner on page 2 of the December 18, 2007 patent owner petition.

V. CONCLUSION

1. The '074 *inter partes* reexamination proceeding and the '076 reissue application **are merged** into a single consolidated proceeding.

2. The December 18, 2007 patent owner petition under 37 CFR 1.183 to waive the requirement under 37 CFR 1.98(a)(2) that copies of foreign patent documents and non-patent references be provided with an information disclosure statement in the '076 reissue application is **granted**.

3. A copy of this decision will be placed in the Image File Wrappers (IFWs) of the '074 *inter partes* reexamination proceeding and the '076 reissue application.

4. As pointed out above, the claims in the reissue application are **not** the same as the claims in the *inter partes* reexamination proceeding. **Therefore, the filing of housekeeping amendment(s) (to make the claims identical) is required as set forth above in this decision, within ONE (1) MONTH OR THIRTY DAYS, whichever is later, of the mail date of this decision, placing the same amendments in both cases.** The response to the requirement must be strictly limited to placing the same amendments in both cases (so that the specification, claims and drawings are identical in both cases.)

5. Jurisdiction over the '074 inter partes reexamination file and the '076 reissue application file will reside with the Central Reexamination Unit (CRU) to await the filing of housekeeping amendment(s) in accordance with section II(B) of this decision.

6. Once any housekeeping amendment is received, or the time for filing the housekeeping amendment(s) has expired, jurisdiction over the merged reissue and *inter partes* reexamination proceeding will be forwarded to the appropriate examiner for the preparation of an Office action in the merged proceeding. The examiner assigned to the merged proceeding will not be an examiner who was involved in any part of the examination of the '306 patent (e.g., by preparing and/or signing an Office action), pursuant to MPEP 2636. All further examination should be conducted in accordance with sections II(B) and II(C) of this decision.

7. Failure to submit appropriate housekeeping amendment(s), that place(s) the same amendment(s) in both files **within one month or thirty days, whichever is later, of the mail date of this decision** 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.

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

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

cn

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(For Patent Owner)

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(For Requester)

In re Chang et al.
Reissue Application No. 12/004,076
Filed: December 18, 2007
For: U.S. Patent No. 6,680,306

In re Chang et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

DECISION
VACATING AND EXPUNGING
EXAMINER CONSIDERED IDS

This decision **VACATES and EXPUNGES** the examiner correspondence in BOTH the 95/000,074 and 12/004,076 cases, dated August 12, 2008 in which the scanned in IDS (submitted by applicant: 9/12/08) copy improperly failed to indicate references crossed-through as not considered by the Examiner; specifically references BD, CL, CS, CU , CA1, CK2, CL3 and CT3.

Attached is a correct copy indicating references provided in applicant's 9/12/08 IDS and considered by the examiner, as well as the above- recited references which were not considered as indicated by cross-through lines.

CONCLUSION

- The examiner correspondence dated August 12, 2008 regarding examiner consideration of Applicant's 9/12/08 IDS is **VACATED and EXPUNGED** from the official record, and will not be available to the public, by closing the paper in the IFW database, and by marking it non-public.

- Attached is a correct IDS copy indicating Examiner consideration (and non-consideration) of references provided in Applicant's 9/12/08 submitted Information Disclosure Statement (IDS).

- Any inquiry concerning this communication should be directed to Bennett Celsa, Quality Assurance Specialist, at (571) 272-0807.

Bennett Celsa
Quality Assurance Specialist
Technology Center 1600

Best Available Copy
Best Available Copy

EFS-Web Receipt date: 12/18/2007

application no. 12004076 - GAU: 1623

control no. 95/000,074 12/004,076

Used in Lieu of PTO/SB/08A/B
(Based on PTO 10-07 version)

Substitute for form 1449/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet	1	of	7

Complete if Known	
Patent Number	Reissue of 6,680,306
Filing Date	Concurrently Herewith
First Named Inventor	Yan Chang
Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	104831-0002-401

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Document Number Number-Kind Code[2] (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	AA*	US-2002/0107222	08-08-2002	Platt	
	AB*	US-2003/0013681	01-16-2003	Chang et al.	
	AC*	US-2003/0064957	04-03-2003	Klyosov et al.	
	AD*	US-5,490,911	02-13-1996	Enriquez et al.	
	AE*	US-5,490,991	02-13-1996	Enriquez et al.	
	AF*	US-5,498,702	03-12-1996	Mitchell et al.	
	AG*	US-5,547,945	08-20-1996	Ye et al	
	AH*	US-5,639,737	06-17-1997	Rubin	
	AI*	US-5,681,923	10-28-1997	Platt	
	AJ*	US-5,831,052	11-03-1998	Hillman et al.	
	AK*	US-5,834,442	11-10-1998	Raz et al.	
	AL*	US-5,895,784	04-20-1999	Raz et al.	
	AM*	US-6,258,383	07-10-2001	Gohlke et al.	
	AN*	US-6,274,566	08-14-2001	Eliaz et al.	
	AO*	US-6,423,314-B2	07-23-2002	Platt	
	AP*	US-6,500,807 12-31-2002		Platt et al.	
	AQ*	US-6,642,205	11-04-2003	Klyosov et al.	
	AR*	US-6,645,946	11-11-2003	Klyosov et al.	
	AS*	US-6,680,306	01-16-2003	Chang et al.	
	AT*	US-6,875,451-A1	04-05-2005	Ellison et al.	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Foreign Patent Document Country Code[3]-Number[4]-Kind Code[5] (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T[6]
	BA	WO-97/34907	09-25-1997	Platt David		
	BB	WO-00/07624	02-17-2000	Teijin Ltd et al.		
	BC	WO-00/62076	10-19-2000	Hsu Daniel K et al.		
	~~BD~~	~~WO-000118~~	~~06-21-2002~~	~~Chang et al~~		
	BE	WO-02/057284	07-25-2002	Nilsson Ulf et al.		
	BF	WO-02/076474	10-03-2002	Pro Pharmaceuticals Inc		
	BG	WO-02/26262	04-04-2002	Pro Pharmaceuticals Inc		
	BH	EP-0 888 776 A1	01-07-1999	Takara Shuzo Co. Ltd.		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. [1] CITE NO.: Those application(s) which are marked with an single asterisk (*) next to the Cite No. are not supplied (under 37 CFR 1.98(a)(2)(iii)) because that application was filed after June 30, 2003 or is available in the IFW. [2] Applicant's unique citation designation number (optional). [3] See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. [4] Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). [5] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [6] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [6] Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No.[1]	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[2]
	CA	Aparicio, A. "In vitro cytoreductive effects on multiple myeloma cells induced by	

Examiner Signature	/Leigh Maier/	Date Considered	06/22/2008

10831285_1.DOC

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /LM/

Best Available Copy
Best Available Copy

EFS-Web Receipt date: 12/18/2007

application no. 12004076 - GAU: 1623
control no. 95/000,074

Used in Lieu of PTO/SB/08A/B
(Based on PTO 10-07 version)

Substitute for form 1449/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet	2	of	7

Complete If Known	
Patent Number	Reissue of 6,680,306
Filing Date	Concurrently Herewith
First Named Inventor	Yan Chang
Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	104831-0002-401

		bisphosphonates." Leukemia 12, 220-229 (1998).	
	CB	Bold, R.J. et al. "Chemosensitization of Pancreatic Cancer by Inhibition of the 26S Proteasome." J. Surg. Res. 100, 11-17 (2001).	
	CC	Brewer, C.F. "Binding and cross-linking properties of galectins. Biochim. Biophys." Acta 1572, 255-262 (2002).	
	CD	Burke, P.A. et al. "Combined Modality Radioimmunotherapy." Cancer 94, 1320-1331 (15 Feb. 2002).	
	CE	Camby, I. et al. "Galectins are differently expressed in supratentorial pilocytic astrocytomas, astrocytomas, anaplastic astrocytomas and glioblastomas, and significantly modulate tumor astrocyte migration." Brain Pathology 11, 12-26 (2001).	
	CF	Cherayil, B.J. et al. "Molecular cloning of a human macrophage lectin specific for galactose." PNAS 87, 7324-7328 (Sept. 1990).	
	CG	Choufani, G. et al. "The Levels of Expression of Galectin-1, Galectin-3, and the Thomsen-Friedenreich Antigen and Their Binding Sites Decrease as Clinical Aggressiveness Increases in Head and Neck Cancers. Cancer 86, 2353-2363 (1 Dec. 1999)."	
	CH	Cindolo, L. et al. "Galectin-1 and Galectin-3 Expression in Human Bladder Transitional-Cell Carcinomas." Int. J. Cancer 84, 39-43 (1999).	
	CI	Cooper, D.N.W. "Galectinomics: finding themes in complexity." Biochim Biophys Acta 1572, 209-231 (2002).	
	CJ	Cotter, British Journal of Haematology 111:52-60 (2000)	
	CK	Danguy, A. et al. "Galectins and cancer." Biochim. Biophys Acta 1572, 285-293 (2002).	
	CL	~~Definition of apoptosis and cytotoxicity, Wikipedia~~	
no date	CM	Del Bino, G. et al. "Altered Susceptibility of Differentiating HL-60 Cells to Apoptosis Induced by Antitumor Drugs." Leukemia 8, 281-288 (Feb. 1994).	
	CN	DiPaola, R.S. and Aisner, J. "Overcoming bcl-2- and p53-Mediated Resistance in Prostate Cancer." Seminars in Oncology 26, 112-116 (Feb. 1999).	
	CO	Eastman, A. and Rigas, J.R. "Modulation of Apoptosis Signaling Pathways and Cell Cycle Regulation." Seminars in Oncology 26, 7-16 (Oct. 1999).	
	CP	Fan, W. et al. "In vitro evaluation of combination chemotherapy against human tumor cells." Oncology Reports 5, 1035-1042 (1998).	
	CQ	Francois, C. et al. "Galectin-1 and Galectin-3 Binding Pattern Expression in Renal Cell Carcinomas." Am. J. Clin. Pathol. 112, 194-203 (1999).	
	CR	Frankel et al. "Synthetic glycoamine analogs synergies with taxol and cisplatin in inducing programmed cell depth in ovarian cancer cells." Proc Am Assoc Can Res (1997) 88th Ann Meeting, abstr. #627	
	CS	~~Franz, G. "Structure-Activity Relation of Polysaccharides with Antitumor Activity." Farm.~~ Tijdschr. Belg. 1987, 64(4), pages 301-311, (Eng.), see entire abstract. Chem Vol. 108, 1988 (Columbus, OH, USA) page 20, the abstract No. 31316n.	
	CT	Fujimoto et al., "Clinical Outcome of Postoperative Adjuvant Immunochemotherapy with Sizofiran for Patients with Resectable Gastric Cancer: a Randomised Controlled Study." Eur J Cancer (1991) 27(9), pp. 1114-1118	
	CU	~~CBC 500 GeloSolonos Clinical Data. R&D Focus Drug News, BRUGNL. an.1100 (2001)~~	
	CV	Glinsky et al., "Inhibition of colony formation in agarose of metastatic human breast carcinoma and melanoma cells by synthetic glycoamine analogs." Clin. Exp. Metastasis (1996) 14, pp. 253-267.	
	CW	Glinsky et al., "Inhibition of Human Breast Cancer Metastasis in Nude Mice by Synthetic Glycoamines." Cancer Research (1996) 56, pp. 5319-5324.	
	CX	Glinsky, G.V., "Anti-adhesion cancer therapy." Cancer and Metastasis Reviews (1998) 17, pp. 177-185.	

Examiner Signature	/Leigh Maier/	Date Considered	06/22/2008

10831285_1.DOC

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /LM/

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Sheet	3	of	7

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Filing Date	Concurrently Herewith
First Named Inventor	Yan Chang
Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	104831-0002-401

	CY	Grant, S. and Dent, P. "Rational integration of agents directed at novel therapeutic targets into combination chemotherapeutic regiments." Curr. Opin. Investigational Drugs 2, 1600-1605 (2001).	
	CZ	Green et al., "Adhesion-dependent multicellular drug resistance." Anti-Cancer Drug Design (1999) 14, pp. 153-168.	
	~~CA1~~	~~Gross, A. "The role of BCL-2 family members in apoptosis." Published by the Department of~~ Biological Regulation, Weizmann Institute of Science, Israel. no date	
	CB1	Guess et al., "Modified Citrus Pectin (MCP) Increases the Prostate-Specific Antigen Doubling Time in Men with Prostate Cancer: A Phase II Pilot Study," Prostate Cancer and Prostatic Diseases 6:301-304 (2003)	
	CC1	Hara, I. et al. "Sodium butyrate induces apoptosis in human renal cell carcinoma cells and synergistically enhances their sensitivity to anti-Fas-mediated cytotoxicity." Int. J. Oncol. 17, 1213-1218 (2000).	
	CD1	Hayashi et al., "Effects of Daily Oral Administration of Quercetin Chalcone and Modified Citrus Pectin on Implanted Colon-25 Tumor Growth in Balb-c Mice," Alternative Medicine Review 5(6):546-552 (2000)	
	CE1	Hernandez, J.D. and Baum, L.G. "Ah, sweet mystery of death! Galectins and control of cell fate." Glycobiology 12, 127R-136R (2002).	
	CF1	Hortobagyi, G.N. "Recent Progress in the Clinical Development of Docetaxel (Taxotere)." Seminars in Oncology 26, 32-36 (June 1999).	
	CG1	Hrdlickova, E. et al. "Detection of galectin-3 in tear fluid at disease states and immunohistochemical and lectin histochemical analysis in human corneal and conjunctival epithelium." Br. J. Ophthalmol. 85, 1336-1340 (2001).	
	CH1	Hua Chang Gon et al., "The NH2 Terminus of Galectin-3 Governs Cellular Compartmentalization and Functions in Cancer Cells," Cancer Research 59:6239-6245 (1999)	
	CI1	Huei-Min Lin et al., "Calectin-3 Mediates Genistein-Induced G2/M Arrest and Inhibits Apoptosis," Carcinogenesis 21(11):1941-1945 (2000)	
	CJ1	Hyeong-Reh Choi Kim et al., "Cell Cycle Arrest and Inhibition of Anoikis by Galectin-3 in Human Breast Epithelial Cells," Cancer Research 59:4148-4154 (1999)	
	CK1	Ida Iurisci et al., "Concentrations of Galectin-3 in the Sera of Normal Controls and Cancer Patients," Clinical Cancer Research 6:1389-1393 (2000)	
	CL1	Inohara, H. et al. "Expression of Galectin-3 in Fine-Needle Aspirates as a Diagnostic Marker Differentiating Benign from Malignant Thyroid Neoplasms." Cancer 85, 2475-2484 (1 June 1999).	
	CM1	Inohara, H. et al., "Effects of Natural Complex Carbohydrate (Citrus Pectin) on Murine Melanoma Cell Properties Related to Galectin-3 Functions," Glycoconjugate Journal 11:527-532 (1994)	
	CN1	Inufusa, H. et al. "Role of galectin-3 in adenocarcinoma liver metastasis." Int. J. Oncol. 19, 913-919 (2001).	
	CO1	Jensen-Jarolim, E. et al. "Anti-Galectin-3 IgG Autoantibodies in Patients with Crohn's Disease Characterized by Means of Phage Display Peptide Libraries." J. Clin. Immunol. 21(5), 348-356 (2001).	
	CP1	Johnson, K. R. et al. "Antagonistic Interplay between Antimitotic and G1-S Arresting Agents Observed in Experimental Combination Therapy." Clin. Cancer Res. 5, 2559-2565 (Sept. 1999).	
	CQ1	Juliao, S. et al. "Galectin-3: A Marker and Diagnostic Aid for Chordoma." Present at the 47th Annual Meeting, Orthopaedic Research Society, February 25-28, 2001, San Francisco, CA.	
	CR1	KARMANOS, Barbara Ann Cancer Institute. "Novel Therapeutic Targets & Therapies." www.karmanos.org/we/research/prostate/novel.html retrieved on 1/27/2003.	✓

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Patent Number	Reissue of 6,680,306
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First Named Inventor	Yan Chang
Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	104831-0002-401

	CS1	KILPATRICK, D. C. "Animal Lectins: a historical introduction and overview." Biochim. et Biophys. Acta 1572, 187-197 (2002).	
	CT1	KIM, R. et al. "A pitfall in the survival benefit of adjustment chemotherapy for node- and hormone receptor-positive patients with breast cancer: The paradoxical role of Bcl-2 oncoprotein (Review)." Int. J. Oncol. 19, 1075-1080 (2001).	
	CU1	Klasa, R. J. et al. "Eradication of Human Non-Hodgkin's Lymphoma in SCID Mice by BCL-2 Antisense Oligonucleotides Combine with Low-Does Cyclophosphamide." Clin. Cancer Res. 6, 2492-2500 (June 2000).	
	CV1	Leffler, H. et al. "Specificity of Binding of Three Soluble Rat Lung Lectins to Substituted and Unsubstituted Mammalian B-Galactosides." J. Biol. Chem. 261(22), 10119-10126 (5 Aug. 1986).	
	CW1	Lim, Y. et al. "Identification of autoantibodies associated with systemic lupus erythematosus. Biochem." Biophys. Res. Comm. 295, 119-124 (2002).	
	CX1	Linehan, W. M. "Inhibition of Prostate Cancer Metastasis: a Critical Challenge Ahead. J. Nat." Cancer Inst. 87(5), 331-332 (1 March 1995).	
	CY1	Liu et al., "Citrus Pectin: Characterization and Inhibitory Effect on Fibroblast Growth Factor - Receptor Interaction," J. Agric. Food Chem. 49:3051-3057 (2001)	
	CZ1	Liu, F.-T. et al. "Intracellular functions of galectins." Biochim et Biophys Acta 1572, 263-273 (2002).	
	CA2	Lopes de Menezes, D. E. et al. "Molecular and Pharmacokinetic Properties Associated with the Therapeutics of Bcl-2 Antisense Oligonucleotide G3139 Combined with Free and Liposomal Doxorubicin." Clin. Cancer Res. 6, 2891-2902 (July 2002).	
	CB2	Lotz, M. M. et al. "Decreased expression of Mac-2 (carbohydrate binding protein 35) and loss of its nuclear localization are associated with the neoplastic progression of colon carcinoma." PNAS 90, 3466-3470 (April 1993).	
	CC2	Majlessipour, F. "The Combination Regimen of Idarubicin and Taxotere is Effective Against Human Drug-resistent Leukemic Cell Lines." Anticancer Res. 22, 1361-1368 (2002).	
	CD2	Matarrese P., et al., (Abstract) "Galectin-3 Overexpression Protects from Apoptosis by Improving Cell Adhesion Properties," Int. Cancer 85(4):545-554 (2000)	
	CE2	Matarrese, P., et al. "Galectin-3 overexpression protects from cell damage and death by influencing mitochondrial homeostasis." FEBS Letters 473, 311-315 (2000).	
	CF2	Mey, A. et al. "Expression of the galactose binding protein Mac-2 by human melanoma cell-lines." Cancer Letters 81, 155-163 (1994).	
	CG2	Nachman Mazuret et al., "Phosphorylation of the B-Galactoside-binding Protein Galectin-3 Modulates Binding to its Ligands," The Journal of Biological Chemistry 275(46):36311-36315 (2000)	
	CH2	Nakamura, M. et al. "Involvement of galectin-3 expression in colorectal cancer progression and metastasis." Int. J. Oncol. 15, 143-148 (1999).	
	CI2	Nangia-Makker et al., "Galectin-3 Induces Endothelial Cell Morphogenesis and Angiogenesis," American Journal of Pathology 156(3):899-909 (2000)	
	CJ2	Nangia-Makker et al., "Inhibition of Human Cancer Cell Growth and Metastasis in Nude Mice by Oral Intake of Modified Citrus Pectin," Journal of the National Cancer Institute 94(24):1854-1862 (2002)	
	~~CK2~~	~~Nangia-Makker, P. et al. "Inhibition of Human Cancer Cell Growth and Metastasis in Nude~~ Mice by Oral Intake of Mofified Citrus Pectin." J. Nat. Cancer Inst. 94(24) 1854-1862 (18 Dec. 2002) duplicate	
no date	~~CL2~~	~~Novocastra Laboratories, Ltd. "Galectin-3: mouse monoclonal antibody NCL-GAL3."~~	
	CM2	Ohannesian, D. W. et al. "Carcinoembryonic Antigen and Other Glycoconjugates Act as Ligands for Galectin-3 in Human Colon Carcinoma Cells." Cancer Res. 55, 2191-2199 (15	

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Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	104831-0002-401

		May 1995).	
	CN2	ONCOLINK: LILLY ONCOLOGY TREATMENT OPTIONS. www.oncolink.com/treatment/section.cfm retrieved on 2/12/2003.	
	CO2	ORLANDI, F. et al. "Galectin-3 Is a Presurgical Marker of Human Thyroid Carcinoma." Cancer Res. 58, 3015-3020 (15 July 1998).	
	CP2	Pascal O. Berberat et al., "Comparative Analysis of Galectins in Primary Tumors of Tumor Metastasis in Human Pancreatic Cancer," The Journal of Histochemistry & Cytochemistry 49(4):539-549 (2001)	
	CQ2	PERILLO, N. L. "Galectins: versatile modulators of cell adhesion, cell proliferation, and cell death." J. Mol. Med. 76, 402-412 (1998).	
	CR2	PIENTA, K.J. et al. "Inhibition of spontaneous metastasis in a rat prostate cancer model by oral administration of modified citrus pectin." J. Nat. Cancer Inst. 87(5), 348-353 (1 March 1995).	
	CS2	PLATT, D. and Raz, A. "Modulation of the Lung Colonization of B16-F1 Melanoma Cells by Citrus Pectin." J. Nat. Cancer Inst. 84, 438-442 (18 March 1992).	
	~~CT2~~	~~Pratima Nangia-Makker et al., "Galectin-3 Induces Endothelial Cell Morphogenesis and~~ Angiogenesis," Americal Journal Pathology 156(3):899-909 (2000) duplicate	
	CU2	Propharmaceuticals, Inc. Confidential Private Placement Memorandum, Aug. 23, 2000, pp. 1-63.	
	CV2	PUGLIESE, G. "The Diabetic Milieu Modulates the Advanced Glycation End Product-Receptor Comples in the Mesangium by Inducing or Upregulating Galectin-3 Expression." Diabetes 49, 1249-1257 (July 2000).	
	CW2	Rabinovich G.A. et al., "Galectins and Their Ligands: Amplifiers, Silencers or Tuners of the Inflammatory Response?" Trends in Immunology 23(6):313-320 (2002)	
	CX2	RABINOVICH, G.A. "Role of galectins in inflammatory and immunomodulatory processes. Biochim. Biophys." Acta 1572, 274-284 (2002).	
	CY2	Rabinovich, G.A. et al. "Recombinant Galectin-1 and Its Genetic Delivery Suppress Collagen-induced Arthritis via T Cell Apoptosis." J. Exp. Med. 190(3), 385-397 (2 Aug. 1999).	
	CZ2	Rabinovich, G.A. et al. "The antimetastatic effect of a single low dose of cycolphosphamide involves modulation of galectin-1 and Bcl-2 express." Cancer Immunol. Immunother. 50, 597-603 (2002).	
	CA3	Raynaud, F. I. "Pharmacokinetics of G3139, a Phosphorothioate Oligodeoxynucleotide Antisense to bcl-2, after Intravenous Administration or Continuous Subcutaneous Infusion to Mice. J. Pharmacol." Exp. Therapeutics 281(1), 420-427 (1997).	
	CB3	Raz A. et al., "Endogenous galactoside-binding lectins: a new class of functional tumor cell surface molecules related to metastasis." Cancer and Metastasis Reviews (1987) 6, pp. 433-452.	
	CC3	Renard et al., "Structure of the repeating units in the rhamnogalacturonic backbone of apple, beet and citrus pectins." Carbohydrate Research (1995) 275, pp. 155-165.	
	CD3	ROS, J.M., et al., "Extraction, characterisation, and enzymatic degradation of lemon peel pectins." Carbohydrate Research (1996) 282, pp. 271-284.	
	CE3	Round et al., "Investigating the nature of branching in pectin by atomic force microscopy and carbohydrate analysis." Carbohydrate Research (2001) 331, pp. 337-342.	
	CF3	Rudin, C. M. et al. "A pilot trial of G3139, a bcl-2 antisense oligonucleotide, and paclitaxel in patients with chemorefractory small-cell lung cancer." Ann. Oncol. 13, 539-545 (2002).	
	CG3	Ruiter, G. A. et al. "Alkyl-Lysophospholipids as Anticancer Agents and Enhancers of Radiation-Induced Apoptosis." Int. J. Radiation Oncol. Biol. Phys. 49(2), 415-419 (2001).	
	CH3	S.E. Baldus et al., "Increased Galectin-3 Expression in Gastric Cancer: Correlations with Histopathological Subtypes, Galactosylated Antigen and Tumor Cell Proliferation," Tumor	

Examiner Signature	/Leigh Maier/	Date Considered	06/22/2008

10831285_1.DOC

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First Named Inventor	Yan Chang
Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	104831-0002-401

		Biol., 21:258-266 (2000)	
	CI3	Sano, H. et al. "Human Galectin-3 Is a Novel Chemoattractant for Monocytes and Macrophages." J. Immunol. 165, 2156-2164 (2000).	
	CJ3	Sauer, G. et al. "New Molecular Targets of Breast Cancer Therapy." Strahlenther. Onkol. 178(3), 123-133 (2002).	
	CK3	Shih, C. et al. Cryptophycins: "A Novel Class of Potent Antimitotic Antitumor Depsipeptides." Curr. Pharm. Des. 7, 1259-1276 (2001).	
	CL3	SÖRME, P. et al. "Low Micromolar Inhibitors of Galectin-3 Based on 3-Derivatization of N-Acetyllactosmaine." ChemBioChem 3, 183-189 (2002).	
	CM3	Takahashi, T. et al. "Mechanisms of the apoptotic activity of Cl-F-araA in a human T-ALL cell line, CCRF-CEM." Cancer Chemother Pharmacol. 50, 193-201 (2002).	
	CN3	Takenaka et al., "Galectin-3 and Metastasis," Glyococonjugate Journal 19:543-549 (2004)	
	CO3	Tentori, L. et al. "Role of Wild-Type p 53 on the Antineoplastic Activity of Temozolomide Alone or Combined with Inhibitors of Poly(ADP-Ribose) Polymerase." J. Pharmacol. Exp. Therapeutics 285(2), 884-893 (1998).	
	CP3	Tortora, G. et al. "Combined Blockade of Protein Kinase A and Bcl-2 by Antisense Strategy Induces Apoptosis and Inhibits Tumor Growth and Angiogenesis." Clin. Cancer Res. 7, 2537-2544 (Aug. 2001).	
	CQ3	Tortora, G. et al. "Protein Kinase A as Target for Novel Integrated Strategies of Cancer Therapy." Ann. N.Y. Acad. Sci. 968, 139-147 (2002).	
	CR3	Tu, S.-M. et al. "Combination adriamycin and suramin induces apoptosis in bcl-2 expressing prostate carcinoma cells." Cancer Letters 93, 147-155 (1995).	
	CS3	Usuda, J. et al. "Increased Cytotoxic Effects of Photodynamic Therapy in IL-6 Gene Transfected Cells via Enhanced Apoptosis." Int. J. Cancer 93, 475-40 (2001).	
	CT3	Vivat-Hannah, V. et al. "Synergistic Cytotoxicity Exhibited by Combination Treatment of Selective Retinoid Ligands with Taxol (Paclitaxel)." Cancer Res. 61(24), 8703-8711 (15 Dec. 2001).	
	CU3	Vladislav V. Glinsky et al., "Effects of Thomsen-Friedenreich Antigen-specific Peptide P-30 on B-Galactoside-mediated Homotypic Aggregation and Adhesion to the Endothelium of MDA-MB-435 Human Breast Carcinoma Cells," Cancer Research 60:2584-2588 (2000)	
	CV3	Vladislav V. Glinsky et al., "The Role of Thomsen-Friedenreich Antigen in Adhesion of human Breast and Prostate Cancer Cells to the Endothelium," Cancer Research 61:4851-4857 (2001)	
	CW3	Webster's New World Dictionary, 3rd. ed., Simon & Schuster (New York, 1988) page 433.	
	CX3	Wen-Qin Zhu et al., "Rapin Release of Intracellular Galectin-3 from Breast Carcinoma Cells by Fetuin," Cancer Research 61:1869-1873 (2001)	
	CY3	Wu, X.-X. et al. "Enhancement of Fas-mediated Apoptosis in Renal Cell Carcinoma Cells by Adriamycin. " Cancer Res. 60, 2912-2818 (1 June 2000).	
	CZ3	Xia, F. "The molecular basis of radiosensitivity and chemosensitivity in the treatment of breast cancer." Semin. Radiat. Oncol. 12(4), 296-304 (2002).	
	CA4	Xu, X.-C. et al. "Differential expression of galectin-1 and galectin-3 in benign and malignant salivary gland neoplasms." Int. J. Oncol. 17, 271-276 (2000).	
	CB4	Yamamoto, D. et al. "Synergistic action of apoptosis induced by eicosapentaenoic acid and TNP-470 on human breast cancer cells." Breast Cancer Res. Treatment 55, 149-160 (1999).	
	CC4	YAMAOKA, K. et al. "Overexpression of A β-Galactoside Binding Protein Causes Transformation of Balb3T3 Fibroblast Cells." Biochem. Biophys. Res. Comm. 179(1), 272-279 (30 Aug. 1991).	
	CD4	Yamazaki, K. et al. "Simultaneous Induction of Galectin-3 Phosphorylated on Tyrosine Residue, p21 waf1/Cip1/Sdi1, and the Proliferating Cell Nuclear Antigen at a Distinctive Period of Repair of Hepatocytes Injured by CCl4." Biochem. Biophys. Res. Comm. 280, 1077-1084	

Examiner Signature	/Leigh Maier/	Date Considered	06/22/2008

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /LM/

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				Art Unit	N/A
(Use as many sheets as necessary)				Examiner Name	Not Yet Assigned
Sheet	7	of	7	Attorney Docket Number	104831-0002-401

		(2001).	
	CE4	Yang, R.-Y. et al. "Expression of galectin-3 modulates T-cell growth and apoptosis." PNAS 93, 6737-6742 (June 1996).	
	CF4	Yoshii, T. et al. "Galectin-3 Phosphorylation is Required for Its Anti-apoptotic Function and Cell Cycle Arrest." J. Biol. Chem. 277(9), 6852-6857 (1 March 2002).	
	CG4	Zeng, S. et al. "In Vitro Evaluation of Schedule-dependent Interactions between Docetaxel and Doxorubicin against Human Breast and Ovarian Cancer Cell." Clin. Cancer Res. 6, 3766-3773 (Sept. 2000).	
	CH4	Zetter, "Angiogenesis and tumor metastasis," Annu. Rv. Med. 49:407-424 (1998)	
	CI4	Zhan et al., "Scarity or complete lack of single rhamnose residues interspersed within the homogalacturonan regions of citrus pectin." Carbohydrate Research (1998) 308, pp. 373-380	

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95/000,074	01/31/2005	6680306	104831-0002-601	8879

28120 7590 06/30/2010

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PATENT NO. : 6680306
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/004,076	12/18/2007	Yan Chang	104831-0002-401	9016

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Inter Partes Reexamination Proceeding
Control No. 95/000,074
Filed: January 31, 2005
For: U.S. Patent No. 6,680,306

In re Chang et al
Reissue Application No. 12/004,076
Filed: December 18, 2007
For: U.S. Patent No. 6,680,306

DECISION DISSOLVING MERGER

Inter partes reexamination proceeding control no. 95/000,074 and reissue application no. 12/004,076 are before the Office of Patent Legal Administration for *sua sponte* dissolution of their merger, in order to permit separate prosecution of the *inter partes* reexamination proceeding and the reissue application.

REVIEW OF RELEVANT FACTS

- On January 20, 2004, U.S. Patent No. 6,680,306 (the '306 patent) issued to Dr. Yan Chang and Dr. Vodek Sasak.

- On January 31, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,074 (the '074 reexamination proceeding).

- On April 12, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed in the '074 reexamination proceeding.

- On June 13, 2005, the patent owner filed an amendment and response to the April 12, 2005 nonfinal Office action in the '074 proceeding ("the June 13, 2006 patent owner response").

[1] The request for *inter partes* reexamination was filed by Pro-Pharmaceuticals, Inc., the real party in interest.

- On July 15, 2005, the requester filed comments to the June 13, 2005 patent owner response in the '074 proceeding.

- On October 18, 2005, a nonfinal Office action was mailed in the '074 proceeding.

- On December 18, 2007, the patent owner filed a reissue application for reissue of the '306 patent, which filing was assigned application number 12/004,076 (the '076 reissue application).

- Prosecution in the '074 proceeding progressed until, on May 13, 2008, a decision merging the '074 proceeding with the '076 reissue application was mailed. No Office action was issued in the '076 reissue application prior to its merger with the '074 proceeding.

- On June 12, 2008, the patent owner filed a housekeeping amendment in the merged proceeding of the '074 reexamination proceeding and the '076 reissue application ("the merged proceeding").

- Prosecution in the merged proceeding progressed until, on December 10, 2009, a nonfinal Office action was mailed, setting a two-month period for response. The time for response to the December 10, 2009 Office action expired after February 10, 2010. To date, no response has been received from the patent owner.

DECISION

The May 13, 2008 decision merging the '074 proceeding and the '076 reissue application states:[2]

> If the reissue applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. Thereafter, with respect to the '074 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (i.e., 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). . .

In this instance, the patent owner failed to file a timely and appropriate response to the December 10, 2009 nonfinal Office action. Accordingly, the merger of the '074 *inter partes* reexamination proceeding and the '076 reissue application is hereby **dissolved** and severed into two separate proceedings.

Jurisdiction over the '076 reissue application **is forwarded** to Technology Center 1600, where the '076 reissue application **will be held abandoned**.

---

[2] See page 13, item no. 7, of the May 13, 2008 decision merging the '074 *inter partes* reexamination proceeding and the '076 reissue application.

Jurisdiction over the '074 *inter partes* reexamination proceeding **is forwarded** to the Central Reexamination Unit **for the processing of a** Notice of Intent to Issue a Reexamination Certificate (**NIRC**) in accordance with the last action of the Office. Because all of the pending claims in the merged proceeding were rejected in the December 10, 2009 nonfinal rejection, **a reexamination certificate canceling all of the pending claims in the '074 *inter partes* reexamination proceeding will be issued in due course.** See MPEP 2687.

CONCLUSION

- The merger of the '074 *inter partes* reexamination proceeding and the '076 reissue application is hereby **dissolved** and severed into (1) a separate reissue application, no. 12/004,076, and (2) a separate *inter partes* reexamination proceeding, control no. 95/000,074. The '076 reissue application and the '074 *inter partes* reexamination proceeding will be addressed **separately** and **concurrently**.

- Jurisdiction over the '074 *inter partes* reexamination proceeding **is forwarded** to the Central Reexamination Unit **for the processing of a** Notice of Intent to Issue a Reexamination Certificate (**NIRC**) in accordance with the last action of the Office.

- Jurisdiction over the '076 reissue application **is forwarded** to Technology Center 1600, where the '076 reissue application **will be held abandoned**.

- Telephone inquiries relating to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

6-29-10
Kenpetmerger/IP-reissue
Kenpetmerger/sever

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(For Patent Owner)

MAILED

DEC 15 2009

CENTRAL REEXAMINATION UNIT

Keith R. Haupt, Esq.
Wood Herron & Evans, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202-2917

(For Requester)

In re Raymond Rudolph Spivey	:
Reexamination Proceeding	: DECISION *SUA*
Control No.: 95/000,077	: *SPONTE* WAIVING
Filed: February 18, 2005	: RULES UNDER 37 CFR
For: U.S. Patent No. 6,715,639	: 1.183

This is a decision under 37 CFR 1.183 *sua sponte* waiving the provisions of 37 CFR 1.943(c) to the extent set forth below.

35 U.S.C. § 314 provides, in relevant part:

> Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

The third party's respondent brief filed June 26, 2008 fails to comply with 37 CFR 1.943(c) as follows: it exceeds fifteen pages in length and no certificate of word count has been provided to indicate that it does not exceed the 7,000 word limit.

An examiner's answer has been prepared and mailed in this proceeding. This issue was not raised by the examiner or by the opposing party, and apparently did not prevent the examiner or the opposing party from treating the issues in this appeal on their merits. At this point in time, requiring a new third party respondent brief would require a response period for the new brief, a new examiner's answer, and a response period following the examiner's answer, which would run contrary to the statutory mandate of 35 U.S.C. § 314 that "all inter partes reexamination proceedings ... including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

Based on the particular facts and circumstances of this proceeding, coupled with the fact that the third party's respondent brief filed June 26, 2008 has already been addressed in an examiner's answer and the mandate for special dispatch in *inter partes* reexamination proceedings, the requirements of 37 CFR 1.943(c) are hereby waived for the third party's respondent brief of June 26, 2008 in this reexamination proceeding.

CONCLUSION

1. The provisions of 37 CFR 1.943(c) are hereby waived for the third party's respondent brief of June 26, 2008, in this *inter partes* reexamination proceeding.

2. Telephone inquiries with regard to this decision should be directed to Andres Kashnikow at (571) 272 – 4361.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

12/15/2009

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MAR 07 2008

CENTRAL REEXAMINATION UNIT

FOLEY AND LARDNER LLP
SUITE 500
300 K STREET NW
WASHINGTON, DC 20007

(For Patent Owner)

DAVID M. OSTFIELD
ADAMS AND REESE LLP
4400 ONE HOUSTON CENTER
1221 MCKINNEY
HOUSTON, TX 77010

(For Requester)

In re Bittleston
Reexamination Proceeding
Control No. 95/000,078
Request Dated: February 23, 2005
For: U.S. Patent No. 6,671,233

: DECISION re
: PETITION TO CONFIRM
: PRIORITY CLAIM

On October 31, 2007, the patent owner (petitioner) filed a paper entitled "Petition to Confirm Priority Claim, or in the Alternative to Accept an Unintentionally Delayed Priority Claim Under 37 C.F.R. § 1.78(a)," (hereinafter "Petition"), which requests that the Office confirm the priority claim, which was believed to be properly made during the prosecution of the application that issued as U.S. Patent No. 6,671,233.

For the reasons set forth below, the Petition is ***granted*** in that the Office has determined that the priority claim was established during the prosecution of the application that issued as U.S. Patent No. 6,671,233. This decision does not treat the alternative petition to accept an unintentionally delayed priority claim under 37 CFR 1.78(a) for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS IN THE REEXAMINATION PROCEEDING

1. U.S. Patent No. 6,671,233 (hereinafter, the '233 patent), issued to Bittleston, on December 30, 2003.

2. A third party requested *inter partes* reexamination of the '233 patent pursuant to 37 CFR 1.915, on February 23, 2005. The reexamination proceeding was assigned Control No. 95/000,078 (hereinafter, the '078 proceeding).

3. On May 19, 2005, an order granting the reexamination and a first Office action was mailed.

4. On July 18, 2005, the patent owner amended the first line of the specification to state that U.S. patent application No. 09/284,030, for which benefit was already claimed, is the National Stage of International Application No. PCT/GB97/03507.

5. On October 2, 2007, an Action Closing Prosecution (ACP) was mailed for the '078 proceeding. The ACP objected to the amendment of the first line of the specification because the examiner deemed it was a new, untimely benefit claim.

6. On October 31, 2007, the patent owner filed the above-mentioned Petition, and a response to the ACP.

7. On November 30, 2007, the third party requester submitted comments to the patent owner's response to the ACP. On pages 6-8, the third party submitted comments regarding the alternative petition to accept an unintentionally delayed priority claim under 37 CFR 1.78(a).

REVIEW OF THE RELEVANT FACTS IN U.S. APPLICATION NO. 09/893,234

1. U.S. Application No. 09/893,234 issued as U.S. Patent No. 6,671,223, the patent under reexamination, on December 30, 2003. The patent contained the benefit claim to U.S. Application No. 09/893,234.

2. On June 26, 2001, U.S. Application No. 09/893,234 was filed. As part of the filing, the transmittal letter contained a claim that the subject application was a continuation of U.S. application no. 09/284,030. This benefit claim under 37 CFR 1.78 was not made in the first line of the specification or in an application data sheet as required by 37 CFR 1.78. The Office, however, recognized the benefit claim as evidence by the filing receipt and scheduled the application for publication based upon the benefit claim.

3. On September 12, 2002, U.S. Application No. 09/893,234 was published.

4. On July 28, 2003, an Office action noted that the application lacked the required reference to the prior application no. 09/284,030 in order to properly claim benefit under 37 CFR 1.78 and suggested that such a reference should be included in the specification.

5. On September 12, 2003, the applicant filed a reply to the July 28th Office action, in which the first line of the specification was amendment to include a reference to U.S. application no. 09/284,030 and stated the specific relationship (i.e., continuation) that existed between the two applications. The amendment did not include the fact that U.S. application no. 09/284,030 is a National Stage entry of International Application No. PCT/GB/03507.

DECISION

I. The Petition to Confirm the Priority Claim:

As pointed out above, a benefit claim under 35 U.S.C. 120 to prior application no. 09/284,030 was established during the prosecution of application no. 09/893,234. While the benefit claim was not compliant with 37 CFR 1.78 upon filing, the Office did recognize the benefit on the transmittal sheet as evidenced by the date of the 18-month publication and the filing receipt. During the prosecution of application no. 09/893,234, the applicant did submit an amendment to satisfy the requirements of 37 CFR 1.78. In accordance with MPEP 211.01, subpart III A, a petition for the Office to accept an unintentionally delayed benefit claim is only required when the Office does not recognize the benefit claim because of noncompliance with the requirements of 37 CFR 1.78. Accordingly, a petition was not required to enter the amendment that satisfied the requirements of 37 CFR 1.78.

The amendment of July 18, 2005 (during the '078 proceeding) to the first line of the specification to include more information about prior application no. 09/284,030 does not constitute a new benefit claim. Rather, this amendment merely includes further information concerning an already established benefit claim in accordance with MPEP 201.11, subpart III A. As suggested by this section of the MPEP, the amendment includes the information that the prior application no. 09/284,030 is the National Stage Entry of International Application No. PCT/GB97/03507. This does not create a new benefit claim because application no. 09/284,030 is simply national stage phase of PCT/GB97/03507. See MPEP 1893.03(b).[1] Therefore, the amendment of July 18, 2005 did not attempt to make a new benefit claim to PCT/GB97/03507, and the amendment will be entered in the '078 proceeding.

[1] "An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application."

II. The Alternative Petition to Accept an Unintentionally Delayed Priority Claim:

The Petition to confirm the priority claim is treated as a petition under 37 CFR 1.181 to invoke the supervisory authority of the Director. Only the petition filed under 37 CFR 1.181 is addressed in this decision.

37 CFR 1.4(c) states:
Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Because petitions filed under 37 CFR 1.78(a) are decided by the Office of Patent Legal Administration or the Office of Petitions while petitions filed under 37 CFR 1.181 are decided by the Central Reexamination Unit, the third party must submit the petition under 37 CFR 1.78(a), if desired, in a separate paper to avoid confusion and delay.

The petition under 37 CFR 1.181 is before the Central Reexamination Unit for consideration, and is the only petition addressed in this decision.

The third party comments, dated November 30, 2007, only addressed the Petition to Accept an Unintentionally Delayed Priority Claim under 37 CFR 1.78(a). Since this alternative petition is not being addressed in this decision, the third party comments will also not be addressed.

CONCLUSION

1. The Petition to Confirm the Priority Claim is **granted**.

2. The amendment to the first line of the specification on July 18, 2005 will be entered.

3. The proceeding is being forwarded to the examiner for consideration of the papers filed in response to the ACP.

4. 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.

Andy Kashnikow

Andy Kashnikow
Supervisory Patent Examiner
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,078	02/23/2005	6671223	10431-6	6181

22428 7590 05/11/2009

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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4400 ONE HOUSTON CENTER
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MAILED

MAY 1 1 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,078*.

PATENT NUMBER *6,671,223*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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Foley & Lardner LLP
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

David M. Ostfield
Adams and Reese LLP
4400 One Houston Center
1221 McKinney
Houston, TX 77010

(For Third Party Requester)

In re Simon Hastings Bittleston	:	
Inter Parte Reexamination Proceeding	:	**DECISION DISMISSING**
Control No.: 95/000,078	:	**PETITION UNDER**
Filed: February 23, 2005	:	**37 CFR 1.182**
For: U.S. Patent No.: 6,671,223	:	

This is a decision on the patent owner papers filed on April 29, 2009, titled "Petition Under 37 CFR 1.182 To Temporarily Suspend Mailing Of A Reexamination Certificate To Determine Whether Prosecution Should Be Re-opened In Light Of Additional Disclosure."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition is dismissed.

Thus, the IDS filed April 29, 2009, has not been entered for consideration by the examiner.

FEES

The petition fee of $400 has been received.

BACKGROUND

1. Patent number 6,671,223 ("the '223 patent") issued on December 30, 2003, with claims 1-29.

2. The third party, Compagnie Generale deGeophysique, filed a request for *inter partes* reexamination of claims 1-29 of the '223 patent that was assigned control no. 95/000,078 on February 23, 2005.

3. A decision granting the request for *inter partes* reexamination of claims 1-29 of the '223 patent was mailed May 19, 2005.

4. Prosecution progressed to the point where a Notice of Intent to Issue Reexamination Certificate was issued February 18, 2009.

5. On April 29, 2009, the present petition was filed along with an Information Disclosure Statement, a PTO SB/08 (two sheets), and copies of prior art references.

6. The reexamination proceeding is presently in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

DECISION

I. Pertinent Regulations

35 U.S.C. 314 Conduct of inter partes reexamination proceedings.

...(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. (Emphasis added.)

MPEP 2687.01 Examiner Consideration of Submissions After NIRC

.....any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after the NIRX (except as indicated immediately below) must be accompanied by a petition under 37 CFR 1.182. The petition must be granted, in order to have the amendment, information disclosure statement, or other paper related to the merits considered. Where an amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding is filed after the NIRC, and the accompanying petition under 37 CFR 1.182 is granted, the examiner will reconsider the case in view of the new information , and if appropriate, will reopen prosecution. See MPEP 2656 for a detailed discussion of the criteria for obtaining entry and consideration of information disclosure statement filed after the NIRC.

MPEP 2656 Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. Once the reexamination has entered the Reexamination Certificate printing cycle (452 status), pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
>
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the printing cycle for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added.)

II. Findings and Analysis

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2656 noted above.

In the present instance, the fact situation fails to satisfy all grounds that would be analogous to those of 37 CFR 1.313(c). The petition fails to make an unequivocal statement as to why the art submitted makes at least one claim unpatentable and fails to provide an amendment to such claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. To the contrary, patent owner states that "Patent Owner is unable to make all of the statements listed in MPEP § 2656, because it believes the claims in the '078 proceeding to be patentable." However, patent owner could have provided a discussion of the substance of the items of information, and could have applied the teachings of the same to the claim limitations in the present reexamination proceeding in support of the belief that the claims in the '078 proceeding remain patentable.

Therefore, the present petition does not satisfy the requirements set out in the MPEP for a petition submitted for consideration of an IDS after the NIRC has been mailed, even before the proceeding has entered the printing cycle.

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

In view of the above, the petition is dismissed.

CONCLUSION

1. The patent owner petition filed on April 29, 2009, requesting consideration of an Information Disclosure Statement is dismissed.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS will, however, be placed in the electronic file.

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 Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

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(for Patent Owner)

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APR 07 2006
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Patterson, Thuente, Skaar & Christensen, P.A.
Attention: Bradley J. Thorson, Esq.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

(for Third Party Requester)

In re Leroy Braun et al. :
Inter Partes Reexamination Proceeding :
Control No. 95/000,080 :
Filed: March 1, 2005 :
For U.S. Patent No. 56,644,120 :

DECISION ON PETITION
TO ACCEPT PAPERS

This is a decision on the petition under 37 CFR 1.10(e), filed January 13, 2006, by the patent owner, to accept an amendment submitted therewith as being timely filed based on its original deposit by express mail.

The petition is dismissed as moot.

The patent owner requested that a copy of the reply originally filed on November 14, 2005, via express mail, be accepted under the provisions of 37 CFR 1.10(e).

The petition is moot because the reply filed November 14, 2005 has been located and associated with the file record. Inconvenience to the patent owner and the third party requester is regretted.

An Office communication will be issued in due course.

Arthur Grimley, Acting Group Director
Technology Center 2800
Semiconductors, Optical and Electrical
Systems and Components

NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION	Control No. 95/000,080	Patent Under Reexamination 6644120	
	Examiner John E. Chapman	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

1. ☐ No proof of service is included with the paper filed by ☐ patent owner ☐ requester on _____. 37 CFR 1.248 and 1.903. Proof of service is required within a time period of 30-days or one month from the date of this letter, whichever is longer. Failure to serve the paper may result in the paper being refused consideration. If the failure to comply with this requirement results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).

2. ☐ The paper filed on _____ by the ☐ patent owner ☐ requester is unsigned. A duplicate paper or ratification, properly signed, is required within a time period of 30-days or one month from the date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).

3. ☐ The paper filed on _____ by the ☐ patent owner ☐ requester is signed by _____ who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required within a time period of 30-days or one month from the date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).

4. ☐ The amendment filed by patent owner on _____, does not comply with 37 CFR 1.530. 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 prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case). The amendment will not be entered, although the argument the rein will be considered as it applies to the proceeding without the amendment should the prosecution be limited under 37 CFR 1.957(c).

5. ☐ The amendment filed by patent owner on _____, does not comply with 37 CFR ☐1.20(c)(3) and/or ☐1.20(c)(4), as to excess claim fees. 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 fee deficiency, or the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case), to effect the "abandonment" set forth in 37 CFR 1.20(c)(5).

6. ☒ Other: See attachment.

NOTE: PATENT OWNER EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956. NO EXTENSION OF TIME IS PERMITTED FOR THIRD PARTY REQUESTER. 35 U.S.C. § 314(b)(2).

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 Office action.

ATTACHMENT TO PTOL-2069

This in response to the third party's papers filed December 14, 2005.

A NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION was mailed on October 12, 2005, in which notice the patent owner was given one month within which to file an amendment in compliance with 37 CFR 1.530.

The patent owner timely filed an amendment on November 14, 2005. Therefore, the third party requestor was entitled to file comments to the patent owner's response under 37 CFR 1.947. The requestor then timely filed comments on December 14, 2005.

The requestor's comments cite a non-patent literature document entitled "Virtual Corporation Model 320 Clinical Audiometer User Manual."

Pursuant to 37 CFR 1.948(a):

"(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;
(2) which is necessary to rebut a response of the patent owner; or
(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim."

The requester's comments fail to establish that any of (a)(1)-(3) are satisfied. The requester has stated that the prior art reference is cited (1) to show that it was "well-known to one of skill in the art at the time of the invention in 1996 that the output of a computer sound card could be connected with another device by a wire to enable the sound signals to be passed to the device" and (2) "to rebut the findings of fact made by the Examiner in this regard." However, the prior art reference was cited for the purpose of contesting the examiner's confirmation of the patentability of claim 15. The examiner did not find that it was not "well-known to one of skill in the art at the time of the invention in 1996 that the output of a computer sound card could be connected with another device by a wire to enable the sound signals to be passed to the device." Nor has the requester indicated any other finding of fact by the examiner for which the citation of the prior art reference is necessary to rebut. Rather, the citation of the prior art reference appears to be for the purpose of establishing a substantial new question of patentability regarding claim 15, based on a reference that the requester failed to supply in the initial request for *inter partes* reexamination.

Since the December 14, 2005 requestor comments provide new art without establishing that any of (a)(1)-(3) are satisfied, the comments are improper and are therefore being returned herewith. See MPEP 2666.05, part II.

A copy of this decision will be made of record.

Pursuant to MPEP 2666.05, part II

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper, and should provide a time period of 30 days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party with an explanation of what is not proper, and at that point the comments can no longer be resubmitted.

Accordingly, the requester is provided with a time period of 30 days from the issuance of this Notice for the third party requester to rectify and refile the comments.

ALL future correspondence in relation to this *inter partes* reexamination proceeding should be directed:

By mail to: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By fax to: (571) 273-0100
Central Reexam Unit

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

John E. Chapman
Primary Examiner
Art Unit 2856

Arthur Grimley
Group Director (acting)
Technology Center 2800

Enclosure (for Requestor): Requestor's comments filed on December 14, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,080	03/01/2005	6644120	3493.03US01	5798

164 7590 03/30/2007

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Patterson, Thuente, Skarr & Christensen, P.A. (Patent Owner)
Attention: Bradley J. Thorson, Esq.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

Alan M. Koenick (Requester)
Kinney & Lange P.A.
The Kinney & Lange Building
312 South Third Street
Minneapolis, MN 55415-1002

MAILED

MAR 3 0 2007

CENTRAL REEXAMINATION UNIT

In re Application of	:
Braun et al.	:
Application No. 95/000,080	: DECISION ON PETITION
Patent No. 6,644,120	:
Filed: March 1, 2005	:
	:

This is a decision on the requester's April 25, 2006 petition titled "PETITION UNDER 37 CFR § 1.181".

The relief requested is the following:

A) Pursuant to 37 CFR 1.181(a)(1), that the Acting Group Director's decision of April 25, 2006 be reviewed, to permit (a) entry of the entry of the requester's comments of December 14, 2005, including citation of new art, and (b) to permit consideration of such art; and

(B) Pursuant to 37 CFR 1.181(a)(3), that the supervisory of the Director be invoked to reassign the above captioned proceeding to another examiner.

The petition is **GRANTED** as to the relief requested under 37 CFR 1.181(a)(1) for consideration of third party requester's new art[1] **and DISMISSED** as to entry of requester's

[1] Since such art was also submitted by the patent owner; see the below discussion.

comments

The petition is **DISMISSED AS MOOT** as to the relief requested under 37 CFR 1.181(a)(3).

FACTS

1. U.S. Patent 6,644,120 (the '120 patent) issued on November 11, 2003. Applicant filed a continuation application 10/685,240 (the '240 application) on October 14, 2003, i.e., prior to the issuance of the '120 patent. Application 11/053,408, for continuation of the '240 application, was filed on February 8, 2005. The continuation application were assigned to Examiner Chapman.

2. The requester filed a request for *inter partes* reexamination of the '120 patent on March 1, 2005, resulting in the present proceeding control number 95/000,080 (the '080 proceeding). The proceeding was assigned to Examiner Chapman.

3. The requester also filed *ex parte* reexamination requests for U.S. patents 5,811,681 (90/008,067) and 6,416,482 (90/008,066) both filed June 27, 2006.

4. On May 15, 2005, a decision ordering reexamination was mailed for the '080 proceeding. A first Office action accompanied the mailing.

5. On June 15, 2005, Examiner Chapman conducted interviews with applicant (the patent owner) in continuation applications 10/685,240 and 11/053,408.

6. On July 11, 2005, the patent owner filed an amendment in the '080 *inter partes* reexamination proceeding.

7. On July 29, 2005, the Office issued a Notice of Defective Paper in the '080 proceeding notifying the patent owner that the July 11, 2005 amendment was improper in that amendment format and it did not comply with 37 CFR 1.530.

8. On August 10, 2005, requester filed comments in response to the patent owner's amendment of July 11, 2005.

9. On August 11, 2005, the patent owner filed a response to the

Notice of Defective Paper.

10. On September 9, 2005, requester filed comments in response to the patent owner's amendment of August 11, 2005.

11. On October 12, 2005, the Office issued a Notice of Defective Paper in the '080 proceeding, notifying the patent owner of a deficiency in the August 11, 2005 amendment.

12. On November 14, 2005, patent owner submitted a response to the notice of Defective Paper.

13. On December 14, 2005, the requester submitted comments in response to patent owner's amendment of November 14, 2005, and included an IDS submission providing a new non-prior art reference.

14. On April 7, 2006 the Acting Group Director returned requester's comments which included the IDS submission, because the submission failed to satisfy the requirements of 37 CFR 1.948.

15. On April 25, 2006, the requester filed this petition under 37 CFR 1.181.

16. On December 6, 2006,, patent owner submitted the same reference to the Office that was denied entry on December 14, 2005. Patent owner asserts that the submission to the Office was in response to the requester serving a copy of the reference on patent owner.

17. On January 4, 2007, reexamination control number 95/000,080 was transferred from examiner John Chapman in Technical Center 2800 to Margaret Rubin an examiner in the Central Reexamination Unit.

REGULATIONS

37 CFR 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to

appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 1.948 Limitations on submission of prior art by third party requester following the order for *inter partes* reexamination.

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the

examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

DECISION

1. **Requester's petition under 37 CFR 1.181(a)(1) to invoke the authority of the Director to compel the examiner to consider entry of requester's is DISMISSED. Requester's petition under 37 CFR 1.181(a)(1) to consider the art is GRANTED.**

On December 14, 2005, the requester submitted comments in response to patent owner's amendment. The comments included a citation of a non-patent literature document entitled "Virtual Corporation Model 320 Clinical Audiometer User Manual." On April 4,7, 2007, The Office returned the comments and held the requester comments to be improper and returned them, because the third party requester had failed to establish that it met any of the requirements of 37 CFR 1.948(a)(1)-(3).

Requester has now filed the present petition pursuant to 37 CFR 1.181(a)(1) asserting that (a) the Office erred in not considering the requester comments as compliant and (b) the newly cited prior art should have been considered by the Office since it was submitted to rebut a finding of fact made by the examiner; requester asserts that, in at least two instances, the Office made factual finding relating to confirmation of claim 15.

Assertion (a):

Specifically, requester asserts that examiner erred in his factual finding that "the prior art fails to teach and/or fairly suggest" a multimedia audiometer as claimed, wherein a multimedia input interface communicatively connects a processor and a test signal generator to deliver the proper instruction to a test subject." Accordingly, requester argues that, under 37 CFR 1.948,

requester is entitled to rebut the finding of facts cited in conjunction with comments pursuant to 37 CFR 1.947 by presenting new art and a new proposed rejection.

Requester's argument is not persuasive.

Requester has misinterpreted the examiner's findings of fact. The examiner stated that the prior art of record fails to teach and/or fairly suggest a multimedia audiometer as claimed, wherein a multimedia input interface communicatively connects a processor and a test signal generator to deliver the proper instruction to a test subject. The examiner *did not* make a statement that this particular claimed feature is not known in the prior art in general. The examiner's finding is directed to the art of record, and is not a representation that a validity search has been made as to all art in existence. [2]

The examiner is stating that the particular claimed feature is not shown in the prior art references that were cited by requester (or any other art of record), and it is that statement which the requester is permitted to rebut under 37 CFR 1.948(a)(1). Requester has failed to establish that the reference was being cited to rebut a finding of fact by the examiner, because requester did not provide any new information rebutting the examiner's interpretation of what the art of record shows. The presently proposed substitution of a new art rejection for that of the art of record is not a rebuttal of the examiner's finding that the feature in question is not taught by the art of record. Rather, such a substitution is a rebuttal of a finding that the feature in question is not taught by any art in existence, a finding that clearly was not made by the examiner. It is to be noted that such a statement could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and cannot include such a search while still complying with the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

In view of the above, contrary to requester's arguments, requester has not provided the requisite showing under 37 CFR 1.948(a)(1).

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[2] If a party becomes aware of new art showing the feature in question, that party would be free to consider the filing of a new reexamination request.

As a final point, it is to be noted that if a requester could substitute a new-art rejection for those of record each time an examiner refuses to adopt requester's proposed rejection, this would lead to endless prosecution. The requester would cite new art every time the examiner refuses to adopt a rejection and the prosecution would be endless. Such would eviscerate the 37 CFR 1.948 limitations.

Assertion (b): As to the petition request that the newly cited prior art be considered by the Office, the request will be granted.

The patent owner has submitted the same new art as was submitted by requester pursuant to the regulations, and such has an entry right. Accordingly, the non-patent literature reference will be considered by the Central Reexamination Unit examiner.

Patent Owner asserts that to force a patent owner to summit a reference for consideration by accusing the patent owner of failing to comply with the duty of candor, regardless of the requester's ability to satisfy the requirements of 37 CFR 1.948(a) would render the provisions of 37 CFR 1.948(a) meaningless. [3] Such assertion is, however, moot, since patent owner has already submitted the new art. It is further to be noted that 37 CFR 1.948(a) is not meaningless, because the proposed rejection based on the new art is not entered for consideration. Rather, the examiner will address the references submitted by patent owner on 5/1/2006 and 12/6/2006 in the next Office action, as the art cited in any information disclosure would be addressed.

2. **Requester's petition under 37 CFR 1.181(a)(3) is dismissed as moot in view of the Central Reexamination Unit transferring the application from Technical Center 2800 to the Central Reexamination Unit and reassigning control number 95/000,080 to central reexamination unit examiner Margaret Rubin.**

Requester asserts that Examiner Chapman should be removed from the *inter partes* reexamination control number 95/000,080 because the examiner conducted interviews in applications 10/685,240 and

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[3] It is to be noted that the patent owner has *not* shown the existence of a duty to open the package from a third party that contains art/documents/information.

11/053,048. Requester asserts that 37 CFR 1.955 would be rendered meaningless if claims similar to identical to those under reexamination can be discussed with the examiner assigned to the reexamination in an *ex parte* interview in a related but separate case (an application).

This aspect of requester's petition is dismissed as moot because reexamination control number 95/000,080 has been transferred to the Central Reexamination Unit. The transfer to the Central Reexamination Unit was part of an Office initiative to have all *ex parte and inter parte* reexamination proceedings handled under the jurisdiction of a central unit, the Central Reexamination Unit.

Such transfer of proceedings to the Central Reexamination Unit is not related to the basis for the examiner reassignment request in this petition. No evidence has been presented to indicate that Examiner Chapman conducted himself in any manner other than a proper manner. The Office notes that the two applications in which the interviews were conducted were not reexamination applications. MPEP 713.03 makes clears that interviews can be conducted in non *inter partes* reexamination applications.

It is to be noted that the burden is upon requesting party to show that the examiner of record should be removed from a reexamination proceeding on grounds of improper conduct, including a showing of bias or the appearance of bias. See *In re Ovshinsky* 24 USPQ2d 1241(Jan. 29, 1992). Requester freely admits that Examiner Chapman did not have any improper intent in conducting the subjective interview. In addition, requester has shown no inappropriate influence on the present proceeding resulting from the interviews conducted.

As pointed out above, however, the present proceeding has in-fact been re-assigned, and as such this requested relief of the petition has been rendered moot.

2. Return of Papers:

A copy of the December 14, 2005 requester comments was submitted with the present requester petition. Given that these comments do not have an entry right, as pointed out in the discussion of point 1 above, the comments paper is being "returned" to the third party requester. Inasmuch as the comments paper has been scanned into the electronic Image File Wrapper (IFW) and cannot

be removed from the IFW, the comments paper will be "returned" to the requester by being marked "closed" and "non-public." The comments paper will not be part of the official record.

CONCLUSION

1. The petition is GRANTED as to the relief requested under 37 CFR 1.181(a)(1) for consideration of third party's new art **and** is DISMISSED as to entry of third party requester's comments.

2. The petition is DISMISSED AS MOOT as to the relief requested under 37 CFR 1.181(a)(3).

3. The copy of the December 14, 2005 requester comments submitted with the present requester petition is being "returned" to the requester. The "return" will take the form of closing the comments in the IFW files of the present reexamination proceeding and marking the comments as "not public." No copy of the December 14, 2005 requester comments paper will be maintained elsewhere in the Office.

4. After the mailing of this decision, examiner Rubin will respond to the amendment filed by Patent Owner filed on November 14, 2005. In addition, examiner Rubin will address the IDS submissions by Patent Owner on May 1, 2006 and December 6, 2006.

5. **ALL** future correspondence in relation to this *inter partes* reexamination proceeding should be directed to:

By Mail: Mail Stop *Inter* Partes Reexam"
Central Reexamination Unit
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Va 22314

By Fax: (571)273-0100
Central Reexam Unit

By Hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, Va 22314

6. Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration at 571-272-7757.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy
Central Reexamination Unit

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MAILED
SEP 20 2005
REEXAM UNIT

In re reissue application of
Ronald Kronenberger
Application No. 11/035,428
Filed: January 13, 2005
For: U.S. Patent No. 6,507,956

In re reexamination proceeding of
Ronald Kronenberger
Control No. 95/000,081
Filed: March 3, 2005
For: U.S. Patent No. 6,507,956

DECISION SUSPENDING ACTION IN REISSUE AND PROVIDING PERIOD FOR AMENDMENT IN REEXAMINATION

The instant reissue application and reexamination proceeding are before the Office of Patent Legal Administration for *sua sponte* consideration of action of action to be taken under 37 CFR 1.991

at this time. The third party reexamination requester's request for merger of proceedings will also be addressed at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,507,956 (the '956 patent) issued to Ronald Kronenberger, on January 21, 2003.

2. On January 13, 2005, the patent owner filed a "broadening" reissue application based on the '956 patent, which was assigned Application Number 11/035,428 (the '428 reissue application). New claims 31-47(not present in the '956 patent) are provided in the reissue application. Additionally, original patent claims 1 and 17 are cancelled and claims 2, 3, 5, 6, 8-16, 18-20, 23, 29, and 30 are amended. No Office action has been mailed in the '248 reissue application.

3. A request for ***inter partes*** reexamination of the '956 patent was filed by a third party requester on March 3, 2005, and the resulting reexamination proceeding was assigned Control Number 95/000,081(the '081 reexamination proceeding). (David Peyser Sportswear, Inc. Corporation is identified as the real party in interest for the requester.) In the request for *inter partes* reexamination, (*see* Item "C." at page 3 of the request), the <u>third party requester requests</u> that the '081 *inter partes* reexamination proceeding and the '428 reissue application be merged because: (1) the time between filing the '428 reissue application and the '081 proceeding is short (about one and a half months); (2) the prior art raised and requiring consideration is common to both the '428 reissue application and the '081 *inter partes* reexamination proceeding; and (3) the amended claims of the reissue application are substantially the same as the claims of the issued '956 patent.

4. Notice of the filing of the reissue application was published in the *Official Gazette* on April 12, 2005.

5. Notice of the filing of the *inter partes* reexamination was

published in the *Official Gazette* on April 19, 2005.

6. On May 18, 2005, an order granting the reexamination request was mailed for the '081 proceeding. The order was NOT accompanied by an Office action.

7. A review of the '428 reissue file shows that patent owner has amended the specification in Col. 4, paragraph 40; has amended claims 2, 3, 5, 6, 8-16, 18-20, 23, 29, and 30; has cancelled claims 1 and 17; and has added claims 31-47 (which new claims are not present in the reexamination proceeding). A review of the prosecution history of the '081 reexamination file shows that claims 1-30 are pending. A first Office action has not been mailed in either of the two proceedings.

DECISION

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."

The instant reissue application and reexamination proceeding Control No. 95/000,081 are currently pending for the same patent. Since the Order has been mailed pursuant to 37 CFR 1.931 in the '081 reexamination proceeding, and both proceedings have been announced in the *Official Gazette*, a decision under 37 CFR 1.991 is timely.

The decision as to whether the *inter partes* reexamination and reissue proceedings will be merged, or one of the proceedings will be suspended, *is discretionary*. As pointed out in item 3 of the above Review of Facts, the third party requester has requested that the reexamination and reissue proceedings be merged.

Looking at the present situation, the following is considered and noted:

1. The merger option:

If the instant *inter partes* reexamination and reissue proceedings were to be merged, the merger would permit a third party (the *inter partes* reexamination requester) to comment on the broadened claims of the reissue application, and to participate in the appeal process as to such claims; yet, the reissue and reexamination statutes do not provide such a right of third party comment and participation. When Congress legislated the *inter partes* reexamination statute, Congress provided, in 35 U.S.C. 314(a), 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]

A decision to merge the '081 reexamination proceeding and the instant '428 reissue application would include within the merged proceeding - pending claims which are broader than the claims of the issued patent. The rights of the *inter partes* reexamination requester to comment during such a merged proceeding and to participate in the appeal process could not be annulled, since they are required by statute, i.e., 35 U.S.C. 314(b) and 35 U.S.C. 315(b) respectively. Thus, merger of the '081 proceeding and the instant reissue application would provide the third party requester with the right to support any Office rejections and to reply to any Office or patent owner reasons for patentability with regard to the newly added broadened claims. Yet, the effect and intent of the *inter partes* reexamination statue (35 U.S.C. 314(a)) is to preclude any third party requester comment and participation as to broadened claims. Since third party requester input as to the broadened claims presented by the '428 reissue application, and Office consideration of that input, is not within the scope of *inter partes* reexamination nor is it provided for elsewhere by

statute, combining the '081 *inter partes* reexamination with the instant broadening reissue application would run counter to the patent statute.

The main (focal) point here is that third party requester input, and Office consideration of same, as to the broadened claims *per se* is not within the scope of *inter partes* reexamination, since the *inter partes* reexamination statute precludes same. The merger of the *inter partes* reexamination with the reissue proceeding would permit and provide for such input and consideration as to the broadened claims of the '428 reissue application, in violation of the statute;[1] thus, a merger of the proceedings would not be appropriate.

It is also to be noted that a merger would fundamentally change the nature of what would otherwise be an *ex parte* reissue proceeding under 35 U.S.C. 251, i.e., what would otherwise be an *ex parte* proceeding as to the broadened claims.

In summary, while in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, the third party's request for merger would promulgate an interpretation of the patent regulations that violates federal statute.[2]

2. The option to conduct the proceedings separately:

It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '956 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 addition, in the present instance, 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

---

[1] Even if broadening claims were not presently included in the reissue application, the applicant/patent owner could provide same at some future point in the prosecution.

[2] An Office decision to merge would present a position inconsistent with the Congressional mandate of the reexamination statute as set forth above, and thus, it would be rejected. See *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") and *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.")

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 would run contrary to the intent of the *inter partes* reexamination statute.

3. The suspension option:

Given that the examination of the instant reissue and reexamination proceedings will not be conducted separately and at the same time, and will not be merged for the reasons stated, the question remains as to which of the two proceedings should proceed, and which should be suspended.

To answer to this question, it is observed that there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceeding (pursuant to 35 U.S.C. 314(c)). Because 35 U.S.C. 314(c) provides the statutory requirement that *inter partes* reexamination proceedings must be conducted with special dispatch, the examination of the reexamination proceeding must take precedence. Thus, it is the reissue proceeding that will be suspended.

In this instance, the *inter partes* reexamination and reissue proceedings were filed within about one and a half months of each other, and no Office action on the merits has issued for either proceeding. Thus, a suspension of the reissue proceeding would not delay a proceeding that has progressed substantially toward its resolution. In addition, the reissue application was filed for the purpose of broadening the patent prior to the expiration of the statutory period for broadening the patent claims, i.e., two years from the patent grant, and a suspension of the reissue proceeding will not interfere with that purpose, since the patent owner's right to have the broadened claims considered by the Office will be preserved. At the same time, the broadened claims in the suspended reissue application will be kept beyond the reach of the third party requester's comments.

Based on the above, action in the reissue application is hereby **suspended** pursuant to 37 CFR 1.103(e) in favor of the reexamination proceeding. The reissue application suspension shall remain in effect until the conclusion of the *inter partes* reexamination proceeding control no. 95/000,081 by the issuance of the reexamination certificate.

ONE MONTH TO FILE AMENDMENT

In this instance, the patent owner reissue application was filed prior to the request for reexamination. Accordingly, the patent owner is provided a ONE MONTH period to file an amendment in the 95/000,081 reexamination proceeding, to include any non-broadening issue from the reissue application (appropriate for reexamination) before the Office in the reexamination proceeding. This would leave only the broadening issues for resolution via the reissue application after the reexamination proceeding is concluded. In is noted that, under 37 CFR 1.939:

> "(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination."

To the extent that this provision requires waiver of the rules, waiver is hereby granted in this instance.

CONCLUSION

1. Action in the 11/035,428 reissue application is **suspended** pursuant to 37 CFR 1.103(e), until the completion of the *inter partes* reexamination proceeding control no. 95/000,081 by the issuance of the reexamination certificate.

2. The patent owner is provided a ONE MONTH period to file an amendment in the 95/000,081 reexamination proceeding, pursuant to the above discussion.

3. After the reexamination certificate for the '081 reexamination proceeding has issued, an Office action will be mailed for the reissue application.

4. The patent owner is advised to, at the time that a reexamination certificate is issued for the 95/000,081 reexamination, call the issuance of the certificate to the attention of the Office, and request a resumption of examination of the reissue application. The patent owner

may include an amendment of the reissue application claims at that time, if such is deemed appropriate based upon the results of the reexamination proceeding.

5. A copy of this decision is being placed in both the 11/035,428 reissue file and the 95/000,081 reexamination file.

6. The reexamination proceeding is being forwarded to the Central Reexamination Unit for processing, where it will be retained until the earlier of (a) the submission of the amendment in the 95/000,081 reexamination proceeding or (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment. The proceeding will then be forwarded via the appropriate Group Director to the examiner for the issuance of an Office action.

7. Telephone inquiries related to the examination of the reissue proceeding should be directed to the primary examiner, Gary Welch, at (571) 272-4996.

8. Telephone inquiries related to this decision should be directed to Elizabeth L. Dougherty, Senior Legal Advisor, at (571) 272-7733.

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

April 7, 2005
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RDC

David P. Lhota Stearns Weaver Miller Weissler Alhadeff & Sitterson PA 200 East Broward Boulevard Suite 1900 Ft. Lauderdale, FL 33301	:	(For Patent Owner)
John J. Gresens Merchant & Gould, P.C. P.O. Box 2903 Minneapolis, MN 55402-0903	:	(For Third Party Requester)
Patent Number: D 478,188 Reexamination Control Number: 95/000,083 Filed: March 7, 2005	:	DECISION ON PETITION

MAILED
OCT 05 2005
REEXAM UNIT

This is in response to the petition filed June 13, 2005, requesting review of the examiner's determination mailed May 11, 2005, denying the request for *inter partes* reexamination. The petition requests that the request for *inter partes* reexamination of U.S. Patent No. D 478,188 be granted. The petitioner asserts that there is no indication that the examiner considered the Declaration of Paul Madgwick. The instant petition is accepted as a timely petition under 37 C.F.R. 1.181 (no fee required).

A review of the examiner's decision denying the request for *Inter Partes* Reexamination of U.S. Patent No. D 478,188, clearly indicates that the examiner did review and consider the Declaration of Paul Madgwick. This is evidenced, for example, in the discussion of the Blazek images in the paragraph bridging pages 2 and 3 of the decision, where the examiner states that the "requestor cites the declaration of Mr. Madgwick in an attempt to establish these images as prior art". The examiner further notes "(h)owever, there is no factual evidence presented to positively identify and correlate the referenced images to the Blazek website".

It is noted the petitioner refers to MPEP 2616 which states:

> Affidavits and declarations which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination.

As noted above, the examiner did consider and address the Madgwick Declaration in making the determination to deny the request for *inter partes* reexamination. Upon consideration of the declaration, the assertions in the declaration were not found to be persuasive nor to be supported by factual evidence. With regard to the MPEP section referred to by petitioner, this section indicates that the affidavits and declarations should explain the contents or

pertinent dates in more detail. For example, a declaration from a librarian attesting to the date a monthly magazine was received would be persuasive to establish the date of reference within the month indicated on the magazine. However, in the instant situation, the assertions in the declaration are an attempt to establish the reference date and not to explain a pertinent date in more detail. Although such assertions to establish the reference date have been considered, such assertions are not supported by factual evidence as indicated by the examiner, because no factual evidence is presented to identify and correlate the referenced images to a particular website nor is factual evidence presented which establishes a date that the images were posted.

The USPTO has independently attempted to confirm the reference dates asserted by searching the Internet Archive at www.archive.org for the web pages noted in the Madgwick Declaration. However, although the Internet Archive shows, for example, that the blazek-glass.com website had pages posted dating back to 1999, neither the pages nor the images that may have been included on the pages could be viewed. Therefore, the search results did not conclusively show that the images presented in the request for *inter partes* reexamination were available on the dates indicated in the Madgwick Declaration (Note that the July 21, 2004 blazek-glass.com website page in the Internet Archive was viewable.).

The petition is **DENIED.**

This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

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REEXAMINT

Thomas B. Luebbering
Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108

In re Application of Harte Application No. 95/000,084 Patent No. 6,543,305 Filed: March 21, 2005	: DECISION DISMISSING PETITION

This decision is in response to patent owner's petition titled "PETITION UNDER 37 CFR 1.10(e) to establish receipt of correspondence" and filed on September 26, 2005 requesting that the Office establish a date of response to the June 3, 2005 *inter partes* Office action as July 29, 2005.

Patent Owner's petition under 1.10(e) is dismissed as **moot.**

Patent Owner has filed a petition requesting that the Office enter July 29, 2005 as the date of response to the reexamination Office action. Patent Owner's petition is in response to a telephone conversation between Ms. Patricia Volpe, Central Reexamination Unit and patent owner's representative where Ms. Volpe advised patent owner's representative that Mr. Doug McGinty patent examiner of the Central Reexamination Unit did not receive the amendment.

Patent Owner in compliance with 37 CFR 1.10(e) and MPEP 513(VII) submitted the following documents :

A) a true copy of the originally deposited correspondence showing the number of the Express Mail label;

B) a copy of the return postcard receipt date-stamped by OIPE marked July 29, 2005; and

C) a copy of the Express Mail Label showing the "date-in" entered by the USPS, and statements, signed by the person who deposited the documents as "Express Mail" with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying the petition are true copies.

Patent Owner's petition is moot because the Office did enter the patent owner's response to the June 3, 2005 *inter partes* Office action as July 29, 2005. The Office mailed to patent owner on October 20, 2005 a notice that the July 29, 2005 amendment was non-compliant with rule 1.530 and gave applicants thirty (30) days or one month from the date of the letter or the time remaining in the time period remaining in the response to the last Office action, whichever is longer, to correct the informality. On November 10, 2005 patent owner submitted a response to the notice of non-compliant amendment. On December 09, 2005 within thirty days the third

party requester responded to patent owner's amendment filed November 10, 2005. Presently, the patent owner's response as well as the comments from the third party requester are being reviewed by the CRU examiner and an examiner action will be mailed soon.

Any additional questions should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration at 571-272-7757.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
For Patent Examinationn Policy

cc:

H. Frederick Rusche
Husch & Eppenberger, LLC
190 Carondelet Plaza
St. Louis, Missouri 63105

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100127

DATE : January 27, 2010

TO SPE OF : ART UNIT 2917

SUBJECT : Request for Certificate of Correction on Patent No.: D467,270 C1

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

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

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

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

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

☒ **Approved** All changes apply.

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

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

Comments:

Office mistake in Inter Partes Reexamination Certificate (0133rd) US 467,270 C1

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

ma1

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Edward A. Meilman, Esq.
Dickstein, Shapiro, Morin, & Oshinsky, LLP
1177 Avenue of the Americas 41st Floor
New York, NY 10036

(For Patent Owner)

MAILED
NOV 14 2005
REEXAM UNIT

James V. Costigan
Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036

(For Third Party Requester)

In re Ivan Villax et al
Reexamination Proceeding
Control No. 95/000,087
Filed: April 5, 2005
For: U.S. Patent No. 6,528,666

: DECISION TO DISMISS
: PETITION UNDER
: 37 CFR 1.181 TO ACCEPT
: PAPER AS BEING TIMELY
: FILED UNDER 37 CFR 1.8(b)

This is a decision on the October 27, 2005 third party requester petition under 37 CFR 1.181(a)(3) to accept the paper filed on September 8, 2005 as being timely filed pursuant to the provisions of 37 CFR 1.8(b).

This petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is **DISMISSED**.

BACKGROUND

On August 5, 2005, the patent owner timely filed a response to the first Office action. The response was accompanied by a certificate of service certifying that a true copy of the August 5, 2005 communication was served on the third party requester on August 4, 2005.

On September 8, 2005, the third party requester filed comments on the patent owner's August 5, 2005 response, as evidenced by the date stamped by the Office on the postcard receipt. Office records, however, fail to reveal that any certificate of mailing accompanied the September 8, 2005 communication by the third party requester.

On September 22, 2005, the third party requester filed a certificate of mailing shown on its face to be dated September 6, 2005, stating that "this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450". The third party requester has not, however, presented any evidence, such as a proper statement under 37 CFR 1.8(b), that this certificate of mailing was originally attached to the September 8, 2005 communication.

DECISION

35 U.S.C. 314(a)(2) provides, in pertinent part:

"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."

37 CFR 1.947 provides, in pertinent part:

"Each time the patent owner files a response to an Office action on the merits . . . a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. . . . The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8."

Pursuant to 35 U.S.C 314(a)(2), the third party requester was required by statute to file any written comments within 30 days from the date of service (August 4, 2005) of the patent owner's response. Since the 30-day time period for response is required by the statute, it cannot be extended. See also 37 CFR 1.947. Since September 4, 2005, fell on Labor Day weekend, the third party requester was required to file any comments no later than Tuesday, September 6, 2005. See 37 CFR 1.7(a). In the absence of a proper certificate of mailing pursuant to 37 CFR 1.8, therefore, the September 8, 2005 comments cannot be considered by the examiner, since they are not timely filed. See 37 CFR 1.957(a).

Petitioner, who is the third party requester in this proceeding, argues that the entire submission filed on September 8, 2005 contains the essential information required for a certificate of mailing pursuant to 37 CFR 1.8. Petitioner argues that the submission included an attached postcard receipt containing the typewritten phrase "September 6, 2005 (w/Certificate of Mailing)," that the postcard receipt included the attorney's typewritten initials, and that the postcard receipt included the following typewritten statement: "The return of this postcard properly stamped will acknowledge receipt in the U.S. Patent and Trademark Office of the following subject matter: Written Comments on Response to Office Action; Certificate and International Search Report." Petitioner additionally argues that the signature appearing at the end of the paper entitled "Written Comments on Response to Office Action" may serve as the signature for a certificate of mailing, since this paper was attached to the postcard. Petitioner urges that there is no requirement in 37 CFR 1.8 as to the exact form of a certificate of mailing, where it is to be placed, how or where a signature is affixed or if an original signature is required because the rule [37 CFR 1.8(a)(1)(ii)] merely states that "the person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated."

In addressing petitioner's arguments, it is initially noted that 37 CFR 1.8(a)(1) provides, in pertinent part:

> "Correspondence will be considered as being timely filed if:
>
> > . . . (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

The postcard receipt received on September 8, 2005, cannot serve as the certificate of mailing because it is not signed. By referring to "the person signing the certificate," 37 CFR 1.8(a)(1)(ii) requires a signature affixed to the certificate of mailing. In addition, MPEP 512 clearly requires that a signature be affixed to the certificate of mailing. MPEP 512 provides, in pertinent part:

> "The certification requires a signature. Specifically, if the certification appears on a paper that requires a signature, two signatures are required, one for the paper and one for the certification."

The signature appearing at the end of the September 8, 2005 paper entitled "Written Comments on Response to Office Action," therefore, may not serve as the signature for the certificate of mailing.

Furthermore, the postcard receipt cannot be considered a certificate of mailing because it is not part of the official file. It is standard Office procedure that the postcard receipt be detached, date-stamped, and returned to the sender as proof of the date of receipt of correspondence with the Office, i.e., the "Office Date" stamp of receipt, pursuant to MPEP 505. See also MPEP 503.

In this instance, the petitioner has failed to meet the requirements of 37 CFR 1.8(b), which states, in pertinent part (emphasis added):

> " In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is . . . decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> > (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> >
> > (2) Supplies an additional copy of the previously mailed or transmitted correspondence **and certificate**; and
> >
> > (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission . . ."

Specifically, petitioner has failed to attach to the petition and reference a true copy of any proper certificate of mailing dated September 6, 2005 and previously submitted on September 8, 2005, together with a true copy of the September 8, 2005 communication, pursuant to 37 CFR 1.8(b)(2). Petitioner has also failed to provide a statement attesting on a personal knowledge basis, or to the satisfaction of the Director, that the copy of the September 8, 2005 communication and the copy of the certificate of mailing dated September 6, 2005, *together comprise* a true copy of the communication that was originally submitted to the Office on September 8, 2005, pursuant to 37 CFR 1.8(b)(3).

For the reasons given above, petitioner's submission fails to meet the criteria set forth in 37 CFR 1.8 and in MPEP 512 for establishing the timely receipt by the Office of the September 8, 2005 communication. Accordingly, the petition is dismissed.

CONCLUSION

1. The petition is **DISMISSED**.

2. The September 8, 2005 communication from the third party requester is not timely, and will not be addressed. That communication includes a paper entitled "Written Comments on Response to Office Action," a paper entitled "Certificate" and signed by Shoichi Okuyama, an eleven page corrected translation of Japanese reference JP 60-6700, and a four-page international search report for PCT/GB 02/02644.

3. Jurisdiction over the proceeding is being returned to the Examiner for prompt issuance of an Office Action in the 95/000,087 proceeding. The Action Closing Prosecution will not address the September 8, 2005 communication from the third party requester.

4. All correspondence relating to this inter partes reexamination proceeding should be directed to:

Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
United States Patent and Trademark Office
P. O. Box 1450
Alexandria VA 22313-1450

Please FAX any communications to:

(571) 273-9900
Central Reexamination Unit

Please hand deliver any communications to:

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

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

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

11-03-05
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Edward A. Meilman
Dickstein Shapiro Morin & Oshinsky LLP
41st Floor
1177 Avenue of the Americas
New York, NY 10036 - 2714

(For Patent Owner)

MAILED

OCT 17 2007

CENTRAL REEXAMINATION UNIT

James V. Costigan
Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036

(For Requester)

In re Villax et al
Inter Partes Reexamination Proceeding
Control No. 95/000,087
Filed: April 5, 2005
For: U.S. Patent No. 6,528,666

DECISION ON PETITION AND EXPUNGING IMPROPER PAPER

This is a decision addressing the following:

1. The document filed by the third party requester on June 7, 2006, entitled "Request for Remand" (hereinafter, "the June 7, 2006 third party requester document entitled "Request for Remand").

2. An opposition to the June 7, 2006 third party requester document entitled "Request for Remand," filed by the patent owner on June 20, 2006.

3. A reply to the patent owner's June 20, 2006 opposition, filed by the third party requester on June 27, 2006.

4. The petition under 37 CFR 1.181 filed by the third party requester on April 2, 2007, requesting review of the June 7, 2006 third party requester request for remand (hereinafter, "the April 2, 2007 third party requester petition").

The June 7, 2006, June 20, 2006, June 27, 2006, and April 2, 2007 papers, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The June 7, 2006 third party requester document entitled "Request for Remand" is **dismissed**.

The June 20, 2006 patent owner opposition to the June 7, 2006 document entitled "Request for Remand" is **moot**.

The April 2, 2007 third party requester petition under 37 CFR 1.181 is **granted to the extent** that the "Request for Remand" has been reviewed and dismissed.

The June 27, 2006 third party requester reply to the patent owner's June 20, 2006 opposition, entitled "Reply to Opposition to Request for Remand," is **improper** under 37 CFR 1.947, and **will be expunged** from the record.

REVIEW OF FACTS

- On March 4, 2003, U.S. Patent No. 6,528,666 (the '666 patent) issued to Ivan Villax and Zita Mendes.
- On April 5, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,087 (the '087 proceeding).
- On June 10, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.
- On August 5, 2005, the patent owner filed a response to the April 12, 2005 Office action.
- On September 8, 2005, the third party requester filed written comments directed to the June 10, 2005 Office action and the patent owner's August 5, 2005 response to that Office action.
- On October 27, 2005, the third party requester filed a petition under 37 CFR 1.181 requesting entry of the September 8, 2005 third party requester comments as being timely filed.
- On November 14, 2005, the third party requester's October 27, 2005 petition was dismissed.
- On November 14, 2005, an action closing prosecution was mailed.
- On March 8, 2006, a right of appeal notice was mailed.
- On April 6, 2006, the third party requester filed a notice of appeal.
- On June 7, 2006, the third party requester filed an appellant brief.
- Also on June 7, 2006, the third party requester filed a document entitled "Request for Remand" (the June 7, 2006 third party requester document entitled "Request for Remand") and a declaration under 37 CFR 1.132 of Filippo La Loggia.

[1] The request for *inter partes* reexamination was filed by Farmabios S.p.A., the real party in interest.

- On June 20, 2006, the patent owner filed a document entitled "Opposition to Request for Remand."

- On June 27, 2006, the third party requester filed a document entitled "Reply to Opposition to Request for Remand."

- On June 30, 2006, the patent owner filed a respondent brief, in response to the third party requester's June 7, 2006 appellant brief.

- On August 22, 2006, the patent owner filed a document entitled "Notice of Typographical Error," notifying the Office of a typographical error in the June 30, 2006 respondent brief.

- On April 2, 2007, the third party requester filed a petition under 37 CFR 1.181 (the April 2, 2007 third party requester petition), requesting review of the June 7, 2006 third party requester request for remand.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

(b) RESPONSE. —

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner 's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner 's response.

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

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.

37 CFR 1.937(b) provides:

The inter partes reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.939(a) provides, in pertinent part:

> 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.

37 CFR 1.945 provides:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 41.63(c) provides:

> 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 41.64(a) provides:

> Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

37 CFR 41.77(b) provides, in pertinent part (emphasis added):

> . . . **When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options** with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:
>
> (1) Reopen prosecution. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both . . .

MPEP 2667 I B 3 provides, in pertinent part:

> Third party comments in response to a patent owner submission which does not respond to an Office action are not permitted, since 37 CFR 1.947 only permits comments in response to the patent owner's response to an Office action. For example, where the patent owner submits a new power of attorney, the third party requester is not permitted to submit a set of comments, because the patent owner submission is not a response to an Office action. If the third party requester does comment, it will be returned.

DECISION

I. *The June 7, 2006 Third Party Requester Document Entitled "Request for Remand" and the June 20, 2006 Patent Owner Opposition*

The third party requester requests that the '087 *inter partes* reexamination proceeding be "remanded" to the examiner for consideration of the declaration under 37 CFR 1.132 of Filippo

La Loggia, which is attached to the June 7, 2006 third party requester document entitled "Request for Remand."

Jurisdiction over an *inter partes* reexamination proceeding, however, remains with the examiner until all briefs and examiner's answers have been entered, after which the proceeding is transmitted to the Board, pursuant to 37 CFR 41.64. In the '087 proceeding, jurisdiction remains with the examiner since an examiner's answer has not yet been mailed.

Furthermore, affidavits or other evidence filed after the date of filing an appeal will not be admitted pursuant to 37 CFR 41.63(c), other than as permitted by reopening under 37 CFR 41.77(b)(1), which is not the case here. See also 37 CFR 1.116(f). To request entry of the declaration under 37 CFR 1.132 by Filippo La Loggia filed on June 7, 2006, the third party requester must file a petition under 37 CFR 1.183, accompanied by the petition fee set forth in 37 CFR 1.17(f), to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f).

Even if the June 7, 2006 third party requester document entitled "Request for Remand" had contained a petition under 37 CFR 1.183, the document was not accompanied by an authorization for the Office to charge fees, such as the petition fee set forth in 37 CFR 1.17(f).

For the reasons given above, the June 7, 2006 third party requester document entitled "Request for Remand" is **dismissed**.

Since the third party requester did not submit a petition and fee to obtain consideration of the substance of the matter, the June 20, 2006 patent owner opposition responding to the June 7, 2006 third party requester document entitled "Request for Remand" is **moot**.

The June 7, 2006 and June 20, 2006 documents will be retained in the file, but will not be further treated on the merits.

II. *The June 27, 2006 Third Party Requester Document Entitled "Reply to Opposition to Request for Remand"*

The June 27, 2006 third party requester document entitled "Reply to Opposition to Request for Remand" contains comments in response to the patent owner's opposition to the June 7, 2006 third party requester document entitled "Request for Remand."

37 CFR 1.947, however, only permits comments by the third party requester in response to the patent owner's response to an Office action. See MPEP 2667 I B 3. Since the patent owner's June 27, 2006 opposition is not in response to an Office action on the merits, the third party requester document entitled "Reply to Opposition to Request for Remand" is **improper**.

Further, even if a proper petition were filed, once an opposition to the petition is filed, any further paper in opposition/rebuttal/response to the opposition paper is improper and will not be considered. There is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination.

Because the June 27, 2006 third party requester document is an improper paper, it does not have an entry right under the rules. Consequently, this document is not being made a part of the record of the present proceeding, and it is returnable without consideration of its substance. The June 27, 2006 submission was, however, scanned into the electronic Image File Wrapper (IFW) of the proceeding, before the discovery of the impropriety. Thus, the submission cannot be physically returned to the requester. Rather, the IFW copy of the document is being expunged by closing the document in the IFW file of the present proceeding, and by marking the document "not public." The June 27, 2006 third party requester document will not constitute part of the record of the present reexamination proceeding.

III. *The April 2, 2007 Third Party Requester Petition*

The April 2, 2007 third party requester petition under 37 CFR 1.181 requests the Office to review the June 7, 2006 third party requester document entitled "Request for Remand."

The June 7, 2005 third party requester document entitled "Request for Remand" has been addressed as discussed above. Consequently, the April 2, 2007 third party requester petition under 37 CFR 1.181 is **granted to the extent that** the request has been reviewed above.

CONCLUSION

1. The June 7, 2006 third party requester document entitled "Request for Remand" is **dismissed**. The June 20, 2006 patent owner opposition to the June 7, 2006 document is **moot**.

2. The June 7, 2006 third party requester document entitled "Request for Remand," and the June 20, 2006 patent owner opposition to the June 7, 2006 document entitled "Request for Remand," will be retained in the file but will not be further treated on the merits.

3. The third party requester document entitled "Reply to Opposition to Request for Remand" is **improper** and **will be expunged from the record**. The document is being expunged by closing the document in the IFW file of the present proceeding, and by marking the document "not public."

4. The April 2, 2007 third party requester petition under 37 CFR 1.181, requesting the Office to review the June 7, 2006 third party requester document entitled "Request for Remand," is **granted to the extent that** the request has been reviewed and dismissed.

5. The third party requester is given a period of 30 days from the mail date of this decision to file a response to this decision.

6. Any response to this decision by the third party requester must be served on the patent owner pursuant to 37 CFR 1.908 and 37 CFR 1.248.

7. The patent owner may once file an opposition within a period of 30 days from the date of service of the third party requester's response to this decision. The patent owner's opposition shall be limited to issues raised by the third party requester's response to this decision. The time for submitting an opposition by the patent owner may not be extended.

8. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration, pending a response to the decision, or the expiration of time for response to this decision. If no response by the third party requester is timely received in response to this decision, the June 7, 2006 declaration under 37 CFR 1.132 by Filippo La Loggia will be retained in the file but will not be further treated on the merits, and jurisdiction over the '087 proceeding will be forwarded to the examiner for action.

SUBMISSION OF CORRESPONDENCE

All correspondence relating to this *inter partes* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Inter Partes* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

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

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

cn

October 11, 2007
C:\kiva\kimpropa\IP\ 95_087 need 183 to enter affidavit + no reply to opposition.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,087	04/05/2005	6528666	515-4232	1171

7590 03/13/2008

EXAMINER

Edward A. Meilman, Esq.
DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas 41st Floor
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ART UNIT	PAPER NUMBER

DATE MAILED: 03/13/2008

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

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(For Patent Owner)

MAILED

MAR 13 2008

CENTRAL REEXAMINATION UNIT

James V. Costigan
Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036

(For Requester)

In re Villax et al
Inter Partes Reexamination Proceeding
Control No. 95/000,087
Filed: April 5, 2005
For: U.S. Patent No. 6,528,666

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

This is a decision on the November 16, 2007 third party requester petition under 37 CFR 1.183, to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and to enter the June 7, 2006 declaration of Filippo La Loggia (hereinafter, "the November 16, 2007 requester petition").

This decision also addresses the June 20, 2006 patent owner paper entitled "Opposition to Request for Remand" (hereinafter, "the June 20, 2006 patent owner opposition"). The June 20, 2006 patent owner opposition was filed in response to the requester petition filed on June 7, 2006. For the reasons set forth in the previous decision mailed on October 17, 2007, however, the June 7, 2006 requester petition was dismissed, and the June 20, 2006 patent owner opposition was determined to be moot. The instant November 16, 2007 requester petition was filed in response to the October 17, 2007 decision. A patent owner paper renewing the June 20, 2006 patent owner opposition was not filed, and the time period set forth in item no. 7 of page 7 of the October 17, 2007 decision for such a filing has expired. Under the specific facts and circumstances of this proceeding, however, the Office elects to address the June 20, 2006 patent owner opposition.

The November 16, 2007 requester petition, the June 20, 2006 patent owner opposition, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The third party requester petition under 37 CFR 1.183 is accompanied by the appropriate petition fee of $400 under 37 CFR 1.17(f). This fee will be charged to Deposit Account 08-1540.

The November 16, 2007 requester petition to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) is **dismissed**.

REVIEW OF FACTS

- On March 4, 2003, U.S. Patent No. 6,528,666 (hereinafter, "the '666 patent") issued to Ivan Villax and Zita Mendes.

- On April 5, 2005, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/000,087 (hereinafter, "the '087 proceeding").

- On June 10, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.

- On August 5, 2005, the patent owner filed a response to the June 10, 2005 Office action.

- On September 8, 2005, the third party requester filed written comments directed to the June 10, 2005 Office action and the patent owner's August 5, 2005 response to that Office action.

- On October 27, 2005, the third party requester filed a petition under 37 CFR 1.181 requesting entry of the September 8, 2005 third party requester comments as being timely filed.

- On November 14, 2005, the third party requester's October 27, 2005 petition was dismissed.

- On November 14, 2005, an action closing prosecution was mailed.

- On March 8, 2006, a right of appeal notice was mailed.

- On April 6, 2006, the third party requester filed a notice of appeal.

- On June 7, 2006, the third party requester filed an appellant brief.

- Also on June 7, 2006, the third party requester filed a document entitled "Request for Remand" and a declaration under 37 CFR 1.132 of Filippo La Loggia (hereinafter, "the La Loggia declaration").

- On June 20, 2006, the patent owner filed a document entitled "Opposition to Request for Remand."

- On June 27, 2006, the third party requester filed a document entitled "Reply to Opposition to Request for Remand."

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[1] The request for *inter partes* reexamination was filed by Farmabios S.p.A., the real party in interest.

- On June 30, 2006, the patent owner filed a respondent brief, in response to the third party requester's June 7, 2006 appellant brief.

- On August 22, 2006, the patent owner filed a document entitled "Notice of Typographical Error," notifying the Office of a typographical error in the June 30, 2006 respondent brief.

- On April 2, 2007, the third party requester filed a petition under 37 CFR 1.181, requesting review of the June 7, 2006 third party requester request for remand.

- On November 17, 2007, a decision was mailed dismissing the June 7, 2006 third party requester document entitled "Request for Remand" and granting the April 2, 2007 third party requester petition under 37 CFR 1.181 to the extent that the "Request for Remand" had been reviewed and dismissed. The November 17, 2007 decision also determined that the June 20, 2006 patent owner opposition to the June 7, 2006 document entitled "Request for Remand" was moot.

- On November 16, 2007, the third party requester filed the instant petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and to enter the June 7, 2006 declaration of Filippo La Loggia (hereinafter, "the November 16, 2007 requester petition").

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 provides, in pertinent part:

(b) RESPONSE. —

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner 's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner 's response.

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.116 provides, in pertinent part:

(e) An affidavit or other evidence submitted after . . . an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made

in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

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.

37 CFR 1.937(b) provides:

The inter partes reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.945 provides:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.981 provides:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the inter partes reexamination proceeding will not be reopened or reconsidered by the primary examiner except under the provisions of § 41.77 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

37 CFR 41.61(a) provides:

(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

37 CFR 41.63(c) provides:

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 41.64 provides:

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may *sua sponte* order the proceeding remanded to the examiner.

37 CFR 41.77(b) provides, in pertinent part (emphasis added):

. . . **When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options** with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) Reopen prosecution. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both . . .

MPEP 2258 provides, in pertinent part (emphasis added):

Issues relating to 35 U.S.C. 112 are addressed only with respect to new claims or amendatory subject matter in the specification, claims or drawings . . .

I. PRIOR ART PATENTS OR PRINTED PUBLICATIONS AND DOUBLE PATENTING

*
*

B. Matters Other Than Patents or Printed Publications

Rejections will not be based on matters other than patents or printed publications, such as public use or sale, inventorship, **35 U.S.C. 101**, fraud, etc. In this regard, see *In re Lanham*, 1 USPQ2d 1877 (Comm'r Pat. 1986), and *Stewart Systems v. Comm 'r of Patents and Trademarks*, 1 USPQ2d 1879 (E.D. Va. 1986). A rejection on prior public use or sale, insufficiency of disclosure, etc., cannot be made even if it relies on a prior art patent or printed publication. Prior art patents or printed publications must be applied under an appropriate portion of 35 U.S.C. 102 and/or 103 when making a rejection.

MPEP 2658 provides, in pertinent part:

II. COMPLIANCE WITH 35 U.S.C. 112

Where new or amended claims are presented or where any part of the disclosure is amended, the claims of the reexamination proceeding are to be examined for compliance with 35 U.S.C. 112. See MPEP § 2258 for a discussion of the examination in a reexamination proceeding based upon 35 U.S.C. 112.

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IV. OTHER MATTERS

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*

H. Issues Not Considered in Reexamination

If questions other than those indicated above (for example, questions of patentability based on public use or on sale, fraud, abandonment under 35 U.S.C. 102(c), etc.) are raised by the third party requester or the patent owner during a reexamination proceeding, the existence of such questions will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved. Such questions could arise in a reexamination requester's 37 CFR 1.915 request or in 37 CFR 1.947 comments by the third party requester.

MPEP 2660 III provides, in pertinent part:

> The examiner's first Office action will be a statement of the examiner's position, and it should be so complete that the second Office action can properly be made an Action Closing Prosecution (ACP).

MPEP 2678 provides, in pertinent part:

> If no rebuttal brief is received within the one month period set in the examiner's answer, the Central Reexamination Unit (CRU) will issue a notification letter to parties . . . and will then forward the reexamination proceeding to the Board of Patent Appeals and Interferences for decision on the appeal(s).

DECISION

Jurisdiction

The requester urges that the Director may provide the relief requested in the instant petition without suspending the rules under 37 CFR 1.183, because the provisions of 37 CFR 41.64(c) allow the Director to *sua sponte* order the reexamination proceeding to be remanded to the examiner [by the Board of Patent Appeals and Interferences (the Board)] at any time prior to the entry by the Board. [2] The Board, however, cannot remand a proceeding over which the Board does not have jurisdiction. Pursuant to 37 CFR 41.64(a), jurisdiction over the proceeding only passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board. The reexamination proceeding remains with the examiner until an examiner's answer has been mailed and either a rebuttal brief has been filed or the time for filing a rebuttal brief has expired. See MPEP 2678. Since an examiner's answer has not been mailed in the '087 proceeding, jurisdiction clearly has not yet passed to the Board. For this reason, the requested relief can only be obtained by way of a petition under 37 CFR 1.183 to suspend the rules. Jurisdiction has been forwarded from the examiner to the Office of Patent Legal Administration for the purposes of addressing the instant November 16, 2007 requester petition under 37 CFR 1.183.

Analysis

The requester urges "that the Director, in the interest of justice, waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and direct the Primary Examiner to consider the Declaration of Filippo La Loggia which was submitted on June 7, 2006."

The entry of an affidavit is prohibited after the mailing of a Right of Appeal Notice (RAN) in an *inter partes* reexamination proceeding (37 CFR 1.116(f)) and after the filing of a notice of appeal (37 CFR 41.63(c)), except as provided by 37 CFR 41.77(b)(1), which permits that patent owner, not the requester, to reopen prosecution within the provisions provided by the rule. In the instant case, the La Loggia declaration was filed on the same date (June 7, 2006) as the filing of requester's appellant brief.

The requester states: "The Declaration was not earlier presented because it was not until patentability of the claims was confirmed that the Examiner withdrew the presumption that the

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[2] See the second paragraph of page 3 of the November 16, 2007 requester petition.

Takahara process would result in the formation of compound III(b) [as recited in the '666 patent, which is the patent under reexamination]." [3] The requester further states that this action by the examiner "resulted in prejudice which can result in the loss of the Third Party Requester[']s rights with regard to the '666 patent." [4] The requester urges: "Basic fairness should allow the material evidence in the Declaration of Filippo LaLoggia to be considered in view of the Examiner's earlier position on the Takahara reference." [5]

Requester's argument that the La Loggia declaration was not earlier presented because it was not until patentability of the claims was confirmed that the examiner withdrew the above-described presumption, however, is not persuasive. As the patent owner correctly points out in the opposition, the issue of whether the Takahara process would result in the formation of compound IIIb was first raised by the patent owner in his August 5, 2005 response to the June 10, 2005 first Office action.[6]

The requester, in the request for reexamination,[7] proposed a rejection of all of the patent claims, including claims 16-18, under 35 U.S.C. 102(b) as being unpatentable over Takahara alone. The examiner, in rejecting patent claims 16-18 under 35 U.S.C. 102(b) over the Takahara reference in the June 10, 2005 first Office action, stated (emphasis added):

> "The Examiner presumes, **absent evidence on the record to the contrary**, that the intermediate product of claim 16 of the ['666] patent [which included compound IIIb] forms in the fluorination process [of the Takahara reference] and then decomposes to give the observed product." [8]

The examiner's phrase "absent evidence to the contrary" clearly provided an invitation for the patent owner to rebut the examiner's presumption that the Takahara process resulted in the formation of the intermediate product of patent claim 16 (which included compound IIIb), and also served to notify the requester of the examiner's invitation to raise the issue.

The patent owner did rebut the examiner's presumption in his August 5, 2005 response, arguing that the presumption that the Takahara reaction proceeds in a stepwise manner, that the stepwise manner "includes *the transitory formation of a stereoisomer of compound IIIb* sometime during that process," and that "the presumed stepwise reaction involves production, even fleetingly, of a compound having particular structure at some time" is "*most clearly speculation*" (emphasis added). [9]

The requester fails to provide any reason why the requester did not, at that point, timely submit the La Loggia declaration to address this issue, which was newly raised in patent owner's August

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[3] See, e.g., the recitation of compound IIIb in claims 1, 16, and 18 of the '666 patent (the patent under reexamination).
[4] See the last paragraph of page 1 and the paragraph bridging pages 2 and 3 of the November 16, 2007 requester petition.
[5] See the paragraph bridging pages 2 and 3 of the November 16, 2007 requester petition.
[6] See page 2 of the June 20, 2006 patent owner opposition.
[7] See the top of page 2 of the request for reexamination, filed April 5, 2005.
[8] See the paragraph bridging pages 4 and 5 of the June 10, 2005 first Office action.
[9] See the paragraph bridging pages 7 and 8 of the August 5, 2005 patent owner response to the June 10, 2005 first Office action.

5, 2005 response, and which was initially addressed by the examiner in the June 10, 2005 Office action. As the patent owner correctly points out, the requester was on notice that the examiner's presumption in the first Office action, i.e., that the intermediate product of claim 16 of the '666 patent (which included compound IIIb) is formed in the Takahara process, was being challenged by the patent owner. [10] The requester had an earlier opportunity to submit the La Loggia declaration in response to patent owner's challenge, but failed to do so.

Requester's September 8, 2005 comments after patent owner's August 5, 2005 response were untimely filed and consequently, were not entered for consideration and were not treated on the merits.[11] The requester, however, failed to file the La Loggia declaration to support the September 8, 2005 comments in response to the patent owner's arguments, as correctly pointed out by the patent owner. [12] Specifically, the requester argued: "T*he Patentee has asserted that Takahara does not disclose a stepwise process* as is disclosed by the Villax et al patent [the '666 patent], *in which the transitory formation of a stereoisomer of compound IIIb occurs. It must be noted that the ['666 patent] does not disclose the isolation and characterization of intermediate IIIb* . . . but instead directly adds the aqueous sulfite solution to the fluorination, as is shown by Takahara . . . For these reasons, the rejection of claims 16-18 is proper and should be maintained" (emphasis added). [13] The requester, therefore, had an opportunity to respond, and did not timely respond; and even if the comments had been timely, they did not respond to the issue raised by the patent owner of whether compound IIIb is formed by the Takahara process. At that point, requester failed to submit the La Loggia declaration to support his argument.[14]

The requester now urges that the La Loggia declaration was not earlier presented because "it was not until the patentability of the claims was confirmed that the examiner withdrew the presumption that the Takahara process would result in the formation of compound III(b)." [15]

The examiner withdrew his reliance on the presumption and his rejection, and confirmed the patent claims in the second Office action, which was an action closing prosecution. The requester did not have another opportunity to provide comments until after the mailing of the right of appeal notice, because the patent owner did not file a response to the action closing

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[10] See the second paragraph of page 2 of the June 20, 2006 patent owner opposition.

[11] 35 U.S.C. 314(b)(2) requires the requester to file any comments on patent owner's response within 30 days after the date of service of patent owner's response. **Since the 30 day period for the submission of requester's comments was statutory, it could not be waived by the Office.** Requester's comments were not submitted until after the statutory due date, also as evidenced by the postcard receipt date stamped by the USPTO, which was submitted by the requester. A certificate of mailing was not submitted with requester's comments as required by 37 CFR 1.8(a)(1)(ii), but was later submitted two weeks after the submission of requester's comments. As stated in the November 14, 2005 decision, the requester failed to submit any evidence that this certificate of mailing was originally attached to requester's comments, including a statement as required under 37 CFR 1.8(b)(3).

[12] See the last paragraph of page 3 of the June 20, 2006 patent owner opposition.

[13] See the bottom of page 3 of requester's September 8, 2005 comments.

[14] Had the requester submitted evidence earlier in the prosecution (for example, had the requester submitted a declaration with the September 8, 2005 comments and/or before the mailing of the action closing prosecution), the earlier-submitted evidence may have later been entered upon filing a petition under 37 CFR 1.183, even if the earlier-submitted evidence had not been timely filed at the time of its submission. In the instant case, however, the La Loggia declaration in any event cannot be entered because it addresses an issue that is not within the scope of reexamination, as discussed *infra*.

[15] See the paragraph bridging pages 1 and 2 of the November 16, 2007 requester petition.

prosecution.[16] The requester, however, had an earlier opportunity to submit the declaration. The 30-day statutory period within which the requester is permitted to file comments on patent owner's response [17] would have little purpose if the requester were permitted to refrain from filing, within the 30-day window, any evidence needed to support his comments, and if the requester were instead permitted to wait until the filing of an appeal brief to request that prosecution be reopened, which is not only after the examiner withdraws the rejection and confirms the claims, but also is after a notice of appeal has been filed, simply because the requester wished to wait until the examiner's presumption, and the rejection in which the presumption was made, has been withdrawn.

The Office is required by statute to conduct *inter partes* reexamination proceedings with special dispatch.[18] Where a requester has an earlier opportunity to submit evidence such as a declaration (as in the present case), the Office cannot, as a matter of policy, permit a requester to refrain from filing the evidence until after the mailing of a right of appeal notice (or, for that matter, until after the filing of a notice of appeal and at the time of filing the brief), since this would cause an unnecessary delay in prosecution. Pursuant to MPEP 2660 III, it is Office policy that the examiner's first Office action (in which the examiner originally made the presumption in the instant case) should be so complete that the second Office action can properly be made an action closing prosecution. The requester, therefore, was on notice that the second Office action in the instant proceeding may be made an action closing prosecution, and was also on notice that the examiner's presumption, i.e., that the intermediate product of claim 16 of the '666 patent (which included compound IIIb) is formed in the Takahara process, was challenged by the patent owner. The requester should have been aware of the possibility that the examiner could withdraw reliance on this presumption, in response to patent owner's challenge, and confirm the patent claims. The requester, however, still failed to submit the La Loggia declaration.[19]
As a further point, the examiner's presumption was withdrawn in the action closing prosecution mailed November 14, 2005. Rather than filing a petition for waiver of the rules with the La Loggia declaration immediately, requester waited until June 7, 2006, when the requester filed its appellant brief. Thus, requester waited until the point was reached where the appeal was briefed, and now would have to be "backed up" to negate the appeal and the brief, in addition to the right of appeal notice. This clearly is not consistent with the statutorily mandated special dispatch in reexamination.

Furthermore, the La Loggia declaration does not clarify the record or simplify the issues on appeal. The requester states that the La Loggia declaration was not earlier submitted, because the examiner did not withdraw the presumption and confirm the claims until the action closing prosecution. As the patent owner correctly points out, however, the La Loggia declaration does not rebut the examiner's withdrawal of the presumption that compound IIIb is formed by the process of Takahara.[20] The La Loggia declaration, in fact, does not address the process of the

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[16] The requester may only file comments after a response has been filed by the patent owner. See U.S.C. 314(b)(2).
[17] See 35 U.S.C. 314(b)(2).
[18] See 35 U.S.C. 314(c).
[19] Nor was the Takahara reference new to the requester, since it was the requester who proposed a rejection of all of the patent claims under 35 U.S.C. 102(b) as being unpatentable over Takahara. See the top of page 2 of the request for reexamination filed April 5, 2005. See also the discussion of Takahara on, for example, pages 2-7 of the request.
[20] See page 3 of the June 20, 2006 patent owner opposition.

Takahara reference at all. Rather, the La Loggia declaration raises **an issue that is not within the scope of reexamination**, since it attempts to show that the process as described in Example 1 of the '666 patent, the patent under reexamination, is inoperable because it allegedly does not form compound IIIb as claimed in the '666 patent. Thus, it would not be appropriate to enter and consider the declaration.

Specifically, the La Loggia declaration is submitted to show that "the intermediate compound of formula (IIIb) of [the patent under reexamination] does not actually form . . ., despite what is reported in that patent." [21] The requester argues that "[t]he Declaration shows that compound IIIb according to [the patent under reexamination] is not obtained as a material under the reaction conditions of Example 1 of [the patent under reexamination]." [22]

The requester submits this evidence to bolster his argument that even though the Takahara reference fails to teach the formation of compound IIIb, any product formed by the patent under reexamination is inherently formed by the process of Takahara, since the process disclosed in the Takahara reference is the same as that disclosed in Example 1 of the patent under reexamination. <u>This is NOT a case, however, where the same product is inherently formed, because the processes of the patent and of the Takahara reference are not shown to be identical. Contrary to requester's arguments, the Takahara reference does not in fact disclose a process that is identical or substantially identical to that disclosed in the patent under reexamination</u>. Takahara employs acetyl fluoride (CH_3COF) as the fluorinating agent while the patent employs selectfluor (1-Chloromethyl-4-Fluoro-1, 4-Diazoniabicyclo[2.2.2]Octane Bis-(Tetrafluoroborate)). These are two chemically distinct electrophilic fluorinating agents with different properties. They cannot be considered to be equivalent *a priori* in a specific chemical context. Takahara treats the product formed by fluorination, in trichlorofluoromethane (CCl_3F), of the steroid precursor with a saturated aqueous solution of sodium sulfite (Na_2SO_3)), while the '666 patent treats the fluorination product with a mixture of ammonia, sodium metabisulfite ($Na_2S_2O_5$) in dichloromethane (CH_2Cl_2). Again these are distinctly different reductive conditions and cannot be assumed to have equivalent chemical consequences in a particular chemical context. Finally, while the starting materials of Takahara are closely related to those of the '666 patent, they are not identical, since they differ in the stereochemical disposition of the C-16 methyl group which has an alpha orientation in the patent and a beta orientation in Takahara. The extreme sensitivity of steroid chemistry to differing patterns of substitution is well known. Takahara's process, therefore, is not identical or substantially identical to the process of the patent.

<u>Since the process of the patent under reexamination is NOT the same or substantially the same as the process of Takahara</u>, the only purpose that the La Loggia declaration serves is to attempt to show that the invention of original claim 16 of the patent under reexamination (the scope of which includes compound IIIb) either is partially or wholly inoperable, and/or that the original disclosure of the patent under reexamination fails under 35 U.S.C. 112, first paragraph. Issues of inoperability under 35 U.S.C. 101, and those of lack of written description and/or lack of enablement under 35 U.S.C. 112 of the original specification and original patent claims, are not within the scope of reexamination, and must not be addressed on the merits. See MPEP 2658

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[21] See paragraph no. 4 of the June 7, 2006 La Loggia declaration.

[22] See the first full sentence of page 3 of the November 16, 2007 requester petition.

and 2258. Accordingly, the La Loggia declaration will not be entered, since it raises an issue that is not within the scope of reexamination.

Final Comments and Summary

Waiver is not intended to be routine, and the situation presented must rise to the level of an "extraordinary situation" that would justify waiver under 37 CFR 1.183. See e.g., *Issidorides v. Ley*, 4 USPQ 2d 1861 (Comm. of Patents 1987) ("It is not the policy of the Patent and Trademark Office, however, to routinely waive rules"), citing, *Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580, 584 (CCPA 1972) ("the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183"). In order to grant of any petition under 37 CFR 1.183, petitioner must show (1) that an extraordinary situation is presented where (2) justice requires waiver of the rule for which waiver is requested. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner has not show that either condition exists in this case. Petitioner has not demonstrated that the delay in submission of the La Loggia declaration was caused by "extraordinary circumstances," such that it should be entered at the time of filing the appeal brief; rather, here, requester had ample opportunity to present the declaration earlier. Furthermore, justice does not require waiver of the rule to enter the La Loggia declaration; rather, the declaration must not be entered because it raises an issue that is not within the scope of reexamination. The failure of the requester to submit the La Loggia declaration in response to patent owner's August 5, 2005 response, and the attempt by the requester to submit evidence that is not within the scope of reexamination, is not a situation under which the Office should provide relief pursuant to 37 CFR 1.183.

For the reasons given above, the June 7, 2006 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and to enter the La Loggia declaration is **dismissed**.

CONCLUSION

1. The June 7, 2006 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and to enter the La Loggia declaration is **dismissed**.

2. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration, pending a response to the decision, or the expiration of time for response to this decision.

3. If no response by the third party requester is timely received in response to this decision, the June 7, 2006 declaration under 37 CFR 1.132 by Filippo La Loggia will remain in the file, but will not be entered and will not be further treated on the merits, and jurisdiction over the '087 proceeding will be forwarded to the examiner for action.

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

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

cn

3-13-08
C:\kiva\kimpropa\IP\\95_0087 dismiss183 to enter affidavit with appeal+aff not w-i scope of reexam.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,087	04/05/2005	6528666	515-4232	1171

7590 07/15/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2008

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MAILED

JUL 15 2008

CENTRAL REEXAMINATION UNIT

James V. Costigan
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(For Requester)

In re Villax et al
Inter Partes Reexamination Proceeding
Control No. 95/000,087
Filed: April 5, 2005
For: U.S. Patent No. 6,528,666

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

This is a decision on the May 16, 2008 third party requester request for reconsideration of the March 13, 2008 decision by the Office, which dismissed the third party requester's petition under 37 CFR 1.183[1] to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and to enter the June 7, 2006 declaration of Filippo La Loggia (hereinafter, "the May 16, 2008 requester request for reconsideration").

This decision also addresses the May 21, 2008 patent owner paper entitled "Opposition to Request for Reconsideration of Decision Dismissing Petition Under 37 CFR § 1.183" (hereinafter, "the May 21, 2008 patent owner opposition"). The May 21, 2008 patent owner opposition is filed in response to the May 16, 2008 requester request for reconsideration.

The May 16, 2008 requester request for reconsideration, the May 21, 2008 patent owner opposition, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The May 16, 2008 requester request for reconsideration under 37 CFR 1.183 is accompanied by the appropriate petition fee of $400 under 37 CFR 1.17(f). This fee will be charged to Deposit Account 08-1540.

SUMMARY

The May 16, 2008 requester request for reconsideration of the March 13, 2008 decision dismissing requester's petition under 37 CFR 1.183 is **dismissed as moot**. The May 21, 2008 patent owner opposition, filed in response to the May 16, 2008 requester request for reconsideration, is **moot**.

[1] The third party requester petition under 37 CFR 1.183 was filed on November 16, 2007.

REVIEW OF FACTS

- On March 4, 2003, U.S. Patent No. 6,528,666 (hereinafter, "the '666 patent") issued to Ivan Villax and Zita Mendes.

- On April 5, 2005, a request for *inter partes* reexamination was filed by the third party requester,[2] and the resulting reexamination proceeding was assigned control number 95/000,087 (hereinafter, "the '087 proceeding").

- On June 10, 2005, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.

- Prosecution progressed until November 16, 2007, when the third party requester filed a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f) and to enter a declaration of Filippo La Loggia filed on June 7, 2006 (hereinafter, "the November 16, 2007 requester petition").

- On March 13, 2008, a decision was mailed dismissing the November 16, 2007 requester petition.

- On May 16, 2008 (certificate of mailing, May 13, 2008), the third party requester filed the instant request for reconsideration of the March 13, 2008 decision (hereinafter, "the May 16, 2008 requester request for reconsideration").

- On May 21, 2008, the patent owner filed the instant opposition to the requester request for reconsideration of the March 13, 2008 decision (hereinafter, the "May 21, 2008 patent owner opposition").

- On May 27, 2008, the Office mailed a nonfinal action reopening prosecution in the '087 proceeding.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.116 provides, in pertinent part:

> (f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

37 CFR 1.181(f) provides, in pertinent part:

> Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

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[2] The request for *inter partes* reexamination was filed by Farmabios S.p.A., the real party in interest.

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 41.3 provides, in pertinent part:

> (b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title . . .
>
> *
> *
>
> (e) Time for action. (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:
>
> > (i) File the petition within 14 days from the date of the action from which the party is requesting relief, and
> >
> > (ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

37 CFR 41.63(c) provides:

> 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 41.64(a) provides:

> Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

MPEP 2678 provides, in pertinent part:

> If no rebuttal brief is received within the one month period set in the examiner's answer, the Central Reexamination Unit (CRU) will issue a notification letter to parties . . . and will then forward the reexamination proceeding to the Board of Patent Appeals and Interferences for decision on the appeal(s).

DECISION

Jurisdiction

The patent owner urges that the May 16, 2008 requester request for reconsideration be dismissed as untimely pursuant to 37 CFR 41.3(e). The provisions of 37 CFR 41.3, however, do not apply to petitions on matters that are **not** pending before the Board of Patent Appeals and Interferences (hereinafter, "the Board), such as petitions under 37 CFR 1.183 to suspend the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f). See 37 CFR 41.3(b).

As stated in the March 13, 2008 decision, jurisdiction over the proceeding only passes to the Board upon transmittal to the Board of the file, including all briefs and examiner's answers, pursuant to 37 CFR 41.64(a). The reexamination proceeding remains with the examiner until an examiner's answer has been mailed and either a rebuttal brief has been filed or the time for filing

a rebuttal brief has expired. See MPEP 2678. Since an examiner's answer has not been mailed in the '087 proceeding, jurisdiction clearly has not yet passed to the Board.

For this reason, jurisdiction over the proceeding is before the Office of Patent Legal Administration for the purposes of addressing the May 16, 2008 requester request for reconsideration of the March 13, 2008 decision dismissing requester's petition under 37 CFR 1.183, and the May 21, 2008 patent owner opposition to this request for reconsideration.[3]

The May 16, 2008 Requester Request for Reconsideration is Timely

The time period for response to a decision dismissing a petition under 37 CFR 1.183 is governed by 37 CFR 1.181(f), unless another time period is set in the decision. Since no time period was set in the March 13, 2008 decision dismissing requester's petition under 37 CFR 1.183, any request for reconsideration of the March 13, 2008 decision must be filed no later than May 13, 2008, which is within two months from the mail date of the March 13, 2008 decision, pursuant to 37 CFR 1.181(f).

The May 16, 2008 requester request for reconsideration is accompanied by a certificate of mailing under 37 CFR 1.8,[4] indicating that it was deposited with the United States Postal Service as first class mail, addressed to the Office, on May 13, 2008, which is within the required time period for reply under 37 CFR 1.181(f).

For the reasons given above, the May 16, 2008 requester request for reconsideration is timely filed.

Analysis

The requester urges "that the [March 13, 2008] Decision Dismissing Petition . . . be vacated and that the matter [i.e., the nonentry of the La Loggia declaration] be submitted to the Primary Examiner." The primary examiner, however, has issued a nonfinal Office action, mailed on May 27, 2008, addressing the nonentry of the La Loggia declaration and reopening prosecution in the '087 proceeding.

For this reason, the May 16, 2008 requester request for reconsideration is **dismissed as moot**, and consequently, the May 21, 2008 patent owner opposition is also **moot**.

CONCLUSION

- The May 16, 2008 requester request for reconsideration of the March 13, 2008 decision dismissing requester's petition under 37 CFR 1.183 is **dismissed as moot**. Accordingly, the May 21, 2008 patent owner opposition filed in response to the May 16, 2008 requester request for reconsideration is **moot**.

---

[3] See paragraph no. 2 of the conclusion found on page 11 of the March 13, 2008 decision.
[4] See the bottom of page 3 of the May 16, 2008 requester request for reconsideration.

- Jurisdiction over the '087 proceeding is being forwarded to the examiner to await any response to the May 27, 2008 nonfinal Office action.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,087	04/05/2005	6528666	515-4232	1171

7590 12/31/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/31/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date: MAILED

DEC 3 1 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000087
PATENT NO. : 6528666
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,087
Filed: April 5, 2005
For: US Patent No. 6,528,666

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.956]

This is a decision on the petition filed December 19, 2008 to request a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Action Closing Prosecution (ACP) mailed December 5, 2008.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution (ACP) dated December 5, 2008, which set a one-month date for filing a response thereto. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(g).

37 CFR 1.956 (c) states:

> (c) The time for taking any action by a patent owner in an *inter 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 1.956 to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2665 states, in pertinent part:

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314 (c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor.

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

The petition for extension of time states that the Office action of December 5, 2008 is extensive and includes new references in support of the Examiner's position. The action has been transmitted to Patent Owner, located in Portugal. The Patent Owner will be closed from December 24, 2008 through January 4, 2009 which is nearly half of the shortened time period for response. Additional time is necessary to fully assess the merits of the rejections and to prepare a complete response.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a <u>one-month</u> extension of time in which to file a response to the Office action. Accordingly, the response is due February 5, 2009. Patent Owner should expect that future requests for extensions will not be

granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for a one-month extension of time in which to file a response to the Office action of December 5, 2008 is **GRANTED**.

2. The Patent Owner's response is due February 5, 2008.

3. Response may be submitted as follows:

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

By Mail to: Mail Stop *Ex Parte* Reexam
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By Fax to: (571) 273-9900
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4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

for Deborah Jones
Gregory Morse,
Director, Central Reexamination Unit

mai

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(For Requester)

MAILED
NOV 28 2005
REEXAM UNIT

In re Microunity Systems Engineering, Inc.
Reexamination Proceeding
Control No.: 95/000,089
Filed: April 15, 2005
For: U.S. Patent No. 6,643,765 B1

: DECISION ON PETITION
: ALLEGING *ULTRA VIRES*
: ACTION AND REQUESTING
: WITHDRAWAL OF REJECTION

This is a decision on the October 3, 2005 patent owner petition under 37 CFR 1.183 for certain specified relief on the basis that the examiner's Office action rejecting claims 1-30 of U.S. Patent 6,643,765 (the '765 patent) is asserted to constitute an *ultra vires* action beyond the statutory and regulatory authority of an examiner during reexamination.

The relief requested by patent owner is that (1) certain statements regarding entitlement of the '765 patent to 35 U.S.C. §120 benefit of prior United States be patent 6,295,599 (the '599 patent) be stricken from the June 1, 2005, Office action, (2) the mailing date of the action be reset, and (3) a particular ground of rejection in the Office action dated June 1, 2005, be withdrawn because it is improper.

As all of the relief requested appears to be a request for the exercise of the supervisory authority of the Director of the United States Patent and Trademark Office, and inasmuch as patent owner does not identify any specific regulation for which suspension or waiver is requested, the petition is being treated under 37 CFR 1.181. Therefore, no petition fee is required.

As the patent owner petition is directed to a jurisdictional challenge, it is before the Office of Patent Legal Administration for decision.

SUMMARY

The petition is dismissed as to all relief requested, for the reasons set forth below.

REVIEW OF FACTS

1. The '765 patent issued on November 4, 2003.

2. A request for reexamination of the '765 patent was filed on April 15, 2005. The request was assigned control No. 95/000,089 (the '089 reexamination proceeding).

3. Reexamination was ordered for the '089 proceeding on June 1, 2005.

4. A first Office action rejecting claims 1-30, *i.e.* all of the patent claims, was mailed on June 1, 2005. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. In response to a timely filed petition and supplemental petition for extension of time by patent owner, a two month extension of time for filing a response to the June 1, 2005 Office action was granted on July 19, 2005.

6. A supplemental petition requesting an additional extension of time was filed on August 29, 2005.

7. A decision denying the additional extension of time was mailed on September 21, 2005.

8. A timely response to the June 1, 2005 Office action was filed by the patent owner on October 3, 2005, a Monday.

9. Also on October 3, 2005, the patent owner filed the instant petition.

DECISION

35 U.S.C. § 311 states, in part:

> "(a) IN GENERAL. - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301."

35 U.S.C. § 312 states, in part:

> "(a) REEXAMINATION. - Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

MPEP § 2646, Part I, states, in part:

> "A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where <u>no discretion</u> to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> "(A) the reexamination order is not based wholly on prior art patents or printed publications;
> (B) reexamination is prohibited under 37 CFR 1.907;
> (C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
> (D) reexamination was ordered for the wrong patent;

(E) reexamination was ordered based on a duplicate copy of the request; or
(F) the reexamination order was based **wholly** on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g. the application which matured into the patent, a prior reexamination, an interference proceeding)."

The Order Granting Reexamination Was Not An *Ultra Vires* Action

The question of whether an order granting reexamination is based upon the grounds permitted by 35 U.S.C. §§ 311 and 312 is a question of whether the Office has jurisdiction to order reexamination. As discussed in MPEP § 2246, if an order granting a request for reexamination is based **wholly** upon consideration of subject matter that is not permitted by the statute, then the granting of the request for reexamination is outside of the jurisdiction of the Office and is an *ultra vi*res action on the part of the Office. However, a substantive determination to order reexamination based upon grounds permitted by the statute is not subject to judicial review [1]

The request for reexamination, filed on April 15, 2005, cited numerous patents and printed publications upon which requester asserted more than thirty different grounds for finding a substantial new question of patentability. One of the cited publications is identified as the Ide *et al* publication. [2] The Ide *et al* publication date, March 1993, is a date earlier than the earliest date recited in the benefit claim of the '356 patent. The Ide *et al* publication was not of record during the original examination of the application that matured into the '356 patent. The examiner's order granting reexamination held that the Ide *et al* publication raised a substantial new question of patentability with respect to claims 18-48. [3] The examiner therefore granted the request for reexamination. [4] Pursuant to 35 U.S.C. § 313 [5] and MPEP § 2643, [6] the examiner ordered reexamination of all patent claims. A first action on the merits, (i.e., an action discussing the patentability of all patent claims), was mailed concurrently with the order granting reexamination. [7]

The order granting *inter partes* reexamination, having been based upon a prior art publication that raised a substantial new question of patentability with respect to one or more of the '356 patent claims, was a proper exercise of the jurisdiction conferred upon the Office by 35 U.S.C. §§ 311 and 312. Patent owner has not advanced any rationale for holding that the order for reexamination was based upon subject matter outside of the jurisdiction conferred upon the

---

[1] *Heinl v. Godici*, 143 F. Supp. 2d 593 (E.D. VA. 2001); *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35 (D.D.C. 1998)
[2] A 320-MFLOPS CMOS Floating-Point Processor Unit for Superscalar Processors, IEEE Journal of Solid State Circuits, Vol. 28, No. 3, published March 1993.
[3] The '765 patent contains claims 1-30.
[4] See Order Granting Reexamination dated June 1, 2005, at pages 2-3.
[5] The statute states: "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes **reexamination of the patent** for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314." (Emphasis supplied.)
[6] MPEP § 2643 states in pertinent part: "If a substantial new question of patentability is found as to any claim, reexamination will be ordered and will normally cover all claims except for claims that have been finally held invalid in a Federal Court decision on the merits."
[7] 35 U.S.C. § 313 states: "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314."

Office by the reexamination statutes. Therefore, it is held that the examiner's order granting reexamination was not an *ultra vires* act on the part of the Office.

No Ground Of Rejection Set Forth In The Examiner's First Office Action Is Subject to Review by Petition

35 U.S.C. 315 states, in part:

> "(a) PATENT OWNER-- The patent owner involved in an *inter partes* reexamination proceeding under this chapter—
> (1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim; and
> (2) may be a party to any appeal taken by a third-party requester under subsection (b)."

37 CFR 1.959 states, part:

> "(a) Upon the issuance of a Right of Appeal Notice under § 1.953, the patent owner involved in an inter partes reexamination proceeding may appeal to the Board of Patent Appeals and Interferences **with respect to the final rejection of *any* claim of the patent** by filing a Notice of Appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b)." (Emphasis supplied.)

37 CFR 41.61 states, in part:

> "(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1)."

37 CFR 1.181states, part:

> "Petition may be taken to the Director:
> (a)(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court."

The relief requested by patent owner is that the following statements of the examiner set forth in the Office action dated June 1, 2005 [8] be stricken from the Office action:

1. Parent United States Patent 6,295,599 (the '599 patent) does not support the claims of the '765 patent; and

2. The claims of the '765 patent to are not entitled to 35 U.S.C. § 120 benefit of the '599 patent.

Patent owner further requests that an allegedly improper rejection of patent claims 1-30 in view of the combination of Hansen et al [9] and the Ide *et al* publication be withdrawn as exceeding the statutory and regulatory authority of an examiner during reexamination, and that the mailing date of the Office action be reset.

The first Office action dated June 1, 2005, in fact contains numerous grounds of rejection, and all of the patent claims stand rejected over patents and/or publications other than the Hansen *et al*

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[8] Pursuant to 37 CFR 1.935 and MPEP § 2660, the first Office action the merits, *i.e.*, on the patentability of the claims of the '765 patent, was mailed together with the order granting reexamination.
[9] PCT Publication No. WO 97/07450, published February 27, 1997.

and Ide *et al* publications. [10] Notwithstanding patent owner's attempt to cast both the rejection based upon Hansen *et al* and Ide *et al*, and the rationale set forth by the examiner in support of that rejection, as being *ultra vires* acts exceeding the examiner's authority in an *inter partes* reexamination proceeding, the record reveals that the rejection in question is simply one of a number of rejections set forth in the June 1, 2005 Office action. As discussed, *infra*, the question of whether the rejection based upon Hansen *et al* and Ide *et al* is legally correct must be addressed on appeal, and not by petition.

Patent owner's belief that the rejection based upon the Hansen *et al* and Ide *et al* publications is legally impermissible in this proceeding does not convert the examiner's promulgation of the rejection into a question of the examiner's jurisdiction to take a particular action, thereby creating a petition right to contest the propriety of taking that action. 37 CFR 1.181(a)(1) permits petitions **only** from matters that are not subject to appeal to the Board of Patent Appeals and Interferences ("Board"). In terms of determining the propriety of a particular ground of rejection in an *inter partes* reexamination proceeding, the statutes and regulations make no distinction between a ground of rejection based upon anticipation or nonobviousness and a ground of rejection that allegedly violates 35 U.S.C. § 312(a) (because it is alleged to be based upon grounds other than the application of prior art patents and printed publications). The jurisdiction to determine that any particular ground of rejection is or is not legally correct resides <u>with the Board</u>. [11] Patent owner has not demonstrated that any ground of rejection currently of record in this proceeding **could not** ultimately be appealed to the Board. Rather, it appears that **any** rejection maintained and made final by the examiner issuing a Right of Appeal Notice [12] in this proceeding, may then be appealed to the Board. The Board will then have jurisdiction to determine whether any appealed rejection is or is not legally correct.

It should be noted that even if patent owner ultimately appeals a particular ground of rejection in this proceeding, and successfully demonstrates that the rejection and supporting rationale are legally incorrect because they are based upon matters outside of the scope of the reexamination statutes and regulations, [13] this would not mean that the rejection and supporting rationale should have been treated as petitionable *ultra vires* actions in the sense that the Office lacked jurisdiction to order reexamination of the '356 patent and promulgate rejections during that proceeding. Instead, the rejection would simply be considered to be a legally incorrect rejection in a reexamination proceeding in which, for the reasons set forth above, the Office had clear jurisdiction to order reexamination.

In a reexamination proceeding that is not itself *ultra vires*, because the Office did in fact have jurisdiction to order reexamination, patent owner's remedy with respect to any rejection and supporting rationale believed to be erroneous, is to appeal in accordance with the statutes, and regulations that establish and implement the right to appeal rejections in *inter partes* reexamination proceedings. In this regard, it should be noted that the decision in *Patlex Corporation v. Quigg*, 680 F. Supp. 33, (D.D.C. 1988), was a decision **on appeal from a decision of the PTO Board of Appeals and Interferences,** and not a decision reviewing an adverse decision

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[10] See Office action dated June 1, 2005, pages 18-24, 34-35, and 38-47.

[11] See 35 U.S.C. § 315; see also 37 CFR 1.959 and 41.61.

[12] See 37 CFR 1.953.

[13] This decision expresses no view on the rejection and rationale complained of by patent owner, since the question of the propriety of the rejection in question is proper for appeal, and therefore is not proper for petition. Accordingly, this decision expresses no opinion regarding the propriety of reexamining a 35 USC §120 benefit claim in an *inter partes* reexamination proceeding, or upon patent owner's position vis-à-vis MPEP § 2167 (*sic*, 2617)

on petition. [14] Where, as in *Patlex* and as here, the order granting reexamination has not been shown to have been an *ultra vires* action on the part of the Office, thereby depriving the Office of jurisdiction to reexamine, the propriety of a rejection alleged to be based upon subject matter not proper for consideration in reexamination is properly determined by appeal, and not by way of petition.

Finally, it is acknowledged that this petition as filed was styled as a petition pursuant to 37 CFR 1.183, but has been treated as a petition under 37 CFR 1.181 for the exercise of the Director's general supervisory authority. [15] However, even if the instant petition could properly be construed as a petition to waive or suspend the provisions of 37 CFR 1.181(a)(1) [16], it does not appear that patent owner has established that the instant petition addresses an extraordinary situation in which justice requires waiver or suspension of that regulation. It is immediately apparent that the patent owner has resort to the Board in an effort to ultimately prevail on the merits of whether the examiner's rejection is tenable under the provisions of the *inter partes* reexamination statute. Thus, this situation, in which claims have allegedly been improperly rejected based upon allegedly improper rationales, does not present an extraordinary circumstance where review is needed by petition (based on a lack of any other available relief). Rather, the circumstance is familiar in examination and reexamination proceedings before the Office, and routine appeal procedures are in place to provide relief where appropriate.

CONCLUSION

1. The patent owner petition under 37 CFR 1.181 to strike [17] the rejection and its supporting rationale based upon the Hansen *et al* and Ide *et al* patents, as set forth in the June 1, 2005 Office action, is dismissed.

2. No statement by the examiner regarding entitlement of the '765 patent to benefit of the '599 patent will be stricken because such statements are part of the rationale supporting the rejection that will not be stricken.

3. The date of the June 1, 2005 Office action will not be reset, since patent owner is not entitled to have any portion of that action stricken. Further, the examiner will not be directed to state in a new or revised Office action that Hansen *et al* is not available as prior art, because that statement is part of the appealable rejection that will not be stricken.

4. To the extent that patent owner regards the petition as having been filed under 37 CFR 1.183 to waive or suspend the provisions of 37 CFR 1.181(a)(1) which preclude relief by way of petition on matters subject to appeal, patent owner has not demonstrated that this matter presents an extraordinary situation in which justice requires waiver or suspension of the 37 CFR 1.181(a), or of any other regulation.

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[14] In *Patlex*, reexamination had been order based upon five substantial new questions of patentability. See *Patlex*, at page 35.
[15] See page 1, third paragraph of this decision.
[16] As noted at page 1 of this decision, patent owner did not identify any specific regulation(s) for which waiver or suspension was requested.
[17] As being an *ultra vires* action on the part of the Office

5. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to either await the filing of any party papers if the time for filing same has not expired, or to process any and all party papers if there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

6. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, to Elizabeth L. Dougherty, Senior Legal Advisor at (571) 272-7733.

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

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November 28, 2005

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

HAYNES AND BOONE LLP
IP SECTION
2323 VICTORY AVENUE
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(For Third Party Requester)

In re: Hansen *et alia*	:
Inter Partes Reexamination Proceeding	: DECISION ON PETITION
Control No. 95/000,089	: FILED UNDER 37 CFR 1.181
Request Deposited: April 15, 2005	:
For: U.S. Patent No. 6,643,765	:

This is a decision on the December 5, 2008, patent owner petition entitled "PETITION FOR SUPERVISORY AUTHORITY UNDER 37 CFR §1.181" requesting the "RAN be withdrawn and a new Action Closing Prosecution ("ACP") be issued by the examiner."

The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR §1.181 and no fee is required.

For the reasons set forth below, the patent owner petition is **DISMISSED** with respect to the underlying relief requested.

BACKGROUND

1. U.S. patent No. 6,643,765 ("the '765 patent") issued to Hansen *et alia* on November 3, 2003.

2. On April 15, 2005, an *inter partes* request for reexamination of the '765 patent, assigned control No. 95/000,089 ("the '089 proceeding"), was filed by a third party requester (3PR).

3. On June 1, 2005, the Office issued an order granting the request for *inter partes* reexamination, and an accompanying Office action.

4. On March 2, 2006, the Office issued an Action Closing Prosecution (ACP).

5. On November 5, 2008, the Office issued a Right of Appeal Notice (RAN).

6. On December 5, 2008, a Notice of Appeal and the present petition were filed.

DECISION

I. Background:

The Hansen PCT is an intervening reference that is applied in a 35 USC §103 rejection. At issue is whether the claims in the '599 patent are entitled to a date which predates the Hansen PCT reference. During prosecution, PO has alleged that support can be found in an appendix that was submitted in application number 09/382,402, which matured in US Patent Number 6,295,599 (a parent to the '765 patent). The appendix was referenced as follows when the application was filed:

SPECIFICATION

+SU **Microfiche Appendix**

Included herewith as an Appendix are 5 sheets of microfiche of ~~63 frames each.~~ 309

+SP **Related Applications**

This application is related to Provisional Application No. 60/097;635, filed August 24, 1998, and is a continuation in part of U.S. Patent Application No. 09/169,963, filed October 13, 1998 which is in turn related to U.S. Patent Application No. 08/516,036, filed August 16, 1995, now U.S. Patent No. 5,742,840.

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II. Patent Owner Petitioner's Position:

The Patent Owner (PO) argues that "THE MPEP §608 REJECTION IS NEW" in the RAN. Specifically, PO alleges "the PTO never linked the §103 rejection to the procedural requirements set forth in MPEP §608.01(p) or MPEP §608.05 or the PTO's new contention that the '599 Appendix filed with the '599 patent is not part of the '599 disclosure." PO alleges that the office considered the Appendix to part of the disclosure earlier in prosecution but has changed that position in the RAN.

III. Analysis and Findings

In the non-final office action of June 1, 2005, claims 1-30 were rejected under 35 USC 103 as unpatentable over Hansen in view of IDE as indicated on page 10, paragraph numbered 23. The office took a two-prong approach to the issue of claim support in the application that matured into the '599 patent. Specifically, the action notes that the appendix was not incorporated by reference into the specification. Then, the action contends that even if the appendix had been incorporated by reference, the claims would still not have support. See especially, pages 5 and 6, "Additionally, although it was never incorporated by reference into the specification of parent patent 6,295,599, the appendix supplied with the specification of parent patent 6,295,599 was also reviewed to determine if it provided written description and enablement as required by 35 USC § 112 for the above claimed feature..." and page 8, "Additionally, the appendix to parent patent 6,295,599 was reviewed, even though it was never incorporated by reference into the specification of parent patent 6,295,599." Each of these quotations is followed by a discussion of the office's position that even if the appendix was part of the specification, there would still not be support for the claimed subject matter of the '765 patent in the application that matured into the '599 patent. In no way can this be construed as a concession that the office thinks the appendix was part of the specification, it is merely additional support for the office's position that the claims of the '765 patent do not have support in the application that matured into the '599 patent.

In the ACP, the rejection of claims 1-30 under 35 USC 103 as unpatentable over Hansen in view of IDE was maintained at page 2, paragraph numbered 3. The office continues with the position that claims of the '765 patent do not have support back to the filing date of the application that matured into the '599 patent. Pages 5 and 6 outline why the appendix was improper:

> "Patent owner is reminded that as per MPEP § 608.05 and 37 CFR § 1.96 which was in effect at the time of filing of the '599 patent application (see MPEP 7th edition), the only mention of an appendix to a patent specification was to deposit a lengthy computer program listing.
>
> 37 CFR 1.96 Submission of computer program listings.

> (c) As an appendix which will not be printed. If a computer program listing printout is eleven or more pages long, applicants must submit such listing in the form of microfiche, referred to in the specification (see Section 1.77(a)(6)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" must be made at the beginning of the specification at the location indicated in Section 1.77(a)(6). Any amendments thereto must be made by way of revised microfiche.
>
> No Other material at that time was permitted to form part of an appendix. In the case of patent '599, the appendix clearly contains material which is not a computer program listing. Accordingly, the '599 patent appendix is an improper appendix."

This section is again followed by a discussion of the office's position that even if the appendix was part of the specification, there would still not be support for the claimed subject matter of the '765 patent in the application that matured into the '599 patent. Although the office acknowledges that the material was submitted as of the filing date of the application that matured into the '599 patent, in no way can this be construed as a concession that the office thinks the appendix was part of the specification. The discussion of how the '599 appendix does not provide written description support for the claimed subject matter of the '765 patent is merely additional support for the office's position that the claims of the '765 patent do not have support in the application that matured into the '599 patent.

In the RAN, the rejection of claims 1-30 under 35 USC 103 as unpatentable over Hansen in view of IDE ("Ground 1") was maintained at page 4. The office continues with the position that claims of the '765 patent do not have support back to the filing date of the application that matured into the '599 patent. Specifically, on pages 7 and 8, the RAN states:

> "However, as discussed further below, the information in the appendix of the '599 Patent was not expressly incorporated by reference into the specification of the '599 Patent. Thus, the information in the appendix would not be considered as being part of the specification. Because of this, the inclusion of this matter within the later filed '765 Patent would be considered as adding new matter in the '765 Patent."

The USPTO has consistently rejected the relevant claims under 35 USC 103 as unpatentable over Hansen in view of IDE across these three office actions. It should be noted that whether or not the rejection is proper (i.e. whether or not the claims have support back to a date which predates the Hansen PCT reference) is not addressed in this decision as that is an appealable issue.

Patent owner has requested an oral hearing on this matter (page 11). While 37 CFR 1.181 permits the USPTO to decide that an oral hearing on a petition is necessary, that is a decision for the agency and not for the petitioner. A review of the record and the circumstances of this

case shows that such a hearing is not necessary. Accordingly, it is unnecessary to decide if the rule barring interviews on the merits in *inter partes* reexaminations also bars oral hearings on *inter partes* reexamination petitions. No oral hearing has been conducted on this matter.

As rejections are based on statutes or (in situations not relevant here) judicial doctrines rather than sections of the Manual of Patent Examining Procedure, reference to or reliance on an MPEP section does not constitute a new ground of rejection. As claims 1-30 have been rejected under 35 USC 103 as unpatentable over Hansen in view of IDE in each of the three relevant actions, the RAN will not be withdrawn.

In view of the above, the petition is **DISMISSED**.

CONCLUSION

1. Patent Owner's request to find the RAN mailed November 5, 2008 premature is **dismissed**.

2. **All** correspondence relating to this *inter partes* 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 *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

By hand: 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.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

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

Gregory Morse
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,089	04/15/2005	6643765	33142.12	2037

7590 03/06/2009

EXAMINER

Leonard Guzman
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600 13th Street N. W.
Washington, DC 20005-3096

ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 06 2009
CENTRAL REEXAMINATION UNIT

In re *Inter Partes* Reexamination Proceeding	:	DECISION
Control No. 95/000,089	:	DISMISSING
Filed: April 15, 2005	:	PETITION
For: U.S. Patent No. 6,643,765	:	

This is a decision on the January 6, 2009 patent owner petition entitled "Petition to Suspend Rule 37 C.F.R. § 1.943(c) Pursuant to the Provisions of 37 C.F.R. § 1.183)."

The petition and *inter partes* reexamination control number 95/000,089 are before the Office of Patent Legal Administration for decision on the petition.

FEES

Petitioner has authorized a charge of the required $400.00 fee (37 CFR 1.17(f)) for a 37 CFR 1.183 petition to Deposit Account No. 50-0417.

REVIEW OF FACTS

1. United States Patent Number 6,643,765 ("the '765 patent") issued on November 4, 2003.

2. A request for *inter partes* reexamination of the '765 patent was filed on April 15, 2005, by a third party requester. The request was assigned Reexamination Control Number 95/000,089 (the '089 reexamination proceeding").

3. On June 1, 2005, the Office mailed, in the '089 reexamination proceeding, an order for *inter partes* reexamination and a non-final Office action.

4. The proceeding progressed to the point where, on November 5, 2008, the Office issued a Right of Appeal Notice (RAN).

5. On December 5, 2008, patent owner filed a Notice of Appeal and a petition under 37 CFR 1.181 requesting that the RAN be withdrawn and a new Action Closing Prosecution be issued.

6. On January 6, 2009, the patent owner filed the present petition requesting waiver of the provisions of 37 CFR 1.943(c) to the extent that patent owner be permitted to file an appeal brief that would be no more than 50 pages in length.

7. On February 3, 2009, the Office mailed a decision dismissing the December 5, 2008 petition under 37 CFR 1.181.

8. On February 5, 2009, patent owner filed an appeal brief. The appeal brief was accompanied by a certificate stating that the brief contained 13,998 words, including the table of contents but excluding the parts of the appeal brief exempted by 37 CFR 1.943(c).

9. On February 6, 2009, patent owner filed a supplemental appeal brief. Appellant states that the supplemental appeal brief is submitted in ratification of the appeal brief filed on February 5, 2009. The supplemental appeal brief includes the signature of appellant's representative at the conclusion of the appellant's arguments in the brief, which appellant states was inadvertently omitted in the appeal brief filed February 5, 2009.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

DECISION

The record shows that on November 5, 2008, the Office mailed a Right of Appeal Notice (RAN). On December 5, 2008, patent owner filed a notice of appeal. On January 9, 2009, patent owner filed the instant petition requesting waiver of the provisions of 37 CFR 1.943(c) to the extent that patent owner be permitted to file an appeal brief that would be no more than 50 pages in length. The Office took no action on the petition prior to the due date for patent owner to file its appeal brief.

The record further shows that patent owner filed an appeal brief on February 5, 2009, the last day of the period for such appeal brief. The appeal brief filed by patent owner was accompanied by a certificate stating that the brief contained 13,998 words, including the table of contents but excluding the parts of the appeal brief exempted by 37 CFR 1.943(c). Therefore, the appeal brief complies with the provisions of 37 CFR 1.943(c). The supplemental appeal brief filed February 6, 2009, ratified the appeal brief filed February 5, 2009.

In the present '089 reexamination proceeding, the patent owner has timely filed an appeal brief that complies with 37 CFR 1.943(c). Accordingly, the January 6, 2009 patent owner petition seeking waiver of the provisions of 37 CFR 1.943(c) is moot.

CONCLUSION

1. The patent owner petition filed on January 6, 2009 is dismissed as moot.

2. Jurisdiction is being transferred to the Central Reexamination Unit for appropriate action on the proceeding by the examiner in due course.

3. Telephone inquiries related to this decision should be directed to the Eugenia Jones, Senior Legal Advisor, at (571) 272-7727, or in her absence, to the undersigned, at (571) 272-7710.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,089	04/15/2005	6643765	33142.12	2037

7590 06/18/2010

EXAMINER

Leonard Guzman
MCDERMOTT WILL & EMERY LLP
600 13th Street N. W.
Washington, DC 20005-3096

ART UNIT	PAPER NUMBER

DATE MAILED: 06/18/2010

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
HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue, Suite 700
AUSTIN, TX 75219

Date:

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JUN 1 8 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000089
PATENT NO. : 6643765
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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CENTRAL REEXAMINATION UNIT

Leonard Guzman
MCDERMOTT WILL & EMERY LLP
600 13th Street N. W.
Washington DC 20005-3096

(For Patent Owner)

HAYNES AND BOONE LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

In re: Hansen *et alia*	: DECISION ON PETITION
Inter Partes Reexamination Proceeding	: FOR RECONSIDERATION
Control No. 95/000,089	: OF DECISION DISMISSING
Request Deposited: April 15, 2005	: PETITION TO WITHDRAW
For: U.S. Patent No. 6,643,765	: RIGHT OF APPEAL NOTICE

This is a decision on the April 4, 2009, patent owner petition entitled "PETITION FOR RECONSIDERATION OR ALTERNATIVELY FOR SUPERVISORY AUTHORITY UNDER 37 CFR §1.181" requesting the "reopening of prosecution...as the Right of Appeal Notice of November 5, 2008 ("RAN") should be revoked as untimely because it substantially modifies positions previously taken by the office".

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

For the reasons set forth below, the patent owner petition is **DISMISSED** with respect to the underlying relief requested.

BACKGROUND

1. U.S. patent No. 6,643,765 ("the '765 patent") issued to Hansen *et alia* on November 3, 2003.

2. On April 15, 2005, an *inter partes* request for reexamination of the '765 patent, assigned control No. 95/000,089 ("the '089 proceeding"), was filed by a third party requester (3PR).

3. On June 1, 2005, the Office issued an order granting the request for *inter partes* reexamination, and an accompanying Office action.

4. On March 2, 2006, the Office issued an Action Closing Prosecution (ACP).

5. On November 5, 2008, the Office issued a Right of Appeal Notice (RAN).

6. On December 5, 2008, a Notice of Appeal and petition requesting the RAN be withdrawn were filed.

7. On February 3, 2009, the petition requesting the RAN be withdrawn was dismissed.

8. On April 3, 2009, the present petition was filed.

DECISION

Initially, it is noted that the petition of April 3, 2009 seeks review in the alternative.

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

It appears that the petition primarily urges a reconsideration of their previous petition, whose arguments are incorporated into the present petition, in combination with new arguments and positions set forth in the present petition. This appears to be the thrust of the present petition and such issues are addressed in this decision.

To the extent that Patent Owner "alternatively petitions" for supervisor authority with respect to the decision rendered on February 3, 2009, said request is dismissed under 37 CFR 1.4(c) since that different matter is considered by a different branch or section of the office.

I. Background:

The Hansen PCT is an intervening reference that is applied in a 35 USC §103 rejection. At issue is whether the claims in the '599 patent are entitled to a date which predates the Hansen PCT reference. During prosecution, PO has alleged that support can be found in an appendix that was submitted in application number 09/382,402, which matured in US Patent Number 6,295,599 (a parent to the '765 patent). The appendix was referenced as follows when the application was filed:

SPECIFICATION

+SU **Microfiche Appendix**

Included herewith as an Appendix are 5 sheets of microfiche of ~~63 frames each.~~ 309

+SP **Related Applications**

This application is related to Provisional Application No. 60/097,635, filed August 24, 1998, and is a continuation in part of U.S. Patent Application No. 09/169,963, filed October 13, 1998 which is in turn related to U.S. Patent Application No. 08/516,036, filed August 16, 1995, now U.S. Patent No. 5,742,840.

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II. Patent Owner Petitioner's Position:

The Patent Owner (PO) argues (by virtue of incorporating the petition of December 5, 2008 into the present petition) that "THE MPEP §608 REJECTION IS NEW" in the RAN. Specifically, PO alleges "the PTO never linked the §103 rejection to the procedural requirements set forth in MPEP §608.01(p) or MPEP §608.05 or the PTO's new contention that the '599 Appendix filed with the '599 patent is not part of the '599 disclosure." PO alleges that the office considered the Appendix to part of the disclosure earlier in prosecution but has changed that position in the RAN.

PO newly argues in the present petition that the first office action of June 1, 2005 did not take the position "that lack of incorporation by reference lead to defeat of the claim to priority". Instead, PO argues that the only analysis made by the first office action implied that the office considered the appendix incorporated by reference, but the appendix did not provide 112 support. PO also argues that the "ACP likewise contains no statements by the Examiner indicating that a lack of incorporation by reference destroyed Patent Owner's claim of benefit to priority". To support those arguments, PO cites to various portions of the actions that present the examiner's position that, if the appendix was incorporated by reference, the appendix would not provide 112 support for the 120 priority claim.

III. Analysis and Findings

In the non-final office action of June 1, 2005, claims 1-30 were rejected under 35 USC 103 as unpatentable over Hansen in view of IDE as indicated on page 10, paragraph numbered 23. The office took a two-prong approach to the issue of claim support in the application that matured into the '599 patent. Specifically, the action notes that the appendix was not incorporated by reference into the specification. Then, the action contends that even if the appendix had been incorporated by reference, the claims would still not have support. See especially, pages 5 and 6, "Additionally, although it was never incorporated by reference into the specification of parent patent 6,295,599, the appendix supplied with the specification of parent patent 6,295,599 was also reviewed to determine if it provided written description and enablement as required by 35 USC § 112 for the above claimed feature..." and page 8, "Additionally, the appendix to parent patent 6,295,599 was reviewed, even though it was never incorporated by reference into the specification of parent patent 6,295,599."

However, the main analysis on pages 6-8 regarding the written description support is based on the examiner's position that the appendix was **not** incorporated by reference to be part of the specification. The analysis outlines all nine times that the term "floating point" was used in the specification of parent patent 6,295,599. The appendix is over 300 pages in length and uses the term many dozens (if not hundreds) of times. So, the examiner's analysis of all nine instances of the term "floating point" in the specification of the '599 patent is based on the examiner's assertion that the appendix is not incorporated by reference to be part of the specification.

Petitioner's quotations taken from the office action that include an analysis of the alternate position (that even if the appendix had been incorporated by reference, it still would not provide written description support) can not be read in a vacuum. They must be read in the context that it is an alternate analysis to the examiner's main position that the appendix was not incorporated by reference to be part of the specification.

Therefore, petitioner's argument that the office first took the position that the appendix was not incorporated by reference into the specification in the RAN is not persuasive because the examiner took this position in the first office action.

In the ACP, the rejection of claims 1-30 under 35 USC 103 as unpatentable over Hansen in view of IDE was maintained at page 2, paragraph numbered 3. The office continues with the position that claims of the '765 patent do not have support back to the filing date of the application that matured into the '599 patent. Pages 5 and 6 outline why the appendix was improper:

> "Patent owner is reminded that as per MPEP § 608.05 and 37 CFR § 1.96 which was in effect at the time of filing of the '599 patent application (see MPEP 7th edition), the only mention of an appendix to a patent specification was to deposit a lengthy computer program listing.

> 37 CFR 1.96 Submission of computer program listings.
>
> (c) As an appendix which will not be printed. If a computer program listing printout is eleven or more pages long, applicants must submit such listing in the form of microfiche, referred to in the specification (see Section 1.77(a)(6)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" must be made at the beginning of the specification at the location indicated in Section 1.77(a)(6). Any amendments thereto must be made by way of revised microfiche.
>
> No Other material at that time was permitted to form part of an appendix. In the case of patent '599, the appendix clearly contains material which is not a computer program listing. Accordingly, the '599 patent appendix is an improper appendix."

It seems clear from the record that the examiner has taken the position that an improper appendix is not part of the specification. However, for arguments sake, this section is again followed by a discussion of the office's position that even if the appendix was part of the specification, there would still not be support for the claimed subject matter of the '765 patent in the application that matured into the '599 patent. Although the office acknowledges that the material was submitted as of the filing date of the application that matured into the '599 patent, in no way can this be construed as the office taking the position that the appendix was part of the specification. The discussion of how the '599 appendix does not provide written description support for the claimed subject matter of the '765 patent is merely additional support for the office's position that the claims of the '765 patent do not have support in the application that matured into the '599 patent.

Petitioner's quotations taken from the ACP that include an analysis of the alternate position (that even if the appendix had been incorporated by reference, it still would not provide written description support) can not be read in a vacuum. They must be read in the context that it is an alternate analysis to the examiner's main position that the appendix was not incorporated by reference to be part of the specification.

Therefore, petitioner's argument that the office first took the position that the appendix was not incorporated by reference into the specification in the RAN is not persuasive because the examiner took this position in the first office action and the ACP.

In the RAN, the rejection of claims 1-30 under 35 USC 103 as unpatentable over Hansen in view of IDE ("Ground 1") was maintained at page 4. The office continues with the position that claims of the '765 patent do not have support back to the filing date of the application that matured into the '599 patent. Specifically, on pages 7 and 8, the RAN states:

> "However, as discussed further below, the information in the appendix of the '599 Patent was not expressly incorporated by reference into the specification of the '599 Patent. Thus, the information in the appendix would not be considered as being part

of the specification. Because of this, the inclusion of this matter within the later filed '765 Patent would be considered as adding new matter in the '765 Patent."

The USPTO has consistently rejected the relevant claims under 35 USC 103 as unpatentable over Hansen in view of IDE across these three office actions. It should be noted that whether or not the rejection is proper (i.e. whether or not the claims have support back to a date which predates the Hansen PCT reference) is not addressed in this decision as that is an appealable issue.

Patent owner has requested an oral hearing on this matter (page 9). While 37 CFR 1.181 permits the USPTO to decide that an oral hearing on a petition is necessary, that is a decision for the agency and not for the petitioner. A review of the record and the circumstances of this case shows that such a hearing is not necessary. Accordingly, it is unnecessary to decide if the rule barring interviews on the merits in *inter partes* reexaminations also bars oral hearings on *inter partes* reexamination petitions. No oral hearing has been conducted on this matter.

As rejections are based on statutes or (in situations not relevant here) judicial doctrines rather than sections of the Manual of Patent Examining Procedure, reference to or reliance on an MPEP section does not constitute a new ground of rejection. As claims 1-30 have been rejected under 35 USC 103 as unpatentable over Hansen in view of IDE in each of the three relevant actions, the RAN will not be withdrawn.

In view of the above, the petition is **DISMISSED**.

CONCLUSION

1. Patent Owner's request for "reopening of prosecution...as the Right of Appeal Notice of November 5, 2008 ("RAN") should be revoked as untimely because it substantially modifies positions previously taken by the office" is **dismissed**.

2. **All** correspondence relating to this *inter partes* 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 *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office

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

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

By hand: 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.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

3. This decision is not a final agency decision and is without prejudice to a request for reconsideration or higher-level review.

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

Gregory Morse
Director, Center Reexamination Unit

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JUL 26 2007

CENTRAL REEXAMINATION UNIT

Dorsey & Whitney, LLP 250 Park Avenue New York, NY 10177	:	For Patent Owner
Stuart P. Meyer, Esq. Fenwick & West 801 California Street Mountain View, CA 94041	:	For Requester
In re: Thomson et al. *Inter Partes* Reexamination Proceeding Control No. 95/000,090 Filed: May 2, 2005 For: US Patent No. 6,298,715	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.956]

This is a decision on the July 17, 2007 patent owner "Petition for Extension of Time" requesting that the time for responding to the Action Closing Prosecution mailed July 2, 2007 be extended by one month.

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 Action Closing Prosecution mailed July 2, 2007, which set a one month date for filing a response thereto. The request for extension is the first request for an extension of time with respect to the Action Closing Prosecution. The petition for extension of time was timely filed on July 17, 2007, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

Extensions of time in *inter partes* reexaminations are governed by 37 CFR 1.956:

37 CFR § 1.956 Patent owner extensions of time in inter partes reexamination.

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

MPEP 2665, Extension of Time for Patent Owner Response, states in part.

> "Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period."

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

The patent owner notes the lengthy nature of the action, which included several new grounds of rejection, and the fact that new prior art has been applied therein.

Analysis and Findings

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

Accordingly, the time for filing a reply to the outstanding Office action is extended for one month and therefor the reply is due on September 3, 2007. (September 2, 2007 being a Sunday.) Patent Owner may expect that any further extensions of time to respond to the Office action will be granted only in an extraordinary situation. See MPEP 2665.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Action Closing Prosecution dated July 2, 2007 is **granted**.

2. The Patent Owner's response is due September 3, 2007.

3. Response may be submitted as follows:

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

4. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis, for
Director
Central Reexamination Unit

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Matthew T. Bailey (For Patent Owner)
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Marcus J. Millet (For Requester)
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& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

MAILED
AUG 23 2005
REEXAM UNIT

In re Mark R. Tremblay et al.	:
Reexamination Proceeding	: DECISION
Control No.: 95/000,093	: DENYING
Filed: May 17, 2005	: PETITIONS
For: U.S. Patent No.: 6,424,333	:
	:
In re Mark R. Tremblay et al.	:
Reexamination Proceeding	:
Control No.: 95/000,094	:
Filed: May 19, 2005	:
For: U.S. Patent No.: 6,275,213	:

On July 6, 2005, the patent owner petitioned in both of the above-captioned proceedings under 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c), making the somewhat unusual request that the two *inter partes* reexamination proceedings be dismissed, or in the alternative, suspended. On July 29, 2005, the third party requester filed petitions and oppositions under 37 CFR 1.183 in response to the patent owner's petitions. On August 5, 2005, the patent owner filed a reply to the third party requester's oppositions.[1]

The petitions and oppositions are before the Director of the Office of the Patent Legal Administration of the United States Patent and Trademark Office. Although there is no provision in the statute or rules for this type of petition, which asks for the extraordinary relief of terminating or suspending two *inter partes* reexaminations, the Office will consider the petitions in view of the unusual circumstances.

For reasons set forth below, the petitions are denied.

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[1] Because the Manual of Patent Examining Procedure (MPEP) does not permit petitioners to file a reply, the patent owner's reply has not been considered. MPEP § 2646 ("The filing of a 37 CFR § 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester.").

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. (Petitioner), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination), willfully infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[2]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion (Petitioner patent owner) against Sony (Requestor) on Immersion's claims of infringement of the '333 and '213 patents.[3] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[4]

5. On May 17, 2005, a request for reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 90/000,093 (the '0093 proceeding), was filed by a third party requester on behalf of Sony. The validity of claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, a request for reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 90/000,094 (the '0094 proceeding), was filed by a third party requester on behalf of Sony. The validity of claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441).

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[2] *2005 U.S. Dist. LEXIS 4777*
[3] *2005 U.S. Dist. LEXIS 4781*
[4] *2005 U.S. Dist. LEXIS 4784*

8. On July 6, 2005, the patent owner filed the present petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, the requester filed petitions and oppositions under 37 CFR § 1.183 in response to the patent owner's petitions.

10. On August 5, 2005, the patent owner filed a reply to the third party requester's oppositions.[5]

11. On August 17, 2005, the Office issued orders granting the request for reexamination in both the '0093 and '0094 reexamination proceedings, finding that the requests raise a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. Sony's initial brief in the Federal Circuit appeal is due on August 22, 2005, but has filed for a 60-day extension of time to file its brief.

For the reasons that follow, the patent owner's petitions to dismiss or suspend the reexamination of the '333 and '213 patents are denied.

DECISION

I. The Patent Reexamination System

In 1980, Congress added a new administrative procedure known as *ex parte* reexamination. 35 U.S.C. §§ 301-307. *Ex parte* reexamination allows third parties to call to the Office's attention new prior art issues that might affect a patent's validity that the examiner did not consider during the patent's initial examination. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601 (Fed. Cir. 1985) (*Patlex I*). Congress contemplated three principal benefits of reexamination: (i) settle validity disputes more quickly and less expensively than protracted litigation; (ii) allow courts to refer patent validity questions to the expertise of the Office; and (iii) reinforce "investor confidence in the certainty of patent rights" by affording the Office an opportunity to review doubtful patents. *Patlex I*, 758 F.2d at 602. Thus, reexamination furthers the interests of both the public and patent owners in ensuring a strong, reliable patent system by allowing the Office a second look and testing the validity of patents in view of new evidence, thereby weeding out dubious patents. The Office's expertise in science and technology as well as patent law places the agency in a unique position to assess a patent's validity correctly and efficiently. Moreover, a paramount obligation mandated by Congress upon the Office is to conduct all reexaminations with "special dispatch." 35 U.S.C. § 305. In the only Federal Circuit case to consider the meaning of "special

[5] As pointed out above, MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply has accordingly not been considered.

dispatch," the court ruled that the Office incorrectly suspended a reexamination of a patent in view of a validity challenge in a concurrent litigation, because such a suspension ran contrary to the statutory "special dispatch" requirement for reexamination proceedings. *See Ethicon v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

Ex parte reexamination, however, does not provide a meaningful opportunity for the requester to participate once reexamination is ordered. 35 U.S.C. §§ 301-307. As a result, "such reexamination had been used infrequently" since it was enacted in 1980. 145 Cong. Rec. S14720 (Nov. 17, 1999). In order to encourage more third parties to use reexamination, Congress enacted in 1999 the *inter partes* reexamination procedure "as an option to the existing *ex parte* reexamination proceedings." *Id.* With this new option, third parties can now fully participate throughout the reexamination proceeding. Moreover, "[w]ith *inter partes* reexamination, it is believed that a better balance can be achieved toward the goal of improving patent quality and validity." H.R. Rep. 107-121 (June 28, 2001).

In creating the *inter partes* reexamination statutory framework, Congress borrowed heavily from the existing *ex parte* reexamination regime. For example, "[a]ny third party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of prior art cited under the provisions of section 301." 35 U.S.C. § 311. In addition, as is the case for *ex parte* reexamination, within 3 months from the filing of an *inter partes* reexamination request, the USPTO Director must determine whether a substantial new question of patentability has been raised by the request to justify initiating a reexamination proceeding. 35 U.S.C. § 312. Further, *inter partes* reexamination proceedings must likewise be conducted with "special dispatch." 35 U.S.C. § 314(c).

A key difference between *inter partes* and *ex parte* reexamination, is that Congress provided the requester with an opportunity to meaningfully participate throughout the proceeding. 35 U.S.C. § 314(b). Further, although Congress continued with its overarching mandate that *inter partes* reexaminations be conducted with "special dispatch," in contrast to *ex parte* reexamination, Congress provided the Office with discretion to suspend *inter partes* reexamination proceedings for "good cause." *See* 35 U.S.C. § 314(c). Another difference is that while Congress gave patent owners a specific right to file a statement in response to the order for an *ex parte* reexamination (35 U.S.C. § 304), Congress chose not to provide a similar provision in *inter partes* reexamination. In fact, Congress specifically gave the Office the authority to issue the first action on the merits on the same day as the order for reexamination is issued. 35 U.S.C. § 313. Additionally, with *inter partes* reexamination, Congress specifically provided estoppel provisions when a "final decision" upholding the validity of patent claims has been reached in a civil action or in a prior *inter partes* reexamination. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims. *Id.* Accordingly, while Congress desired that the

creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also contemplated in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other. Until that time, however, the Office is obligated to move forward in the *inter partes* reexamination with "special dispatch." Only "good cause" will permit the Office from deviating from that statutory mandate.

II. Petitioner's Arguments

Petitioner requests that the Office dismiss or suspend the present *inter partes* reexamination proceedings, based on the following three arguments:

(1) The instant proceeding should be dismissed based on the March 24, 2005 District Court decision adverse to SONY, because, in Petitioner's view, 35 U.S.C. § 317 precludes SONY from requesting *inter partes* reexamination once the U.S. District Court issued its "final decision" finding the claims of the '213 and '333 patents not invalid;

(2) In the alternative, Petitioner requests that the Office suspend the *inter partes* reexaminations pending the final resolution of the concurrent litigation now pending in the U.S. Court of Appeals for the Federal Circuit; and

(3) Petitioner argues that the Office's present practice of issuing the initial Office action on the merits at the same time as the order initiating an *inter partes* reexamination proceeding deprives patent owners of their due process rights.

III. Since Claim 1 From Each Patent Was Not Litigated in the Concurrent Civil Action, the Office Cannot Dismiss Either *Inter Partes* Reexamination Proceeding

Petitioner seeks dismissal, in their entirety, of both *inter partes* reexamination proceedings based on the allegation that "a final decision has been entered against Sony [requester] in a federal civil action" and the allegation that "[requester] seeks to relitigate the same validity defense that . . . already [was] litigated and lost in court." Pet. at 2. Petitioner admits, however, that at least one claim in each patent that is part of the reexamination requests (*i.e.*, claim 1, in each case) has not been litigated in the civil action. Pet. at 6, ¶ 12. Because claims exist in each reexamination proceeding that have never been litigated, the Office cannot dismiss either of the *inter partes* reexamination proceedings.

Section 317(b) requires that in order for the estoppel effect to apply to the present *inter partes* reexamination proceedings, "a final decision has been entered against a party in a civil action"

holding that the "party has not sustained its burden of providing invalidity of any patent claim in suit . . . ." Thus, the section 317(b) estoppel provision was not written to estop any and all validity challenges to a patent after a final validity decision has been reached in litigation regarding some or all of the patent's claims. Instead, the estoppel triggers on a claim by claim basis. Petitioner fails to acknowledge this distinction in its petition. Here, since claim 1 of both the '213 and '333 patents were not litigated, no final decision, let alone any decision, has been reached regarding the validity of those claims. Therefore, even assuming that Petitioner's proposed interpretation of "final decision" in section 317(b) is a district court decision would be correct, there has been no district court decision on the validity of claim 1 of either patent. Thus, no estoppel applies to claim 1 of each reexamination proceeding under any theory. For that reason alone, Petitioner's requested relief to terminate the entire proceedings cannot be granted.

Although Petitioner did not specifically request a partial termination of the reexamination proceedings, *i.e.*, termination only with respect to the claims litigated from the '213 and '333 patents, the Office has considered that option as well. However, as explained below, since the section 317(b) estoppel provision applies only after a "final decision" by the Federal Circuit, the Office cannot dismiss the litigated claims from the two *inter partes* reexamination proceedings at this time.

IV. The Estoppel Provisions Do Not Apply Until After a "Final Decision" Which Does Not Occur Until After Any Appeals To The Federal Circuit

A. Congress Contemplated that *Inter Partes* Reexamination and Litigation of that Same Patent Could Occur Simultaneously

There is no doubt that *ex parte* reexamination of a patent and litigation of that same patent can occur simultaneously. In *Ethicon v. Quigg*, 849 F.2d 1422, 1428-1429, (Fed. Cir. 1988), the patent was both being reexamined and in civil litigation. The Office suspended the reexamination until the litigation was finally resolved. The Federal Circuit reversed the Office's decision, and ordered the Office to continue the reexamination while the litigation was ongoing. The court gave several reasons for its decision, including the statutory mandate that reexaminations must be conducted with special dispatch. *Inter partes* reexamination has the same "special dispatch" requirement. *See* 35 U.S.C. 317(b). Similarly, like *ex parte*, *inter partes* reexamination does not include provisions that (i) preclude an *inter partes* reexamination when a civil action has been filed, or (ii) preclude a civil action on a patent once an *inter partes* reexamination has been started on that same patent. The statute thus clearly contemplates that there may be concurrent proceedings, at least for some period of time. 35 U.S.C. § 317. However, the statute does provide that once the validity challenge to certain patent claims is "finally" resolved in either the civil action or the *inter partes* reexamination, then any concurrent proceeding in the other forum may no longer be maintained on the same issue or issues that could have been raised. 35 U.S.C. §§ 315(c) and 317. Congress confirmed its intent to permit concurrent proceedings by providing the USPTO Director with discretion to suspend an *inter partes* reexamination during concurrent litigation for "good cause." 35 U.S.C. § 314(c). Put more simply, the Office would have no need to suspend a reexamination proceeding based upon

a civil action if the reexamination proceeding could not occur and be maintained in the first place. The district court has similar stay provisions as well. 35 U.S.C. § 318. Thus, Petitioner's argument that "Congress intended for *inter partes* reexamination to be an alternative, not a supplement, to litigation" and therefore, "gave requester a choice: reexamination or litigation, but not both" (Pet. at 14-15) is either incorrect, or an overstatement at best.

Inter partes reexamination does differ from *ex parte* reexamination in certain respects. First, by definition, in an *inter partes* reexamination proceeding, the requester is more of a participant than in an *ex parte* reexamination proceeding. Second, there is a reciprocal estoppel provision between *inter partes* reexamination and civil litigation proceedings. Third, there are suspension provisions both for the Office and the courts when concurrent *inter partes* reexamination and civil proceedings are pending. Petitioner's first argument goes to the second of these differences (*i.e.*, the estoppel provisions). Petitioner's second argument goes to the suspension provisions. These arguments will now be addressed.

B. The Reciprocal Estoppel Provisions Apply After a "Final Decision," Which Does Not Occur Until <u>After</u> Any Appeal to the Federal Circuit is Over

After a "final decision," issues that were raised or could have been raised in a civil action or a prior *inter partes* reexamination cannot be raised or continued to be raised in another *inter partes* reexamination as to the same claims. 35 U.S.C. § 317(b). Similarly, after a "final decision" of an ordered *inter partes* reexamination finding a claim valid, issues raised (or that could have been raised) regarding that claim's validity cannot be raised in a civil action. 35 U.S.C. § 315(c). Petitioner's first argument hinges upon what is meant by a "final decision." Specifically, Petitioner asserts that the "meaning of the term 'final decision' refers to "appealable decisions of a subordinate tribunal, such as a district court judgment . . . and does not require exhaustion of all appeals." Pet. at 9. In its opposition, Requester argues that "the term 'final decision' in § 317(b) is used to describe the finality of a decision on patentability sufficient to extinguish a party's right to request or proceed with an *inter partes* reexamination on the same claims" which does not occur until "the action ends after the appeal process." Opp. at 10-11.

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as <u>after</u> a Federal Circuit decision, and not simply after a district court (or BPAI) decision as Petitioner argues. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[6]

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[6] Regarding Petitioner's contention that "final decision" in statutes refers to a district court decision, a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only "final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not <u>final</u> until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. The Office interprets the term "final decision" for either proceeding[7] as "after all appeals." *See* MPEP § 2686. The Office's interpretation is correct for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

First, "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law that holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a).

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after

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[7] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

any appeals. *See* 35 U.S.C. § 315 (c) (barred from raising invalidity in a civil action if previously "finally" held valid in a *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is easy to see that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> . . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised . . . .

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." Furthermore, Petitioner's attempt to parse words and phrases from this legislative history to argue that "after any appeals" only applies to a "final decision in an *inter partes* reexamination" but does not apply to a "final decision" in a civil action not only lacks merit, but is illogical when reading the legislative history in the context of the statutory framework as a whole. *See* Pet. at 17-18. As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic supports construing the term "final decision" as "after all appeals." In contrast, adopting Petitioner's construction of "final decision" would not only be inconsistent with the underlying policy of *inter partes* reexamination, it would make the statutory scheme unworkable. Pet. at 9-11. For example, if a district court enters a decision holding all claims in a patent not

invalid, and later on appeal, is reversed (or modified), then the conclusion of an *inter partes* proceeding prior to exhaustion of appeals would have been premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the reexamination proceedings. A completely new request for reexamination would have to be made in a redundant fashion. Clearly, such redundancy is a result Congress did not intend in light of the fact that it provided the PTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to work properly.

C. The *Timken* Case

In its opposition to the instant petition, the requester relies on *Timken Co. v. United States*, 893 F.2d 337 (Fed. Cir. 1990), for the general proposition that "final decision" can mean different things in different statutes. Opp. at 11 (citing *Timken*, 893 F.2d at 339) ("term 'final decision' can mean different things in different situations."). Requester further points out that in *Timken*, the Federal Circuit interpreted the statutory term "final decision . . . in an action" as "after all appeals." Opp. at 11. While *Timken* is factually distinguishable from the present matter because it flows from a different statute and refers to a "final decision" from an agency rather than a civil action in a court, it nevertheless shows that Congress is free to use the term "final decision" and define it to mean "after appeals" if Congress so chooses. Accordingly, *Timken*, confirms that when interpreting the term "final decision," the specific statutory scheme from which it is embodied must be consulted. *Timken*, 893 F. 2d at 339. A close reading of *Timken* provides further assistance in construing the specific terminology "final decision . . . in an action." *See Timken*, 893 F.2d at 339 ("Most persuasive is the fact that the term "final court decision" must be read together with the words that follow, specifically, 'in the action.' An 'action' does not end when one court renders a decision, but continues through the appeal process."). *Timken* shows the Federal Circuit has interpreted the language "final decision . . . in an action" as "after all appeals" in the past, and supports the proposition that the Office is reasonable in interpreting similar language in a similar manner in this instance (*i.e.*, "final decision . . . in a civil action"). Finally, applying a similar analysis as in *Timken*, the Office's construction of the term "final decision . . . in a civil action" with respect to 35 U.S.C. § 317 is consistent with language in its respective legislative history (*i.e.*, "after any appeals").

D. 35 U.S.C. § 317 Does Not Codify the Common Law *Res Judicata* Doctrine

Petitioner also argues that Congress has codified the common law principle of judicial *res judicata* and applied it to Office proceedings. Pet. at 11-12. This is incorrect. Petitioner relies on its interpretation of "final decision" to establish a link that is inconsistent with the statute and its legislative history as discussed above. In addition, administrative *res judicata* and not judicial *res judicata* is the common law doctrine that typically applies to agency proceedings. It is unlikely that Congress would codify the court-court doctrine and apply it to a court-agency situation, which is normally governed by an administrative doctrine, without doing so in express terms.

The key distinction between administrative *res judicata* in the court-agency context and court-court *res judicata*, as applied in the cases cited by Petitioner, is discussed by Wright and Miller:

> When an agency proceeding follows after a judicial determination, the agency may wish, or may be required, to honor the judgment by precluding readjudication of common issues. ** Of course preclusion is limited in this setting by the general rules that limit all preclusion—there is no preclusion if different issues are presented, the judicial determination was a preliminary ruling that does not count as an adjudication on the merits, a lower burden of persuasion applies in the agency, and so on. And the separate statutory competencies of courts and agencies commonly mean that a judicial decision does not bar a later agency proceeding as a matter of claim preclusion.

18B Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal Practice and Procedure § 4475 (2d ed. 2002) (footnotes deleted, underlining added). The Federal Circuit, specifically relied on the lower burden of persuasion in the Office when requiring the Office to continue with an *ex parte* reexamination proceeding:

> [I]f the district court determines a patent is not invalid, the PTO should continue its reexamination because, of course, the two forums have different standards of proof for determining invalidity.

Ethicon v. Quigg, 849 F.2d 1422, 1428-1429, (Fed. Cir. 1988). This is not to say that *Ethicon* controls in *inter partes* reexamination cases or that Congress codified the doctrine of administrative *res judicata*. Instead, in creating *inter partes* reexamination, Congress established a statutory estoppel regime against the backdrop of *Ethicon*, *ex parte* reexamination procedures, and court-agency *res judicata*, not to wholesale adopt court-court *res judicata* as argued by petitioner.

The estoppel regime in *inter partes* reexamination, as explained above, prevents the Office from terminating an *inter partes* reexamination proceeding before its conclusion or until the courts, after all appeals, decide the issue as between the parties. This is consistent with the Federal Circuit's admonition in *Ethicon* that "if a court finds a patent invalid, and that decision is either upheld on appeal or not appealed, the PTO may discontinue its reexamination." *Ethicon*, 849 F.2d at 1429(emphasis added).

Petitioner argues that *Ethicon* is inapplicable because Congress "amended the very language that the Federal Circuit relied on to decide *Ethicon*, 35 U.S.C. § 305 ("All reexamination proceedings ... will be conducted with special dispatch")." Pet. at 13. This is incorrect. The special dispatch requirement is still maintained in *inter partes* reexamination. 35 U.S.C. § 314(c). The amendment cited by Petitioner did not eliminate the special dispatch requirement; it simply provided that the Director may, for good cause, suspend (not terminate or discontinue) an *inter partes* reexamination proceeding.

V. Since the Office Must Reexamine Claim 1, and There Has Been No Final Decision as to the Litigated Claims, Good Cause Does Not Exist to Suspend the Reexamination Proceedings

Petitioner requests, in the alternative, that the Office suspend the reexamination proceedings until the Federal Circuit decides the pending appeal (Appeal Nos. 05-1227, 1358 and 1441) of the district court decision. In Petitioner's view, good cause exists to suspend the proceeding because (i) it is contrary to the statute to permit an *inter partes* reexamination after a district court has entered a decision on the validity of the patent, and (ii) suspension "will prevent the unnecessary and wasteful expenditure of resources by the Office and Immersion [Petitioner patent owner], while the co-pending appeal is decided." Pet. at 26.

Petitioner's first reason for suspension is simply a restatement of its earlier position (that the district court decision estops the reexamination), which has been rebutted for the reasons stated above. Petitioner's second reason once again overlooks the key fact, - that both reexaminations involve a patent claim not asserted in the civil action. Thus, no matter what the Federal Circuit does, the Office is required to go forward and reexamine claim 1 to completion. Accordingly, the only question remaining is whether the Office suspends the reexamination proceeding given at least one claim (or more) will be reexamined later.

Pursuant to 35 U.S.C. § 314(c), *inter partes* reexamination proceedings "shall be conducted with special dispatch" within the Office, "[u]nless otherwise provided by the Director for good cause." The Office has recognized, through rulemaking, that a concurrent litigation may, in certain circumstances, establish good cause to suspend a reexamination proceeding:

> If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

37 CFR 1.987. The MPEP provides two examples of what can establish "good cause":

(1) co-pending litigation includes an issue best decided in court, rather than Office;
(2) co-pending litigation includes an issue that cannot be decided by the Office, but affects the resolution of the proceeding.

See MPEP § 2686.04. Petitioner does not argue that the present facts fall within either example, although "good cause' is not limited to the MPEP examples.

Petitioner argues that the court proceeding is now at such an advanced stage that it would promote administrative efficiency to suspend the reexamination proceeding to await the Federal Circuit's decision. This position has some merit. The Federal Circuit decision potentially could narrow the two reexamination proceedings by removing the litigated claims from the proceedings. However, a reexamination proceeding still would have to continue as to non-litigated claim 1 of each proceeding, regardless of the Federal Circuit decision. Further, Congress mandated that the Office conduct reexaminations with "special dispatch," which the

Office is obligated to follow regarding the non-litigated claims, at the very least.

More specifically, regardless of how the Federal Circuit decides the appeal in the concurrent litigation, each reexamination proceeding will continue after that decision at a minimum for at least one non-litigated claim (i.e., claim 1). The section 317(b) estoppel provision only applies on a claim by claim basis, not to the patent as a whole. To elaborate, a party is estopped from requesting or maintaining an *inter partes* reexamination for those claims litigated in a civil action once a final decision has been reached. As explained earlier, it is undisputed that there has been no decision with respect to claim 1 of either patent, - since the validity of claim 1 was not litigated in the civil action. Petitioner has not alleged (presumably, since the statutory language will not support it) that since "some" claims of the patent were involved in the civil action, estoppel applies to "all" claims. The statute speaks to estoppel of claims, not of patents as a whole.

It is not in the Office's interest to conduct a piecemeal reexamination of a patent, where the Office reexamines some claims while suspending review of other claims. A reexamination of claim 1 in each proceeding will already require the examiner to review the written description, the drawings, other claims in the patent, and the prior art. Thus, there is relatively little additional effort to reexamine all claims, instead of just some. Moreover, an initial review of claim 1 for each patent suggests that, although not identical, it is similar to the litigated claims of the respective patents. Thus, it is appropriate and efficient that the reexamination be continued and carried out on the litigated claims, along with claim 1. In contrast, reexamining claim 1 now, and then possibly reexamining the other claims later, poses the administrative burden of the Office having to potentially do a significant amount of rework, while frustrating the requirement that these proceedings be conducted with special dispatch.[8] Moreover, in the 25 year history that the Office has conducted reexamination proceedings, it has never reexamined some claims of a patent while suspending review of other claims.

Furthermore, it is uncertain whether the Federal Circuit's decision will ultimately estop a reexamination of the litigated claims for the '333 and '213 patents. For example, the district court's decision on validity could be reversed or vacated, with a remand for a new trial. In that case, reexamination of the litigated claims would continue since there would be no "final" decision. Accordingly, the Office is faced with a choice of (i) suspending the entire proceedings, even though it will have to eventually reexamine claim 1 regardless of the Federal Circuit's decision, (ii) suspending reexamination of some, but not all, of the claims, or (iii) reviewing all the claims of the patents. The Office has never engaged in piecemeal reexamination in the past, and Congress had never expressed intent for the Office to do so. As already explained, the first choice is contrary to the statute, since claim1 has to be reexamined with special dispatch, and the second choice does not relieve the Office of any administrative burden in a meaningful way. At the same time, while it is in the Office's interests to avoid doing work that ultimately could be

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[8] As of the date of this decision, Sony's (Requestor) initial brief in the Federal Circuit appeal is due August 22, 2005, but has filed a request for a 60 day extension, which is commonly granted. Thus, it does not appear that briefing will be complete in the appeal until the end of 2005. As a result, it may take one year or longer before the Office has the benefit of the Federal Circuit's decision in the appeal.

mooted by the concurrent litigation, on balance, "good cause" does not exist at this time to warrant suspending the proceedings, in whole or in part. If, however, the Office becomes aware that the validity issue(s) on appeal with respect to the litigated claims were identical to the issues developed during the reexamination regarding the reexamined claims (e.g., claim construction of a particular claim term shared in all the claims), then the matter would be looked at again to see if that might be a circumstance where it would be in the interests of administrative efficiency to await the Federal Circuit's decision on that disputed issue before the Office continued the reexamination proceeding.[9]

Finally, one of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial question of patentability not previously considered by the Office. It is thus in the public interest of patent quality that the reexamination continue at this time. It is further to be noted that the reexamination of a patent is not merely a duplication of a validity challenge in court, as suggested by Petitioner. In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit noted that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. *Id.* at 1427-29. Since the "clear and convincing" standard used in court proceedings is more difficult to satisfy than the "preponderance" standard applied by the Office, claims held valid by the courts may be still rejected in a reexamination proceeding. Moreover, because a patent owner can amend the claims in a reexamination proceeding, the Office gives claims their broadest reasonable interpretation consistent with the specification, which is different than the claim interpretation employed by the courts. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). Thus, the two proceedings are not duplicative and it is appropriate, as contemplated by the statute, that both proceedings continue until one of them reaches a "final decision," which then will require the termination of the validity challenge to those same patent claims in the other forum.

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[9] The Office is sympathetic to the fact that Petitioner has already been through a district court litigation defending the validity of several (but not all) of the claims in the reexamination proceedings. Nonetheless, the district court decision did **not** include one claim in each reexamination proceeding, and as to the other claims, the decision is not yet "final." Moreover, because Congress wrote section 317(b)'s estoppel provision on a claim-by-claim basis, if all the claims of the '213 and '333 patents had been litigated, then that might be an example where good cause would exist to suspend the reexaminations. Since the Office recognizes that if not every claim's validity is at issue in a civil action (which is not uncommon), one can at least begin a reexamination by asserting non-litigated claims for the reasons already stated, the Office has little choice but to move forward with the proceedings at this time. However, the Office has advised the parties to keep it apprised of the Federal Circuit appeal, and will act accordingly once the Federal Circuit's decision (mandate) issues. However, since the estoppel provision is written in terms of claims and not in terms of patents, the reexamination proceedings will go forward as to claim 1 (in each reexamination proceeding) regardless of the Federal Circuit's decision. Quite simply, since the estoppel provision is written in terms of claims and not in terms of patents, a party can request an *inter partes* reexamination after a Federal Circuit decision, as to the validity of claims not involved in the litigation (civil action). This is Congress' decision.

VI. Petitioner Has Not Been Denied Due Process

Finally, Petitioner argues that the Office's current *inter partes* reexamination procedures, which provide that an initial, non-final action on the merits will ordinarily be included with an order for reexamination,[10] prevent Petitioner from being heard at a meaningful time and in a meaningful manner. In Petitioner's view, the practice of precluding a patent owner from participating in an *inter partes* reexamination prior to the issuance of an initial action (37 CFR 1.939(b)) is "inconsistent with constitutional dictates of due process." Pet. at 20.

First, it bears noting that this argument has essentially been rejected by the Federal Circuit in *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 484-86 (Fed. Cir. 1985) ("*Patlex II*"). Although *Patlex II* involved an *ex parte* reexamination, the court's reasoning in that case applies with equal force to *inter partes* reexaminations. In *Patlex II*, the patent owner in that case claimed that 37 CFR 1.530, which precludes a patent owner from participating in the Director's threshold determination of whether to grant a request for *ex parte* reexamination, violated his due process rights by depriving him of the right to be heard prior to the decision on whether to order a reexamination. *Id.* The Federal Circuit rejected the due process challenge because (i) the Office's order for reexamination is only a preliminary decision, not a final agency action, and (ii) the patent owner has ample opportunity to participate in the reexamination proceeding and respond to the examiner's findings. *Id.* at 485-86. Thus, the court has already determined that the constitutional requirement for "due process" does not provide patent owners with a right to participate before the Office issues a preliminary, non-final action in a reexamination proceeding.

Rather than contending that *Patlex II* was wrongly decided, Petitioner instead contends that constitutional due process requires that patent owners be permitted to file a substantive paper before the Office issues an initial Office action on the merits (which is the next agency action in a reexamination proceeding after the order).[11] It is black letter law that an initial Office action

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[10] Current procedure encourages (MPEP § 2660), but does not require, an initial action on the merits to be issued with the order to reexamine, thereby following the statutory mandate to conduct *inter partes* reexamination proceedings with "special dispatch." 35 U.S.C. § 314. The inclusion of a first action with the order is specifically contemplated by 35 U.S.C. § 313, which reads "[t]he order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314." However, in this particular instance, the initial, non-final action does not accompany the order issued today, but instead will follow in due course.

[11] When Congress in 1999 enacted the *inter partes* reexamination statute (35 U.S.C. §§ 311-18), it was presumably aware of the Federal Circuit's decision in *Patlex II* upholding 37 CFR 1.530(a), thereby essentially ratifying that practice for *inter partes* reexam proceedings, since the relevant statutory sections mirror that for *ex parte* reexaminations. *See Fluor Corp. v. United States*, 126 F.3d 1397, 1404 (Fed. Cir. 1997) ("Congress presumed to be aware of judicial interpretations of law, and that when Congress enacts a new statute incorporating provisions similar to those in prior law, it is assumed to have acted with awareness of judicial interpretations of prior law."); *see also San Huan New Materials High Tech, Inc. v. Int'l Trade*

does not substantively affect a patent owner's rights. Rather, a patent remains valid and in force throughout the reexamination process, whether *ex parte* or *inter partes*. *Heinl v. Godici*, 143 F.Supp.2d 593, 600 (E.D.Va. 2001)(citing *Patlex I*, 758 F.2d at 603); *see also Patlex Corp. v. Quigg*, 680 F.Supp. 33, 35 (D.D.C. 1988). In fact, this does not change unless and until a Federal Circuit mandate issues, invalidating the claims (assuming appeal rights are exhausted). In contrast, the initial action on the merits is only the first step in the administrative proceeding, and Petitioner has many opportunities to be heard during the proceeding before it becomes final.

The Federal Circuit explained in *Patlex II* that the general test for evaluating due process in administrative procedures is set forth in *Mathews v. Eldridge*, 424 U.S. 319 (1976):

> First, the private interest that will be affected by the official action; second, the risk of an erroneous deprivation of such interest through the procedures used, and the probable value, if any, of additional or substitute procedural safeguards; and finally, the Government's interest, including the function involved and the fiscal and administrative burdens that the additional or substitute procedural requirement would entail.

Id. at 335. As to the first factor, the private interest affected is similar to that in *Patlex II* – "the temporary deprivation of full enjoyment of patent rights" for the period needed to correct an erroneous determination in the first action. *Patlex II*, 771 F.2d at 485. The patent owner will have an opportunity to address what is felt to be a deprivation from an erroneous unfavorable first Office action in the second Office action, at which point the Office will have the benefit of the patent owner's response to the first Office action. That intervening period would not be too long in time, since all reexaminations must be conducted with "special dispatch." 35 U.S.C. § 314. Regarding the second factor, the risk of examiner error due to lack of information from the patent owner is low, because examining the patentability of patent claims on the merits in view of prior art references is the core function of a patent examiner. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003) ("As persons of scientific competence in the fields in which they work, examiners and administrative patent judges on the Board are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would provide to such persons"). The scope of *inter partes* reexamination is specifically limited to reviewing patent claims against prior art references. 35 U.S.C. § 311. Accordingly, the Federal Circuit appropriately recognized patent examiners to be "disinterested experts," mitigating against the risk of error. *Patlex II*, 771 F.2d at 485. Moreover, the court's recognition that examiners are independent and disinterested

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Comm'n, 161 F.3d 1347, 1355 (Fed. Cir. 1999); *Mudge v. United States*, 308 F.3d 1220, 1232 (Fed. Cir. 2002). In addition, unlike the *ex parte* reexamination statutory regime, Congress chose to not provide for any patent owner statement option after an order for an *inter partes* reexamination. Compare 35 U.S.C. § 304 with 35 U.S.C. § 313. Rather, Congress specifically authorized that the Office may move up the date an initial action on the merits issues to the same day as the order initiating the *inter partes* reexamination. *Id.* Accordingly, Petitioner's constitutional challenge applies not only to the Office's procedures, but to the constitutionality of 35 U.S.C. § 313 as well. In other words, is it unconstitutional for Congress to grant the Office the authority to issue an initial action the same day as the order, in view of the Office's existing practice barring any patent owner participation in a reexamination prior to the order.

experts necessarily refutes Petitioner's suggestion that an examiner would be inclined not to change any unfavorable position in the first Office action in view of a patent owner's response. Contrary to Petitioner's assertions, the fact that it is intended by the Office that the first action be "comprehensive" and intended to be the "primary" action simply refers to requirement that examiners should identify all of the issues in the first action, not that the first action is intended to be a final position. Indeed, examiners are required by regulation to reconsider positions taken in an initial Office action in view of the patent owner's response. 37 CFR 1.112. Regarding the third and final factor, the governmental interest, as the court in *Patlex II* noted, the administrative convenience of the challenged practice here is not entitled to "controlling weight in our review of the constitutional issue." *Id.*

In view of the above factors, the challenged practice comports with due process because the risk of error is low, and the private interest affected is only temporary and can be resolved during the patent owner's various opportunities to be heard during the administrative proceeding. The Supreme Court has held that "the demands of due process do not require a hearing, at the initial stage *or at any particular point* or at more than one point in an administrative proceeding so long as the requisite hearing is held before the final order becomes effective." *Opp Cotton Mills, Inc. v. Administrator*, 312 U.S. 126, 152-53 (1941) (emphasis added) (cited by *Patlex II* at 485).

Accordingly, Petitioner's attempt to distinguish *Patlex II* on the grounds that an initial Office action is one step farther along in the proceeding than the order to begin a reexamination is not a meaningful difference. First, like the reexamination order, any unfavorable first Office action is NOT a final agency action. 37 CFR §§ 1.945 and 1.949; *see also Heinl v. Godici*, 143 F.Supp.2d 593, 597-600 (E.D.Va. 2001)(highlighting numerous opportunities for patent owner to respond before agency action becomes final, and until then, no irreparable harm). In other words, an initial action does not have "the status of law" or immediate legal force. *See Federal Trade Comm'n v. Standard Oil Co. of California*, 449 U.S. 232, 239-42 (1980). Rather, it is only an initial position, indicating that the examiner has reason to believe that the patent claims are unpatentable in view of prior art. Second, as with the reexamination order, the patent owner has numerous opportunities to rebut any positions in a first Office action that find patent claims unpatentable. After every non-final Office action, like the first one, the patent owner has the right to respond. 37 CFR 1.937(b) (citing, *inter alia*, 37 CFR 1.111(a)(1)). The patent owner has other opportunities to present his position to the examiner as well. 37 CFR §§ 1.951 and 1.116. In addition, the patent owner has the opportunity to appeal an examiner's final decision to the Board of Patent Appeals and Interferences, which includes briefing and an oral hearing. 35 U.S.C. § 315. Thus, Petitioner's concern that it will not have a fair opportunity in the proceeding to respond to any "one-sided argument" presented in a request for *inter partes* reexamination is not correct. Accordingly, the current *inter partes* reexamination procedures, which follow Congress's specific authorization to issue an initial action the same day as the order, comports with the requirements for due process.

CONCLUSION

1. The petitions to dismiss or, in the alternative, to suspend the reexamination proceedings are denied.

2. This decision is a final agency action within the meaning of 5 U.S.C. § 704. This decision does not, however, preclude parties from seeking relief on this matter at some point in the future, should the circumstances on which this decision was grounded change.

3 The reexamination proceedings are being retained within the jurisdiction of Office of Patent Legal Administration for one month, after which it will be forwarded to Technology Center 2600 for the issuance of a first Office action in each proceeding.

4. The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5. Telephone inquiries with regard to this decision should be directed to Anton Fetting, Senior Legal Advisor, at 571-272-7717 or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

FUTURE CORRESPONDENCE IN PROCEEDING

All correspondence relating to these *inter partes* reexamination proceedings should be directed:

By U.S. Postal Service Mail:	Mail Stop *Inter Partes* Reexam Central Reexamination Unit Office of Patent Legal Administration United States Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-0100 Central Reexamination Unit
By hand (or delivery service):	Customer Service Window Randolph Building 401 Dulany St. Alexandria, VA 22314

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

8-23-05
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REEXAM UNIT

In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,093 Filed: May 17, 2005 For: U.S. Patent No.: 6,424,333	DECISION GRANTING PETITIONS TO SUSPEND
In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,094 Filed: May 19, 2005 For: U.S. Patent No.: 6,275,213	

This is a decision on the September 9, 2005 patent owner petitions in both of the above-captioned proceedings under 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c), requesting that the two *inter partes* reexamination proceedings be suspended. This is also a decision on the September 26, 2005 third party requester petitions and oppositions under 37 CFR 1.183 filed in response to the patent owner's petitions.

The petitions and oppositions are before the Director of the Office of the Patent Legal Administration of the United States Patent and Trademark Office. Although there is no provision in the statute or rules for this type of petition, which asks for the extraordinary relief of suspending two *inter partes* reexaminations, the Office will consider the petitions in view of the unusual circumstances associated with the petitions.

For reasons set forth below, the patent owner petitions are granted, to suspend the examination

and prosecution of the two *inter partes* reexamination proceedings until the circumstances in the parallel litigation warrant termination or resumption of the examination and prosecution.

For reasons set forth below, the third party requester petitions are granted to the extent that they have been considered, but are otherwise denied (i.e., examination and prosecution of the proceeding will not go forward, but rather, action is suspended for the proceedings).

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. ("Petitioner" or "Immersion"), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination), willfully infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[1]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony ("Requester" or "Sony") on Immersion's claims of infringement of the '333 and '213 patents.[2] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[3]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '0093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was not litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '0094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was not litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441).

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[1] 2005 U.S. Dist. LEXIS 4784.
[2] 2005 U.S. Dist. LEXIS 4781.
[3] 2005 U.S. Dist. LEXIS 4784.

8. On July 6, 2005, the patent owner filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, the requester (Sony) filed petitions and oppositions under 37 CFR § 1.183 in response to the patent owner's petitions.

10. On August 5, 2005, the patent owner filed a reply to the requester's (Sony) oppositions.[4]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '0093 and '0094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '0093 and '0094 reexamination proceedings.

13. On September 9, 2005, the patent owner filed (a) the present petitions to suspend the present *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, the patent owner filed a petition in the present two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Such jurisdiction over the two proceedings is in fact being retained by the Office of Patent Legal Administration.

15. On September 26, 2005, the requester filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. Immersion's principal brief is due December 7, 2005.

DECISION

I. The August 23, 2005 Petition Decision

In the August 23, 2005 decision denying Immersion's July 6, 2005 petitions to dismiss or stay the two *inter partes* reexamination proceedings, the Office reviewed the relevant portions of the

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[4] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply has accordingly not been considered.

inter partes reexamination statute. The decision noted that Congress, in creating the *inter partes* reexamination statutory framework in 2002, borrowed heavily from the existing *ex parte* reexamination regime. For example, *inter partes* reexamination proceedings, like *ex parte* reexaminations, must be conducted with "special dispatch." 35 U.S.C. § 314(c). Unlike *ex parte* reexamination, however, Congress provided the Office with the statutory authority and discretion to suspend *inter partes* reexamination proceedings for "good cause." *See* 35 U.S.C. § 314(c).

Another difference between the two regimes is that Congress specifically provided estoppel provisions to shut down an *inter partes* reexamination of a patent claim when a "final decision" upholding the validity of that claim has been reached in a civil action or in a prior *inter partes* reexamination proceeding. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then (a) that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims, and (b) "an *inter partes* reexamination previously requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office." *Id.*

The August 23, 2005 decision further explained that the statute and legislative history of the estoppel provisions make clear that the *inter partes* reexamination of a claim (requested by a party) must be terminated once a final decision upholding the validity of that claim (challenged by the same party) had issued "after any appeals," not simply just after a district court decision which is still pending on appeal. While Congress desired that the creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also provided in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends in a manner adverse to a third party, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other proceeding.

In the August 23, 2005 decision, the Office noted that Sony's request for *inter partes* reexamination was made not only for all of the litigated claims in the concurrent litigation, but also for claim 1 of each patent, which were *not* part of the litigation. Accordingly, even though the concurrent litigation was at an advanced stage and a Federal Circuit affirmance of the district court's validity decision would narrow the two reexamination proceedings by removing the litigated claims, the Office recognized that each reexamination proceeding would still have to continue as to non-litigated claim 1, regardless of the Federal Circuit's decision. Therefore, the Office did not find "good cause" to suspend the reexamination of claim 1 of each patent. In addition, the Office determined that it did not make sense to create a piecemeal reexamination process by moving forward on reexamining claim 1 while suspending reexamination of the litigated claims pending the outcome of the appeal. Accordingly, the Office denied patent owner Immersion's petition to stay the *inter partes* reexamination proceedings for lack of good cause.

II. Petitioner Patent Owner's Requested Relief

Immersion now renews its request that the Office suspend the present *inter partes* reexamination proceedings, pending the final resolution of the concurrent litigation now pending in the U.S. Court of Appeals for the Federal Circuit, i.e., until the Federal Circuit decides the pending appeal (Appeal Nos. 05-1227, 1358 and 1441) of the district court decision.[5] The renewed request is based on the following arguments:

(1) Petitioner argues that "good cause" exists to suspend the proceedings because suspension will conserve the resources of the Office and also "will advance the purposes of the *inter partes* reexamination system by relieving all parties of the onerous burdens of proceeding with the reexaminations while simultaneously litigating the same claims in Federal Court." Pet. at 3-4.

(2) Petitioner argues that its recent statutory disclaimer of claim 1 in each of the '213 and '333 patents removes the only significant reason for the denial of its previous July 6, 2005 petitions to suspend the proceedings, namely that reexamination of claim 1 of each patent was requested in the reexamination requests, and claim 1, in each case, was not before the court in the litigation. In other words, petitioner points out that now that claim 1 from each patent has been eliminated, the remaining claims for which the Office has found a substantial new question of patentability are identical to the litigated claims, which survived Sony's validity challenge in district court, and are now pending appeal. Thus, in petitioner's view, a Federal Circuit decision affirming the district court's decision as to the validity of those litigated claims would subsequently require the Office to shut down the *inter partes* reexamination of all the claims that the Office has reviewed (the litigated claims), in view of the estoppel provision in 35 U.S.C. § 317(b). For that reason, petitioner urges the Office to suspend the two *inter partes* reexamination proceedings to wait and see if the Federal Circuit's decision will effectively moot the reexamination proceedings, which are now only at the beginning stage.

III. "Good Cause" Now Exists to Suspend the *Inter Partes* Reexamination Proceedings Because the Claims Under Review in the Proceedings Are Identical to the Claims Pending at the Federal Circuit

Pursuant to 35 U.S.C. § 314(c), *inter partes* reexamination proceedings "shall be conducted with special dispatch" within the Office, "[u]nless otherwise provided by the Director for good cause." The Office has recognized, through rulemaking, that a concurrent litigation may, in certain circumstances, establish "good cause" to suspend an *inter partes* reexamination proceeding:

> If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

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[5] Immersion's initial petitions requested termination, or in the alternative, suspension of the reexamination proceedings. Immersion's current petitions request only suspension.

37 CFR 1.987.[6]

A district court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause," due to the real possibility that the 35 U.S.C. § 317(b) estoppel may very well attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.

A. In the August 23, 2005 decision, the Office pointed out that it was undesirable to conduct a piecemeal reexamination of a patent, where the Office reexamines some claims while suspending review of other claims until a later date. Reexamination was requested, in each case, as to the litigated claims and non-litigated claim 1. Based on those requests, the Office ordered reexamination in each case, finding a substantial new question of patentability as to each of the requested claims. The August 23, 2005 decision recognized that, even if the Federal Circuit upheld the district court's claim validity findings, the 35 U.S.C. § 317(b) estoppel provision would not bar reexamination of claim 1, which is not involved in the concurrent litigation. Thus, the pending Federal Circuit appeal did not affect the requirement that claim 1 would be required to be reexamined with special dispatch, and the Office accordingly decided that "good cause" did not exist to suspend the reexaminations for only the litigated claims pending the outcome of the appeal, because such a suspension would create the potential for complex piecemeal reexamination.

Since the August 23, 2005 decision, new events have occurred, i.e., patent owner Immersion has statutorily disclaimed claim 1 in each patent. Thus, the reexamination proceedings will no longer continue as to non-litigated claim 1. Accordingly, Immersion's elimination of claim 1 in each proceeding aligns the claims and issues when comparing the two reexamination proceedings to the appeal now pending at the Federal Circuit. An affirmance by the Federal Circuit will terminate these *inter partes* reexamination proceedings based on the estoppel provision of 35 U.S.C. § 317(b). Immersion therefore makes a good case to suspend the proceedings, since it is a reasonable likelihood that the Federal Circuit's decision will moot the reexamination proceedings.

Despite patent owner Immersion's disclaimer of claim 1 in each patent, Sony contends that the same piecemeal reexamination concerns that the Office had in its August 23, 2005 decision still presently exist. At pages 2-5 of Sony's September 26, 2005 petitions and oppositions, Sony argues that the reexamination proceedings should not be suspended because, - even if the Federal

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[6] The Manual of Patent Examining Procedure (MPEP) provides two examples of situations that can establish "good cause": (1) co-pending litigation includes an issue best decided in court, rather than Office; and (2) co-pending litigation includes an issue that cannot be decided by the Office, but affects the resolution of the proceeding. See MPEP § 2686.04. Petitioner patent owner does not argue that the present facts fall within either example, but rather "good cause' is not limited to the MPEP examples. Petitioner is correct that the situations expressed in the MPEP are merely exemplary and that other fact situations may merit suspending an *inter partes* reexamination for good cause.

Circuit affirms the district court's decision as to the validity of the litigated claims (and thereby bars the instant reexamination of the litigated claims), Sony believes that the Office is nevertheless required to reexamine all of the remaining (after disclaimer of claim 1) non-litigated claims in the patents. In Sony's view, even though claim 1 of each patent has been disclaimed, the Office must begin reexamination, with special dispatch, of the remainder of the non-litigated claims, i.e., claims 2–6, 7–40, 46–48, 51–52, and 55–60 of the '213 patent, and claims 2–13 of the '333 patent, even though Sony did not include any of these claims in its two requests for reexamination and the Office did not include any of these claims in its two orders for reexamination.

As support, Sony points to 35 U.S.C. § 314, which states that once a substantial new question of patentability is found and reexamination is ordered:

> Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

That language, however, does not require the Office to reexamine claims that were not part of a request for reexamination. Instead, it simply requires that the Office apply in a reexamination proceeding, the same statutory procedures that were used during the "initial examination." At the present stage of the instant reexamination proceedings, the only claims that have been considered by the Office are the claims for which Sony requested review.

At the present stage in the two reexamination proceedings, the Office's work so far has been limited to solely a review of whether the request raises a substantial new question of patentability only for the claims for which Sony requested review. Having only recently ordered reexamination based on the requested claims, no review of any of the non-requested claims has taken place. Sony cannot complain as to this result, since it was free to request reexamination of all the claims of both patents, but made the choice not to do so. In other words, if Sony was interested in having all the non-litigated claims reexamined in addition to the litigated claims, it had the opportunity to do so when it filed its requests for reexamination but chose not to do so.

Sony also argues that the Office examines all claims of a patent during a reexamination proceeding, even if the request for the Office to reexamine a patent is limited to only some of the claims, citing MPEP 2658(IV)(B). While, as pointed out specifically in MPEP 2640, the Office "usually" reexamines all claims of a patent, it is not required to do so in every case. On the particular facts and present stage of the instant reexaminations, this argument is not persuasive.

B. As a result of the disclaimer of claim 1 in each patent, the issue of "good cause" is now only a question whether it would be equitable and beneficial to go forward now with reexamination of the litigated claims, rather than wait for the Federal Circuit's decision on the appeal.

Petitioner patent owner argues that the court proceeding is now at such an advanced stage that it would promote administrative efficiency to suspend the *inter partes* reexamination proceedings to await the Federal Circuit's decision. This position has merit. The Federal Circuit decision

potentially could remove the litigated claims from the two proceedings, leaving no claims to be reexamined. If so, the reexamination proceedings would be terminated. It is not in the Office's and parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation which is soon to be finally resolved. That is particularly true here where the administrative proceedings have only just begun.

On the other hand, as pointed out in Sony's September 26, 2005 petitions and oppositions at pages 5-7, it is uncertain whether the Federal Circuit's decision will affirm the district court's decision and ultimately estop the instant reexaminations of the litigated claims for the '333 and '213 patents. It is possible that the district court's decision on validity could be reversed or vacated, with a remand for a new trial.

Taking the above positions into account, it is determined that "good cause" exists to wait for the outcome of the Federal Circuit appeal, because the reexamination proceedings are at just their beginning stages, while the concurrent litigation is potentially near its final resolution. It bears noting that Sony chose to permit the District Court litigation to proceed for three years before filing its requests for reexamination in May of 2005, only after judgment was entered in Immersion's favor in the litigation. Had Sony filed its requests for reexamination earlier, the reexamination proceedings would now have been much farther along in the process, and may likely have been completed at the Office before the district court issued its decision. Moreover, had Sony filed its reexamination requests earlier in the litigation, the district court might have stayed the litigation to await the Office's decisions in the two reexamination proceedings. After choosing to go years through the entire district court litigation proceeding without asking for the Office's input, Sony cannot complain that a suspension of the present reexamination proceedings will deprive Sony of a chance to obtain the Office's decision, when there is a strong possibility that the Federal Circuit's decision will estop the Office from issuing any decision at all. In short, Sony cannot have it both ways. Sony waited three years after the district court case began, and waited until after the district court issued a final decision, such that its district court litigation can in no way be affected by any decision on its reexamination requests. Sony's delay is the reason that the current reexaminations may very well be mooted before any decision issues. Sony chose its route and must now deal with the consequences of its decision.

Accordingly, on balance, "good cause" has been found to exist to warrant suspending the two *inter partes* reexamination proceedings, and patent owner's petition will be granted. Indeed, if the Office did not find "good cause" in the present situation, then the question would arise as to when the Office ever would exercise its statutory authority to suspend an *inter partes* reexamination for good cause based on a concurrent, pending appeal on the validity of the same claims.

Finally, Sony also argues that the uncertainty as to the time for resolution of the concurrent litigation, and as to the result itself, has increased as a result of Sony's motion for relief from the District Court's judgment under Federal Rule of Civil Procedure 60(b), which may lead the court to request a remand from the Federal Circuit. The simple answer is the Federal Circuit still has jurisdiction over the concurrent litigation at present. Should the District Court request and obtain a remand from the Federal Circuit, Sony may, at that point, petition for resumption of the two

reexamination proceedings.

Requester Sony argues at page 7 of the September 26, 2005 petitions and oppositions that the public interest is not served by a suspension in this instance. However, the public may obtain a decision from the Federal Circuit on the patent claims subject to the litigation, and then the public is free to request a subsequent reexamination of the two patents as to either the litigated (depending on the outcome in the concurrent litigation), or the non-litigated patent claims, using the results of the litigation as a starting point and adding information as appropriate.

IV. The Issue of Final Agency Action *re* Decisions:

The August 23, 2005 decision denying the petition to dismiss or suspend the proceedings was issued by the Director of the Office of Patent Legal Administration as a final agency action within the meaning of 5 U.S.C. § 704. The instant decision is likewise being designated as final agency action. At pages 9-10 of the requester's September 26, 2005 petitions and oppositions, it is urged that such designation of the August 23, 2005 decision as final agency action should be withdrawn. Requester points to page 17 of the August 23, 2005 decision, where it is stated that a first Office action "is not a final Agency action"citing *Heinl v. Godici*, 143 F.Supp.2d at 597-600 (E.D.Va. 2001) which in turn cited *Federal Trade Comm'n v. Standard Oil Co. of California*, 449 U.S. 232, 239-42 (1980) as to an initial action not having the status of law or immediate legal force.

The designation of the August 23, 2005 decision as a final agency action will not be withdrawn. The point made in that decision, and in *Heinl*, is that both the order for reexamination and the first Office action are not final agency decisions as to the patentability, or lack thereof, of the patent claims. As stated in the same paragraph of the August 23, 2005 decision quoted from by the requester, "it is only an initial position, indicating that the examiner has reason to believe **that the patent claims are unpatentable in view of prior art**." [Emphasis added]. With respect to the finality of the August 23, 2005 decision (and the instant decision as well), such finality is not directed to the patentability, or lack thereof, of the patent claims. Rather, it is directed to only the issue of suspension of the instant *inter partes* reexamination proceedings (in both the August 23, 2005 decision and the present decision), and dismissal of the proceedings without a final decision as to the merits (in the August 23, 2005 decision). Accordingly, the designation of both decisions as final agency action with respect to the issues to which they are addressed is deemed appropriate, and this matter of relief requested by the third party requester will not be granted.

CONCLUSION

1) The patent owner petitions are granted to suspend both of the *inter partes* reexamination proceedings until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal.

2) The third party requester petitions are granted to the extent that they have been considered, but are otherwise denied.

3) This decision is a final agency action within the meaning of 5 U.S.C. § 704. This decision does not, however, preclude parties from seeking relief on this matter at some point in the future, should there be a change in the circumstances on which this decision is grounded.

4) The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5) Telephone inquiries with regard to this decision should be directed to Anton Fetting, Senior Legal Advisor, at 571-272-7717 or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

FUTURE CORRESPONDENCE IN PROCEEDINGS

All correspondence relating to these *inter partes* reexamination proceedings should be directed:

By U.S. Postal Service Mail:	Mail Stop *Inter Partes* Reexam Central Reexamination Unit 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 Randolph Building 401 Dulany St. Alexandria, VA 22314

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

11-15-05
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MAILED
MAR 22 2006
REEXAM UNIT

In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,093 Filed: May 17, 2005 For: U.S. Patent No.: 6,424,333	DECISION DISMISSING PETITIONS
In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,094 Filed: May 19, 2005 For: U.S. Patent No.: 6,275,213	

This is a decision on the December 15, 2005 third party requester petitions in both of the above-captioned proceedings under 37 CFR 1.907(a) and 35 U.S.C. § 317(a). The petitions request hat the USPTO Director authorize requester (Sony) to file additional requests for *inter partes* reexamination of U.S. patents 6,424,333 and 6,275,213. On January 23, 2006, the patent owner (Immersion) filed oppositions to the petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

The petitions and oppositions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

For reasons set forth below, the third party requester petitions are dismissed.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. (hereinafter "patent owner" or "Immersion"), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[1]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony (hereinafter "requester" or "Sony") on Immersion's claims of infringement of the '333 and '213 patents.[2] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[3]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR § 1.183 in response to Immersion's petitions.

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[1] 2005 U.S. Dist. LEXIS 4784.
[2] 2005 U.S. Dist. LEXIS 4781.
[3] 2005 U.S. Dist. LEXIS 4784.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[4]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 reexamination proceedings (in the decisions, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the present two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions to suspend the instant '093 and '094 reexamination proceedings until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony filed requests for *ex parte* reexamination of claims 2, 3, 5, 6, 7, 15, 16, 17, 20, 21, 25, 41, 42, 43, 44, 45, 46, 49, 50, 53 and 54 of the '213 patent and claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17 and 18 of the '333 patent, the requests being assigned control Numbers 90/007,843 (for reexamination of the '213 patent) and 90/007,844 (for reexamination of the '333 patent).

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[4] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

19. On December 15, 2005, Sony filed the instant petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a), requesting that the USPTO Director authorize Sony to file additional requests for *inter partes* reexamination of the '333 and '213 patents, in order to permit Sony to request *inter partes* reexamination of certain claims of the '213 and '333 patents that it failed to request in its initial set of *inter partes* reexamination requests, dated May 17 and 19, 2005.

20. On January 23, 2006, Immersion filed oppositions to Sony's petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

21. On March 9, 2006, a substantial new question of patentability (SNQ) was found for claims 2, 3, 5, 6, 15, 16, 17, 20, 21 and 25 of the '213 patent and for claims 2, 3, 4, 5, 6, 7, 8, 9, 12 and 13 of the '333 patent, and *ex parte* reexamination proceedings 90/007,843 and 90/007,844 were ordered.

DECISION

35 U.S.C. § 317 (*Inter partes* reexamination prohibited) provides in pertinent part:

> (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**." [Emphasis added.]

37 CFR 1.907(a) is the regulation that implements the provisions of 35 U.S.C. § 317(a) and provides as follows:

> "Once an order to reexamine has been issued under § 1.931, 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 under § 1.997, unless authorized by the Director."

Sony petitions the USPTO Director to authorize Sony to file additional requests for *inter partes* reexamination of the'333 and '213 patents, seeking to have the Office reexamine claims that Sony failed to request for reexamination in its initial set of requests, dated May 17 and 19, 2005. Sony's request is for the purpose of placing claims before the Office for reexamination that were not before the District Court, and are not before the Federal Circuit, in the litigation detailed above. These claims will be referred to as the "non-litigated claims." The petitions set forth Sony's reasons why such claims should be before the Office for *inter partes* reexamination.

Initially, although the petitions have been filed in the '093 and '094 reexamination proceedings, they request relief that is not directed to the '093 and '094 proceedings. Note that 35 U.S.C. § 317 and 37 CFR 1.907(a) only authorize the USPTO Director to act on such a petition filed together with a proffered second *inter partes* reexamination request, accompanied by the requisite reexamination filing fee.[5] Thus, on this basis alone, the petitions must be dismissed. However, further grounds for dismissal, directed to the merits of the petitions will be set forth below for a complete resolution of the underlying issues.

In the petitions, Sony states that it has filed requests for *ex parte* reexamination of U.S. patents 6,275,213 and 6,424,333. As pointed out above, such requests have indeed been filed, and have been assigned Control Numbers 90/007,843 and 90/007,844 respectively. Reexamination has been ordered as to most of the non-litigated claims for both of the proceedings. As reexamination has been granted for the two *ex parte* reexamination requests, Sony may now petition, under 37 CFR 1.989, for merger of each of the two *ex parte* reexamination proceedings with its respective *inter partes* reexamination proceeding. See MPEP 2686.1, part VI. If such a petition is granted, then in the merged proceedings, Sony would retain its participation right for review of all the claims in the merged proceedings by virtue of having requested the '0093 and '0094 *inter partes* reexamination proceedings.[6]

In the present petitions, Sony has requested extraordinary relief that is provided for by 35 U.S.C. § 317(a) to permit it to file a second *inter partes* reexamination proceeding for the same patents. The language and intent of the statute clearly prohibit two co-pending *inter partes* reexaminations filed by the same party (real party in interest), unless there is no other avenue of relief and justice dictates such relief. In this case, another avenue of relief does exist. [7] Sony's rights resulting from a grant of the present petitions would not differ from those that would result if each of the two *ex parte* reexamination proceedings were merged with its respective *inter partes* reexamination proceeding. That is because any merged proceeding of the now pending *ex*

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[5] It is to be noted that the instant petitions do not have an entry right in the '0093 and '0094 *inter partes* reexamination proceedings, since the petitions are not directed to the merits of the '0093 and '0094 proceedings and do not address any patent owner petition or response. Nevertheless, the rules are waived to the extent that the petitions are being addressed, based on the ongoing concurrent litigation, and the facts and circumstances of the present case.

[6] 37 CFR 1.989(b) provides: "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. "

[7] The extraordinary nature of this statutorily provided relief can readily be understood by reference to the legislative history of 35 U.S.C. § 317, which provides (emphasis added):
"Subtitle F creates a new section 317 which sets forth certain conditions by which inter partes reexamination is prohibited **to guard against harassment of a patent holder**. In general, once an order for inter partes reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for inter partes reexamination until an inter partes reexamination certificate is issued and published, unless authorized by the Director." 106 Cong. Rec. S14720 (Nov. 17, 1999).
In this instance, in addition to Sony having initiated the '093 and '094 *inter partes* reexamination proceedings, Sony has now also recently initiated two *ex parte* reexamination proceedings for other claims of Immersion's two patents. Sony's petition here requests the authority to initiate yet another two *inter partes* reexamination proceedings, making a total of six reexamination proceedings of Immersion's two patents.

parte and *inter partes* proceedings would be conducted using *inter partes* reexamination rules and procedures. See 37 CFR 1.989(b). Any equities potentially present that warrant the granting of the present petition would also be present for potentially granting a merger.[8] Since Sony can obtain the relief requested in the present petitions via an alternative procedural avenue, there is no justification to grant the requested extraordinary relief under 35 U.S.C. § 317(a) of permitting Sony to file a second *inter partes* reexamination proceeding for the same patents. The petitions are accordingly dismissed.

The stated goal of Sony's present petition is to have the Office reexamine claims in addition to the ones it requested in its May 17 and 19, 2005 *inter partes* reexamination requests. Now that Sony has made that formal request, through *ex parte* reexamination requests, which requests have been recently granted, it appears that Sony has already achieved its objective.

Further, the statutory restriction on filing a second *inter partes* reexamination request directed to the non-litigated claims as is requested in the petition will be removed once the final decision is issued in the litigation by the court, if the final decision is adverse to Sony. At that time, the Office would terminate the '093 and '094 *inter partes* reexamination proceedings, thereby opening the door for Sony to file subsequent requests for the *inter partes* reexamination of the non-litigated claims of Immersion's two patents, pursuant to 35 U.S.C. § 317(a). Given the advanced state of the current litigation, Sony has not established that a delay resulting from the statutory limitation against permitting a third party from triggering more than one pending *inter partes* reexamination proceeding will be of a significant duration to provide basis for the extraordinary relief presently requested.

As a final point, this decision is not to be interpreted as an indication regarding whether or not a petition for merger of the *ex parte* reexamination proceedings with the instant *inter partes* reexamination proceedings would be granted. It is merely a holding that the extraordinary relief provided for by 35 U.S.C. § 317(a) will not be granted where there is a more conventional avenue to accomplish the same purpose and provide relief analogous to that requested. See also *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982) for the principle that extraordinary relief will not normally be considered if the rules provide an avenue for obtaining the relief sought.

CONCLUSION

1) The Sony (i.e., third party requester) petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a) are <u>dismissed.</u>

2) The above-captioned *inter partes* reexamination proceedings remain suspended until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal.

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[8] Likewise, where a substantial new question of patentability exists for granting a second *inter partes* reexamination; it also exists for granting an *ex parte* reexamination.

3) The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

4) Telephone inquiries with regard to this decision should be directed to Anton Fetting, Senior Legal Advisor, at 571-272-7717 or, in his absence, to the undersigned at 571-272-7710.

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

3-22-06
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(For Patent Owner)

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(For Requester)

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,093
Filed: May 17, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,844
Filed: December 13, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,843
Filed: December 13, 2005
For: U.S. Patent No.: 6,275,213

DECISION
DENYING
PETITIONS

This is a decision on the April 11, 2006 requester (hereinafter "requester" or "Sony") petitions filed (a) under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and (b) under 37 CFR 1.182 for merger of:

1. Reexamination Control No.: 90/007,844 with Reexamination Control No.: 95/000,093, and

2. Reexamination Control No.: 90/007,843 with Reexamination Control No.: 95/000,094.[1]

On May 3, 2006, the patent owner (hereinafter "patent owner" or "Immersion") filed oppositions to Sony's petitions.

The petition fee of $400 set forth in 37 CFR 1.17(f) for each of the present petitions under 37 CFR §§ 1.182 and 1.183 has been charged to Sony's Deposit Account No. 12-1095, in accordance with petitioner's authorization at the last sentence of page 2 of the April 11, 2005 petitions. A total of $800 will be charged for the two petitions directed to the two sets of proceedings

The petitions and oppositions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office ("USPTO" or "Office").

For reasons set forth below, Sony's petitions are:

Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions; and

Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion, obtained a jury verdict (Civil Action No. 02-0710 CW) in the

[1] See the penultimate paragraph of the second page of the petitions which identifies the petitions as being filed under 37 CFR §§ 1.182 and 1.183.

United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[2]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony on Immersion's claims of infringement of the '333 and '213 patents.[3] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[4]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR 1.183 in response to Immersion's petitions.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[5]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

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[2] 2005 U.S. Dist. LEXIS 4784.
[3] 2005 U.S. Dist. LEXIS 4781.
[4] 2005 U.S. Dist. LEXIS 4784.
[5] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 *inter partes* reexamination proceedings (in the decision, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions, finding "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony filed requests for *ex parte* reexamination of claims 2, 3, 5, 6, 7, 15, 16, 17, 20, 21, 25, 41, 42, 43, 44, 45, 46, 49, 50, 53 and 54 of the '213 patent and claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17 and 18 of the '333 patent, the requests being assigned control Numbers 90/007,843 (for reexamination of the '213 patent) and 90/007,844 (for reexamination of the '333 patent).

19. On December 15, 2005, Sony filed petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a), requesting that the USPTO Director authorize Sony to file <u>additional</u> requests for *inter partes* reexamination of the '333 and '213 patents, in order to permit Sony to request *inter partes* reexamination of certain claims of the '213 and '333 patents that it failed to request in its initial set of *inter partes* reexamination requests, dated May 17 and 19, 2005.

20. On January 23, 2006, Immersion filed oppositions to Sony's petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

21. On March 9, 2006, a substantial new question of patentability (SNQ) was found for claims 2, 3, 5, 6, 15, 16, 17, 20, 21 and 25 of the '213 patent and for claims 2, 3, 4, 5, 6, 7, 8, 9, 12 and

13 of the '333 patent, and *ex parte* reexamination proceedings 90/007,843 and 90/007,844 (hereinafter, the '843 and '844 proceedings) were ordered.

22. On March 22, 2006, the Senior Legal Advisor of the Office of Patent Legal Administration issued a decision dismissing Sony's December 15, 2005 petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

23. On April 11, 2005, Sony filed the instant petitions. The instant petitions are filed under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and under 37 CFR 1.182 for merger of the '844 and '093 proceedings, and merger of the '843 and '094 proceedings.

24. On May 3, 2006, Immersion filed oppositions to Sony's merger petitions.

25. On December 13, 2005, Sony brought action in the United States District Court, Eastern District of Virginia, pursuant to the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706, to obtain judicial review of the Office's November 17, 2005 petition decision suspending the '093 and '094 *inter partes* reexamination proceedings. Specifically, Sony sought review of the Office's November 17, 2005 decision which found that "good cause" existed under 35 U.S.C. § 314(c) to suspend the just-commenced '093 and '094 *inter partes* reexamination proceedings with respect to certain claims in the '213 and '333 patents on the ground that the validity of those claims were already the subject of an ongoing appeal in the U.S. Court of Appeals for the Federal Circuit. Sony argued that the Office abused its discretion in suspending the proceedings, contending the Office had a legal obligation to reexamine all claims in the patents (except the two disclaimed claims), including the claims Sony failed to request for reexamination.

26. On May 22, 2006, the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462, issued a decision in favor of the Office. The decision upheld the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings and also upheld the Office's discretion to not reexamine claims of the '213 and '333 patents for which *inter partes* reexamination was not requested.

27. A patent owner's statement under 37 CFR 1.530 has not been received in the '843 and '844 *ex parte* reexamination proceedings, and the time for filing such statement has expired.

DECISION WAIVNG RULES, TO PERMIT CONSIDERATION OF MERGER PETITIONS

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)."

The present petitions do not have an entry right under the rules. *See* 37 CFR 1.510, 1.535, and 1.550. The appropriate provisions of the rules are, however, waived to permit consideration of the instant Sony merger petitions, based upon the specific facts and unique circumstances of the present situation, as well as statements made in the Office's March 22, 2006 decision dismissing Sony's petitions to file additional requests for *inter partes* reexamination. Likewise, the appropriate provisions of the rules are *sua sponte* waived to permit consideration of Immersion's oppositions to the merger petitions.

DECISION ON MERGER PETITIONS

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. [Emphasis added].

In addition, MPEP 2686.01(I) provides:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings **normally** will be merged once reexamination has been ordered in both proceedings. In this situation the second request is decided based on the original patent claims and if reexamination is ordered in the second proceeding, the reexamination proceedings **normally** would be merged."

Reexamination of the '333 patent has been ordered in the '844 *ex parte* proceeding and '093 *inter partes* proceeding, and reexamination of the '213 patent has been ordered in the '843 *ex parte* proceeding and '094 *inter partes* proceeding. In addition, a patent owner's statement under 37 CFR 1.530 has not been received in the '844 and '843 proceedings, and the time for filing such has expired. [6] [7] Accordingly, a decision under 1.989(a) on the Sony petitions for merger is timely.

The issue to be decided is whether the *ex parte* reexaminations should be merged with the respective *inter partes* reexaminations. The present petitions raise a novel question regarding merger practice, because, pursuant to 35 U.S.C. § 314(c), the present '093 and'094 *inter partes* reexaminations are currently suspended.

At page 3 of the petitions, Sony argues that:

> "there is every reason to merge the two proceedings, and no proper reason to refrain from such merger. As set forth in M.P.E.P. § 2686.01, '[i]f a second request for reexamination is filed where a certificate will issue for a first reexamination later than three months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings.' Here, all of the proceedings are at a relatively early stage; reexamination has been ordered in all of the proceedings, but no first Official Action has been issued in any of the proceedings. As the Office has already held that 'it is not in the Office's interest to conduct a piecemeal reexamination of a patent' because a reexamination of any claim 'will already require the Examiner to review the written description, the drawings, other claims in the patent and the prior art,' and accordingly, there is relatively little additional effort to reexamine all claims instead of just some' in a given reexamination proceeding. (Decision Denying Petitions dated August 23, 2005 in the '093 and '094 *Inter Partes* Reexaminations at 13.) There is no reason for the Office to consider the same issues twice, rather than once."

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, as with the Office's decisions to reexamine claims beyond those requested and to suspend an *inter partes* reexamination for "good cause," the Office's

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[6] Pursuant to MPEP 2283(III), "[I]f Request 2 is granted, the order in the second proceeding should be mailed immediately. The two requests should be held in storage until the patent owner's statement and any reply by the requester have been received in Request 2, or until the time for filing same expires."

[7] As to the suspended '093 and '094 proceedings, there is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding.

decision to merge two reexaminations is a purely discretionary act. *See Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462 (E.D.Va. May 22, 2006).

First, the statute does not require the Office to merge or consolidate multiple reexamination proceedings. In fact, the statute is silent as to this procedural issue. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 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." (Emphasis added)). Furthermore, while the MPEP states that the Office will "normally" merge two reexaminations, that general policy does not address the unique circumstances here, in which one set of proceedings has been suspended. Indeed, the Office has never had to address the question of dissolving a suspension order for the sake of merging proceedings.

Pursuant to 35 U.S.C. 314(c), the USPTO Director may suspend an *inter partes* reexamination proceeding "for good cause." In the present instance, the Office's November 17, 2005 petition decision suspended the '093 and '094 *inter partes* reexamination proceedings because the Federal Circuit appeal on the same patent claims was far advanced in comparison to the *inter partes* reexamination proceedings, which had only recently been commenced. Thus, there was ample "good cause" to suspend the *inter partes* reexamination proceedings pending completion of the Federal Circuit appeal, in view of the statutory estoppel that would operate upon a final decision on the claims by the Federal Circuit. *See* 35 U.S.C. § 317(b).

Further, the U.S. District Court for Eastern District of Virginia upheld the Office decision to suspend the '093 and '094 *inter partes* reexamination proceedings, stating that "the PTO did not abuse its discretion in concluding that there was good cause to suspend reexamination of the litigated claims in light of the more advanced Federal Circuit appeal focusing on the same claims...." [8] The District Court found that "the PTO's decision to suspend *inter partes* review of the patent claims in issue here was clearly supported by good cause and therefore well within the bounds of the PTO's discretion." [9] Thus, Sony has already appealed the merits of the suspension order, but the court rejected that challenge.

Based on the above, the requested merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would consolidate a suspended *inter partes* proceeding with an *ex parte* proceeding which must go forward with special dispatch. *See Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). The same would be true for the requested merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. In each instance, the requested merged proceeding would be required to proceed with special dispatch, based on the presence of the *ex parte* reexamination

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[8] *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462, Slip Copy at 11.
[9] *Id.* ,at 7.

proceeding. Thus, the merger of the two sets of proceedings would necessarily require dissolving the Office's decision to suspend the *inter partes* reexamination proceedings.

While Sony is correct that the Office usually prefers to avoid piecemeal reexamination, merging the two sets of proceedings in the present instance would clearly circumvent the Office's suspension decision of the *inter partes* reexamination proceedings, which was approved by the District Court based upon the reasoning advanced by the Office. Indeed, merging the proceedings here would render the Office's discretion to suspend meaningless, and would defeat the whole purpose behind the suspension decision, *i.e.*, to await the final outcome on the litigated claims. Furthermore, such a result would undermine the legislative intent underlying 35 U.S.C. 314(c) (expressly providing the Office with discretion to find "good cause" to suspend). In view of the foregoing, the more appropriate course is to preserve the suspension decision (and all the reasoning given therein) and deny the merger petition, rather than permit Sony to collaterally attack the suspension order (which has already been affirmed by the District Court). In other words, the Office does not find that its concern over piecemeal reexamination overrides, in this instance, the reasoning for why the Office suspended the *inter partes* reexamination proceedings. Moreover, there will not be any piecemeal reexamination if the Federal Circuit affirms the District Court's decision as to validity, because the *inter partes* reexaminations will be terminated under 35 U.S.C. 317(b) and 37 CFR 1.907(b).[10]

Accordingly, the request for merger is denied.

It is also noted that pursuant to 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."

In the present instance, a merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would inappropriately provide Sony, as the third party requester of the *inter partes* reexamination, with *inter partes* participation rights as to the entirety of '844 *ex parte* reexamination proceeding, in which Sony's rights of participation are currently limited by the *ex parte* reexamination statute. Again, the same would be true for a merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. Sony's desire to have the Office consider in the *inter partes* reexamination context all the issues that Sony has raised in the *ex parte* reexaminations would improperly circumvent 35 U.S.C. § 317(a), which prohibits a third party requester from raising issues in a second *inter partes* reexamination when the third party has already triggered a pending *inter partes* reexamination. That prohibition, in view of the facts of the present case, also militates against granting Sony's petition to merge the two sets of proceedings. In other words, a third party should not be able circumvent § 317(a)'s prohibition by (i) triggering an *inter partes* reexamination limited to certain issues, (ii) raising new issues in an *ex parte* proceeding, and then (iii) automatically

[10] Should the Federal Circuit remand or vacate the lower court's validity findings, the Office at that time can consider reviewing the suspension decision as well as the question of merging the proceedings.

expecting the *ex parte* proceeding to be merged with the pending *inter partes* proceeding, let alone an *inter partes* proceeding that has been suspended for "good cause," which has already been affirmed by a district court.

CONCLUSION

1) The Sony (i.e., third party requester) petitions are

   Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions, and

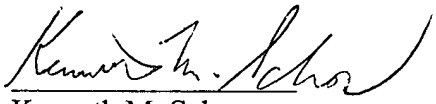
   Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

2) The above-captioned '093 and '094 *inter partes* reexamination proceedings remain suspended until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal identified above.

3) The above-captioned '843 and '844 *ex parte* reexamination proceedings are ready for action, and jurisdiction over the '843 and '844 proceedings is transferred to the examiner for that purpose.

4) The parties to the'093 and '094 *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5) Telephone inquiries with regard to this decision should be directed to the undersigned at 571-272-7710.



Kenneth M. Schor
Senior Legal Advisor
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In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,093
Filed: May 17, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

DECISION GRANTING PETITIONS

This is a decision on the March 27, 2007 patent owner petitions to terminate both of the above-captioned proceedings. The petitions are taken as a petition under 37 CFR 1.182 [1] to terminate the two proceedings.

[1] 37 CFR 1.182 provides that "[a]ll 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." There is no provision in the rules for a petition to terminate a reexamination proceeding.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The petition fee is required by 37 CFR 1.182 is hereby waived, based upon the fact that patent owner is providing notification to the Office regarding the conclusion of litigation, as it was called upon to do by the Office.[2]

For reasons set forth below, the patent owner petitions are granted.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. (hereinafter "patent owner" or "Immersion"), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[3]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony (hereinafter "requester" or "Sony") on Immersion's claims of infringement of the '333 and '213 patents.[4] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[5]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was not litigated in the district court proceeding.

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[2] For example, Item (4) of the conclusion of November 17, 2005 decision of Director of the Office of Patent Legal Administration stated:

"The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and **notify the Office when that appeal has been resolved**." [Emphasis added]

[3] 2005 U.S. Dist. LEXIS 4784.

[4] 2005 U.S. Dist. LEXIS 4781.

[5] 2005 U.S. Dist. LEXIS 4784.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was not litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR § 1.183 in response to Immersion's petitions.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[6]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 reexamination proceedings (in the decisions, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the present two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

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[6] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions to suspend the instant '093 and '094 reexamination proceedings until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony brought action in the United States District Court, Eastern District of Virginia, pursuant to the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706, to obtain judicial review of the Office's November 17, 2005 petition decision suspending the '093 and '094 *inter partes* reexamination proceedings. Specifically, Sony sought review of the Office's November 17, 2005 decision which found that "good cause" existed under 35 U.S.C. § 314(c) to suspend the just-commenced '093 and '094 *inter partes* reexamination proceedings with respect to certain claims in the '213 and '333 patents on the ground that the validity of those claims were already the subject of an ongoing appeal in the U.S. Court of Appeals for the Federal Circuit. Sony argued that the Office abused its discretion in suspending the proceedings, contending the Office had a legal obligation to reexamine all claims in the patents (except the two disclaimed claims), including the claims Sony failed to request for reexamination.

29. On May 22, 2006, the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462, issued a decision in favor of the Office. The decision upheld the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings and also upheld the Office's discretion to not reexamine claims of the '213 and '333 patents for which *inter partes* reexamination was not requested.

30. On March 27, 2007, Immersion filed the present petitions to terminate both of the '093 and '094 *inter partes* reexamination proceedings, in a paper titled NOTIFICATION OF FINAL JUDGMENT AND ISSUANCE OF MANDATE IN CONCURRENT PROCEEDINGS AND PETITION TO TERMINATE INTER PARTES REEXAMINATION PROCEEDINGS.

DECISION

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter.

The patent owner, Immersion Corporation, has provided notification to the Office as to the status of requester Sony's appeal to the Federal Circuit from the March 24, 2005 Judgment entered by the United States District Court for the Northern District of California. Immersion states that the appeal proceedings have been concluded by dismissal with prejudice, and has included a copy of the Federal Circuit's Order on March 8, 2007, and a copy of the court's corrected Order on March 14, 2007, to that effect.

As pointed out by Immersion, since Sony's appeal has been dismissed, the judgment of the District court stands. As set forth above (in the Background section of this decision), the March 24, 2005 Judgment entered by District Court, was adverse to requester Sony as to the '333 and '213 patents. Sony did not sustain its burden of proving the invalidity of the patent claims in suit, for which it requested the '093 and '094 *inter partes* reexaminations. It is that judgment of the District court which now stands, and is no longer subject to appeal. Accordingly, based upon 35 U.S.C. 317(b), the prosecution of the '093 and '094 *inter partes* reexamination proceedings is hereby terminated.

Jurisdiction over the '093 and '094 reexamination proceedings is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceedings. The CRU will mail the present decision, and process the'093 and '094 reexamination files to update the Image File Wrapper (IFW) records for the proceedings. The files will be assigned a 822 status. For each proceeding, a copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

1) The patent owner petitions are granted.

2) The prosecution of the '093 and '094 *inter partes* reexamination proceedings is hereby terminated, and the proceedings will be concluded.

3) Jurisdiction over the present reexamination proceeding is being forwarded to the Central Reexamination Unit for further processing to conclude the proceedings.

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

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

6-1-07
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MAILED
AUG 23 2005
REEXAM UNIT

In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,093 Filed: May 17, 2005 For: U.S. Patent No.: 6,424,333	DECISION DENYING PETITIONS
In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,094 Filed: May 19, 2005 For: U.S. Patent No.: 6,275,213	

On July 6, 2005, the patent owner petitioned in both of the above-captioned proceedings under 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c), making the somewhat unusual request that the two *inter partes* reexamination proceedings be dismissed, or in the alternative, suspended. On July 29, 2005, the third party requester filed petitions and oppositions under 37 CFR 1.183 in response to the patent owner's petitions. On August 5, 2005, the patent owner filed a reply to the third party requester's oppositions.[1]

The petitions and oppositions are before the Director of the Office of the Patent Legal Administration of the United States Patent and Trademark Office. Although there is no provision in the statute or rules for this type of petition, which asks for the extraordinary relief of terminating or suspending two *inter partes* reexaminations, the Office will consider the petitions in view of the unusual circumstances.

For reasons set forth below, the petitions are denied.

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[1] Because the Manual of Patent Examining Procedure (MPEP) does not permit petitioners to file a reply, the patent owner's reply has not been considered. MPEP § 2646 ("The filing of a 37 CFR § 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester.").

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. (Petitioner), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination), willfully infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[2]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion (Petitioner patent owner) against Sony (Requestor) on Immersion's claims of infringement of the '333 and '213 patents.[3] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[4]

5. On May 17, 2005, a request for reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 90/000,093 (the '0093 proceeding), was filed by a third party requester on behalf of Sony. The validity of claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, a request for reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 90/000,094 (the '0094 proceeding), was filed by a third party requester on behalf of Sony. The validity of claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441).

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[2] *2005 U.S. Dist. LEXIS 4777*
[3] *2005 U.S. Dist. LEXIS 4781*
[4] *2005 U.S. Dist. LEXIS 4784*

8. On July 6, 2005, the patent owner filed the present petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, the requester filed petitions and oppositions under 37 CFR § 1.183 in response to the patent owner's petitions.

10. On August 5, 2005, the patent owner filed a reply to the third party requester's oppositions.[5]

11. On August 17, 2005, the Office issued orders granting the request for reexamination in both the '0093 and '0094 reexamination proceedings, finding that the requests raise a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. Sony's initial brief in the Federal Circuit appeal is due on August 22, 2005, but has filed for a 60-day extension of time to file its brief.

For the reasons that follow, the patent owner's petitions to dismiss or suspend the reexamination of the '333 and '213 patents are denied.

DECISION

I. The Patent Reexamination System

In 1980, Congress added a new administrative procedure known as *ex parte* reexamination. 35 U.S.C. §§ 301-307. *Ex parte* reexamination allows third parties to call to the Office's attention new prior art issues that might affect a patent's validity that the examiner did not consider during the patent's initial examination. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601 (Fed. Cir. 1985) (*Patlex I*). Congress contemplated three principal benefits of reexamination: (i) settle validity disputes more quickly and less expensively than protracted litigation; (ii) allow courts to refer patent validity questions to the expertise of the Office; and (iii) reinforce "investor confidence in the certainty of patent rights" by affording the Office an opportunity to review doubtful patents. *Patlex I*, 758 F.2d at 602. Thus, reexamination furthers the interests of both the public and patent owners in ensuring a strong, reliable patent system by allowing the Office a second look and testing the validity of patents in view of new evidence, thereby weeding out dubious patents. The Office's expertise in science and technology as well as patent law places the agency in a unique position to assess a patent's validity correctly and efficiently. Moreover, a paramount obligation mandated by Congress upon the Office is to conduct all reexaminations with "special dispatch." 35 U.S.C. § 305. In the only Federal Circuit case to consider the meaning of "special

[5] As pointed out above, MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply has accordingly not been considered.

dispatch," the court ruled that the Office incorrectly suspended a reexamination of a patent in view of a validity challenge in a concurrent litigation, because such a suspension ran contrary to the statutory "special dispatch" requirement for reexamination proceedings. *See Ethicon v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

Ex parte reexamination, however, does not provide a meaningful opportunity for the requester to participate once reexamination is ordered. 35 U.S.C. §§ 301-307. As a result, "such reexamination had been used infrequently" since it was enacted in 1980. 145 Cong. Rec. S14720 (Nov. 17, 1999). In order to encourage more third parties to use reexamination, Congress enacted in 1999 the *inter partes* reexamination procedure "as an option to the existing *ex parte* reexamination proceedings." *Id.* With this new option, third parties can now fully participate throughout the reexamination proceeding. Moreover, "[w]ith *inter partes* reexamination, it is believed that a better balance can be achieved toward the goal of improving patent quality and validity." H.R. Rep. 107-121 (June 28, 2001).

In creating the *inter partes* reexamination statutory framework, Congress borrowed heavily from the existing *ex parte* reexamination regime. For example, "[a]ny third party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of prior art cited under the provisions of section 301." 35 U.S.C. § 311. In addition, as is the case for *ex parte* reexamination, within 3 months from the filing of an *inter partes* reexamination request, the USPTO Director must determine whether a substantial new question of patentability has been raised by the request to justify initiating a reexamination proceeding. 35 U.S.C. § 312. Further, *inter partes* reexamination proceedings must likewise be conducted with "special dispatch." 35 U.S.C. § 314(c).

A key difference between *inter partes* and *ex parte* reexamination, is that Congress provided the requester with an opportunity to meaningfully participate throughout the proceeding. 35 U.S.C. § 314(b). Further, although Congress continued with its overarching mandate that *inter partes* reexaminations be conducted with "special dispatch," in contrast to *ex parte* reexamination, Congress provided the Office with discretion to suspend *inter partes* reexamination proceedings for "good cause." *See* 35 U.S.C. § 314(c). Another difference is that while Congress gave patent owners a specific right to file a statement in response to the order for an *ex parte* reexamination (35 U.S.C. § 304), Congress chose not to provide a similar provision in *inter partes* reexamination. In fact, Congress specifically gave the Office the authority to issue the first action on the merits on the same day as the order for reexamination is issued. 35 U.S.C. § 313. Additionally, with *inter partes* reexamination, Congress specifically provided estoppel provisions when a "final decision" upholding the validity of patent claims has been reached in a civil action or in a prior *inter partes* reexamination. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims. *Id.* Accordingly, while Congress desired that the

creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also contemplated in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other. Until that time, however, the Office is obligated to move forward in the *inter partes* reexamination with "special dispatch." Only "good cause" will permit the Office from deviating from that statutory mandate.

II. Petitioner's Arguments

Petitioner requests that the Office dismiss or suspend the present *inter partes* reexamination proceedings, based on the following three arguments:

(1) The instant proceeding should be dismissed based on the March 24, 2005 District Court decision adverse to SONY, because, in Petitioner's view, 35 U.S.C. § 317 precludes SONY from requesting *inter partes* reexamination once the U.S. District Court issued its "final decision" finding the claims of the '213 and '333 patents not invalid;

(2) In the alternative, Petitioner requests that the Office suspend the *inter partes* reexaminations pending the final resolution of the concurrent litigation now pending in the U.S. Court of Appeals for the Federal Circuit; and

(3) Petitioner argues that the Office's present practice of issuing the initial Office action on the merits at the same time as the order initiating an *inter partes* reexamination proceeding deprives patent owners of their due process rights.

III. Since Claim 1 From Each Patent Was Not Litigated in the Concurrent Civil Action, the Office Cannot Dismiss Either *Inter Partes* Reexamination Proceeding

Petitioner seeks dismissal, in their entirety, of both *inter partes* reexamination proceedings based on the allegation that "a final decision has been entered against Sony [requester] in a federal civil action" and the allegation that "[requester] seeks to relitigate the same validity defense that . . . already [was] litigated and lost in court." Pet. at 2. Petitioner admits, however, that at least one claim in each patent that is part of the reexamination requests (*i.e.*, claim 1, in each case) has not been litigated in the civil action. Pet. at 6, ¶ 12. Because claims exist in each reexamination proceeding that have never been litigated, the Office cannot dismiss either of the *inter partes* reexamination proceedings.

Section 317(b) requires that in order for the estoppel effect to apply to the present *inter partes* reexamination proceedings, "a final decision has been entered against a party in a civil action"

holding that the "party has not sustained its burden of providing invalidity of any patent claim in suit . . . ." Thus, the section 317(b) estoppel provision was not written to estop any and all validity challenges to a patent after a final validity decision has been reached in litigation regarding some or all of the patent's claims. Instead, the estoppel triggers on a claim by claim basis. Petitioner fails to acknowledge this distinction in its petition. Here, since claim 1 of both the '213 and '333 patents were not litigated, no final decision, let alone any decision, has been reached regarding the validity of those claims. Therefore, even assuming that Petitioner's proposed interpretation of "final decision" in section 317(b) is a district court decision would be correct, there has been no district court decision on the validity of claim 1 of either patent. Thus, no estoppel applies to claim 1 of each reexamination proceeding under any theory. For that reason alone, Petitioner's requested relief to terminate the entire proceedings cannot be granted.

Although Petitioner did not specifically request a partial termination of the reexamination proceedings, *i.e.*, termination only with respect to the claims litigated from the '213 and '333 patents, the Office has considered that option as well. However, as explained below, since the section 317(b) estoppel provision applies only after a "final decision" by the Federal Circuit, the Office cannot dismiss the litigated claims from the two *inter partes* reexamination proceedings at this time.

IV. The Estoppel Provisions Do Not Apply Until After a "Final Decision" Which Does Not Occur Until After Any Appeals To The Federal Circuit

A. Congress Contemplated that *Inter Partes* Reexamination and Litigation of that Same Patent Could Occur Simultaneously

There is no doubt that *ex parte* reexamination of a patent and litigation of that same patent can occur simultaneously. In *Ethicon v. Quigg*, 849 F.2d 1422, 1428-1429, (Fed. Cir. 1988), the patent was both being reexamined and in civil litigation. The Office suspended the reexamination until the litigation was finally resolved. The Federal Circuit reversed the Office's decision, and ordered the Office to continue the reexamination while the litigation was ongoing. The court gave several reasons for its decision, including the statutory mandate that reexaminations must be conducted with special dispatch. *Inter partes* reexamination has the same "special dispatch" requirement. *See* 35 U.S.C. 317(b). Similarly, like *ex parte*, *inter partes* reexamination does not include provisions that (i) preclude an *inter partes* reexamination when a civil action has been filed, or (ii) preclude a civil action on a patent once an *inter partes* reexamination has been started on that same patent. The statute thus clearly contemplates that there may be concurrent proceedings, at least for some period of time. 35 U.S.C. § 317. However, the statute does provide that once the validity challenge to certain patent claims is "finally" resolved in either the civil action or the *inter partes* reexamination, then any concurrent proceeding in the other forum may no longer be maintained on the same issue or issues that could have been raised. 35 U.S.C. §§ 315(c) and 317. Congress confirmed its intent to permit concurrent proceedings by providing the USPTO Director with discretion to suspend an *inter partes* reexamination during concurrent litigation for "good cause." 35 U.S.C. § 314(c). Put more simply, the Office would have no need to suspend a reexamination proceeding based upon

a civil action if the reexamination proceeding could not occur and be maintained in the first place. The district court has similar stay provisions as well. 35 U.S.C. § 318. Thus, Petitioner's argument that "Congress intended for *inter partes* reexamination to be an alternative, not a supplement, to litigation" and therefore, "gave requester a choice: reexamination or litigation, but not both" (Pet. at 14-15) is either incorrect, or an overstatement at best.

Inter partes reexamination does differ from *ex parte* reexamination in certain respects. First, by definition, in an *inter partes* reexamination proceeding, the requester is more of a participant than in an *ex parte* reexamination proceeding. Second, there is a reciprocal estoppel provision between *inter partes* reexamination and civil litigation proceedings. Third, there are suspension provisions both for the Office and the courts when concurrent *inter partes* reexamination and civil proceedings are pending. Petitioner's first argument goes to the second of these differences (*i.e.*, the estoppel provisions). Petitioner's second argument goes to the suspension provisions. These arguments will now be addressed.

B. The Reciprocal Estoppel Provisions Apply After a "Final Decision," Which Does Not Occur Until <u>After</u> Any Appeal to the Federal Circuit is Over

After a "final decision," issues that were raised or could have been raised in a civil action or a prior *inter partes* reexamination cannot be raised or continued to be raised in another *inter partes* reexamination as to the same claims. 35 U.S.C. § 317(b). Similarly, after a "final decision" of an ordered *inter partes* reexamination finding a claim valid, issues raised (or that could have been raised) regarding that claim's validity cannot be raised in a civil action. 35 U.S.C. § 315(c). Petitioner's first argument hinges upon what is meant by a "final decision." Specifically, Petitioner asserts that the "meaning of the term 'final decision' refers to "appealable decisions of a subordinate tribunal, such as a district court judgment . . . and does not require exhaustion of all appeals." Pet. at 9. In its opposition, Requester argues that "the term 'final decision' in § 317(b) is used to describe the finality of a decision on patentability sufficient to extinguish a party's right to request or proceed with an *inter partes* reexamination on the same claims" which does not occur until "the action ends after the appeal process." Opp. at 10-11.

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as <u>after</u> a Federal Circuit decision, and not simply after a district court (or BPAI) decision as Petitioner argues. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[6]

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[6] Regarding Petitioner's contention that "final decision" in statutes refers to a district court decision, a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only "final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not <u>final</u> until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. The Office interprets the term "final decision" for either proceeding[7] as "after all appeals." *See* MPEP § 2686. The Office's interpretation is correct for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

First, "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law that holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a).

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after

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[7] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

any appeals. *See* 35 U.S.C. § 315 (c) (barred from raising invalidity in a civil action if previously "finally" held valid in a *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is easy to see that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> . . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised . . . .

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." Furthermore, Petitioner's attempt to parse words and phrases from this legislative history to argue that "after any appeals" only applies to a "final decision in an *inter partes* reexamination" but does not apply to a "final decision" in a civil action not only lacks merit, but is illogical when reading the legislative history in the context of the statutory framework as a whole. *See* Pet. at 17-18. As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic supports construing the term "final decision" as "after all appeals." In contrast, adopting Petitioner's construction of "final decision" would not only be inconsistent with the underlying policy of *inter partes* reexamination, it would make the statutory scheme unworkable. Pet. at 9-11. For example, if a district court enters a decision holding all claims in a patent not

invalid, and later on appeal, is reversed (or modified), then the conclusion of an *inter partes* proceeding prior to exhaustion of appeals would have been premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the reexamination proceedings. A completely new request for reexamination would have to be made in a redundant fashion. Clearly, such redundancy is a result Congress did not intend in light of the fact that it provided the PTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to work properly.

C. The *Timken* Case

In its opposition to the instant petition, the requester relies on *Timken Co. v. United States*, 893 F.2d 337 (Fed. Cir. 1990), for the general proposition that "final decision" can mean different things in different statutes. Opp. at 11 (citing *Timken*, 893 F.2d at 339) ("term 'final decision' can mean different things in different situations."). Requester further points out that in *Timken*, the Federal Circuit interpreted the statutory term "final decision . . . in an action" as "after all appeals." Opp. at 11. While *Timken* is factually distinguishable from the present matter because it flows from a different statute and refers to a "final decision" from an agency rather than a civil action in a court, it nevertheless shows that Congress is free to use the term "final decision" and define it to mean "after appeals" if Congress so chooses. Accordingly, *Timken*, confirms that when interpreting the term "final decision," the specific statutory scheme from which it is embodied must be consulted. *Timken*, 893 F. 2d at 339. A close reading of *Timken* provides further assistance in construing the specific terminology "final decision . . . in an action." *See Timken*, 893 F.2d at 339 ("Most persuasive is the fact that the term "final court decision" must be read together with the words that follow, specifically, 'in the action.' An 'action' does not end when one court renders a decision, but continues through the appeal process."). *Timken* shows the Federal Circuit has interpreted the language "final decision . . . in an action" as "after all appeals" in the past, and supports the proposition that the Office is reasonable in interpreting similar language in a similar manner in this instance (*i.e.*, "final decision . . . in a civil action"). Finally, applying a similar analysis as in *Timken*, the Office's construction of the term "final decision . . . in a civil action" with respect to 35 U.S.C. § 317 is consistent with language in its respective legislative history (*i.e.*, "after any appeals").

D. 35 U.S.C. § 317 Does Not Codify the Common Law *Res Judicata* Doctrine

Petitioner also argues that Congress has codified the common law principle of judicial *res judicata* and applied it to Office proceedings. Pet. at 11-12. This is incorrect. Petitioner relies on its interpretation of "final decision" to establish a link that is inconsistent with the statute and its legislative history as discussed above. In addition, administrative *res judicata* and not judicial *res judicata* is the common law doctrine that typically applies to agency proceedings. It is unlikely that Congress would codify the court-court doctrine and apply it to a court-agency situation, which is normally governed by an administrative doctrine, without doing so in express terms.

The key distinction between administrative *res judicata* in the court-agency context and court-court *res judicata*, as applied in the cases cited by Petitioner, is discussed by Wright and Miller:

> When an agency proceeding follows after a judicial determination, the agency may wish, or may be required, to honor the judgment by precluding readjudication of common issues. ** Of course preclusion is limited in this setting by the general rules that limit all preclusion—there is no preclusion if different issues are presented, the judicial determination was a preliminary ruling that does not count as an adjudication on the merits, a lower burden of persuasion applies in the agency, and so on. And the separate statutory competencies of courts and agencies commonly mean that a judicial decision does not bar a later agency proceeding as a matter of claim preclusion.

18B Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal Practice and Procedure § 4475 (2d ed. 2002) (footnotes deleted, underlining added). The Federal Circuit, specifically relied on the lower burden of persuasion in the Office when requiring the Office to continue with an *ex parte* reexamination proceeding:

> [I]f the district court determines a patent is not invalid, the PTO should continue its reexamination because, of course, the two forums have different standards of proof for determining invalidity.

Ethicon v. Quigg, 849 F.2d 1422, 1428-1429, (Fed. Cir. 1988). This is not to say that *Ethicon* controls in *inter partes* reexamination cases or that Congress codified the doctrine of administrative *res judicata*. Instead, in creating *inter partes* reexamination, Congress established a statutory estoppel regime against the backdrop of *Ethicon*, *ex parte* reexamination procedures, and court-agency *res judicata*, not to wholesale adopt court-court *res judicata* as argued by petitioner.

The estoppel regime in *inter partes* reexamination, as explained above, prevents the Office from terminating an *inter partes* reexamination proceeding before its conclusion or until the courts, after all appeals, decide the issue as between the parties. This is consistent with the Federal Circuit's admonition in *Ethicon* that "if a court finds a patent invalid, and that decision is either upheld on appeal or not appealed, the PTO may discontinue its reexamination." *Ethicon*, 849 F.2d at 1429(emphasis added).

Petitioner argues that *Ethicon* is inapplicable because Congress "amended the very language that the Federal Circuit relied on to decide *Ethicon*, 35 U.S.C. § 305 ("All reexamination proceedings … will be conducted with special dispatch")." Pet. at 13. This is incorrect. The special dispatch requirement is still maintained in *inter partes* reexamination. 35 U.S.C. § 314(c). The amendment cited by Petitioner did not eliminate the special dispatch requirement; it simply provided that the Director may, for good cause, suspend (not terminate or discontinue) an *inter partes* reexamination proceeding.

V. Since the Office Must Reexamine Claim 1, and There Has Been No Final Decision as to the Litigated Claims, Good Cause Does Not Exist to Suspend the Reexamination Proceedings

Petitioner requests, in the alternative, that the Office suspend the reexamination proceedings until the Federal Circuit decides the pending appeal (Appeal Nos. 05-1227, 1358 and 1441) of the district court decision. In Petitioner's view, good cause exists to suspend the proceeding because (i) it is contrary to the statute to permit an *inter partes* reexamination after a district court has entered a decision on the validity of the patent, and (ii) suspension "will prevent the unnecessary and wasteful expenditure of resources by the Office and Immersion [Petitioner patent owner], while the co-pending appeal is decided." Pet. at 26.

Petitioner's first reason for suspension is simply a restatement of its earlier position (that the district court decision estops the reexamination), which has been rebutted for the reasons stated above. Petitioner's second reason once again overlooks the key fact, - that both reexaminations involve a patent claim not asserted in the civil action. Thus, no matter what the Federal Circuit does, the Office is required to go forward and reexamine claim 1 to completion. Accordingly, the only question remaining is whether the Office suspends the reexamination proceeding given at least one claim (or more) will be reexamined later.

Pursuant to 35 U.S.C. § 314(c), *inter partes* reexamination proceedings "shall be conducted with special dispatch" within the Office, "[u]nless otherwise provided by the Director for good cause." The Office has recognized, through rulemaking, that a concurrent litigation may, in certain circumstances, establish good cause to suspend a reexamination proceeding:

> If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

37 CFR 1.987. The MPEP provides two examples of what can establish "good cause":

(1) co-pending litigation includes an issue best decided in court, rather than Office;
(2) co-pending litigation includes an issue that cannot be decided by the Office, but affects the resolution of the proceeding.

See MPEP § 2686.04. Petitioner does not argue that the present facts fall within either example, although "good cause' is not limited to the MPEP examples.

Petitioner argues that the court proceeding is now at such an advanced stage that it would promote administrative efficiency to suspend the reexamination proceeding to await the Federal Circuit's decision. This position has some merit. The Federal Circuit decision potentially could narrow the two reexamination proceedings by removing the litigated claims from the proceedings. However, a reexamination proceeding still would have to continue as to non-litigated claim 1 of each proceeding, regardless of the Federal Circuit decision. Further, Congress mandated that the Office conduct reexaminations with "special dispatch," which the

Office is obligated to follow regarding the non-litigated claims, at the very least.

More specifically, regardless of how the Federal Circuit decides the appeal in the concurrent litigation, each reexamination proceeding will continue after that decision at a minimum for at least one non-litigated claim (i.e., claim 1). The section 317(b) estoppel provision only applies on a claim by claim basis, not to the patent as a whole. To elaborate, a party is estopped from requesting or maintaining an *inter partes* reexamination for those claims litigated in a civil action once a final decision has been reached. As explained earlier, it is undisputed that there has been no decision with respect to claim 1 of either patent, - since the validity of claim 1 was not litigated in the civil action. Petitioner has not alleged (presumably, since the statutory language will not support it) that since "some" claims of the patent were involved in the civil action, estoppel applies to "all" claims. The statute speaks to estoppel of claims, not of patents as a whole.

It is not in the Office's interest to conduct a piecemeal reexamination of a patent, where the Office reexamines some claims while suspending review of other claims. A reexamination of claim 1 in each proceeding will already require the examiner to review the written description, the drawings, other claims in the patent, and the prior art. Thus, there is relatively little additional effort to reexamine all claims, instead of just some. Moreover, an initial review of claim 1 for each patent suggests that, although not identical, it is similar to the litigated claims of the respective patents. Thus, it is appropriate and efficient that the reexamination be continued and carried out on the litigated claims, along with claim 1. In contrast, reexamining claim 1 now, and then possibly reexamining the other claims later, poses the administrative burden of the Office having to potentially do a significant amount of rework, while frustrating the requirement that these proceedings be conducted with special dispatch.[8] Moreover, in the 25 year history that the Office has conducted reexamination proceedings, it has never reexamined some claims of a patent while suspending review of other claims.

Furthermore, it is uncertain whether the Federal Circuit's decision will ultimately estop a reexamination of the litigated claims for the '333 and '213 patents. For example, the district court's decision on validity could be reversed or vacated, with a remand for a new trial. In that case, reexamination of the litigated claims would continue since there would be no "final" decision. Accordingly, the Office is faced with a choice of (i) suspending the entire proceedings, even though it will have to eventually reexamine claim 1 regardless of the Federal Circuit's decision, (ii) suspending reexamination of some, but not all, of the claims, or (iii) reviewing all the claims of the patents. The Office has never engaged in piecemeal reexamination in the past, and Congress had never expressed intent for the Office to do so. As already explained, the first choice is contrary to the statute, since claim1 has to be reexamined with special dispatch, and the second choice does not relieve the Office of any administrative burden in a meaningful way. At the same time, while it is in the Office's interests to avoid doing work that ultimately could be

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[8] As of the date of this decision, Sony's (Requestor) initial brief in the Federal Circuit appeal is due August 22, 2005, but has filed a request for a 60 day extension, which is commonly granted. Thus, it does not appear that briefing will be complete in the appeal until the end of 2005. As a result, it may take one year or longer before the Office has the benefit of the Federal Circuit's decision in the appeal.

mooted by the concurrent litigation, on balance, "good cause" does not exist at this time to warrant suspending the proceedings, in whole or in part. If, however, the Office becomes aware that the validity issue(s) on appeal with respect to the litigated claims were identical to the issues developed during the reexamination regarding the reexamined claims (e.g., claim construction of a particular claim term shared in all the claims), then the matter would be looked at again to see if that might be a circumstance where it would be in the interests of administrative efficiency to await the Federal Circuit's decision on that disputed issue before the Office continued the reexamination proceeding.[9]

Finally, one of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial question of patentability not previously considered by the Office. It is thus in the public interest of patent quality that the reexamination continue at this time. It is further to be noted that the reexamination of a patent is not merely a duplication of a validity challenge in court, as suggested by Petitioner. In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit noted that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. *Id.* at 1427-29. Since the "clear and convincing" standard used in court proceedings is more difficult to satisfy than the "preponderance" standard applied by the Office, claims held valid by the courts may be still rejected in a reexamination proceeding. Moreover, because a patent owner can amend the claims in a reexamination proceeding, the Office gives claims their broadest reasonable interpretation consistent with the specification, which is different than the claim interpretation employed by the courts. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). Thus, the two proceedings are not duplicative and it is appropriate, as contemplated by the statute, that both proceedings continue until one of them reaches a "final decision," which then will require the termination of the validity challenge to those same patent claims in the other forum.

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[9] The Office is sympathetic to the fact that Petitioner has already been through a district court litigation defending the validity of several (but not all) of the claims in the reexamination proceedings. Nonetheless, the district court decision did **not** include one claim in each reexamination proceeding, and as to the other claims, the decision is not yet "final." Moreover, because Congress wrote section 317(b)'s estoppel provision on a claim-by-claim basis, if all the claims of the '213 and '333 patents had been litigated, then that might be an example where good cause would exist to suspend the reexaminations. Since the Office recognizes that if not every claim's validity is at issue in a civil action (which is not uncommon), one can at least begin a reexamination by asserting non-litigated claims for the reasons already stated, the Office has little choice but to move forward with the proceedings at this time. However, the Office has advised the parties to keep it apprised of the Federal Circuit appeal, and will act accordingly once the Federal Circuit's decision (mandate) issues. However, since the estoppel provision is written in terms of claims and not in terms of patents, the reexamination proceedings will go forward as to claim 1 (in each reexamination proceeding) regardless of the Federal Circuit's decision. Quite simply, since the estoppel provision is written in terms of claims and not in terms of patents, a party can request an *inter partes* reexamination after a Federal Circuit decision, as to the validity of claims not involved in the litigation (civil action). This is Congress' decision.

VI. Petitioner Has Not Been Denied Due Process

Finally, Petitioner argues that the Office's current *inter partes* reexamination procedures, which provide that an initial, non-final action on the merits will ordinarily be included with an order for reexamination,[10] prevent Petitioner from being heard at a meaningful time and in a meaningful manner. In Petitioner's view, the practice of precluding a patent owner from participating in an *inter partes* reexamination prior to the issuance of an initial action (37 CFR 1.939(b)) is "inconsistent with constitutional dictates of due process." Pet. at 20.

First, it bears noting that this argument has essentially been rejected by the Federal Circuit in *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 484-86 (Fed. Cir. 1985) ("*Patlex II*"). Although *Patlex II* involved an *ex parte* reexamination, the court's reasoning in that case applies with equal force to *inter partes* reexaminations. In *Patlex II*, the patent owner in that case claimed that 37 CFR 1.530, which precludes a patent owner from participating in the Director's threshold determination of whether to grant a request for *ex parte* reexamination, violated his due process rights by depriving him of the right to be heard prior to the decision on whether to order a reexamination. *Id.* The Federal Circuit rejected the due process challenge because (i) the Office's order for reexamination is only a preliminary decision, not a final agency action, and (ii) the patent owner has ample opportunity to participate in the reexamination proceeding and respond to the examiner's findings. *Id.* at 485-86. Thus, the court has already determined that the constitutional requirement for "due process" does not provide patent owners with a right to participate before the Office issues a preliminary, non-final action in a reexamination proceeding.

Rather than contending that *Patlex II* was wrongly decided, Petitioner instead contends that constitutional due process requires that patent owners be permitted to file a substantive paper before the Office issues an initial Office action on the merits (which is the next agency action in a reexamination proceeding after the order).[11] It is black letter law that an initial Office action

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[10] Current procedure encourages (MPEP § 2660), but does not require, an initial action on the merits to be issued with the order to reexamine, thereby following the statutory mandate to conduct *inter partes* reexamination proceedings with "special dispatch." 35 U.S.C. § 314. The inclusion of a first action with the order is specifically contemplated by 35 U.S.C. § 313, which reads "[t]he order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314." However, in this particular instance, the initial, non-final action does not accompany the order issued today, but instead will follow in due course.

[11] When Congress in 1999 enacted the *inter partes* reexamination statute (35 U.S.C. §§ 311-18), it was presumably aware of the Federal Circuit's decision in *Patlex II* upholding 37 CFR 1.530(a), thereby essentially ratifying that practice for *inter partes* reexam proceedings, since the relevant statutory sections mirror that for *ex parte* reexaminations. *See Fluor Corp. v. United States*, 126 F.3d 1397, 1404 (Fed. Cir. 1997) ("Congress presumed to be aware of judicial interpretations of law, and that when Congress enacts a new statute incorporating provisions similar to those in prior law, it is assumed to have acted with awareness of judicial interpretations of prior law."); *see also San Huan New Materials High Tech, Inc. v. Int'l Trade*

does not substantively affect a patent owner's rights. Rather, a patent remains valid and in force throughout the reexamination process, whether *ex parte* or *inter partes*. *Heinl v. Godici*, 143 F.Supp.2d 593, 600 (E.D.Va. 2001)(citing *Patlex I*, 758 F.2d at 603); *see also Patlex Corp. v. Quigg*, 680 F.Supp. 33, 35 (D.D.C. 1988). In fact, this does not change unless and until a Federal Circuit mandate issues, invalidating the claims (assuming appeal rights are exhausted). In contrast, the initial action on the merits is only the first step in the administrative proceeding, and Petitioner has many opportunities to be heard during the proceeding before it becomes final.

The Federal Circuit explained in *Patlex II* that the general test for evaluating due process in administrative procedures is set forth in *Mathews v. Eldridge*, 424 U.S. 319 (1976):

> First, the private interest that will be affected by the official action; second, the risk of an erroneous deprivation of such interest through the procedures used, and the probable value, if any, of additional or substitute procedural safeguards; and finally, the Government's interest, including the function involved and the fiscal and administrative burdens that the additional or substitute procedural requirement would entail.

Id. at 335. As to the first factor, the private interest affected is similar to that in *Patlex II* – "the temporary deprivation of full enjoyment of patent rights" for the period needed to correct an erroneous determination in the first action. *Patlex II*, 771 F.2d at 485. The patent owner will have an opportunity to address what is felt to be a deprivation from an erroneous unfavorable first Office action in the second Office action, at which point the Office will have the benefit of the patent owner's response to the first Office action. That intervening period would not be too long in time, since all reexaminations must be conducted with "special dispatch." 35 U.S.C. § 314. Regarding the second factor, the risk of examiner error due to lack of information from the patent owner is low, because examining the patentability of patent claims on the merits in view of prior art references is the core function of a patent examiner. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003) ("As persons of scientific competence in the fields in which they work, examiners and administrative patent judges on the Board are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would provide to such persons"). The scope of *inter partes* reexamination is specifically limited to reviewing patent claims against prior art references. 35 U.S.C. § 311. Accordingly, the Federal Circuit appropriately recognized patent examiners to be "disinterested experts," mitigating against the risk of error. *Patlex II*, 771 F.2d at 485. Moreover, the court's recognition that examiners are independent and disinterested

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Comm'n, 161 F.3d 1347, 1355 (Fed. Cir. 1999); *Mudge v. United States*, 308 F.3d 1220, 1232 (Fed. Cir. 2002). In addition, unlike the *ex parte* reexamination statutory regime, Congress chose to not provide for any patent owner statement option after an order for an *inter partes* reexamination. Compare 35 U.S.C. § 304 with 35 U.S.C. § 313. Rather, Congress specifically authorized that the Office may move up the date an initial action on the merits issues to the same day as the order initiating the *inter partes* reexamination. *Id.* Accordingly, Petitioner's constitutional challenge applies not only to the Office's procedures, but to the constitutionality of 35 U.S.C. § 313 as well. In other words, is it unconstitutional for Congress to grant the Office the authority to issue an initial action the same day as the order, in view of the Office's existing practice barring any patent owner participation in a reexamination prior to the order.

experts necessarily refutes Petitioner's suggestion that an examiner would be inclined not to change any unfavorable position in the first Office action in view of a patent owner's response. Contrary to Petitioner's assertions, the fact that it is intended by the Office that the first action be "comprehensive" and intended to be the "primary" action simply refers to requirement that examiners should identify all of the issues in the first action, not that the first action is intended to be a final position. Indeed, examiners are required by regulation to reconsider positions taken in an initial Office action in view of the patent owner's response. 37 CFR 1.112. Regarding the third and final factor, the governmental interest, as the court in *Patlex II* noted, the administrative convenience of the challenged practice here is not entitled to "controlling weight in our review of the constitutional issue." *Id.*

In view of the above factors, the challenged practice comports with due process because the risk of error is low, and the private interest affected is only temporary and can be resolved during the patent owner's various opportunities to be heard during the administrative proceeding. The Supreme Court has held that "the demands of due process do not require a hearing, at the initial stage *or at any particular point* or at more than one point in an administrative proceeding so long as the requisite hearing is held before the final order becomes effective." *Opp Cotton Mills, Inc. v. Administrator*, 312 U.S. 126, 152-53 (1941) (emphasis added) (cited by *Patlex II* at 485).

Accordingly, Petitioner's attempt to distinguish *Patlex II* on the grounds that an initial Office action is one step farther along in the proceeding than the order to begin a reexamination is not a meaningful difference. First, like the reexamination order, any unfavorable first Office action is NOT a final agency action. 37 CFR §§ 1.945 and 1.949; *see also Heinl v. Godici*, 143 F.Supp.2d 593, 597-600 (E.D.Va. 2001)(highlighting numerous opportunities for patent owner to respond before agency action becomes final, and until then, no irreparable harm). In other words, an initial action does not have "the status of law" or immediate legal force. *See Federal Trade Comm'n v. Standard Oil Co. of California*, 449 U.S. 232, 239-42 (1980). Rather, it is only an initial position, indicating that the examiner has reason to believe that the patent claims are unpatentable in view of prior art. Second, as with the reexamination order, the patent owner has numerous opportunities to rebut any positions in a first Office action that find patent claims unpatentable. After every non-final Office action, like the first one, the patent owner has the right to respond. 37 CFR 1.937(b) (citing, *inter alia*, 37 CFR 1.111(a)(1)). The patent owner has other opportunities to present his position to the examiner as well. 37 CFR §§ 1.951 and 1.116. In addition, the patent owner has the opportunity to appeal an examiner's final decision to the Board of Patent Appeals and Interferences, which includes briefing and an oral hearing. 35 U.S.C. § 315. Thus, Petitioner's concern that it will not have a fair opportunity in the proceeding to respond to any "one-sided argument" presented in a request for *inter partes* reexamination is not correct. Accordingly, the current *inter partes* reexamination procedures, which follow Congress's specific authorization to issue an initial action the same day as the order, comports with the requirements for due process.

CONCLUSION

1. The petitions to dismiss or, in the alternative, to suspend the reexamination proceedings are denied.

2. This decision is a final agency action within the meaning of 5 U.S.C. § 704. This decision does not, however, preclude parties from seeking relief on this matter at some point in the future, should the circumstances on which this decision was grounded change.

3 The reexamination proceedings are being retained within the jurisdiction of Office of Patent Legal Administration for one month, after which it will be forwarded to Technology Center 2600 for the issuance of a first Office action in each proceeding.

4. The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5. Telephone inquiries with regard to this decision should be directed to Anton Fetting, Senior Legal Advisor, at 571-272-7717 or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

FUTURE CORRESPONDENCE IN PROCEEDING

All correspondence relating to these *inter partes* reexamination proceedings should be directed:

By U.S. Postal Service Mail:	Mail Stop *Inter Partes* Reexam Central Reexamination Unit Office of Patent Legal Administration United States Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-0100 Central Reexamination Unit
By hand (or delivery service):	Customer Service Window Randolph Building 401 Dulany St. Alexandria, VA 22314

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REEXAM UNIT

In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,093 Filed: May 17, 2005 For: U.S. Patent No.: 6,424,333	DECISION GRANTING PETITIONS TO SUSPEND
In re Mark R. Tremblay et al. Reexamination Proceeding Control No.: 95/000,094 Filed: May 19, 2005 For: U.S. Patent No.: 6,275,213	

This is a decision on the September 9, 2005 patent owner petitions in both of the above-captioned proceedings under 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c), requesting that the two *inter partes* reexamination proceedings be suspended. This is also a decision on the September 26, 2005 third party requester petitions and oppositions under 37 CFR 1.183 filed in response to the patent owner's petitions.

The petitions and oppositions are before the Director of the Office of the Patent Legal Administration of the United States Patent and Trademark Office. Although there is no provision in the statute or rules for this type of petition, which asks for the extraordinary relief of suspending two *inter partes* reexaminations, the Office will consider the petitions in view of the unusual circumstances associated with the petitions.

For reasons set forth below, the patent owner petitions are granted, to suspend the examination

and prosecution of the two *inter partes* reexamination proceedings until the circumstances in the parallel litigation warrant termination or resumption of the examination and prosecution.

For reasons set forth below, the third party requester petitions are granted to the extent that they have been considered, but are otherwise denied (i.e., examination and prosecution of the proceeding will not go forward, but rather, action is suspended for the proceedings).

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. ("Petitioner" or "Immersion"), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination), willfully infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[1]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony ("Requester" or "Sony") on Immersion's claims of infringement of the '333 and '213 patents.[2] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[3]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '0093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was not litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '0094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was not litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441).

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[1] 2005 U.S. Dist. LEXIS 4784.
[2] 2005 U.S. Dist. LEXIS 4781.
[3] 2005 U.S. Dist. LEXIS 4784.

8. On July 6, 2005, the patent owner filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, the requester (Sony) filed petitions and oppositions under 37 CFR § 1.183 in response to the patent owner's petitions.

10. On August 5, 2005, the patent owner filed a reply to the requester's (Sony) oppositions.[4]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '0093 and '0094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '0093 and '0094 reexamination proceedings.

13. On September 9, 2005, the patent owner filed (a) the present petitions to suspend the present *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, the patent owner filed a petition in the present two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Such jurisdiction over the two proceedings is in fact being retained by the Office of Patent Legal Administration.

15. On September 26, 2005, the requester filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. Immersion's principal brief is due December 7, 2005.

DECISION

I. The August 23, 2005 Petition Decision

In the August 23, 2005 decision denying Immersion's July 6, 2005 petitions to dismiss or stay the two *inter partes* reexamination proceedings, the Office reviewed the relevant portions of the

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[4] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply has accordingly not been considered.

inter partes reexamination statute. The decision noted that Congress, in creating the *inter partes* reexamination statutory framework in 2002, borrowed heavily from the existing *ex parte* reexamination regime. For example, *inter partes* reexamination proceedings, like *ex parte* reexaminations, must be conducted with "special dispatch." 35 U.S.C. § 314(c). Unlike *ex parte* reexamination, however, Congress provided the Office with the statutory authority and discretion to suspend *inter partes* reexamination proceedings for "good cause." *See* 35 U.S.C. § 314(c).

Another difference between the two regimes is that Congress specifically provided estoppel provisions to shut down an *inter partes* reexamination of a patent claim when a "final decision" upholding the validity of that claim has been reached in a civil action or in a prior *inter partes* reexamination proceeding. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then (a) that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims, and (b) "an *inter partes* reexamination previously requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office." *Id.*

The August 23, 2005 decision further explained that the statute and legislative history of the estoppel provisions make clear that the *inter partes* reexamination of a claim (requested by a party) must be terminated once a final decision upholding the validity of that claim (challenged by the same party) had issued "after any appeals," not simply just after a district court decision which is still pending on appeal. While Congress desired that the creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also provided in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends in a manner adverse to a third party, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other proceeding.

In the August 23, 2005 decision, the Office noted that Sony's request for *inter partes* reexamination was made not only for all of the litigated claims in the concurrent litigation, but also for claim 1 of each patent, which were *not* part of the litigation. Accordingly, even though the concurrent litigation was at an advanced stage and a Federal Circuit affirmance of the district court's validity decision would narrow the two reexamination proceedings by removing the litigated claims, the Office recognized that each reexamination proceeding would still have to continue as to non-litigated claim 1, regardless of the Federal Circuit's decision. Therefore, the Office did not find "good cause" to suspend the reexamination of claim 1 of each patent. In addition, the Office determined that it did not make sense to create a piecemeal reexamination process by moving forward on reexamining claim 1 while suspending reexamination of the litigated claims pending the outcome of the appeal. Accordingly, the Office denied patent owner Immersion's petition to stay the *inter partes* reexamination proceedings for lack of good cause.

II. Petitioner Patent Owner's Requested Relief

Immersion now renews its request that the Office suspend the present *inter partes* reexamination proceedings, pending the final resolution of the concurrent litigation now pending in the U.S. Court of Appeals for the Federal Circuit, i.e., until the Federal Circuit decides the pending appeal (Appeal Nos. 05-1227, 1358 and 1441) of the district court decision.[5] The renewed request is based on the following arguments:

(1) Petitioner argues that "good cause" exists to suspend the proceedings because suspension will conserve the resources of the Office and also "will advance the purposes of the *inter partes* reexamination system by relieving all parties of the onerous burdens of proceeding with the reexaminations while simultaneously litigating the same claims in Federal Court." Pet. at 3-4.

(2) Petitioner argues that its recent statutory disclaimer of claim 1 in each of the '213 and '333 patents removes the only significant reason for the denial of its previous July 6, 2005 petitions to suspend the proceedings, namely that reexamination of claim 1 of each patent was requested in the reexamination requests, and claim 1, in each case, was not before the court in the litigation. In other words, petitioner points out that now that claim 1 from each patent has been eliminated, the remaining claims for which the Office has found a substantial new question of patentability are identical to the litigated claims, which survived Sony's validity challenge in district court, and are now pending appeal. Thus, in petitioner's view, a Federal Circuit decision affirming the district court's decision as to the validity of those litigated claims would subsequently require the Office to shut down the *inter partes* reexamination of all the claims that the Office has reviewed (the litigated claims), in view of the estoppel provision in 35 U.S.C. § 317(b). For that reason, petitioner urges the Office to suspend the two *inter partes* reexamination proceedings to wait and see if the Federal Circuit's decision will effectively moot the reexamination proceedings, which are now only at the beginning stage.

III. "Good Cause" Now Exists to Suspend the *Inter Partes* Reexamination Proceedings Because the Claims Under Review in the Proceedings Are Identical to the Claims Pending at the Federal Circuit

Pursuant to 35 U.S.C. § 314(c), *inter partes* reexamination proceedings "shall be conducted with special dispatch" within the Office, "[u]nless otherwise provided by the Director for good cause." The Office has recognized, through rulemaking, that a concurrent litigation may, in certain circumstances, establish "good cause" to suspend an *inter partes* reexamination proceeding:

> If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

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[5] Immersion's initial petitions requested termination, or in the alternative, suspension of the reexamination proceedings. Immersion's current petitions request only suspension.

37 CFR 1.987.[6]

A district court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause," due to the real possibility that the 35 U.S.C. § 317(b) estoppel may very well attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.

A. In the August 23, 2005 decision, the Office pointed out that it was undesirable to conduct a piecemeal reexamination of a patent, where the Office reexamines some claims while suspending review of other claims until a later date. Reexamination was requested, in each case, as to the litigated claims and non-litigated claim 1. Based on those requests, the Office ordered reexamination in each case, finding a substantial new question of patentability as to each of the requested claims. The August 23, 2005 decision recognized that, even if the Federal Circuit upheld the district court's claim validity findings, the 35 U.S.C. § 317(b) estoppel provision would not bar reexamination of claim 1, which is not involved in the concurrent litigation. Thus, the pending Federal Circuit appeal did not affect the requirement that claim 1 would be required to be reexamined with special dispatch, and the Office accordingly decided that "good cause" did not exist to suspend the reexaminations for only the litigated claims pending the outcome of the appeal, because such a suspension would create the potential for complex piecemeal reexamination.

Since the August 23, 2005 decision, new events have occurred, i.e., patent owner Immersion has statutorily disclaimed claim 1 in each patent. Thus, the reexamination proceedings will no longer continue as to non-litigated claim 1. Accordingly, Immersion's elimination of claim 1 in each proceeding aligns the claims and issues when comparing the two reexamination proceedings to the appeal now pending at the Federal Circuit. An affirmance by the Federal Circuit will terminate these *inter partes* reexamination proceedings based on the estoppel provision of 35 U.S.C. § 317(b). Immersion therefore makes a good case to suspend the proceedings, since it is a reasonable likelihood that the Federal Circuit's decision will moot the reexamination proceedings.

Despite patent owner Immersion's disclaimer of claim 1 in each patent, Sony contends that the same piecemeal reexamination concerns that the Office had in its August 23, 2005 decision still presently exist. At pages 2-5 of Sony's September 26, 2005 petitions and oppositions, Sony argues that the reexamination proceedings should not be suspended because, - even if the Federal

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[6] The Manual of Patent Examining Procedure (MPEP) provides two examples of situations that can establish "good cause": (1) co-pending litigation includes an issue best decided in court, rather than Office; and (2) co-pending litigation includes an issue that cannot be decided by the Office, but affects the resolution of the proceeding. See MPEP § 2686.04. Petitioner patent owner does not argue that the present facts fall within either example, but rather "good cause' is not limited to the MPEP examples. Petitioner is correct that the situations expressed in the MPEP are merely exemplary and that other fact situations may merit suspending an *inter partes* reexamination for good cause.

Circuit affirms the district court's decision as to the validity of the litigated claims (and thereby bars the instant reexamination of the litigated claims), Sony believes that the Office is nevertheless required to reexamine all of the remaining (after disclaimer of claim 1) non-litigated claims in the patents. In Sony's view, even though claim 1 of each patent has been disclaimed, the Office must begin reexamination, with special dispatch, of the remainder of the non-litigated claims, i.e., claims 2–6, 7–40, 46–48, 51–52, and 55–60 of the '213 patent, and claims 2–13 of the '333 patent, even though Sony did not include any of these claims in its two requests for reexamination and the Office did not include any of these claims in its two orders for reexamination.

As support, Sony points to 35 U.S.C. § 314, which states that once a substantial new question of patentability is found and reexamination is ordered:

> Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

That language, however, does not require the Office to reexamine claims that were not part of a request for reexamination. Instead, it simply requires that the Office apply in a reexamination proceeding, the same statutory procedures that were used during the "initial examination." At the present stage of the instant reexamination proceedings, the only claims that have been considered by the Office are the claims for which Sony requested review.

At the present stage in the two reexamination proceedings, the Office's work so far has been limited to solely a review of whether the request raises a substantial new question of patentability only for the claims for which Sony requested review. Having only recently ordered reexamination based on the requested claims, no review of any of the non-requested claims has taken place. Sony cannot complain as to this result, since it was free to request reexamination of all the claims of both patents, but made the choice not to do so. In other words, if Sony was interested in having all the non-litigated claims reexamined in addition to the litigated claims, it had the opportunity to do so when it filed its requests for reexamination but chose not to do so.

Sony also argues that the Office examines all claims of a patent during a reexamination proceeding, even if the request for the Office to reexamine a patent is limited to only some of the claims, citing MPEP 2658(IV)(B). While, as pointed out specifically in MPEP 2640, the Office "usually" reexamines all claims of a patent, it is not required to do so in every case. On the particular facts and present stage of the instant reexaminations, this argument is not persuasive.

B. As a result of the disclaimer of claim 1 in each patent, the issue of "good cause" is now only a question whether it would be equitable and beneficial to go forward now with reexamination of the litigated claims, rather than wait for the Federal Circuit's decision on the appeal.

Petitioner patent owner argues that the court proceeding is now at such an advanced stage that it would promote administrative efficiency to suspend the *inter partes* reexamination proceedings to await the Federal Circuit's decision. This position has merit. The Federal Circuit decision

potentially could remove the litigated claims from the two proceedings, leaving no claims to be reexamined. If so, the reexamination proceedings would be terminated. It is not in the Office's and parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation which is soon to be finally resolved. That is particularly true here where the administrative proceedings have only just begun.

On the other hand, as pointed out in Sony's September 26, 2005 petitions and oppositions at pages 5-7, it is uncertain whether the Federal Circuit's decision will affirm the district court's decision and ultimately estop the instant reexaminations of the litigated claims for the '333 and '213 patents. It is possible that the district court's decision on validity could be reversed or vacated, with a remand for a new trial.

Taking the above positions into account, it is determined that "good cause" exists to wait for the outcome of the Federal Circuit appeal, because the reexamination proceedings are at just their beginning stages, while the concurrent litigation is potentially near its final resolution. It bears noting that Sony chose to permit the District Court litigation to proceed for three years before filing its requests for reexamination in May of 2005, only after judgment was entered in Immersion's favor in the litigation. Had Sony filed its requests for reexamination earlier, the reexamination proceedings would now have been much farther along in the process, and may likely have been completed at the Office before the district court issued its decision. Moreover, had Sony filed its reexamination requests earlier in the litigation, the district court might have stayed the litigation to await the Office's decisions in the two reexamination proceedings. After choosing to go years through the entire district court litigation proceeding without asking for the Office's input, Sony cannot complain that a suspension of the present reexamination proceedings will deprive Sony of a chance to obtain the Office's decision, when there is a strong possibility that the Federal Circuit's decision will estop the Office from issuing any decision at all. In short, Sony cannot have it both ways. Sony waited three years after the district court case began, and waited until after the district court issued a final decision, such that its district court litigation can in no way be affected by any decision on its reexamination requests. Sony's delay is the reason that the current reexaminations may very well be mooted before any decision issues. Sony chose its route and must now deal with the consequences of its decision.

Accordingly, on balance, "good cause" has been found to exist to warrant suspending the two *inter partes* reexamination proceedings, and patent owner's petition will be granted. Indeed, if the Office did not find "good cause" in the present situation, then the question would arise as to when the Office ever would exercise its statutory authority to suspend an *inter partes* reexamination for good cause based on a concurrent, pending appeal on the validity of the same claims.

Finally, Sony also argues that the uncertainty as to the time for resolution of the concurrent litigation, and as to the result itself, has increased as a result of Sony's motion for relief from the District Court's judgment under Federal Rule of Civil Procedure 60(b), which may lead the court to request a remand from the Federal Circuit. The simple answer is the Federal Circuit still has jurisdiction over the concurrent litigation at present. Should the District Court request and obtain a remand from the Federal Circuit, Sony may, at that point, petition for resumption of the two

reexamination proceedings.

Requester Sony argues at page 7 of the September 26, 2005 petitions and oppositions that the public interest is not served by a suspension in this instance. However, the public may obtain a decision from the Federal Circuit on the patent claims subject to the litigation, and then the public is free to request a subsequent reexamination of the two patents as to either the litigated (depending on the outcome in the concurrent litigation), or the non-litigated patent claims, using the results of the litigation as a starting point and adding information as appropriate.

IV. The Issue of Final Agency Action *re* Decisions:

The August 23, 2005 decision denying the petition to dismiss or suspend the proceedings was issued by the Director of the Office of Patent Legal Administration as a final agency action within the meaning of 5 U.S.C. § 704. The instant decision is likewise being designated as final agency action. At pages 9-10 of the requester's September 26, 2005 petitions and oppositions, it is urged that such designation of the August 23, 2005 decision as final agency action should be withdrawn. Requester points to page 17 of the August 23, 2005 decision, where it is stated that a first Office action "is not a final Agency action"citing *Heinl v. Godici*, 143 F.Supp.2d at 597-600 (E.D.Va. 2001) which in turn cited *Federal Trade Comm'n v. Standard Oil Co. of California*, 449 U.S. 232, 239-42 (1980) as to an initial action not having the status of law or immediate legal force.

The designation of the August 23, 2005 decision as a final agency action will not be withdrawn. The point made in that decision, and in *Heinl*, is that both the order for reexamination and the first Office action are not final agency decisions as to the patentability, or lack thereof, of the patent claims. As stated in the same paragraph of the August 23, 2005 decision quoted from by the requester, "it is only an initial position, indicating that the examiner has reason to believe **that the patent claims are unpatentable in view of prior art**." [Emphasis added]. With respect to the finality of the August 23, 2005 decision (and the instant decision as well), such finality is not directed to the patentability, or lack thereof, of the patent claims. Rather, it is directed to only the issue of suspension of the instant *inter partes* reexamination proceedings (in both the August 23, 2005 decision and the present decision), and dismissal of the proceedings without a final decision as to the merits (in the August 23, 2005 decision). Accordingly, the designation of both decisions as final agency action with respect to the issues to which they are addressed is deemed appropriate, and this matter of relief requested by the third party requester will not be granted.

CONCLUSION

1) The patent owner petitions are <u>granted</u> to suspend both of the *inter partes* reexamination proceedings until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal.

2) The third party requester petitions are granted to the extent that they have been considered, but are otherwise denied.

3) This decision is a final agency action within the meaning of 5 U.S.C. § 704. This decision does not, however, preclude parties from seeking relief on this matter at some point in the future, should there be a change in the circumstances on which this decision is grounded.

4) The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5) Telephone inquiries with regard to this decision should be directed to Anton Fetting, Senior Legal Advisor, at 571-272-7717 or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

FUTURE CORRESPONDENCE IN PROCEEDINGS

All correspondence relating to these *inter partes* reexamination proceedings should be directed:

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MAILED

MAR 22 2006

REEXAM UNIT

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,093
Filed: May 17, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No. 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

: DECISION
: DISMISSING
: PETITIONS

This is a decision on the December 15, 2005 third party requester petitions in both of the above-captioned proceedings under 37 CFR 1.907(a) and 35 U.S.C. § 317(a). The petitions request hat the USPTO Director authorize requester (Sony) to file additional requests for *inter partes* reexamination of U.S. patents 6,424,333 and 6,275,213. On January 23, 2006, the patent owner (Immersion) filed oppositions to the petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

The petitions and oppositions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

For reasons set forth below, the third party requester petitions are dismissed.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. (hereinafter "patent owner" or "Immersion"), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[1]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony (hereinafter "requester" or "Sony") on Immersion's claims of infringement of the '333 and '213 patents.[2] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[3]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR § 1.183 in response to Immersion's petitions.

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[1] 2005 U.S. Dist. LEXIS 4784.
[2] 2005 U.S. Dist. LEXIS 4781.
[3] 2005 U.S. Dist. LEXIS 4784.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[4]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 reexamination proceedings (in the decisions, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the present two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions to suspend the instant '093 and '094 reexamination proceedings until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony filed requests for *ex parte* reexamination of claims 2, 3, 5, 6, 7, 15, 16, 17, 20, 21, 25, 41, 42, 43, 44, 45, 46, 49, 50, 53 and 54 of the '213 patent and claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17 and 18 of the '333 patent, the requests being assigned control Numbers 90/007,843 (for reexamination of the '213 patent) and 90/007,844 (for reexamination of the '333 patent).

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[4] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

19. On December 15, 2005, Sony filed the instant petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a), requesting that the USPTO Director authorize Sony to file additional requests for *inter partes* reexamination of the '333 and '213 patents, in order to permit Sony to request *inter partes* reexamination of certain claims of the '213 and '333 patents that it failed to request in its initial set of *inter partes* reexamination requests, dated May 17 and 19, 2005.

20. On January 23, 2006, Immersion filed oppositions to Sony's petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

21. On March 9, 2006, a substantial new question of patentability (SNQ) was found for claims 2, 3, 5, 6, 15, 16, 17, 20, 21 and 25 of the '213 patent and for claims 2, 3, 4, 5, 6, 7, 8, 9, 12 and 13 of the '333 patent, and *ex parte* reexamination proceedings 90/007,843 and 90/007,844 were ordered.

DECISION

35 U.S.C. § 317 (*Inter partes* reexamination prohibited) provides in pertinent part:

> (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**." [Emphasis added.]

37 CFR 1.907(a) is the regulation that implements the provisions of 35 U.S.C. § 317(a) and provides as follows:

> "Once an order to reexamine has been issued under § 1.931, 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 under § 1.997, unless authorized by the Director."

Sony petitions the USPTO Director to authorize Sony to file additional requests for *inter partes* reexamination of the'333 and '213 patents, seeking to have the Office reexamine claims that Sony failed to request for reexamination in its initial set of requests, dated May 17 and 19, 2005. Sony's request is for the purpose of placing claims before the Office for reexamination that were not before the District Court, and are not before the Federal Circuit, in the litigation detailed above. These claims will be referred to as the "non-litigated claims." The petitions set forth Sony's reasons why such claims should be before the Office for *inter partes* reexamination.

Initially, although the petitions have been filed in the '093 and '094 reexamination proceedings, they request relief that is not directed to the '093 and '094 proceedings. Note that 35 U.S.C. § 317 and 37 CFR 1.907(a) only authorize the USPTO Director to act on such a petition filed together with a proffered second *inter partes* reexamination request, accompanied by the requisite reexamination filing fee.[5] Thus, on this basis alone, the petitions must be dismissed. However, further grounds for dismissal, directed to the merits of the petitions will be set forth below for a complete resolution of the underlying issues.

In the petitions, Sony states that it has filed requests for *ex parte* reexamination of U.S. patents 6,275,213 and 6,424,333. As pointed out above, such requests have indeed been filed, and have been assigned Control Numbers 90/007,843 and 90/007,844 respectively. Reexamination has been ordered as to most of the non-litigated claims for both of the proceedings. As reexamination has been granted for the two *ex parte* reexamination requests, Sony may now petition, under 37 CFR 1.989, for merger of each of the two *ex parte* reexamination proceedings with its respective *inter partes* reexamination proceeding. See MPEP 2686.1, part VI. If such a petition is granted, then in the merged proceedings, Sony would retain its participation right for review of all the claims in the merged proceedings by virtue of having requested the '0093 and '0094 *inter partes* reexamination proceedings.[6]

In the present petitions, Sony has requested extraordinary relief that is provided for by 35 U.S.C. § 317(a) to permit it to file a second *inter partes* reexamination proceeding for the same patents. The language and intent of the statute clearly prohibit two co-pending *inter partes* reexaminations filed by the same party (real party in interest), unless there is no other avenue of relief and justice dictates such relief. In this case, another avenue of relief does exist. [7] Sony's rights resulting from a grant of the present petitions would not differ from those that would result if each of the two *ex parte* reexamination proceedings were merged with its respective *inter partes* reexamination proceeding. That is because any merged proceeding of the now pending *ex*

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[5] It is to be noted that the instant petitions do not have an entry right in the '0093 and '0094 *inter partes* reexamination proceedings, since the petitions are not directed to the merits of the '0093 and '0094 proceedings and do not address any patent owner petition or response. Nevertheless, the rules are waived to the extent that the petitions are being addressed, based on the ongoing concurrent litigation, and the facts and circumstances of the present case.

[6] 37 CFR 1.989(b) provides: "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. "

[7] The extraordinary nature of this statutorily provided relief can readily be understood by reference to the legislative history of 35 U.S.C. § 317, which provides (emphasis added):
"Subtitle F creates a new section 317 which sets forth certain conditions by which inter partes reexamination is prohibited **to guard against harassment of a patent holder**. In general, once an order for inter partes reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for inter partes reexamination until an inter partes reexamination certificate is issued and published, unless authorized by the Director." 106 Cong. Rec. S14720 (Nov. 17, 1999).
In this instance, in addition to Sony having initiated the '093 and '094 *inter partes* reexamination proceedings, Sony has now also recently initiated two *ex parte* reexamination proceedings for other claims of Immersion's two patents. Sony's petition here requests the authority to initiate yet another two *inter partes* reexamination proceedings, making a total of six reexamination proceedings of Immersion's two patents.

parte and *inter partes* proceedings would be conducted using *inter partes* reexamination rules and procedures. See 37 CFR 1.989(b). Any equities potentially present that warrant the granting of the present petition would also be present for potentially granting a merger.[8] Since Sony can obtain the relief requested in the present petitions via an alternative procedural avenue, there is no justification to grant the requested extraordinary relief under 35 U.S.C. § 317(a) of permitting Sony to file a second *inter partes* reexamination proceeding for the same patents. The petitions are accordingly dismissed.

The stated goal of Sony's present petition is to have the Office reexamine claims in addition to the ones it requested in its May 17 and 19, 2005 *inter partes* reexamination requests. Now that Sony has made that formal request, through *ex parte* reexamination requests, which requests have been recently granted, it appears that Sony has already achieved its objective.

Further, the statutory restriction on filing a second *inter partes* reexamination request directed to the non-litigated claims as is requested in the petition will be removed once the final decision is issued in the litigation by the court, if the final decision is adverse to Sony. At that time, the Office would terminate the '093 and '094 *inter partes* reexamination proceedings, thereby opening the door for Sony to file subsequent requests for the *inter partes* reexamination of the non-litigated claims of Immersion's two patents, pursuant to 35 U.S.C. § 317(a). Given the advanced state of the current litigation, Sony has not established that a delay resulting from the statutory limitation against permitting a third party from triggering more than one pending *inter partes* reexamination proceeding will be of a significant duration to provide basis for the extraordinary relief presently requested.

As a final point, this decision is not to be interpreted as an indication regarding whether or not a petition for merger of the *ex parte* reexamination proceedings with the instant *inter partes* reexamination proceedings would be granted. It is merely a holding that the extraordinary relief provided for by 35 U.S.C. § 317(a) will not be granted where there is a more conventional avenue to accomplish the same purpose and provide relief analogous to that requested. See also *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982) for the principle that extraordinary relief will not normally be considered if the rules provide an avenue for obtaining the relief sought.

CONCLUSION

1) The Sony (i.e., third party requester) petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a) are <u>dismissed.</u>

2) The above-captioned *inter partes* reexamination proceedings remain suspended until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal.

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[8] Likewise, where a substantial new question of patentability exists for granting a second *inter partes* reexamination; it also exists for granting an *ex parte* reexamination.

3) The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

4) Telephone inquiries with regard to this decision should be directed to Anton Fetting, Senior Legal Advisor, at 571-272-7717 or, in his absence, to the undersigned at 571-272-7710.

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

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Westfield, New Jersey 07090

(For Requester)

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,093
Filed: May 17, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,844
Filed: December 13, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,843
Filed: December 13, 2005
For: U.S. Patent No.: 6,275,213

DECISION
DENYING
PETITIONS

This is a decision on the April 11, 2006 requester (hereinafter "requester" or "Sony") petitions filed (a) under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and (b) under 37 CFR 1.182 for merger of:

1. Reexamination Control No.: 90/007,844 with Reexamination Control No.: 95/000,093, and

2. Reexamination Control No.: 90/007,843 with Reexamination Control No.: 95/000,094.[1]

On May 3, 2006, the patent owner (hereinafter "patent owner" or "Immersion") filed oppositions to Sony's petitions.

The petition fee of $400 set forth in 37 CFR 1.17(f) for each of the present petitions under 37 CFR §§ 1.182 and 1.183 has been charged to Sony's Deposit Account No. 12-1095, in accordance with petitioner's authorization at the last sentence of page 2 of the April 11, 2005 petitions. A total of $800 will be charged for the two petitions directed to the two sets of proceedings

The petitions and oppositions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office ("USPTO" or "Office").

For reasons set forth below, Sony's petitions are:

Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions; and

Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion, obtained a jury verdict (Civil Action No. 02-0710 CW) in the

[1] See the penultimate paragraph of the second page of the petitions which identifies the petitions as being filed under 37 CFR §§ 1.182 and 1.183.

United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[2]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony on Immersion's claims of infringement of the '333 and '213 patents.[3] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[4]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR 1.183 in response to Immersion's petitions.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[5]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

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[2] 2005 U.S. Dist. LEXIS 4784.
[3] 2005 U.S. Dist. LEXIS 4781.
[4] 2005 U.S. Dist. LEXIS 4784.
[5] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 *inter partes* reexamination proceedings (in the decision, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions, finding "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony filed requests for *ex parte* reexamination of claims 2, 3, 5, 6, 7, 15, 16, 17, 20, 21, 25, 41, 42, 43, 44, 45, 46, 49, 50, 53 and 54 of the '213 patent and claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17 and 18 of the '333 patent, the requests being assigned control Numbers 90/007,843 (for reexamination of the '213 patent) and 90/007,844 (for reexamination of the '333 patent).

19. On December 15, 2005, Sony filed petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a), requesting that the USPTO Director authorize Sony to file <u>additional</u> requests for *inter partes* reexamination of the '333 and '213 patents, in order to permit Sony to request *inter partes* reexamination of certain claims of the '213 and '333 patents that it failed to request in its initial set of *inter partes* reexamination requests, dated May 17 and 19, 2005.

20. On January 23, 2006, Immersion filed oppositions to Sony's petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

21. On March 9, 2006, a substantial new question of patentability (SNQ) was found for claims 2, 3, 5, 6, 15, 16, 17, 20, 21 and 25 of the '213 patent and for claims 2, 3, 4, 5, 6, 7, 8, 9, 12 and

13 of the '333 patent, and *ex parte* reexamination proceedings 90/007,843 and 90/007,844 (hereinafter, the '843 and '844 proceedings) were ordered.

22. On March 22, 2006, the Senior Legal Advisor of the Office of Patent Legal Administration issued a decision dismissing Sony's December 15, 2005 petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

23. On April 11, 2005, Sony filed the instant petitions. The instant petitions are filed under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and under 37 CFR 1.182 for merger of the '844 and '093 proceedings, and merger of the '843 and '094 proceedings.

24. On May 3, 2006, Immersion filed oppositions to Sony's merger petitions.

25. On December 13, 2005, Sony brought action in the United States District Court, Eastern District of Virginia, pursuant to the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706, to obtain judicial review of the Office's November 17, 2005 petition decision suspending the '093 and '094 *inter partes* reexamination proceedings. Specifically, Sony sought review of the Office's November 17, 2005 decision which found that "good cause" existed under 35 U.S.C. § 314(c) to suspend the just-commenced '093 and '094 *inter partes* reexamination proceedings with respect to certain claims in the '213 and '333 patents on the ground that the validity of those claims were already the subject of an ongoing appeal in the U.S. Court of Appeals for the Federal Circuit. Sony argued that the Office abused its discretion in suspending the proceedings, contending the Office had a legal obligation to reexamine all claims in the patents (except the two disclaimed claims), including the claims Sony failed to request for reexamination.

26. On May 22, 2006, the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462, issued a decision in favor of the Office. The decision upheld the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings and also upheld the Office's discretion to not reexamine claims of the '213 and '333 patents for which *inter partes* reexamination was not requested.

27. A patent owner's statement under 37 CFR 1.530 has not been received in the '843 and '844 *ex parte* reexamination proceedings, and the time for filing such statement has expired.

DECISION WAIVNG RULES, TO PERMIT CONSIDERATION OF MERGER PETITIONS

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)."

The present petitions do not have an entry right under the rules. *See* 37 CFR 1.510, 1.535, and 1.550. The appropriate provisions of the rules are, however, waived to permit consideration of the instant Sony merger petitions, based upon the specific facts and unique circumstances of the present situation, as well as statements made in the Office's March 22, 2006 decision dismissing Sony's petitions to file additional requests for *inter partes* reexamination. Likewise, the appropriate provisions of the rules are *sua sponte* waived to permit consideration of Immersion's oppositions to the merger petitions.

DECISION ON MERGER PETITIONS

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. [Emphasis added].

In addition, MPEP 2686.01(I) provides:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings **normally** will be merged once reexamination has been ordered in both proceedings. In this situation the second request is decided based on the original patent claims and if reexamination is ordered in the second proceeding, the reexamination proceedings **normally** would be merged."

Reexamination of the '333 patent has been ordered in the '844 *ex parte* proceeding and '093 *inter partes* proceeding, and reexamination of the '213 patent has been ordered in the '843 *ex parte* proceeding and '094 *inter partes* proceeding. In addition, a patent owner's statement under 37 CFR 1.530 has not been received in the '844 and '843 proceedings, and the time for filing such has expired. [6] [7] Accordingly, a decision under 1.989(a) on the Sony petitions for merger is timely.

The issue to be decided is whether the *ex parte* reexaminations should be merged with the respective *inter partes* reexaminations. The present petitions raise a novel question regarding merger practice, because, pursuant to 35 U.S.C. § 314(c), the present '093 and'094 *inter partes* reexaminations are currently suspended.

At page 3 of the petitions, Sony argues that:

> "there is every reason to merge the two proceedings, and no proper reason to refrain from such merger. As set forth in M.P.E.P. § 2686.01, '[i]f a second request for reexamination is filed where a certificate will issue for a first reexamination later than three months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings.' Here, all of the proceedings are at a relatively early stage; reexamination has been ordered in all of the proceedings, but no first Official Action has been issued in any of the proceedings. As the Office has already held that 'it is not in the Office's interest to conduct a piecemeal reexamination of a patent' because a reexamination of any claim 'will already require the Examiner to review the written description, the drawings, other claims in the patent and the prior art,' and accordingly, there is relatively little additional effort to reexamine all claims instead of just some' in a given reexamination proceeding. (Decision Denying Petitions dated August 23, 2005 in the '093 and '094 *Inter Partes* Reexaminations at 13.) There is no reason for the Office to consider the same issues twice, rather than once."

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, as with the Office's decisions to reexamine claims beyond those requested and to suspend an *inter partes* reexamination for "good cause," the Office's

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[6] Pursuant to MPEP 2283(III), "[I]f Request 2 is granted, the order in the second proceeding should be mailed immediately. The two requests should be held in storage until the patent owner's statement and any reply by the requester have been received in Request 2, or until the time for filing same expires."

[7] As to the suspended '093 and '094 proceedings, there is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding.

decision to merge two reexaminations is a purely discretionary act. *See Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462 (E.D.Va. May 22, 2006).

First, the statute does not require the Office to merge or consolidate multiple reexamination proceedings. In fact, the statute is silent as to this procedural issue. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 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." (Emphasis added)). Furthermore, while the MPEP states that the Office will "normally" merge two reexaminations, that general policy does not address the unique circumstances here, in which one set of proceedings has been suspended. Indeed, the Office has never had to address the question of dissolving a suspension order for the sake of merging proceedings.

Pursuant to 35 U.S.C. 314(c), the USPTO Director may suspend an *inter partes* reexamination proceeding "for good cause." In the present instance, the Office's November 17, 2005 petition decision suspended the '093 and '094 *inter partes* reexamination proceedings because the Federal Circuit appeal on the same patent claims was far advanced in comparison to the *inter partes* reexamination proceedings, which had only recently been commenced. Thus, there was ample "good cause" to suspend the *inter partes* reexamination proceedings pending completion of the Federal Circuit appeal, in view of the statutory estoppel that would operate upon a final decision on the claims by the Federal Circuit. *See* 35 U.S.C. § 317(b).

Further, the U.S. District Court for Eastern District of Virginia upheld the Office decision to suspend the '093 and '094 *inter partes* reexamination proceedings, stating that "the PTO did not abuse its discretion in concluding that there was good cause to suspend reexamination of the litigated claims in light of the more advanced Federal Circuit appeal focusing on the same claims...." [8] The District Court found that "the PTO's decision to suspend *inter partes* review of the patent claims in issue here was clearly supported by good cause and therefore well within the bounds of the PTO's discretion." [9] Thus, Sony has already appealed the merits of the suspension order, but the court rejected that challenge.

Based on the above, the requested merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would consolidate a suspended *inter partes* proceeding with an *ex parte* proceeding which must go forward with special dispatch. *See Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). The same would be true for the requested merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. In each instance, the requested merged proceeding would be required to proceed with special dispatch, based on the presence of the *ex parte* reexamination

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[8] *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462, Slip Copy at 11.
[9] *Id.* ,at 7.

proceeding. Thus, the merger of the two sets of proceedings would necessarily require dissolving the Office's decision to suspend the *inter partes* reexamination proceedings.

While Sony is correct that the Office usually prefers to avoid piecemeal reexamination, merging the two sets of proceedings in the present instance would clearly circumvent the Office's suspension decision of the *inter partes* reexamination proceedings, which was approved by the District Court based upon the reasoning advanced by the Office. Indeed, merging the proceedings here would render the Office's discretion to suspend meaningless, and would defeat the whole purpose behind the suspension decision, *i.e.*, to await the final outcome on the litigated claims. Furthermore, such a result would undermine the legislative intent underlying 35 U.S.C. 314(c) (expressly providing the Office with discretion to find "good cause" to suspend). In view of the foregoing, the more appropriate course is to preserve the suspension decision (and all the reasoning given therein) and deny the merger petition, rather than permit Sony to collaterally attack the suspension order (which has already been affirmed by the District Court). In other words, the Office does not find that its concern over piecemeal reexamination overrides, in this instance, the reasoning for why the Office suspended the *inter partes* reexamination proceedings. Moreover, there will not be any piecemeal reexamination if the Federal Circuit affirms the District Court's decision as to validity, because the *inter partes* reexaminations will be terminated under 35 U.S.C. 317(b) and 37 CFR 1.907(b).[10]

Accordingly, the request for merger is denied.

It is also noted that pursuant to 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."

In the present instance, a merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would inappropriately provide Sony, as the third party requester of the *inter partes* reexamination, with *inter partes* participation rights as to the entirety of '844 *ex parte* reexamination proceeding, in which Sony's rights of participation are currently limited by the *ex parte* reexamination statute. Again, the same would be true for a merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. Sony's desire to have the Office consider in the *inter partes* reexamination context all the issues that Sony has raised in the *ex parte* reexaminations would improperly circumvent 35 U.S.C. § 317(a), which prohibits a third party requester from raising issues in a second *inter partes* reexamination when the third party has already triggered a pending *inter partes* reexamination. That prohibition, in view of the facts of the present case, also militates against granting Sony's petition to merge the two sets of proceedings. In other words, a third party should not be able circumvent § 317(a)'s prohibition by (i) triggering an *inter partes* reexamination limited to certain issues, (ii) raising new issues in an *ex parte* proceeding, and then (iii) automatically

[10] Should the Federal Circuit remand or vacate the lower court's validity findings, the Office at that time can consider reviewing the suspension decision as well as the question of merging the proceedings.

expecting the *ex parte* proceeding to be merged with the pending *inter partes* proceeding, let alone an *inter partes* proceeding that has been suspended for "good cause," which has already been affirmed by a district court.

CONCLUSION

1) The Sony (i.e., third party requester) petitions are

   Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions, and

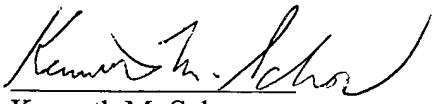
   Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

2) The above-captioned '093 and '094 *inter partes* reexamination proceedings remain suspended until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal identified above.

3) The above-captioned '843 and '844 *ex parte* reexamination proceedings are ready for action, and jurisdiction over the '843 and '844 proceedings is transferred to the examiner for that purpose.

4) The parties to the'093 and '094 *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5) Telephone inquiries with regard to this decision should be directed to the undersigned at 571-272-7710.



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

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In re Mark R. Tremblay et al.
Reexamination Proceeding
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In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

DECISION GRANTING PETITIONS

This is a decision on the March 27, 2007 patent owner petitions to terminate both of the above-captioned proceedings. The petitions are taken as a petition under 37 CFR 1.182 [1] to terminate the two proceedings.

[1] 37 CFR 1.182 provides that "[a]ll 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." There is no provision in the rules for a petition to terminate a reexamination proceeding.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The petition fee is required by 37 CFR 1.182 is hereby waived, based upon the fact that patent owner is providing notification to the Office regarding the conclusion of litigation, as it was called upon to do by the Office.[2]

For reasons set forth below, the patent owner petitions are granted.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion Corp. (hereinafter "patent owner" or "Immersion"), obtained a jury verdict (Civil Action No. 02-0710 CW) in the United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[3]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony (hereinafter "requester" or "Sony") on Immersion's claims of infringement of the '333 and '213 patents.[4] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[5]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was not litigated in the district court proceeding.

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[2] For example, Item (4) of the conclusion of November 17, 2005 decision of Director of the Office of Patent Legal Administration stated:

"The parties to the *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and **notify the Office when that appeal has been resolved**." [Emphasis added]

[3] 2005 U.S. Dist. LEXIS 4784.

[4] 2005 U.S. Dist. LEXIS 4781.

[5] 2005 U.S. Dist. LEXIS 4784.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was not litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

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12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 reexamination proceedings (in the decisions, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the present two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

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[6] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions to suspend the instant '093 and '094 reexamination proceedings until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony brought action in the United States District Court, Eastern District of Virginia, pursuant to the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706, to obtain judicial review of the Office's November 17, 2005 petition decision suspending the '093 and '094 *inter partes* reexamination proceedings. Specifically, Sony sought review of the Office's November 17, 2005 decision which found that "good cause" existed under 35 U.S.C. § 314(c) to suspend the just-commenced '093 and '094 *inter partes* reexamination proceedings with respect to certain claims in the '213 and '333 patents on the ground that the validity of those claims were already the subject of an ongoing appeal in the U.S. Court of Appeals for the Federal Circuit. Sony argued that the Office abused its discretion in suspending the proceedings, contending the Office had a legal obligation to reexamine all claims in the patents (except the two disclaimed claims), including the claims Sony failed to request for reexamination.

29. On May 22, 2006, the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462, issued a decision in favor of the Office. The decision upheld the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings and also upheld the Office's discretion to not reexamine claims of the '213 and '333 patents for which *inter partes* reexamination was not requested.

30. On March 27, 2007, Immersion filed the present petitions to terminate both of the '093 and '094 *inter partes* reexamination proceedings, in a paper titled NOTIFICATION OF FINAL JUDGMENT AND ISSUANCE OF MANDATE IN CONCURRENT PROCEEDINGS AND PETITION TO TERMINATE INTER PARTES REEXAMINATION PROCEEDINGS.

DECISION

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter.

The patent owner, Immersion Corporation, has provided notification to the Office as to the status of requester Sony's appeal to the Federal Circuit from the March 24, 2005 Judgment entered by the United States District Court for the Northern District of California. Immersion states that the appeal proceedings have been concluded by dismissal with prejudice, and has included a copy of the Federal Circuit's Order on March 8, 2007, and a copy of the court's corrected Order on March 14, 2007, to that effect.

As pointed out by Immersion, since Sony's appeal has been dismissed, the judgment of the District court stands. As set forth above (in the Background section of this decision), the March 24, 2005 Judgment entered by District Court, was adverse to requester Sony as to the '333 and '213 patents. Sony did not sustain its burden of proving the invalidity of the patent claims in suit, for which it requested the '093 and '094 *inter partes* reexaminations. It is that judgment of the District court which now stands, and is no longer subject to appeal. Accordingly, based upon 35 U.S.C. 317(b), the prosecution of the '093 and '094 *inter partes* reexamination proceedings is hereby terminated.

Jurisdiction over the '093 and '094 reexamination proceedings is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceedings. The CRU will mail the present decision, and process the'093 and '094 reexamination files to update the Image File Wrapper (IFW) records for the proceedings. The files will be assigned a 822 status. For each proceeding, a copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

1) The patent owner petitions are granted.

2) The prosecution of the '093 and '094 *inter partes* reexamination proceedings is hereby terminated, and the proceedings will be concluded.

3) Jurisdiction over the present reexamination proceeding is being forwarded to the Central Reexamination Unit for further processing to conclude the proceedings.

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

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

6-1-07
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(For Requester)

In re Prevost
Inter Partes Reexamination Proceeding
Control Number 95/000,096
Filed: June 10, 2005
For: U.S. Patent No. 6,723,412

In re reissue application of
Prevost
Application Number 11/305,814
Filed: December 16, 2005
For: U.S. Patent No. 6,723,412

: **DECISION**
: **DISMISSING**
: **PETITION TO**
: **MERGE REISSUE**
: **AND *INTER PARTES***
: **REEXAMINATION**
: **PROCEEDINGS**
: **AND DECISION**
: **SUSPENDING**
: **REISSUE**
: **APPLICATION**
:

The petition under 37 C.F.R. 1.182 filed by patent owner on March 13, 2006, requesting merger of the above-identified reissue and *inter partes* reexamination proceedings is before the Office of Patent Legal Administration for decision. A petition fee of $400 pursuant to 37 C.F.R. 1.17(f) was paid by check.

For the reasons discussed below, the petition is **dismissed**.

The prosecution of the above-mentioned reissue application is hereby **suspended,** pending the conclusion of the 95/000,096 reexamination proceeding by the issuance of the *inter partes* reexamination certificate.

REVIEW OF FACTS

1. U.S. Patent No. 6,723,412 issued to Prevost on April 20, 2004.

2. A request for *inter partes* reexamination of the '412 patent was filed by third party requester on June 10, 2005, and was assigned reexamination control no. 95/000,096.

3. On August 16, 2005, reexamination was ordered and a non-final Office action was mailed in the '096 proceeding.

4. A patent owner's response to the non-final action was filed in the '096 proceeding on November 21, 2005.

5. On December 16, 2005, third party requester filed comments pursuant to 37 C.F.R. 1.947 in the '096 proceeding.

6. Also on December 16, 2005, patent owner filed a reissue application on the '412 patent, which application was assigned application no. 11/305,814. A preliminary amendment was included, adding new claims 29-96.

7. An Action Closing Prosecution (ACP) 37 C.F.R. 1.949 was mailed in the '096 proceeding on February 2, 2006.

8. A request for an extension of time to reply to the ACP in the '096 *inter partes* reexamination proceeding was filed by patent owner on February 21, 2006, and a two-month extension of time was granted in a decision mailed on March 3, 2006.

9. A petition requesting merger of the '096 *inter partes* reexamination proceeding with the reissue application was filed by patent owner on March 13, 2006.

10. On April 14, 2006, patent owner filed a petition in the '814 application, requesting waiver of the two month delay period subsequent to announcement of the reissue application in the Official Gazette. The petition was granted in a decision mailed on April 25, 2006.

11. On May 5, 2006, a response to the ACP was filed by patent owner pursuant to 37 C.F.R. 1.951(a) in the '096 proceeding.

12. Requester filed comments pursuant to 37 C.F.R. 1.951(b) in the '096 proceeding on May 31, 2006.

13. The reissue application no. 11/305,814 was released after preexamination processing from the Office of Initial Patent Examination (OIPE) on June 9, 2006.

14. Notice of the filing of the reissue application no. 11/305,814 was published in the *Official Gazette* on June 20, 2006.

DISCUSSION REGARDING MERGER OF PROCEEDINGS

Under 37 C.F.R. § 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 the Order has been mailed pursuant to § 1.931 in the '096 reexamination proceeding, and the preexamination processing of the '814 reissue application has been completed, the patent owner petition of March 13, 2006, requesting merger of the proceedings is now ripe for consideration and a decision under § 1.991 is timely.

The general policy of the Office is that examination of reissue and 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 all of the proceedings. In making a decision as to whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2686.03.

A review of the prosecution history of the '096 reexamination file shows that no amendments have been made to the claims, and all patent claims stand rejected in the Action Closing Prosecution. The patent owner has filed a response to the ACP, and the third party requester has filed comments in reply to the owner's response. The status of the *inter partes* reexamination is that it is ready for consideration of the response and comments documents, and preparation of the next appropriate Office action.

A review of the reissue (Application No. 11/305,814) prosecution history shows that the reissue application was released from OIPE on June 9, 2006, and announced in the *Official Gazette* on June 20, 2006. In the reissue application, patent owner has filed a preliminary amendment adding new claims 29-96. Therefore, the claims are **not** identical in both proceedings. The

status of the reissue application is that it is ready for examination, but no Office action has yet been mailed.

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 normally appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. However, such merger is ***discretionary***.

35 U.S.C. 314 states (in part):

> (a) . . . 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).
>
> (b) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.
>
> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

As pointed out in MPEP 2686.03, Part II.:

> "Where issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination third party requester, merger would ordinarily not be ordered, and one of the two proceedings stayed."

It is noted that the new claims of the reissue application appear to be broader than the original patent claims, because the new independent claims omit the limitation directed to the particulate layer/material having a thickness of substantially two thirds the length of the ribbons, as recited in the original independent patent claims. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects. See MPEP 1412.03.

In the instant situation, merger of the reissue and *inter partes* reexamination proceedings would provide the third party requester of the *inter partes* reexamination the opportunity to comment on

the examination of the broader claims of the reissue application, and also to participate in the appeal process as to such broader claims. These opportunities are not normally available to a third party requester of a reexamination, since no broadening is permitted in a reexamination proceeding. Therefore, merger of the instant reissue and *inter partes* reexamination proceedings would provide comment and appeal opportunities to the third party requester that were not intended by the *inter partes* reexamination statute, *i.e.,* comment and appeal participation with respect to the broadened reissue claims.

Further, while in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, such consolidation would necessitate the prolonging of prosecution in the *inter partes* reexamination proceeding at a point where the next Office action in the reexamination proceeding will most likely be a final Office action, *i.e.,* a Right of Appeal Notice (RAN). Any such prolonging of prosecution in the *inter partes* reexamination proceeding would be contrary to the **special dispatch** requirement set by the statute. Therefore, rather than merging the reexamination and reissue proceedings in this instance, it is instead appropriate that the reissue application be **suspended** pursuant to 37 C.F.R. § 1.103(e) in favor of the *inter partes* reexamination proceeding for the reasons discussed *supra*. The suspension of the reissue application will prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner into the reissue application. The suspension of the reissue application will also permit the *inter partes* reexamination proceeding to continue to move forward, and this will provide the most efficient and prompt handling of the reexamination proceeding.

Accordingly, the petition requesting merger of the above-mentioned reexamination and reissue proceedings is **dismissed,** and the reissue application is **suspended** pursuant to 37 C.F.R. § 1.103(e) in favor of the *inter partes* reexamination proceeding, for the reasons indicated above. The prosecution of the 11/305,814 reissue application is hereby **suspended,** pending the conclusion of the 95/000,096 *inter partes* reexamination proceeding by the issuance of the *inter partes* reexamination certificate.

CONCLUSION

1. The petition requesting merger of the above-mentioned reexamination and reissue proceedings is **dismissed.**

2. The reissue application is **suspended** pursuant to 37 C.F.R. § 1.103(e) until the *inter partes* reexamination certificate is published for the 95/000,096 *inter partes* reexamination proceeding.

3. A copy of this decision will be made of record in both of the above-mentioned reissue and *inter partes* reexamination proceedings.

4. The jurisdiction of the 95/000,096 *inter partes* reexamination file is being forwarded to the Central Reexamination Unit for consideration and treatment of the patent owner response and third party comments filed subsequent to the ACP.

5. The examiner will issue the next appropriate Office action for the *inter partes* reexamination proceeding in due course. All further examination should be conducted with special dispatch.

6. **All correspondence relating to an *inter partes* reexamination proceeding** should be directed:

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

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

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

8. Telephone inquiries with regard to this decision should be directed to Lynn Kryza, Senior Special Projects Advisor, at (571) 272-7722 or the undersigned at (571) 272-7735.

Robert Clarke

Robert Clarke
Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

July 10, 2006

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CENTRAL REEXAMINATION UNIT

Thomas J. Burger, Esq. (For Requester)
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In re Prevost	:
Reexamination Proceeding	: DECISION ON PETITION
Control No.: 95/000,096	: UNDER 37 CFR 1.181
Filed: June 10, 2005	: TO INVOKE THE SUPERVISORY
For: U.S. Patent No.: 6,723,412	: AUTHORITY OF THE DIRECTOR

This is a decision on a petition filed by the patent owner on May 5, 2006. The petition is entitled PETITION UNDER 37 C.F.R. § 1.181 TO REOPEN PROSECUTION, and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and reopen prosecution by withdrawing the Action Closing Prosecution issued on February 2, 2006.

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 May 5, 2006 is denied with respect to reopening the prosecution of the *inter partes* reexamination proceeding 95/000,096.

REVIEW OF FACTS

1. U.S. Patent No. 6,723,412 issued to Prevost on April 20, 2004.

2. A request for *inter partes* reexamination of the '412 patent was filed by third party requester on June 10, 2005, and was assigned reexamination control no. 95/000,096 (hereinafter "the '096 proceeding").

3. On August 16, 2005, reexamination was ordered and a non-final Office action was mailed in the '096 proceeding.

4. A patent owner's response to the non-final action was filed in the '096 proceeding on November 21, 2005.

5. On December 16, 2005, third party requester filed comments pursuant to 37 C.F.R. 1.947 in the '096 proceeding.

6. An Action Closing Prosecution (ACP) 37 C.F.R. 1.949 was mailed in the '096 proceeding on February 2, 2006.

7. A request for an extension of time to reply to the ACP in the '096 inter partes reexamination proceeding was filed by patent owner on February 21, 2006, and a two-month extension of time was granted in a decision mailed on March 3, 2006.

8. On March 13, 2006, a petition requesting merger of the '096 *inter partes* reexamination proceeding with reissue application 11/ 305,814 was filed by the patent owner.

9. On May 5, 2006[1], a response to the ACP was filed by patent owner pursuant to 37 C.F.R. 1.951(a) in the '096 proceeding, and the present petition under 37 CFR 1.181 to reopen prosecution was also filed.

10. Requester filed comments pursuant to 37 C.F.R. 1.951(b) in the '096 proceeding on May 31, 2006.

11. On July 17, 2007, a DECISION DISMISSING PETITION TO MERGE REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDINGS AND DECISION SUSPENDING REISSUE APPLICATION was mailed in response to the March 13, 2006 petition.

12. On July 24, 2007, a DECISION *SUA SPONTE* RETURNING THIRD PARTY

[1] The response and petition was filed with a certificate of mailing under 37 CFR 1.8 dated May 2, 2006.

REQUESTER'S COMMENTS TO PATENT OWNER'S RESPONSES was mailed. This decision required the third party requester to resubmit the comments deposited on May 31, 2006 and December 16, 2005 in compliance with the provisions of 35 U.S.C. § 314(b)(2) and 37 CFR 1.947.

13. On August 22, 2007, the third party requester resubmitted the comments deposited on May 31, 2006 and December 16, 2005 in compliance with the provisions of 35 U.S.C. § 314(b)(2) and 37 CFR 1.947.

DECISION

The patent owner (petitioner) states that the Action Closing Prosecution dated February 2, 2006 is premature for following two independent reasons: (1) the prosecution should be reopened so the proceedings can be merged with copending reissue control No. 11/305,814 which also involves the '312 patent; and (2) the rejection of ground 14 fails to make a prima facie showing in compliance with the requirements of MPEP 804(II)(B)(1).

First, the patent owner argues that the prosecution should be reopened and merged with copending reissue control No. 11/305,814 which also involves the '312 patent. Patent owner has filed a petition under 37 C.F.R 1.181 to merge the proceedings. Patent owner further stated that that if prosecution remains closed, than the determination of the nature and scope of the inventions in the patent-at-issue might result in inconsistent determinations of patentability. Patent owner further stated that this would unfairly and unnecessarily prejudice the patent owner since there is substantial overlap between the newly presented claims in the reissue and the claims currently undergoing reexamination.

Second, the patent owner argues that the prosecution should not be closed because the rejection of ground 14 fails to make a prima facie showing in compliance with the requirements of MPEP 804(II)(B)(1). In particular, patent owner argues that the Action Closing Prosecution of February 2, 2006 failed to make clear "(A) the differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent" and that "prosecution should be reopened until the defective rejection ground 14 is cured or withdrawn."

The first argument has been carefully considered, but not deemed persuasive. Patent owner's petition to merge the proceedings has been dismissed by the Office in a decision mailed July 17, 2007, and the prosecution of the copending reissue application has been suspended pursuant to 37 CFR 1.103(e) until the *inter partes* reexamination certificate is published. See the decision mailed on July 17, 2006. Accordingly, Patent owner will not be unfairly prejudiced, since any decision on the reissue application will not occur until the reexamination proceeding is

concluded. Therefore, patent owner's argument that prosecution should be reopened on this ground is not persuasive.

The second argument has been carefully considered and the examiner has carefully reviewed the previously made non-statutory obviousness double patenting rejection. In view of this re-evaluation, the examiner will withdraw the rejection of Ground 14 in issuing a Right to Appeal Notice. Therefore, this argument that prosecution should be reopened is effectively moot. In accordance with Office policy and procedures, prosecution need not be reopened if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable). The third party requester has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage*, unless the patent owner responds (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond). See MPEP 2673.01.

Finally, 35 U.S.C. 314(c) requires all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution.

Accordingly, since good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided, the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated February 2, 2006 and reopening of prosecution of the '096 reexamination proceeding is denied.

2. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Special Program Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-1596.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Special Program Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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(For Third Party Requester)

MAILED
OCT 21 2005
REEXAM UNIT

In re reissue application of
Brian Marc Jarvis
Application No. 11/130,438
Filed: May 16, 2005
For: U.S. Patent No. 6,729,932

In re reexamination proceeding of
Brian Marc Jarvis
Control No. 95/000,098
Filed: June 10, 2005
For: U.S. Patent No. 6,729,932

DECISION SUSPENDING ACTION IN REISSUE AND DISMISSING PETITION FOR MERGER OF REISSUE APPLICATION AND REEXAMINATION PROCEEDING

The instant reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of the third party reexamination requester's petition for merger of proceedings, filed on September 26, 2005, and determination of the action to be taken under 37 CFR 1.991 at this time. The August 26, 2005 patent owner response in the reexamination proceeding also has requested such a merger.

SUMMARY

For the reasons set forth below, the third party requester petition requesting merger of the above captioned reissue application and reexamination proceeding is dismissed.

The reexamination proceeding will continue, and the reissue application is suspended until termination and conclusion of the reexamination proceeding by publication of the reexamination certificate.

REVIEW OF FACTS

1. U.S. Patent No. 6,729,932 (the '932 patent) issued to Brian Marc Jarvis, on May 4, 2004.

2. On May 16, 2005, the patent owner filed a "broadening" reissue application based on the '932 patent, which was assigned Application Number 11/130,348 (the '438 reissue application). Concurrently with the filing of the '438 reissue application – (a) new claims 42-65 (not present in the '932 patent) were filed, (b) the specification of the '438 reissue application was amended, and (c) Figure 5 of the patent drawings was canceled. None of the original'932 patent claims were canceled or amended.

3. A request for ***inter partes*** reexamination of the '932 patent was filed by a third party requester on June 10, 2005, and the resulting reexamination proceeding was assigned Control Number 95/000,098 (the '098 reexamination proceeding). Rose Art Industries, Inc. is identified as the real party in interest for the requester.

4. Notice of the filing of the *inter partes* reexamination was published in the *Official Gazette* on July 19, 2005.

5. On July 29, 2005, an order granting the reexamination request was mailed for the '098 proceeding. The order was accompanied by an Office action directed to the patentability of the claims.

6. On August 26, 2005, patent owner filed a response to the July 29, 2005 Office action in the reexamination proceeding. The response canceled certain claims, added "new" claims 42-55, amended the specification, and canceled Figure 5 of the drawings. The remarks section of the response included a request that the '098 reexamination proceeding and the '438 reissue application be merged, citing the general policy of the Office as set forth in MPEP § 2608.03 that a reexamination proceeding and a reissue application directed to the same patent will not be separately conducted. [1]

7. Also on August 26, 2005, patent owner filed a second preliminary amendment in the '438 reissue application. This amendment amended claims 7, 14, 26, 30, 32 36-41, and purported to present "new" claims 42-55.

8. A notice of the filing of the reissue application was published in the *Official Gazette* on September 13, 2005. To date, the '438 reissue application has not received an Office action.

9. On September 26, 2005, the third party requester filed a petition requesting that that the '098 *inter partes* reexamination proceeding and the '438 reissue application be merged. The petition merely indicates (1) that requester would consent to the merger as being in

[1] See Image File Wrapper (IFW) paper filed August 26, 2005, labeled as REM.

accordance with Office policy, [2] and (2) that in the event that merger does not take place, that the reexamination proceeding be handled with "special dispatch" as required by 35 U.S.C. § 314. [3]

10. Also on September 26, 2005, the third party requester filed comments directed to patent owner's August 26, 2005 response to the July 29, 2005 Office action. [4]

DECISION

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.**" [Emphasis added].

The '438 reissue application and the '098 reexamination proceeding are currently pending for the same patent. Since the order granting reexamination has been mailed pursuant to 37 CFR 1.931 in the '098 reexamination proceeding, and both proceedings have been announced in the *Official Gazette*, a decision under 37 CFR 1.991 is timely.

The decision as to whether the *inter partes* reexamination and reissue proceedings will be merged, or one of the proceedings will be suspended, *is discretionary*. As pointed out in item 7 of the above Review of Facts, patent owner has "requested" merger of the two proceedings. As pointed out in item 9 of the above Review of Facts, the third party requester has filed a petition requesting that the two proceedings be merged.

The '438 reissue application and the '098 reexamination proceeding contain different claims. A review of the '438 reissue application shows that while patent owner has purported to amend the '438 reissue application to present claims 1-5, 7-23, 25-27, and 29-55, [5] the '438 reissue application in fact contains pending claims 56-65, as per the amendment filed on May 16, 2005, and as such, contains broadening claims. Also, a cursory inspection of the declaration of record in the '438 reissue application shows that it refers to the reissue application as a broadening reissue application, despite the patent owner's present assertion that the reissue application is not a broadening reissue application. [6]

Looking at the present fact situation, the following is considered and noted:

1. The merger option:

If the instant *inter partes* reexamination and reissue proceedings were to be merged, the merger would permit a third party (the *inter partes* reexamination requester) to comment on the

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[2] See page 1 of the petition.
[3] See page 3 of the petition. This request is not necessary, as all reexaminations are to be handled with special dispatch, and this request is not further addressed herein.
[4] See 37 CFR 1.947.
[5] See paper filed August 26, 2005 labeled REM, at the penultimate paragraph on the second page of the paper. While the remarks indicate that claim 53 is the last pending claim, it is clear that claims 54 and 55 are also pending, as per the last page of the August 26, 2005 paper labeled CLM.
[6] See comments on the third page of the August 26, 2005 paper labeled REM.

broadened claims [7] of the reissue application, and to participate in the appeal process as to such claims; yet, the reissue and reexamination statutes do not provide such a right of third party comment and participation. When Congress legislated the *inter partes* reexamination statute, Congress explicitly provided, in 35 U.S.C. § 314(a), 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].

A decision to merge the '098 reexamination proceeding and the '438 reissue application would include within the merged proceeding pending claims which are broader than the claims of the '932 patent being reexamined. The rights of the *inter partes* reexamination requester to comment during such a merged proceeding and to participate in the appeal process are not to be annulled, since they are required by statute, i.e., 35 U.S.C. § 314(b) and 35 U.S.C. § 315(b) respectively. Thus, merger of the '098 proceeding and the instant reissue application would provide the third party requester with the right to support any Office rejections and to comment on any Office or patent owner reasons for patentability with regard to the newly added broadened claims. Yet, the effect and intent of the *inter partes* reexamination statue (35 U.S.C. § 314(a)) is to preclude any third party requester comment and participation as to broadened claims. Since third party requester input as to the broadened claims presented by the '438 reissue application, and Office consideration of that input, are not within the scope of *inter partes* reexamination, nor is such provided for elsewhere by statute, combining the '098 *inter partes* reexamination with the instant broadening reissue application would run counter to the patent statute.

The main (focal) point here is that third party requester input, and Office consideration of same, as to the broadened claims *per se* is not within the scope of *inter partes* reexamination, since the *inter partes* reexamination statute precludes same. The merger of the *inter partes* reexamination proceeding with the reissue application would permit and provide for such input and consideration as to the broadened claims of the '438 reissue application, in violation of the statute; [8] thus, *a merger of the proceedings would not be appropriate.*

It is also to be noted that a merger would fundamentally change the nature of what would otherwise be an *ex parte* reissue proceeding under 35 U.S.C. 251, *and that too runs counter to the patent statute* (which provides only for an *ex parte* reissue proceeding.

Finally, it is to be observed that, even if the broadening claims were to be deleted from the reissue proceeding, the patent owner would still retain the ability to, at any point in a merged proceeding present broadening claims, thus nullifying any such merged proceeding at patent owner's sole discretion. Further, the fact that broadening claims could be presented at any point in time via such a merged proceeding would render the reexamination proceeding a proceeding which is contrary to the statute.

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[7] At least claims 61-65 are clearly broader than the original patent claims by reason of the omission of the "base" limitation. See paragraphs 4 and 5 of the reissue declaration filed on May 16, 2005 for a discussion of the error being the broadening aspect of the reissue application.

[8] Even if broadening claims were not presently included in the reissue application, the applicant/patent owner could provide broadening claims at some future point in the prosecution.

In view of the above, while in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, the Office declines to exercise its discretion to merge the reexamination and reissue proceedings. [9]

2. The option to conduct the proceedings separately:

It is not appropriate to conduct the examination of the reissue and reexamination proceedings for the '932 patent separately, and at the same time. 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 addition, in the present instance, if the examination of the reissue and reexamination proceedings were conducted separately, the patent owner could place all of its arguments and 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, [10] while the Office would have the benefit of the patent owner's input as to the claims by way of the reissue application. This result runs contrary to the intent of the *inter partes* reexamination statute.

3. The suspension option:

Given that the examination of the instant reissue and reexamination proceedings will not be conducted separately and at the same time for the reasons stated, and will not be merged for the reasons stated, the question remains as to which of the two proceedings should proceed forward, and which should be suspended.

To answer to this question, it is observed that there is a statutory requirement for "special dispatch" in an *inter partes* reexamination proceeding (pursuant to 35 U.S.C. § 314(c)). Because 35 U.S.C. § 314(c) provides the statutory requirement that *inter partes* reexamination proceedings must be conducted with special dispatch, the examination of the reexamination proceeding must take precedence. Thus, it is the reissue proceeding that will be suspended.

In this instance, the *inter partes* reexamination and reissue proceedings were filed within one month of each other. Reexamination has been ordered, and an Office action on the merits has issued for the '098 reexamination proceeding, while the '438 reissue application has not received an Office action. [11] Thus, a suspension of the reissue proceeding would not delay a proceeding that has progressed substantially toward its resolution. It is also to be noted that the reissue

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[9] An Office decision to merge, in this instance, would present a position inconsistent with the Congressional mandate of the patent statute as discussed above, and thus, it is rejected. See *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") and *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.")

[10] 35 U.S.C. § 314(b) (2) states: "Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office **or the patent owner's response thereto**...."[Emphasis added] A patent owner response in the reissue application would not be a response in the reexamination proceeding, and thus, would not trigger the statutory right of the requester to comment on the response.

[11] The announcement of the filing of a reissue application is announced in the *Official Gazette*, pursuant to 37 CFR 1.11(b) was published on September 13, 2005. Generally, a reissue application will not be acted on sooner than two months after the announcement of filing in the *Official Gazette*. See MPEP § 1441. Thus, an action on the '438 reissue application will not issue earlier than November 13, 2005.

application was filed for the purpose of broadening the patent [12] prior to the expiration of the statutory period for broadening the patent claims, *i.e.*, two years from the patent grant, and a suspension of the reissue proceeding will not interfere with that purpose, since the patent owner's right to have the broadened claims considered by the Office will be preserved. At the same time, the broadened claims in the suspended reissue application will be kept beyond the reach of the third party requester's comments.

Based on the above, action in the present 11/130,438 reissue application is hereby **suspended** pursuant to 37 CFR 1.103(e) in favor of the reexamination proceeding. The reissue application suspension shall remain in effect until the conclusion of present *inter partes* reexamination proceeding control No. 95/000,098 by the issuance and publication of a reexamination certificate.

CONCLUSION

1. The third party requester petition to merge the 11/130,438 reissue application and the 95/000,098 reexamination proceeding is dismissed.

2. Action in the 11/130,438 reissue application is **suspended** pursuant to 37 CFR 1.103(e), until the completion of the *inter partes* reexamination proceeding control no. 95/000,098 by the issuance and publication of a reexamination certificate for the proceeding.

3. After a reexamination certificate for the '098 reexamination proceeding has issued and published, an Office action will be mailed for the 11/130,438 reissue application.

4. The patent owner is advised to, at the time that a reexamination certificate is issued and published for the 95/000,098 reexamination, call the issuance of the certificate to the attention of the Office, and request a resumption of examination of the reissue application. The patent owner may include an amendment of the reissue application claims at that time, if such is deemed appropriate based upon the results of the reexamination proceeding.

5. A copy of this decision is being placed in both the 11/130,438 reissue application file and the 95/000,098 reexamination file.

6. The reexamination proceeding is being forwarded , *via* the Technology Center 3700 Special Program Examiner, to the Primary Examiner for immediate action on the response filed by patent owner on August 26, 2005, and the comments on the response that were filed by the third party requester on September 26, 2005.

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[12] And, as noted, *supra*, the stated error in the reissue declaration of record continues to be that the '932 patent claims less than patentee had a right to claim, *i.e.*, the claims are too narrow and will, therefore, be broadened.

7. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

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October 20, 2005

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REEXAM UNIT

In re Microunity Systems Engineering, Inc.
Reexamination Proceeding
Control No.: 95/000,100
Filed: June 28, 2005
For: U.S. Patent No. 6,725,356 B1

: DECISION ON PETITION
: ALLEGING *ULTRA VIRES*
: ACTION AND REQUESTING
: WITHDRAWAL OF REJECTION

This is a decision on the October 11, 2005 patent owner petition under 37 CFR 1.181 for certain specified relief on the basis that the examiner's Office action rejecting claims 1-48 of U.S. Patent 6,725,356 (the '356 patent) is asserted to constitute an *ultra vires* action beyond the statutory and regulatory authority of an examiner during reexamination. No petition fee is required.

The relief requested by patent owner is that (1) certain statements regarding entitlement of the '356 patent to 35 U.S.C. §120 benefit of prior United States be patent 6,295,599 (the '599 patent) be stricken from the September 8, 2005, Office action, (2) that the mailing date of the action be reset, (3) a particular ground of rejection in the Office action dated September 8, 2005, be withdrawn because it is improper, and (4) the examiner be directed to issue a revised or new Office action stating that a particular publication is not prior art.

As the patent owner petition is directed to a jurisdictional challenge, it is before the Office of Patent Legal Administration for decision.

SUMMARY

The petition is dismissed as to all relief requested, for the reasons set forth below.

REVIEW OF FACTS

1. The '356 patent issued on April 20, 2004.

2. A request for reexamination of the '356 patent was filed on June 30, 2005. The request was assigned control No. 95/000,100 (the '100 reexamination proceeding).

3. Reexamination was ordered for the '100 proceeding on September 8, 2005.

4. A first Office action rejecting claims 1-48, *i.e.* all of the patent claims, was mailed on September 8, 2005. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On October 11, 2005, the patent owner filed the instant petition.

6. In response to a timely filed petition for extension of time by patent owner, a two month extension of time for filing reply to the September 8, 2005 Office action was granted on October 12, 2005.

DECISION

35 U.S.C. § 311 states, in part:

> "(a) IN GENERAL. - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301."

35 U.S.C. § 312 states, in part:

> "(a) REEXAMINATION. - Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

MPEP § 2646, Part I, states, in part:

> "A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where <u>no discretion</u> to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> "(A) the reexamination order is not based wholly on prior art patents or printed publications;
> (B) reexamination is prohibited under 37 CFR 1.907;
> (C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
> (D) reexamination was ordered for the wrong patent;
> (E) reexamination was ordered based on a duplicate copy of the request; or
> (F) the reexamination order was based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g. the application which matured into the patent, a prior reexamination, an interference proceeding)."

<u>The Order Granting Reexamination Was Not An *Ultra Vires* Action</u>

The question of whether an order granting reexamination is based upon the grounds permitted by 35 U.S.C. §§ 311 and 312 is a question of whether the Office has jurisdiction to order reexamination. As discussed in MPEP § 2246, if an order granting a request for reexamination

is based **wholly** upon consideration of subject matter that is not permitted by the statute, then the granting of the request for reexamination is outside of the jurisdiction of the Office and is an *ultra vires* action on the part of the Office. However, a substantive determination to order reexamination based upon grounds permitted by the statute is not subject to judicial review. [1]

The request for reexamination, filed on June 30, 2005, cited numerous patents and printed publications based upon which the requester asserted more than seventy different grounds for finding a substantial new question of patentability. One of the cited publications is identified as the Ide *et al* publication. [2] The Ide *et al* publication date, March 1993, is a date earlier than the earliest date recited in the benefit claim of the '356 patent. The Ide *et al* publication was not of record during the original examination of the application that matured into the '356 patent. The examiner's order granting reexamination held that the Ide *et al* publication raised a substantial new question of patentability with respect to claims 18-48. [3] The examiner therefore granted the request for reexamination. [4] Pursuant to 35 U.S.C. § 313 [5] and MPEP § 2643, [6] the examiner ordered reexamination of all patent claims. A first action on the merits, (i.e., an action discussing the patentability of all patent claims), was mailed concurrently with the order granting reexamination. [7]

The order granting *inter partes* reexamination, having been based upon a prior art publication that raised a substantial new question of patentability with respect to one or more of the '356 patent claims, was a proper exercise of the jurisdiction conferred upon the Office by 35 U.S.C. §§ 311 and 312. Patent owner has not advanced any rationale for holding that the order for reexamination was based upon subject matter outside of the jurisdiction conferred upon the Office by the reexamination statutes. Therefore, it is held that the examiner's order granting reexamination was <u>not</u> an *ultra vires* act on the part of the Office.

<u>No Ground Of Rejection Set Forth In The Examiner's First Office Action Is Subject to Review by Petition</u>

35 U.S.C. 315 states, in part:

> "(a) PATENT OWNER-- The patent owner involved in an *inter partes* reexamination proceeding under this chapter—
> (1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim; and

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[1] *Heinl v. Godici*, 143 F. Supp. 2d 593 (E.D. VA. 2001); *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35 (D.D.C. 1998)

[2] A 320-MFLOPS CMOS Floating-Point Processor Unit for Superscalar Processors, IEEE Journal of Solid State Circuits, Vol. 28, No. 3, published March 1993.

[3] The '356 patent contains claims 1-48.

[4] See Order Granting Reexamination dated September 8, 2005, at pages 2-3.

[5] The statute states: "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes **reexamination of the patent** for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314." (Emphasis supplied.)

[6] MPEP § 2643 states in pertinent part: "If a substantial new question of patentability is found as to any claim, reexamination will be ordered and will normally cover all claims except for claims that have been finally held invalid in a Federal Court decision on the merits."

[7] 35 U.S.C. § 313 states: "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314."

(2) may be a party to any appeal taken by a third-party requester under subsection (b)."

37 CFR 1.953 states, part:

"(a) Upon the issuance of a Right of Appeal Notice under § 1.953, the patent owner involved in an inter partes reexamination proceeding may appeal to the Board of Patent Appeals and Interferences **with respect to the final rejection of *any* claim of the patent** by filing a Notice of Appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b)." (Emphasis supplied.)

37 CFR 41.61 states, in part:

"(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1)."

37 CFR 1.181states, part:

"Petition may be taken to the Director:
(a)(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court."

The relief requested by patent owner is that the following statements of the examiner set forth in the Office action dated September 8, 2005 [8] be stricken from the Office action:

1. Parent United States Patent 6,295,599 (the '599 patent) does not support the claims of the '356 patent; and

2. The claims of the '356 patent are not entitled to 35 U.S.C. § 120 benefit of the '599 patent.

Patent owner further requests that an allegedly improper rejection of patent claims 18-48 in view of the combination of the Hansen et al publication [9] and the Ide *et al* publication be withdrawn as exceeding the statutory and regulatory authority of an examiner during reexamination, and that the examiner be directed to issue a new or revised office action stating that Hansen et al publication is not available as prior art as of its publication date.

The first Office action, dated September 8, 2005, in fact contains numerous grounds of rejection, and all of the patent claims stand rejected over patents and/or publications other than the Hansen *et al* and Ide *et al* publications. [10] Notwithstanding patent owner's attempt to cast both the rejection based upon Hansen *et al* and Ide *et al*, and the rationale set forth by the examiner in support of that rejection, as being *ultra vires* acts exceeding the examiner's authority in an *inter partes* reexamination proceeding, the record reveals that the rejection in question is simply one of a number of rejections set forth in the September 8, 2005 Office action. As discussed, *infra*, the question of whether the rejection based upon Hansen *et al* and Ide *et al* is legally correct must be addressed on appeal, and not by petition.

Patent owner's belief that the rejection based upon the Hansen *et al* and Ide *et al* publications is legally impermissible in this proceeding does not convert the examiner's promulgation of the rejection into a question of the examiner's jurisdiction to take a particular action, thereby creating a petition right to contest the propriety of taking that action. 37 CFR 1.181(a)(1) permits

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[8] Pursuant to 37 CFR 1.935 and MPEP § 2660, the first Office action the merits, *i.e.*, on the patentability of the claims of the '356 patent, was mailed together with the order granting reexamination.
[9] PCT Publication No. WO 97/07450, published February 27, 1997.
[10] See Office action dated September 8, 2005, pages 7, 9, 20, 26, 27 and 31.

petitions **only** from matters that are not subject to appeal to the Board of Patent Appeals and Interferences ("Board"). In terms of determining the propriety of a particular ground of rejection in an *inter partes* reexamination proceeding, the statutes and regulations make no distinction between a ground of rejection based upon anticipation or nonobviousness and a ground of rejection that allegedly violates 35 U.S.C. § 312(a) (because it is alleged to be based upon grounds other than the application of prior art patents and printed publications). The jurisdiction to determine that any particular ground of rejection is or is not legally correct resides with the Board. [11] Patent owner has not demonstrated that any ground of rejection currently of record in this proceeding **could not** ultimately be appealed to the Board. Rather, it appears that **any** rejection maintained and made final by the examiner issuing a Right of Appeal Notice [12] in this proceeding, may then be appealed to the Board. The Board will then have jurisdiction to determine whether any appealed rejection is or is not legally correct.

It should be noted that even if patent owner ultimately appeals a particular ground of rejection in this proceeding, and successfully demonstrates that the rejection and supporting rationale are legally incorrect because they are based upon matters outside of the scope of the reexamination statutes and regulations, [13] this would not mean that the rejection and supporting rationale should have been treated as petitionable *ultra vires* actions in the sense that the Office lacked jurisdiction to order reexamination of the '356 patent and promulgate rejections during that proceeding. Instead, the rejection would simply be considered to be a legally incorrect rejection in a reexamination proceeding in which, for the reasons set forth above, the Office had clear jurisdiction to order reexamination.

In a reexamination proceeding that is not itself *ultra vires*, because the Office did in fact have jurisdiction to order reexamination, patent owner's remedy with respect to any rejection and supporting rationale believed to be erroneous, is to appeal in accordance with the statutes, and regulations that establish and implement the right to appeal rejections in *inter partes* reexamination proceedings. In this regard, it should be noted that the decision in *Patlex Corporation v. Quigg*, 680 F. Supp. 33, (D.D.C. 1988), was a decision **on appeal from a decision of the PTO Board of Appeals and Interferences,** and not a decision reviewing an adverse decision on petition. [14] Where, as in *Patlex* and as here, the order granting reexamination has not been shown to have been an *ultra vires* action on the part of the Office, thereby depriving the Office of jurisdiction to reexamine, the propriety of a rejection alleged to be based upon subject matter not proper for consideration in reexamination is properly determined by appeal, and not by way of petition.

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[11] See 35 U.S.C. § 315; see also 37 CFR 1.959 and 41.61.

[12] See 37 CFR 1.953.

[13] This decision expresses no view on the rejection and rationale complained of by patent owner, since the question of the propriety of the rejection in question is proper for appeal, and therefore is not proper for petition. Accordingly, this decision expresses no opinion regarding the propriety of reexamining a 35 USC §120 benefit claim in an *inter partes* reexamination proceeding, or upon patent owner's position vis-à-vis MPEP § 2167 (*sic*, 2617)

[14] In *Patlex*, reexamination had been order based upon five substantial new questions of patentability. See *Patlex*, at page 35.

CONCLUSION

1. The patent owner petition under 37 CFR 1.181 to strike [15] the rejection and its supporting rationale based upon the Hansen et al and Ide et al patents, as set forth in the September 8, 2005 Office action, is dismissed.

2. No statement by the examiner regarding entitlement of the '356 patent to benefit of the '599 patent will be stricken because such statements are part of the rationale supporting the rejection that will not be stricken.

3. The date of the September 8, 2005 Office action will not be reset, since patent owner is not entitled to have any portion of that action stricken. Further, the examiner will not be directed to state in a new or revised Office action that Hansen *et al* is not available as prior art, because that statement is part of the appealable rejection that will not be stricken.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to either await the filing of any party papers if the time for filing same has not expired, or to process any and all party papers if there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

5. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, to Elizabeth L. Dougherty, Senior Legal Advisor at (571) 272-7733.

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

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November 28, 2005

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[15] As being an *ultra vires* action on the part of the Office

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DEC 02 2005
REEXAM UNIT

In re Microunity Systems Engineering, Inc.	:
Reexamination Proceeding	: DECISION GRANTING
Control No.: 95/000,100	: PETITION UNDER
Filed: June 28, 2005	: 37 CFR § 1.183
For: U.S. Patent No. 6,725,356 B1	:

This is a decision on the October 12, 2005 patent owner petition under 37 CFR 1.183 titled "PETITION TO SUSPEND RULE 37 CFR § 1.943 PURSUANT TO THE PROVISIONS OF 37 CFR § 1.183." The petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed 50 pages in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent that the page limit for the response to the September 8, 2005 first Office action is extended to not exceed 60 pages in length.

Pursuant to 37 CFR 1.17(f), the petition fee for filing a petition under 37 CFR 1.183 is $400.00. The fee paid by the patent owner with the instant petition is $130.00. Accordingly, an additional fee of $270.00 has been charged to petitioner's Deposit Account No. 500417 for the petition under 37 CFR 1.183, as authorized by the petition on page 1. This fee represents the difference between the amount ($130.00) paid by applicants on October 12, 2005, and the $400.00 petition fee set forth in 37 CFR 1.17(f).

REVIEW OF FACTS

1. U.S. Patent No. 6,725,356 (the '356 patent) issued on April 20, 2004.

2. A request for reexamination of the '356 patent was filed on June 30, 2005. The request was assigned control No. 95/000,100 (the '100 reexamination proceeding).

3. Reexamination was ordered for the '100 proceeding on September 8, 2005.

4. A first Office action rejecting claims 1-48, *i.e.* all of the patent claims, was mailed on September 8, 2005. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On October 12, 2005, the patent owner filed the instant petition under 37 CFR 1.183.

6. In response to a timely filed petition for extension of time by patent owner, a two month extension of time for filing reply to the September 8, 2005 Office action was granted on October 12, 2005.

APPLICABLE PROVISIONS

37 CFR § 1.943(b) states:

> "Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references

MPEP § 2667 states, in part:

> "The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.

"Where papers are filed during reexamination proceedings, which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: the reexamination file (paper file or IFW file history); the patent file (paper file or IFW file history); or the storage area >(paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA)) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number.

"I. TYPES OF PAPERS RETURNED WITH TECHNOLOGY CENTER DIRECTOR OR REEXAMINATION LEGAL ADVISOR< APPROVAL REQUIRED

A. Filed by Patent Owner

2. Response Is Too Long

Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice."

DECISION

37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds 50 pages in length. In the instant petition, the patent owner requests relief from such limitation when filing a forthcoming response to the Office action of September 8, 2005. Accordingly, the petition is being addressed as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.943(b).

The June 30, 2005 request for *inter partes* reexamination, filed by a third party requester, was ninety-seven (97) pages in length and listed over one hundred (100) exhibits, including prior art. The request applied or suggested sixty-seven (67) different prior art novelty and obviousness rejections against claims 1-48 of the '356 patent. Following the request for reexamination, the Office ordered reexamination for the '100 proceeding on September 8, 2005. Accompanying the order for reexamination was an Office action fifty-eight (58) pages in length, which set forth thirty (30) separate grounds of rejection.

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(b) based, on the fact that the Office action by the examiner lists thirty separate grounds of rejection and is fifty-eight pages in length. Petitioner (patent owner) asserts that the 58 page Office action and its thirty separate grounds of rejection "cannot be fairly addressed in a fifty page response,"[1] as required by 37 CFR 1.943(b). Petitioner further asserts that it is in the interest of justice to allow the patent owner fair opportunity to address each of the grounds [of the Office action], which can only be accomplished by suspending the 50 page response rule of 37 CFR 1.943(b).[2]"

The petition fails to specifically state how many additional pages, beyond the permitted 50-page length, petitioner is requesting to "fairly address" the Office action and its contents. Given this lack of specificity in petitioner's request and the presence of the fifty-page limit set forth in 37 CFR 1.943(b), the petition as presented cannot be granted. Page limits upon responses in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305. Petitioner has failed to provide any justification for an extension of the permitted response page length without any limitation as to the number of pages. To allow petitioner the unfettered ability to provide a response of whatever page limit petitioner deems necessary to address each of the grounds of the Office action could foreseably open the door for a response so voluminous as to substantially delay the instant reexamination proceeding. Nevertheless, given the numerous grounds of rejection set forth by the examiner and petitioner's timely request, the Office will grant the present petition to the extent of waiving the 37 CFR 1.943(b) responses limit of 50 pages:

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[1] Patent owner's present petition at page 3, lines 14-15.
[2] Patent owner's present petition at page 2, lines 20-21.

(A) For only the next immediate response to be supplied by the patent owner in response to the September 8, 2005 Office action, and

(B) To permit patent owner to provide as much as sixty (60) pages for patent owner's response to the September 8, 2005 Office action. The Office will enforce compliance with this new page limit of 60 pages, and a strict review of the length of patent owner's response will be made upon its receipt.

This sixty (60) page limit is deemed equitable in light of the 58 page length of the September 8, 2005 Office action.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to the extent that the page limit for the response to the September 8, 2005 first Office action is extended to not exceed sixty (60) pages in length.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to Elizabeth L. Dougherty, Office of Patent Legal Administration, at (571) 272-7733.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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(For Patent Owner)

MAILED

DEC 12 2005

REEXAM UNIT

David L. McCombs
Haynes and Boone LLP
901 Main Street
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(For Requester)

In re Microunity Systems Engineering, Inc.
Reexamination Proceeding
Control No.: 95/000,100
Filed: June 28, 2005
For: U.S. Patent No. 6,725,356 B1

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the December 6, 2005 renewed patent owner petition under 37 CFR 1.183 titled "REQUEST FOR RECONSIDERATION-PETITION TO SUSPEND RULE 37 CFR § 1.943 PURSUANT TO THE PROVISIONS OF 37 CFR § 1.183." The renewed petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length, to the extent that 90 pages be permitted.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,725,356 (the '356 patent) issued on April 20, 2004.

2. A request for reexamination of the '356 patent was filed on June 30, 2005. The request was assigned control No. 95/000,100 (the '100 reexamination proceeding).

3. Reexamination was ordered for the '100 proceeding on September 8, 2005.

4. A first Office action rejecting claims 1-48, *i.e.* all of the patent claims, was mailed on September 8, 2005. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On October 12, 2005, the patent owner filed a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed 50 pages in length.

6. In response to a timely filed petition for extension of time by patent owner, a two month extension of time for filing reply to the September 8, 2005 Office action was granted on October 12, 2005.

7. On December 2, 2005, the October 12, 2005 petition was granted to the extent that the page limit for the response to the September 8, 2005 first Office action was extended to not exceed 60 pages in length.

8. On December 6, 2005, the patent owner filed the instant renewed petition requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length, to the extent that 90 pages be permitted.

DECISION

37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds 50 pages in length. In the instant renewed petition, the patent owner requests relief from such limitation when filing a forthcoming response to the Office action of September 8, 2005. Petitioner has supplemented the original petition by specifically stating how many additional pages, beyond the permitted 50-page length, petitioner is requesting to "fairly address" the Office action and its contents. Petitioner has requested a 90 page limit for the response to the Office action of September 8, 2005. Upon reconsideration, it is noted that the examiner incorporated from the request, into the Office action of September 8, 2005, some of the rejections proposed by the requester. Based upon the extent of the proposed rejections incorporated, the requested 90 pages is deemed equitable in addressing the Office action. Accordingly, the petition is granted:

(A) For <u>only</u> the next immediate response to be supplied by the patent owner in response to the September 8, 2005 Office action, and

(B) To permit patent owner to provide as much as <u>ninety (90) pages</u> for patent owner's response to the September 8, 2005 Office action. The Office will enforce compliance with

this new page limit of 90 pages, and a strict review of the length of patent owner's response will be made upon its receipt.

CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to permit a patent owner response to the September 8, 2005 first Office action not to exceed ninety (90) pages in length.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to Elizabeth L. Dougherty, Office of Patent Legal Administration, at (571) 272-7733.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
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for Patent Examining Policy

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(For Requester)

MAILED
JAN 10 2006
REEXAM UNIT

In re Microunity Systems Engineering, Inc. :
Reexamination Proceeding : **DECISION**
Control No.: 95/000,100 : **DISMISSING**
Filed: June 28, 2005 : **PETITION**
For: U.S. Patent No. 6,725,356 B1 :

This is a decision on the October 12, 2005 patent owner petition under 37 CFR 1.181 requesting that the first Office action, dated September 8, 2005, be withdrawn in favor of a new Office action. The basis for the relief requested is that the Office action in question is too lengthy, and asserts unduly multiplied cumulative rejections in contradiction to the requirements of 37 CFR 1.937(b), 37 CFR 1.104 and MPEP § 706.02(I). No petition fee is required.

Reexamination proceeding 95/000,100 (the '100 proceeding) and the patent owner petition are before the Office of Patent Legal Administration.

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

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,725,356 (the '356 patent) issued on April 20, 2004.

2. A request for *inter partes* reexamination of the '356 patent was filed on June 28, 2005 and assigned control number 95/000,100.

3. Reexamination was ordered for the '100 proceeding on September 8, 2005.

4. A first Office action rejecting claims 1-48, *i.e.* all of the patent claims, was also mailed on September 8, 2005. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On October 12, 2005, the patent owner filed the instant petition.

RELEVANT STATUTE, REGULATIONS, AND PRACTICE

35 U.S.C. § 315 states, in part:

"(a) PATENT OWNER.- The patent owner involved in an inter partes reexamination proceeding under this chapter-

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b)."

"(b) THIRD-PARTY REQUESTER.- A third-party requester-

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144."

37 CFR 1.104(c)(2) states, in part:

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command."

37 CFR 1.937(b) states:

"The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, **except as otherwise provided**." (Emphasis added.)

37 CFR 1.953 states, in part:

"(a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an inter partes reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits. ...

(c) 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, the inter partes reexamination proceeding will be terminated, and the Director will proceed to issue a certificate under § 1.997 in accordance with the Right of Appeal Notice." (Emphasis added.)

37 CFR 41.61 states, in part:

"(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

"(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, **the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection,** of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1)."

"(b)(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), **a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection,** of any original, proposed amended, or new claim of the patent." (All emphasis supplied.)

MPEP § 2660 III, "Form and Content of First Office Action on the Merits That is Not an Action Closing Prosecution" states, in part:

"The examiner's first Office action will be a statement of the examiner's position, and it should be so complete that the second Office action can properly be made an Action Closing Prosecution (ACP). See MPEP § 2671.02. Accordingly, it is intended that the first Office action be the primary action to establish the issues which exist, such that the patent owner response **and any third party comments** can place the proceeding in condition for the issuance of an ACP.

The examiner's first action should be comprehensive and address all issues as to the prior art patents and/or printed publications. **The action will clearly set forth each ground of rejection and/or ground of objection, and the reasons supporting the ground. The action will also clearly set forth each determination favorable to the patentability of claims, i.e., each rejection proposed by the third party requester that the examiner refuses to adopt.** Reasons why the rejection proposed by the third party requester is not appropriate (i.e., why the claim cannot be rejected under the ground proposed by the third party requester) must be clearly stated for each rejection proposed by the third party requester that the examiner refuses to adopt. Comprehensive reasons for patentability must be given for each determination favorable to patentability of claims. See MPEP § 1302.14 for examples of suitable statements of reasons.

In addition to the grounds and determinations set forth in the action, **the first action should respond to the substance of each argument raised in the request by the third party requester pursuant to 37 CFR 1.915.** Also, it should address any issues proper for reexamination that the examiner becomes aware of independent of the request."

DECISION

Patent owner requests a new Office action because patent owner regards the September 8, 2005 Office action as being non-compliant with 37 CFR 1.104(c). [1] In so concluding, the patent owner relies upon the language in 37 CFR 1.104(c)(2), which mandates that the examiner cite "the best references at his or her command" in an Office action rejecting claims for want of novelty or for obviousness. Patent owner regards the thirty separate grounds of rejection applied to the 48 patent claims as being an unfair application of the "best available prior art." Patent owner also relies upon certain language in MPEP § 706.02(I) "Rejection on Prior Art, Choice of Prior Art, Best Available" [2] as supporting the patent owner's conclusion that the Office action of September 8, 2005, is not confined to the application of the "best available prior art,"- because the action contains such a large number of grounds of rejection that are, in turn, based on such a large number of references, the rejections must, perforce, be cumulative.

Patent owner's position ignores certain critical portions of the *inter partes* reexamination statute and of the regulations that implement the statutory provisions. For example, while 37 CFR 1.937(b) does initially require that Office actions in reexamination proceedings adhere to the requirements of 37 CFR 1.104 through 1.116, 37 CFR 1.937(b) concludes with the caveat "except as otherwise provided." As illustrated, *infra*, 37 CFR 1.104 must be read in light of this caveat, and, when so read, it becomes clear that the *inter partes* reexamination statute and regulations preclude reading 37 CFR 1.104(c)(2) as requiring that the examiner apply (in an *inter partes* reexamination proceeding) only "the best references at his or her command." [3]

Similarly, MPEP § 706.02(I) states that the examiner should **ordinarily** confine prior art rejections to "the best available prior art," and that merely cumulative rejections which would **clearly fall if the primary rejection were not sustained should** be avoided. This language is contained in a section of the MPEP that is not specific to examination procedure in an *inter partes* reexamination proceeding, and can be shown to have little application to the examination practice required by the *inter partes* reexamination statute and regulations. [4]

Guidance with respect to "nonfinal" Office actions in *inter partes* reexamination proceedings [5] is provided in MPEP § 2660(III). This section states that the first Office action **must** establish the issues that exist so that both parties to the reexamination proceeding can appropriately comment and thereby place the proceeding in condition for an Action Closing Prosecution (ACP). [6] MPEP § 2660(III) expressly **requires** the first Office action to set forth each ground of rejection and/or ground of objection, and the reasons supporting the grounds of rejection. Pursuant to MPEP § 2660, the first Office action **must** also clearly set forth each determination favorable to the patentability of claims, and expressly **requires** a discussion of "each rejection

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[1] 37 CFR 1.937(b) states that *inter partes* reexamination proceedings will be conducted in accordance with 37 CFR 1.104 through 1.111.

[2] "Prior art rejections should ordinarily be confined strictly to the best available art. ... Merely cumulative rejections, *i.e.*, those which would clearly fall if the primary rejection were not sustained, should be avoided."

[3] It should be noted that to the extent that the literal language of 37 CFR 1.104(c)(2) is relied upon by patent owner, patent owner has not established that any of the rejections complained of rely upon references other than the best references at the examiner's command.

[4] It is noted that even if MPEP § 706.02(I) were applicable in the instant *inter partes* reexamination proceeding, patent owner has not established that any of the rejections complained of would "clearly fall" for any reason.

[5] In *inter partes* reexamination proceedings, a "nonfinal" action is an action other than a Right of Appeal Notice. See 37 CFR 1.953(c).

[6] An ACP is the action that is promulgated when all issues have been developed, and is the necessary precursor to a Right of Appeal Notice. See 37 CFR 1.949 and MPEP § 2671.02.

proposed by the third party requester that the examiner refuses to adopt." Thus, MPEP § 2660(III) clearly implements the caveat in 37 CFR 1.937(b), i.e., with respect to Office actions in *inter partes* reexamination, the requirement in 37 CFR 1.104(c)(2) regarding citation and reliance upon (only) "the best prior references" at the examiner's command is inapplicable.

The reason why 37 CFR 1.104(c)(2) is not applicable to an *inter partes* reexamination proceeding is precisely because the proceeding is *inter partes*. For example, 35 U.S.C. § 315(b) establishes a right for the third party requester to appeal any determination that patent claims (original or amended) are patentable. A failure to adopt any rejection properly proposed by the requester is a determination that the claims are patentable over that proposed rejection, and such a failure would need to be argued and then appealed by the requester - in order to preserve appeal rights ultimately to the Court of Appeals for the Federal Circuit. Thus, the examiner must apply any rejection that will render the claims unpatentable, so that the requester need not argue and appeal as to that proposed rejection.

Note that it is impossible to determine which claims are patentable, without also determining which claims are not patentable. The determination of which claims are patentable, and which claims are not patentable, necessarily requires the examiner to consider every ground of rejection asserted by the third party requester, and to adopt with, or without modification, each ground of rejection advanced by the third party requester that the examiner believes to be legally sufficient. The examiner can neither simply refuse to adopt a ground of rejection advanced by the third party requester on the ground that it is cumulative to other grounds of rejection, nor merely remain silent with respect to a ground of rejection advanced by the third party requester that the examiner believes to be legally untenable. To do so would preclude the third party requester from meaningfully exercising the appeal rights created by 35 U.S.C § 315(b) as implemented by 37 CFR 1.953 and 41.61.

Similarly, if the examiner were to simply state that a claim is considered to be unpatentable without advancing a ground of rejection together with a rationale in support of that ground of rejection, or were to remain silent with respect to a third party requester proposed rejection that the examiner believes to be legally tenable, the appeal rights of a patent owner could be adversely affected. If an examiner believes that a claim is unpatentable over the art for a reason advanced by the third party requester, but either does not so state or neglects to supply a cogent explanation why the claim is unpatentable, a patent owner would not be able to meaningfully address the merits of the examiner's conclusion on appeal. It is for these reasons that 37 CFR 1.953(c) requires the Right of Appeal Notice to set 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 of each claim.**" (Emphasis supplied.)

While it is understandable that patent owner in the instant proceeding is faced with responding to a lengthy Office action in which a large number of references have been applied to 48 claims with many claims being rejected on multiple grounds, it is clear that *inter partes* reexamination procedure **requires** the examiner to apply every third party proposed ground of rejection that is believed to be tenable so that a patent owner may, if necessary, address these rejections on appeal. This procedural requirement also enables the examiner to satisfy the parallel requirement that the examiner discuss all third party requester proposed rejections that are regarded as being untenable, so that the third party requester may, if necessary, appeal a holding that a claim is patentable. To the extent that patent owner regards the Office action dated September 8, 2005 as failing to comply with 37 CFR 1.104(c)(2) and MPEP 706.02(I), it is clear that the *inter partes* reexamination statute and the regulations implementing the

reexamination statute override the provisions of the regulation and examining practice relied upon by patent owner as bases for the relief requested.

CONCLUSION

1. The petition under 37 CFR 1.181 requesting that the Office action of September 8, 2005 be replaced by a new Office action confined to the application of the "best available art" is dismissed.

2. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, to Elizabeth L. Dougherty, Senior Legal Advisor at (571) 272-7733.

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

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In re Reexamination Control No. 95/000,101
Filed June 30, 2005
For: U. S. Patent No. 6,695,135

DECISION ON PETITION
Under 37 CFR 1.181 and 37 CFR 1.927

This is a decision on a petition filed October 21, 2005 by the third party requestor, under 37 CFR 1.181 and 1.927, for review of the examiner's decision, mailed September 22, 2005, denying the above identified request for reexamination of U.S. Letters Patent No. 6,695,135.

BACKGROUND

An application for U.S. Letters Patent was filed by Robert Lapeyre on January 6, 2003, for a "Flexible Flight Modules in Modular Plastic Conveyor Belts" which was assigned Serial No. 10/248,291. The examiner of the application originally rejected the claims under 35 USC 103 as being obvious over U.S. Patent No. 4,832,183 to Lapeyre ('183) in view of U.S. Patent No. 5,507,383 to Lapyere et al.('383). Applicant responded to the non-final office action with arguments as to why the combination of the teachings of the references was improper, those arguments being that the '183 patent teaches away from the teachings of the '383 patent. From the record the examiner agreed with the applicant's arguments and the application matured into Patent No. 6,696,135 ('135).

On June 30, 2005, a request for reexamination of the '135 patent was filed by third party requestor. Third party requestor argued the applicant's arguments in response to the 35 USC 103 rejection, were flawed.

On September 22, 2005, the examiner issued an "Order" denying the request for reexamination.

The instant petition was timely filed on October 21, 2005 by the requestor.

CONTROLLING AUTHORITY

MPEP § 2258.01 (A) states:

"For a reexamination that was ordered on or after November 2, 2002 (the date of enactment of Public Law 107-273; see section 13105, of the Patent and Trademark Office Authorization Act of 2002), reliance soley on old art (as the basis of a rejection) does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon fact specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."

DISCUSSION

After careful consideration of applicant's appeal, none of the arguments raised support the position that the order denying request for reexamination was improper.

In the present instance, there exists no SNQ based solely on '183 (US Patent No 4,832,183) taken with '383 (US Patent No 5,507,383). The claims of the '135 patent, for which the reexamination is requested, require that an upstanding resilient structure having a bottom thermally bonded to a base member of a rigid conveyor belt module, and wherein the structure extends to a height above the base portion greater than the length of the bottom of the upstanding structure. The '183 reference does not raise a substantial new question of patentability as to the '135 claims. The '183 reference shows a resilient upstanding structure equivalent thereof with '135 patent that was considered in the prosecution of the application that became the '135 patent.

Third party requestor in the request for reexamination argues that the '383 reference teaches thermal bonding of a resilient flight to a relatively rigid base member. However, the '383 reference was previously used in the prosecution of the '135 patent to teach the thermal bonding of a resilient flight to a base member. There is no argument in the reexamination request that Lapeyre et al. '383 is being applied in a manner different than it was applied in the prosecution of the Lapeyre '135 patent application. In the request for reexamination, it is explained that Figure 9 of the '383 reference is considered to be pertinent to the features of the '135 patent. The requester indicates figure 9 of the '383 reference discloses the upstanding structure extending to a height above the base portion greater than the length of the bottom of the upstanding structure. However, upon inspection, the "bottom" of the structure in the '383 reference is not equivalent to that of the '135 patent. If the upstanding structure in Figure 9 of the '383 reference is broadly interpreted to be the rectangular layer 50 that is thermally bonded

to a surface, then the structure does not have a height greater than the bottom's dimension. Conversely, if the upstanding structure in figure 9 of '383 reference is interpreted to be the conical section 51, then the bottom of the structure is not thermally bonded.

Furthermore, the requestor in his petition states the suggestion to combine the references can be found explicitly in the disclosure of the '135 patent, which refers to the '383 reference for teaching co-molding of the resilient flight to the hard base portion in column 3, lines 24-28 of the '135 patent. Third party requestor also points to figure 3 of the '183 reference as being pertinent to this teaching because the figure shows a slidable resilient flight having an upstanding structure of a height greater than the bottom of the upstanding structure. However, the suggestion to combine the '383 reference and the '183 reference cannot come from the '135 patent application which was the subject of examination at the time, it must come from the prior art references themselves.

Third party requestor further argued the lack of response to the "teaches away" argument of applicant in response to the original 103 rejection during the prosecution of the '135 patent. However, this argument does not present the old art in a new light, or in a different way, as compared with its use in the earlier concluded examination, because third party requestor's argument is an argument that reasonably would have been considered in the earlier examination.

For the reasons above, the finality of the action mailed September 22, 2005 was proper and the petition is **DENIED**.

This decision is final and nonappealable. 37 CFR 1.927. No further communication of this matter will be acknowledged or considered.

Robert J. Oberleitner
Director
Patent Technology Center 3600

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.
95/000,102	07/28/2005	6341218	070255.0679	6200

7590 04/23/2009

Sheridan Ross PC
1560 Broadway Suite 1200
Denver, CO 80202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Bruce W. Slayden, II
BAKER BOTTS LLP
1500 SAN JACINTO CENTER 98 SAN JACINTO BOULEVARD
Austin, TX 78701-4078

Date:
MAILED
APR 23 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000102
PATENT NO. : 6341218
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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Bradley M. Knepper Sheridan Ross PC 1560 Broadway Suite 1200 Denver CO 80202	:	(For Patent Owner)
Bruce W Slayden II BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039	:	(For Third Party Requester)
In re: Poplawsky *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/000,102 Deposited on: 28 July 2005 For: US Patent No. 6,341,218	:	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956 and § 1.181]

MAILED

APR 23 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 17 April 2009, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Action Closing Prosecution mailed 20 March 2009, be extended by two (2) months. The petition was timely filed.

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

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

Statement of Relevant Facts

1. On 22 January 2002 US patent No. 6,341,218 was granted to Poplawsky *et alia.*

2. On 28 July 2005 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 14 September 2005 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 20 March 2009 an Action Closing Prosecution was mailed.

5. On 17 April 2009 the instant petition for a two (2) months extension of time was submitted by the patent owner's representative.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the Action Closing Prosecution mailed 20 March 2009, which set a one (1) month date for filing a response thereto. The petition for extension of time was timely filed on 17 April 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Action Closing Prosecution was mailed 20 March 2009. The patent owner submitted a timely filed the petition on 17 April 2009 with the appropriate fee and certificate of service.

The petition dated 17 April 2009 cites the substantial amount of material to be analyzed and for which to respond by the patent counsel within a short amount of time. Additionally the counsel for the patent owner notes that one of the primary inventors is unavailable for a

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

The petition request to extend the response time by two (2) months is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the Action Closing Prosecution dated 20 March 2009 is hereby **granted-in-part**

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

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

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/
for

Gregory Morse,
Director,
Central Reexamination Unit

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UNITED STATES PATENT AND TRADEMARK OFFICE
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DIW Oct-09

(For Patent Owner)

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

COPY MAILED

OCT 30 2009

OFFICE OF PETITIONS

F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY NY 11797

(For Requester)

In re Chung L. Chang	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No. 95/000,103	:	
Request Deposited: 08/01/2005	:	
Attorney Docket Number:	:	
JHNSF.014RX	:	

This is a decision on the third party requester petition filed on October 22, 2009, under 37 CFR 1.137(a),[1] to excuse to the delay in filing a response in the above-identified reexamination proceeding, which, in view of petitioner's assertion that the Board Decision of June 25, 2009 was not received, is also treated as a petition under 37 CFR 1.181.

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

The petition is **dismissed**.

---

[1] A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

BACKGROUND

1. On September 29, 2005, a request for *Inter Partes* reexamination of U.S. Patent No. 6,871,356 was deposited.

2. On June 25, 2009, a Decision of the Board of Patent Appeals and Interferences (Board Decision) was mailed, affirming the examiner and setting a one (1) month period for reply.

3. On September 29, 2009, a Notice of Intent to Issue *Inter Partes* Reexamination Certificate was mailed.

4. On October 20, 2009, the subject petition was filed. Petitioner, third party requester Audiovox Corporation, via its attorney, F. Chau & Associates, LLC, states that it was unavoidably delayed in filing a response to the Board Decision mailed on June 25, 2009, and requests that the Office excuse the delay in filing a Request for Rehearing Pursuant to 37 CFR 41.79.

5. Specifically, petitioner avers that the Board Decision mailed on June 25, 2009 was never received. In support, petitioner has provided a statement by petitioner's registered patent practitioner, Frank Chau, attesting that a search of the file jacket and docket records indicates that the June 25, 2009 Decision on Appeal was not received. In support, a copy of the docket record where the non-received June 25, 2009 Decision on Appeal would have been entered had it been received and docketed has been filed as an exhibit to the petition.

DECISION ON PETITIONS UNDER 37 CFR 1.137(a) AND 1.181

PETITION UNDER 37 CFR 1.137(a)

35 U.S.C. § 133 states that 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.

37 CFR 1.137(a) states that if the delay in reply by applicant or **patent owner** was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a

reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent.

37 CFR 1.550(e)(1) states that if a response by the **patent owner** is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a).

(emphasis added)

The third party requester petition must be dismissed. 37 CFR 1.137(a) and 1.550(e) stipulate that the **patent owner** may obtain relief under 37 CFR 1.137(a). Petitioner, however, is not the patent owner, but rather a third party requester. Accordingly, petitioner Audiovox is precluded from obtaining relief under 37 CFR 1.137(a) and 1.550(e) insomuch as they permit the Office to excuse a delay in filing a timely response to an Office communication.

In addition, no statutory basis is provided, in the *Inter Partes* reexamination statute or elsewhere in the patent statute, for a third party requester to file a petition under 37 CFR 1.137 based on either unavoidable or unintentional delay.

The petition under 37 CFR 1.137(a) is therefore **dismissed**.

PETITION UNDER 37 CFR 1.181

Nonetheless, the petition is taken as a petition under 37 CFR 1.181, asserting that the Board Decision mailed on June 25, 2009, was never received. Petitioner requests, in essence, that the delay in responding to the Board Decision be excused.

A review of the record indicates no irregularity in the mailing of the Board Decision mailed on June 25, 2009, and in the absence of any irregularity in the mailing, there is a strong presumption that the Board Decision mailed on June 25, 2009 was properly mailed to the address of record. This presumption may be overcome by a showing that the Board Decision mailed on June 25, 2009 was not in fact received.

MPEP 711.03(c) states, in pertinent part:

> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice

of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a [two] month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date [two] months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the

> **practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.**
>
> (emphasis added)

Petitioner has not provided a copy of the master docket report for the firm. As the Board Decision set a one (1)-month period for reply, a copy of the master docket report showing all replies docketed for a date one (1)-month from the mail date of the nonreceived Board Decision must be submitted as documentary proof of nonreceipt of the Board Decision. If no such master docket exists, practitioner should so state.

Accordingly, the petition, as taken under 37 CFR 1.181, must be dismissed. However, such dismissal is without prejudice to reconsideration pending submission of the information requested above (*i.e.*, a master docket report) with any renewed petition.

CONCLUSION

1. The petition is **dismissed**.

2. Petitioner is given TWO (2) MONTHS to respond to this decision. **This time period is NOT extendable**.[2]

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
ATTN: Douglas I. Wood
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

[2] 37 CFR 1.181(f).

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

A reply may also be filed via the EFS-Web system.

4. Lastly, it is noted that petitioner submitted $130.00 with the subject petition. The fee for a petition under 37 CFR 1.137(a) is $540.00 rather than $130.00. Accordingly, the balance of $410.00 will be charged to counsel's deposit account, as authorized in the subject petition.

5. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

6. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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UNITED STATES 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.
95/000,104	08/12/2005	6612713	45639-316477	5847

38441 7590 03/01/2010

LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/01/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROBERT E. RICHARDS
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET, SUITE 2800
ATLANTA, GA 30309

Date:

MAILED

MAR 0 1 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000104
PATENT NO. : 6612713
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

LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON TX 76028

(For Patent Owner)

Robert E. Richards
KILPATRICK STOCKTON, LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,104
Filed: August 12, 2005
For: US Patent No. 6,612,713

DECISION DISMISSING PETITION

This is a decision on the third party requester petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES WITH RESPECT TO THE 50-PAGE LIMIT FOR REQUESTER'S COMMENTS," filed on November 16, 2009.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to third party requester's Deposit Account No. 11-0855, as authorized on page 4 of the petition.

The petition under 37 CFR 1.183 is dismissed as to the September 14, 2009 third party requester comments under 37 CFR 1.947, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,612,713 (the '713 patent) issued on September 2, 2003.

2. On August 12, 2005, a request for *inter partes* reexamination of the '713 patent was filed by a third party requester, and assigned Reexamination Control No. 95/000,104 (the '104 proceeding).

3. On September 28, 2005, the Office issued an order granting *inter partes* reexamination in the '104 proceeding with an accompanying first Office action on the merits.

4. On November 21, 2005, patent owner filed a response to the first Office action on the merits.

5. On December 5, 2005, the Office issued a notice of defective paper indicating that patent owner's November 21, 2005 response was improper and setting a time period for resubmission.

6. On December 19, 2005, patent owner submitted a corrected response to the first Office action, addressing the issues raised by the Office in the December 5, 2005 notice of defective paper.

7. On December 21, 2005, the requester submitted a comments paper in response to patent owner's November 21, 2005 response and the first Office action.

8. On January 13, 2006, the requester submitted a new comments paper in response to patent owner's December 19, 2005 corrected response and the first Office action.

9. On December 5, 2006, the Office issued a non-final Office action.

10. On February 7, 2007, patent owner filed a paper in response to the December 5, 2006 non-final Office action.

11. On March 9, 2007, the requester submitted a comments paper in response to patent owner's February 7, 2007 response paper and the December 5, 2006 non-final Office action.

12. On July 25, 2008, the Office issued a notice of defective paper indicating that patent owner's February 7, 2007 response paper was improper and setting a time period for resubmission.

13. On August 25, 2008, patent owner submitted a corrected paper in response to the December 5, 2006 non-final Office action, addressing the issues raised by the Office in the July 25, 2008 notice of defective paper.

14. On March 20, 2009, the Office issued a notice of defective paper indicating that patent owner's August 25, 2008 response paper was improper and setting a time period for resubmission.

15. On April 21, 2009, patent owner submitted a second corrected paper in response to the December 5, 2006 non-final Office action, addressing the issues raised by the Office in the March 20, 2009 notice of defective paper.

16. On May 18, 2009, the requester submitted a comments paper in response to patent owner's April 21, 2009 response paper and the December 5, 2006 non-final Office action.

17. On August 28, 2009, the Office issued a notice of defective paper indicating that requester's May 18, 2009 comments paper was improper due to the addition of new proposed grounds of rejection and setting a time period for resubmission.

18. On September 14, 2009, requester submitted a corrected comments paper in response to patent owner's April 21, 2009 response paper and the December 5, 2006 non-final Office action, addressing the issues raised by the Office in the August 28, 2009 notice of defective paper.

19. On October 22, 2009, the Office issued a decision *sua sponte* "returning" requester's September 14, 2009 papers. The decision noted that requester did not remove the inappropriately added new grounds of rejection. Furthermore, the September 14, 2009 requester response was found facially non-compliant with the 50-page regulatory page limit requirement set for by 37 CFR 1.943(b).

20. On November 16, 2009, requester filed the instant petition paper in the '104 proceeding entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES WITH RESPECT TO THE 50-PAGE LIMIT FOR REQUESTER'S COMMENTS."

21. Also on November 16, 2009, requester filed four additional petitions all under 37 CFR 1.181 requesting supervisory review.

22. On December 18, 2009, the Office issued an Action Closing Prosecution (ACP) in the '104 proceeding.

23. This decision addresses the requester petition under 37 CFR 1.183 requesting waiver of the page limit requirement for third party requester comments in an *inter partes* reexamination proceeding.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.947 provides:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

Discussion

On September 14, 2009, third party requester filed corrected comments under 37 CFR 1.947 responsive to the December 5, 2006 Office action and to the patent owner's April 21, 2009 response. The Office expunged the September 14, 2009 corrected comments as improper on October 22, 2009 in a *sua sponte* decision expunging ("returning") the improper papers. In response to the October 22, 2009 Office decision, third party requester petitions the Office under 37 CFR 1.183 to suspend the 50-page limit for period of 37 CFR 1.943(b) to accept as compliant requester's revised comments submitted on September 14, 2009.

In support of waiver of the rule, third party requester asserts that the comments are in substantial compliance with the 50-page limit requirement of 37 CFR 1.943(b). Requester points out that the comments only facially exceed the 50-page limit by 5 pages and that this *de minimus* overage is due to the use of margins and font size that exceeds the standards of 37 CFR 1.52. Furthermore, requester notes that the comments incorporated several prior art drawings that are of record, which could have been cited to instead of duplicated in the comments, but where included for the convenience of examination.

Third party requester did not make a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and providing an explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record and submitting the resulting comments, which are in excess of 50 pages. By third party requester's own admission, the comments could have been submitted in compliance with the 50-page limit regulatory requirement. However, third party requester asserts "In the interest of justice, suspension of the 50-page limit for the Replacement Comments Of Third Party Requester to Patent Owner's Response In *Inter Partes* Reexamination And To Office Action, which was filed September 14, 2009, and entry of the comments are respectfully requested."

Based on the specific facts set forth in the instant petition under 37 CFR 1.183, third party requester's own admission that comments in compliance with the 50-page limit of 37 CFR 1.943(b) could have been readily drafted and submitted, it is deemed inequitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Waiver of the rules under 37 CFR 1.183 requires an ***extraordinary situation when justice requires*** waiver, because the relief requested cannot be attained under the existing rules. Third party requester's petition states that, by using any one of three different minor formatting choices, compliance with the rules could be readily achieved. Requester does not point to any facts and circumstances unique to the present proceeding that precluded requester from compliance with the 50-page limit regulatory requirement. The failure of patent owner to comply with the rules, in the form of submitting non-compliant comments by choice, does not present an ***extraordinary situation*** under 37 CFR 1.183 to justify suspension of the rules. Therefore, justice does not require suspension of 37 CFR 1.943(b). Accordingly, the present petition is DISMISSED.

CONCLUSION

1. Third party requester's November 16, 2009 petition under 37 CFR 1.183 is dismissed.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

Kenpet7/IP/length

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,104	08/12/2005	6612713	45639-316477	5847

38441 7590 03/01/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/01/2010

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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ATLANTA, GA 30309

Date:

MAILED

MAR 0 1 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000104
PATENT NO. : 6612713
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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MAR 01 2010

CENTRAL REEXAMINATION UNIT

LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028	:	(For Patent Owner)
ROBERT E. RICHARDS KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET, SUITE 2800 ATLANTA, GA 30309	:	(For Third Party Requester)
In re: Kuelbs *Inter Partes* Reexamination Proceeding Control No.: 95/000,104 Deposited: 12 August 2005 For: U.S. Patent No.: 6,612,713	:	DECISION ON PETITIONS UNDER 37 CFR § 1.181

This is a decision on four[1] petitions filed by the third party requester on 16 November 2009. The petitions are entitled:

(1) "PETITION UNDER 37 CFR § 1.181 TO ENTER THE THIRD-PARTY REQUESTER'S REPLACEMENT COMMENTS ON THE BASIS OF THE EXAMINER'S NONCOMPLIANCE WITH MPEP § 2617" [hereinafter "Petition (1)"];

(2) "PETITION UNDER 37 CFR § 1.181 TO ENTER THIRD PARTY REQUESTER'S REPLACEMENT COMMENTS FOR FAILURE OF THE EXAMINER TO COMPLY WITH MPEP § 2667" [hereinafter "Petition (2)"];

(3) "PETITION UNDER 37 CFR § 1.181 TO ENTER THIRD PARTY REQUESTER'S REPLACEMENT COMMENTS BECAUSE THE FIFTY-PAGE LIMIT HAS BEEN PROPERLY MET" [hereinafter "Petition (3)"]; and

[1] A fifth petition was filed on the same date, entitled "PETITION UNDER 37 CFR § 1.183 TO SUSPEND THE RULES WITH RESPECT TO THE 50-PAGE LIMIT FOR REQUESTER'S COMMENTS." This petition will be decided separately.

(4) "PETITION UNDER 37 CFR § 1.181 TO FIND THE THIRD PARTY REQUESTER'S REPLACEMENT COMMENTS IN COMPLIANCE WITH 37 CFR 1.948" [hereinafter "Petition (4)"].

The petitions are a request to the Director to invoke his supervisory authority pursuant to 37 CFR 1.181 and enter the "REPLACEMENT COMMENTS OF THIRD PARTY REQUESTER TO PATENT OWNER'S RESPONSE IN *INTER PARTES* REEXAMINATION AND TO OFFICE ACTION" [hereinafter "the Replacement Comments"] submitted on 14 September 2009. The Replacement Comments were filed in response to a Notice re: Defective Paper to replace the "COMMENTS OF THIRD PARTY REQUESTER TO PATENT OWNER'S RESPONSE IN *INTER PARTES* REEXAMINATION AND TO OFFICE ACTION" [hereinafter "the Original Comments"] submitted on 18 May 2009.

The petitions are before the Director of the Central Reexamination Unit.

The four petitions under 37 CFR 1.181 to invoke the supervisory authority of the Director dated 16 November 2009 are denied with respect to entry of the Replacement Comments filed on 14 September 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,612,713 issued on 2 September 2003.

2. A request for *inter partes* reexamination proceeding, assigned control No. 95/000,104 was filed by a third party requester on 12 August 2005.

3. *Inter partes* reexamination was ordered for the proceeding on 28 September 2005 with a non-final Office action attached.

4. On 5 December 2006, a second non-final Office action was mailed.

5. After two improper proposed amendments and respective Notices re: Defective Paper, patent owner submitted a response on 21 April 2009.

6. On 18 May 2009, the third party submitted the Original Comments to the above response.

7. On 28 August 2009, the examiner issued a Notice re: Defective paper as to the Original Comments.

8. On 14 September 2009, the third party submitted the Replacement Comments at issue here.

9. On 22 October 2009, the Office issued a decision expunging the Replacement Comments from the record.

10. On 16 November 2009, the instant petitions were submitted for consideration.

11. On 18 December 2009, the examiner issued an Action Closing Prosecution. The Replacement Comments, being expunged from the record, were not considered.

12. On 18 January 2010, Patent owner responded to the Action Closing Prosecution.

DECISION

Petition (1)

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

. . .

II. Content

. . .

[W]here a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.<

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior

art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper**>; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester.

. . .

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

MPEP § 2617 Statement in the Request Applying Prior Art (in part)

35 U.S.C. 311(b)(2) states that the request for *inter partes* reexamination must "set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested." 37 CFR 1.915(b)(3) requires that the request 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."

. . .

Any failure to provide the required explanation for any document, combination, or claim will be identified in a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements" (see MPEP § 2627). If a requester receives such a notice that identifies one or more documents, combinations, or claims for which an explanation was not given, the requester has the option to respond by either:

(A) providing a separate explanation for each combination, document, and claim identified in the notice as lacking explanation; or

(B) explicitly withdrawing any document, combination, or claim for which reexamination was requested for which there is no explanation.

Petitioner argues that MPEP § 2617 allows petitioner to provide a separate explanation to cure the defective submission, therefore the examiner failed to comply with section 2617 in requiring the petitioner to remove the improper rejections, rather than allowing for such separate explanation.

The record shows that the Office did allow the petitioner to "rectify and refile" in the notice of defective paper dated 28 August 2009. Petitioner, however, did not fully comply with the requirement to set forth "a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim" in the Replacement Comments.

Examples of proposed rejections which do not fully comply with the requirements of MPEP § 2617 and 35 USC § 311(b)(2) are found in the Replacement Comments pages 52 through 54. The proposed rejections for claims 64, 65, 66, 70, 71 and 72 lack the detailed explanation for each of the distinct permutations of proposed rejections. Specifically, the petitioner proposed rejections of claim 64 under 35 USC § 103 over Mueller or Valdner and Phyle or Rushing and alternatively further in view of Hung. This statement identifies multiple distinct proposed rejections for which a separate explanation must be provided for each proposed rejection. In other words, there must be a separate detailed explanation for each of the following identified proposed rejections:

- Claim 64 is unpatentable based on § 103 over Mueller and Phyle
- Claim 64 is unpatentable based on § 103 over Mueller and Rushing
- Claim 64 is unpatentable based on § 103 over Mueller and Phyle further in view of Hung
- Claim 64 is unpatentable based on § 103 over Mueller and Rushing further in view of Hung
- Claim 64 is unpatentable based on § 103 over Valdner and Phyle
- Claim 64 is unpatentable based on § 103 over Valdner and Rushing
- Claim 64 is unpatentable based on § 103 over Valdner and Phyle further in view of Hung
- Claim 64 is unpatentable based on § 103 over Valdner and Rushing further in view of Hung

The brief discussion on page 52 of the Replacement Comments lacks the required pertinency and manner of applying the cited prior art for each and every proposed rejection because it fails to provide a separate explanation for each proposed rejection. Accordingly, the Replacement Comments did not fully comply with the requirements and was properly not entered in the record in accordance with MPEP 2666.05.

In addition, the Replacement Comments exceeded the 50 page limit of 37 CFR 1.943. For this reason, the paper was properly expunged in the decision dated October 22, 2009. .

The petition is <u>denied</u> for the above reasons.

Petition (2)

37 CFR § 1.947 Comments by third party requester to patent owner's response in *inter partes* reexamination. (in part)

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

. . .

II. Content

. . .

If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper**>; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15)< days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party >requester< with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. >To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

MPEP § 2667 Handling of Inappropriate or Untimely Filed Papers (in part)

. . .

2. Response Is Too Long

Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

Petitioner argues that, because the objection to the Replacement Comments as exceeding the 50-page limit was raised for the first time in the October 22, 2009 decision, the petitioner should have been afforded an opportunity to correct the defect under MPEP § 2667. Petitioner further argues that, while MPEP § 2666.05 provides only a single opportunity to correct a defect, nothing in the rules or MPEP indicates section 2666.05 "trumps" section 2667. Petitioner further argues that nothing in the original notice of defect informed the petitioner that resubmitted comments could not exceed 50 pages, and to impose such a limit denies the petitioner due process.

Upon review of the record, the Replacement Comments exceeded the 50-page limit requirement of 37 CFR 1.943. The Original Comments did not exceed the page limit, and therefore, the 28 August 2009 notice did not state that the comments failed to comply with this requirement. The 28 August 2009 notice clearly stated the Office policy in MPEP 2666.06 that the requester is only given one opportunity to fully comply with all the requirements. 37 CFR 1.947 explicitly allows only for one filing of written comments after a patent owner's response. As stated in MPEP § 2666.05, to the extent that the examiner allows an additional opportunity to correct a defective reply, this is a waiver of this rule. Section 2666.05 goes on to state that, to further the statutory requirement of special dispatch, the rule will not be waived more than once. In other words, Office policy, as stated in MPEP § 2666.05, is balancing the need to provide a recourse to rectify unintentional error(s) in the comments with the statutory requirement of special dispatch by permitting a single waiver of this rule. The due process argument is wholly unpersuasive for these reasons. Thus, it is not really a case of section 2666.05 "trumping" section 2667. It is a case of the petitioner failing to comply with the rules, the Office waiving 37 CFR 1.947 to allow correction of errors, petitioner failing to comply again, and the Office following its established policy that 37 CFR 1.947 will not be waived again.

It should be noted that the need for special dispatch is especially relevant here. The examiner has already issued an ACP in this proceeding after the improper comments, and the Patent Owner has already responded to this action. Entry of the Replacement Comments would require withdrawal of the ACP and subsequent Owner comments, and thus, further delaying the proceeding. This proceeding has already been pending for over four years; and in light of the statutory mandate for special dispatch, it is proper for the Office to prevent further delay by following its rules and procedures, which were established through notice and comment in order to achieve special dispatch in a reasonable manner.

For all these reasons, this petition is <u>denied</u>.

Petition (3)

37 CFR § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination. (in part)

> (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 materials such as prior art references.

The Replacement Comments were 55 pages in length, therefore clearly exceeding the page limit required by the rules. Petitioner argues that portions of the Replacement Comments were excerpts of prior art references, therefore these portions fall within the exclusion of the rule and are not subject to the page limit. When these portions are excluded from the page limit requirement the Replacement Comments do not exceed 50 pages, therefore petitioner argues the Replacement Comments are proper under Rule 1.943(b).

It is clear that the exception to the rule, excluding "reference materials such as prior art references" from the page limit, concerns the filing of the references themselves. An excerpt that is included in the text of the comments is not a "reference material;" it is a part of the comments. By placing these excerpts in the portion of the paper drawn to petitioner's arguments, petitioner made these excerpts part of the argument, and thus, subject to the page limit. It is true that petitioner "could have appended these drawings as exhibits," but this is not what petitioner did. Therefore, the excerpts are subject to the page limit requirement. Accordingly, the petition is denied.

Petition (4)

37 CFR § 1.948 Limitations on submissions of prior art by third party requester following the order for *inter partes* reexamination.

> (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
> (1) which is necessary to rebut a finding of fact by the examiner;
> (2) which is necessary to rebut a response of the patent owner; or
> (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

. . .

II. Content

. . .

As to [Rule 1.948(a)(1)-(3)] where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.<.

Petitioner argues that both the Original Comments and the Replacement Comments included new prior art filed under 37 CFR 1.948(a)(2). The original notice of defective paper mailed August 28, 2009 did not state that the Original Comments failed to comply with Rule 1.948. The Decision mailed October 22, 2009, expunging the Replacement Comments, stated the Replacement Comments did not comply with Rule 1.948. Petitioner argues that since the Original Comments included new prior art, and the original notice did not object to the new art under Rule 1.948, then it is improper for the Decision to object to the Replacement Comments under this ground.

Upon review of the record, it is appropriate for the Decision to object to the filing of the Replacement Comments under 37 CFR 1.948. The original notice mailed August 28, 2009 cited to MPEP § 2666.05, which is clearly discussing the requirements of a submission under 37 CFR 1.948. Therefore it is clear that, while she may not have explicitly said so, the examiner found the Original Comments noncompliant with 37 CFR 1.948. It is permissible for the 22 October 2009 Decision to explicitly state what was already implied—that the Replacement Comments were not compliant with Rule 1.948.

More importantly, as described above in discussing Petition (1), petitioner did not fully correct all of the defects in the original comments. As the Replacement Comments did not comply with all of the requirements, these comments were not entered in the record but "returned" to the requester, in accordance with the policy set forth in MPEP § 2666.05.

For these reasons, the petition arguing the Replacement Comments are compliant with Rule 1.948 is <u>denied</u>.

CONCLUSION

1. The petitions under 37 CFR 1.181 for reconsideration of the decision to not enter of the Replacement Comments are denied.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Sohma et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,105
Filed: August 17, 2005
For: U.S. Patent No. 6,387,499

DECISION DISMISSING PETITION

This is a decision on the "PETITION UNDER 37 C.F.R. 1.181" filed on October 29, 2008.

The petition and *inter partes* reexamination control number 95/000,105, are before the Director of the Central Reexamination Unit for decision.

FACTS

1. U.S. Patent No. 6,387,499 ("the '499 patent") issued to Daisuke Sohma *et al* on May 14, 2002, and is currently assigned to Senju Metal Industry Co, Ltd. ("Senju").

2. On August 17, 2005, a request for reexamination of all of the claims of the '499 patent (claims 1-9) was filed by a third party requester ("requester"). The request was assigned control number 95/000,105 ("the '105 reexamination proceeding") and was accorded a filing date of August 17, 2005.

3. On October 10, 2008, an order granting *inter partes* reexamination for claims 1-9 of the '499 patent was mailed on October 18, 2005.

4. Prosecution of the '105 reexamination proceeding then progressed to the stage that an Action Closing Prosecution (ACP) was mailed on August 7, 2006. Patent owner filed a response to the ACP on October 10, 2006 that included a claim amendment.

5. On November 6, 2006, requester filed written comments directed to the October 10, 2006 patent owner response.

6. On November 15, 2007, a second Action Closing Prosecution ("second ACP") was mailed for the purpose of providing a period of time for patent owner to correct a formal defect in the October 10, 2006 patent owner response.

7. On December 17, 2007, patent owner filed a response to the second ACP, including material addressing the formal defect in the October 10, 2006 patent owner response to the second ACP, and also proposing to add new claim 10.

9. On January 10, 2008, requester filed written comments directed to the December 17, 2007 patent owner response.

10. On March 28, 2008, the Office mailed a Notice of Defective Paper, refusing to enter the December 17, 2007 patent owner response to the second ACP, pointing out that although the second ACP had provisionally accepted the October 6, 2006 patent owner response for examination purposes and had given patent owner one month to correct certain defects in that paper, the December 17, 2007 patent owner response added new claim 10 that had not been part of the October 10, 2006 patent owner response. Patent owner was provided with a time period to correct this matter.

11. On April 28, 2008, patent owner filed papers addressing the March 28, 2008 Notice of Defective Paper.

12. On May 22, 2008, patent owner filed additional papers again introducing new claim 10.

13. On September 19, 2008, the Office returned the May 22, 2008 patent owner papers as being an improper second submission of comments after an ACP.

14. On September 29, 2008, the Office mailed a Right of Appeal Notice (RAN).

15. On October 29, 2008, patent owner filed a Notice of Appeal.

16. Also on October 29, 2008, patent owner filed the petition for supervisory review that is the subject of this decision. The petition seeks review of the refusal to enter proposed claim 10 together with claim amendments that again present claim 10 and a declaration with comparative data.

17. In addition, a petition to waive the provisions of 37 CFR 41.66(a) that preclude extending the time for filing an appellant's brief after the filing of a Notice of Appeal, and a petition for extension of time to file appellant's brief were filed on October 29, 2008 and a separate decision on those petitions is being prepared.

18. On November 11, 2008, requester filed its Notice of Appeal.

19. On November 26, 2008 requester filed written comments directed to the October 29, 2008 patent owner claim amendments and declaration.

RELEVANT AUTHORITY

37 CFR 1.116 states:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an ... action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save the ... reexamination prosecution from termination under ... § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after ... an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after ... an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

37 CFR 1.181 states:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in ... *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; ...

(3) To invoke the supervisory authority of the Director in appropriate circumstances. ...

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in ...inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner. ...

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 1.951 states:

(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.

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

37 CFR 1.953(c) states:

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.

MPEP § 2672, subsections (II) and (III) state, in part:

II. ... The examiner and all other parties to the reexamination should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent and that the patent owner does not have the right to 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 request (see MPEP § 2612). Accordingly, the examiner and other parties should identify and develop all issues prior to the ACP, including the presentation of evidence under 37 CFR 1.131 and 1.132.

III. Once an ACP that is not premature has been entered in a reexamination proceeding, the patent owner no longer has a right to unrestricted further prosecution. Consideration of the proposed amendments submitted after ACP (pursuant to 37 CFR 1.951(a)) will be governed by the strict standards of 37 CFR 1.116. ...

DECISION

The record shows that non-final Office actions were mailed in this proceeding on October 18, 2005 and February 13, 2006. Despite the rejection of all patent claims in the October 18, 2005 Office action, patent owner did not elect to file any claim amendments in response to the Office action. Patent owner did file claim amendments in response to the February 13, 2006 Office action, but did not elect to propose new claim 10 or to proffer any objective evidence in the form of a 37 CFR 1.132 verified showing at that time. After receiving the August 7, 2006 ACP, patent owner again proposed claim amendments, but did not propose new claim 10 or submit a 37 CFR 1.132 showing. Only after receiving the November 15, 2007 second ACP did patent owner propose new claim 10. However claim 10 was refused entry because it was improperly submitted to correct informalities in a paper submitted that did not originally include proposed claim 10. Claim 10 was submitted again as part of a supplemental amendment, but the rules provide for only one submission after the mailing of an ACP. Claim 10 was again submitted with the present petition, after a RAN had been mailed by the Office on September 29, 2008. Only upon filing the present petition did patent owner submit a 37 CFR 1.132 verified showing in support of patentability. This submission was also subsequent to the mailing of the RAN.

Patent owner did not file a request for supervisory authority to reverse the refusal on March 28, 2008 to enter claim 10, or to reverse the September 19, 2008 refusal to enter claim 10. Patent owner now requests entry of proposed new claim 10 and the 37 CFR 1.132 verified showing as these documents accompany the filing of the present petition. The basis for the request for entry of these documents is that patent owner cannot continue these proceedings by re-filing an application or by a request for continued examination. However, patent owner does not state that such considerations only recently became known to patent owner. The fact that there is no continuing "application" practice in *inter partes* reexamination is clearly set forth in Section 2672(II) of the Manual of Patent Examining Procedure. Section 2672(III) also sets forth that the test for entry of claim amendments and other evidence after an ACP is not whether prosecution can or cannot be continued in *inter partes* reexamination, but rather, whether the proposed submission filed after an ACP complies with the provisions of 37 CFR 1.116.

However, the present petition does not explain how the original filings proposed claim 10 satisfied the provisions of 37 CFR 1.116(b), or 37 CFR 1.951(a). The present petition also does not explain how the October 29, 2008 filing of proposed claim 10 satisfies the provisions of 37 CFR 1.116(d)(1). The present petition also does not explain how the presentation of the 37 CFR 1.132 verified statement can be, or should be, admitted in light of the provisions of 37 CFR 1.116(f). 37 CFR 1.116(d)(1) precludes the filing of an amendments and in an *inter partes* reexamination proceeding after mailing of a RAN, with limited exceptions not applicable here. 37 CFR 1.116(f) similarly precludes the filing an affidavit evidence in an *inter partes* reexamination after the mailing of a RAN, again with limited exceptions not applicable here. A RAN was mailed in the '105 reexamination proceeding on September 29, 2008, prior to the re-submission on October 29, 2008 of claim 10 and prior to the concurrent submission of the 37 CFR 1.132 verified statement of Daisuke Sohma. It would appear that petitioner patent owner would not only need to explain why amendment proposing claim 10 and the submission of the Dohma verified statement are proper, but would also have to file a grantable 37 CFR 1.1183 petition demonstrating why the provisions of 37 CFR 1.116(d)(1) and (f) should be waived to permit entry of these items after the mailing of a RAN.

The present petition is not grantable because it does not establish compliance with 37 CFR 1.116(b) or with 37 CFR 1.951(a) for the first two filings of amended claim 10, or provide any

basis for finding that the October 29, 2008 filing of amended claim 10 complies with 37 CFR 1.116(d)(1). The present petition also does not establish that the October 29, 2008 filing of the 37 CFR 1.32 verified statement complies with the provisions of 37 CFR 1.116(f), and is not grantable on that basis as well. Further, as to 37 CFR 1.116(d)(1) and 37 CFR 1.116(f), waiver of those rules would be a necessary predicate to permitting entry of claim 10 and the Dohma verified statement at this point in the proceeding. The present petition is also not grantable because no such waiver has been requested, and no reasons that could support such a waiver have been presented.

ADDITIONAL DISCUSSION

As it has not been established that claim 10 and the Sohma verified statement filed on October 29, 2008 enjoy an entry right in the '105 *inter partes* reexamination proceeding, these papers will be provisionally sealed until patent owner establishes an entry right for these papers. If patent owner does not establish an entry right for these papers, they will be permanently sealed. Sealing of papers in an electronic Image File Wrapper (IFW) is accomplished by marking these documents "closed" and "non-public," such that the documents will form no part of the official electronic (IFW) and will not be available to the public.

As the October 29, 2008 patent owner documents are being provisionally sealed, the November 26, 2008 third party requester written comments directed to those documents will also be provisionally sealed until an entry right is established for both sets of documents. These requester papers will be permanently sealed if no entry right is established for them. The documents will be sealed by marking these documents "closed' and "non-public," such that the documents will form no part of the official electronic IFW, and will not be available to the public.

CONCLUSION

1. The October 29, 2008 patent owner petition under 37 CFR 1.181 to invoke supervisory authority to enter the October 29, 2008 amendment proposing to add claim 10, and to enter the October 29, 2008 37 CFR 1.132 verified statement is dismissed.

2. The October 29, 2008 patent owner petition amendment proposing claim 10 and presenting the 37 CFR 1.132 verified statement are provisionally sealed, pending a showing that they are entitled to entry or a finding that they should be permanently sealed.

3. The October 29, 2008 patent owner petition amendment proposing claim 10 and presenting the 37 CFR 1.132 verified statement are provisionally sealed, pending a showing that they are entitled to entry or a finding that they should be permanently sealed.

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, Art Unit 3991, at (571) 272-1535, or to Andres Kashnikow at (571) 272-4361.

Gregory A. Morse
Director, Central Reexamination Unit

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JUN 27 2007

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Haberman
Reexamination Proceeding
Control No. 95/000,106
Filed: August 22, 2005
For: U.S. Patent No. 6,857,712

: DECISION ON
: PETITION
: (37 CFR 1.927)

The paper filed by requester on December 16, 2005, styled as "Petition Under 37 CFR §§ 1.927 and 1.181 to Review the Order Denying Request for *Inter Partes* Reexamination," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the examiner's finding, in the November 16, 2005 Order denying the request for reexamination, that a substantial new question of patentability has not been raised as to claims 1-15 of U.S. Patent No. 6,857,712 (hereinafter, the '712 patent). Specifically, petitioner requests that the CRU Director to find that a substantial new question of patentability (SNQ) exists for claims 1-15 of the '712 patent, and to order examination of claims 1-15.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,857,712 (hereinafter, the '712 patent) issued on February 22, 2005 from an application, filed on April 4, 2003.

2. On April 21, 2005, the patent owner, Forecast Consoles, filed a request for *ex parte* reexamination of claims 1-15 of the '712 patent, and the resulting reexamination proceeding was assigned Control No. 90/007,516 (hereinafter, the '7516 proceeding).

3. An order granting the '7516 request for reexamination of claims 1-15 was issued on July 6, 2005.

4. On August 22, 2005, the third party requester, Keith D. Nowak, filed a request for *inter partes* reexamination of claims 1-15 of the '712 patent, and the resulting reexamination proceeding was assigned Control No. 95/00,106 (hereinafter, the '106 proceeding). TBC Consoles, Inc. is identified as the real party in interest. The third party requester served the patent owner with the request on August 22, 2005.

5. An order denying the '106 request for reexamination of claims 1-15 was issued on November 16, 2005.

6. On December 16, 2005, the third party requester, Keith D. Nowak, filed the above-mentioned petition under 37 CFR §§ 1.927 and 1.181. The requester served the patent owner with the above-mentioned petition on December 16, 2005.

DECISION

I. Petitioner's Grounds in Support of the Requested Relief:

Petitioner advances the following several grounds in support of his position that the denial of the request for reexamination should be reversed by the Director:

1. In regards to the reexamination of claims 1, 6 and 7 based on U.S. Patent No. 4,836,625 to Catta (hereinafter "Catta") or the Series 200 Console System brochure from Evan (hereinafter "Evan"), petitioner advances that the fact that reexamination was ordered based on the same two references for the same claims in another proceeding does not prevent ordering reexamination in this proceeding because the substantial new question has "not yet been decided."
2. In regards to the reexamination of claims 2-5 and 8 based on Catta or Evans in view of U.S. Patent No. 5,921,052 to Kemp (hereinafter "Kemp"), the Engineering Drawing by SBFI (hereinafter the "SBFI Drawing"), or U.S. Patent No. 6,050,659 to LaCour (hereinafter "LaCour '659"), petitioner argues that the examiner's denial of reexamination, which based on the fact that the independent claim is not shown to have a

substantial new question of patentability and therefore, the dependent claims do not have a substantial new question of patentability, cannot be sustained.

3. The petitioner also states that the public policy underlying the establishment of *inter partes* reexamination supports that the request for reexamination should be granted.
4. The petitioner argues that reexamination should be granted since petitioner believes that they might be potentially barred from filing another request for reexamination.
5. In regards to the other grounds for the denial of reexamination, the petitioner states that he disagrees with the examiner. The petitioner only mentioned one particular ground regarding the explanation of the Engineering Drawing being insufficient, and alleges that the explanation given is sufficient.

Petitioner's arguments set forth in 1 and 3 above are addressed in section III. A. below. Petitioner's arguments set forth in 2, 4.and 5 above are addressed in section III. B. below.

II. Standard of Review

37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* 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 1-15 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 1-15 of the '712 patent.

III. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* 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 311(a) requires that a request for *inter partes* 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 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." Questions relating to grounds of rejection other than those based on prior art patents or printed publications should **not** be included in the request and will not be considered by the examiner if included. 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 *inter partes* 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.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

IV. Analysis of the Request for Reexamination

A. The request fails to raise a substantial new question of patentability regarding the Evan and Catta references that is different from the substantial new question of patentability raised in the '7516 proceeding.

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

As explained in the order denying reexamination, in accordance with MPEP 2640, if the subsequent request includes the art which raised a substantial new question in the earlier pending reexamination, then reexamination should be ordered only if the art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the art cited in the subsequent request raises the same substantial new question of patentability as that raised in the earlier pending reexamination, the subsequent request should be denied.

In this case, the request failed to raise a different substantial new question of patentability, because it does not provide new information about the Catta and Evan references (e.g., pre-existing technology). The '7516 ordered reexamination of claims 1-15 of the '712 patent based on the same references to Catta and Evans. Because reexamination is already ordered in another proceeding, the requester must provide a different substantial new question of patentability by, for example, providing a "new light" to references already considered in the other proceeding. As discussed in the section above, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. The request failed to clearly provide this information, and the examiner appropriately denied the request for reexamination on this ground. This is a request for *inter partes* reexamination, and requester would be expected to provide the specifics of a proposed ground of rejection in compliance with the 35 U.S.C. 311(b)(2) requirement that that the request "set forth the **pertinency and manner of applying** cited prior art to every claim for which reexamination is requested" [emphasis added]. The examiner would then either adopt, or not adopt, the proposed ground of rejection, and requester would have an appeal right as to the examiner's decision. Had requester set forth the specifics of one or more proposed grounds of rejection, by setting forth the pertinency and manner of applying cited prior art to the claims, it would appear that the requester could have relied upon the providing of a "new light" with respect to previously cited references, because the patent owner did not set forth the specifics of a rejection in its prior request for reexamination. **Requester chose not to do so**, and therefore failed to raise a different substantial new question of patentability. This could, however, be remedied by the filing of a new request for reexamination, as will be discussed below.

This is consistent with the legislative history as discussed above, and accordingly, petitioner's arguments concerning legislative history are not persuasive. As discussed above, petitioner can still avail themselves of the *inter partes* reexamination proceeding, if petitioner can formulate a request that brings forth some new technological information that was not consider in a previous examination. Accordingly, petitioner is not caught in the "catch 22" situation as it advanced in the petition.

B. The request fails to raise a substantial new question of patentability regarding the Evan and Catta references in view of the newly cited references (e.g., Kemp, SBFI Drawing, LaCour '659,

or the Engineering Drawing), and a substantial new question of patentability newly cited references (e.g., Kemp, SBFI Drawing, LaCour '659, or the Engineering Drawing).

The request stated the following proposed rejections, which were based on newly cited references:

1. Claims 2-5 of Haberman to be unpatentable over Catta in view of US Patent 5,921,052 to Kemp or the drawing labeled SBFI Drawing.
2. Claim 8 of Haberman to be unpatentable over Catta or Evan in view of US Patent 6,05,659 to LaCour (LaCour '659).
3. Claims 9-14 of Haberman to be unpatentable in view of Kemp or the SBFI Drawing.
4. Claim 15 of Haberman to be unpatentable over Kemp or the SBFI Drawing in view of LaCour '659.
5. Claims 1-15 of Haberman to be unpatentable in view of LaCour '659.
6. Claims 1 to 15 of Haberman to be unpatentable in view of one or more of the above discussed patents or publications and the document labeled as the Engineering Drawing.

As indicated in the order denying reexamination, there is nothing in the record to establish that the SBFI Drawing and the Engineering Drawing are publications. Only patents and printed publications will be considered in deciding a substantial new question of patentability in a reexam proceeding. See 35 U.S.C. 301. Accordingly, the SBFI Drawing and the Engineering Drawing cannot be used to establish a substantial new question of patentability.

In regard to the substantial new questions of patentability based upon Kemp and LaCour, the request fails to meet the requirements of 35 U.S.C. 311 and 37 CFR 1.915. Specifically, the request is not compliant with 37 CFR 1.915(b)(3), which requires "[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."

Under 35 U.S.C. 311, the requester must "set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested." Then, under 35 U.S.C. 312 and 313, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised by a request for reexamination. To implement these statutory provisions, 37 CFR 1.915(b)(3) requires that the request include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications...." See MPEP 2617. Accordingly, it is mandatory that the request clearly set forth in detail the specifics of what the third party requester considers the "substantial new question of patentability" to be. A request will point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office. See MPEP 2616.

Under 35 U.S.C. 312, the patent owner in an *inter partes* reexamination proceeding has an appeal right "with respect to any decision adverse to the patentability of" the patent claims, and the reexamination requester has an appeal right "with respect to any final decision favorable to the patentability of" the patent claims. Accordingly, the requester must explain each substantial new question of patentability in terms of a proposed ground of rejecting the claims to which the substantial new question of patentability is directed.

For proposed obviousness rejections, requester **must provide** basis for combining the cited references,[2] and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination. Preferably, the requester should quote the pertinent teachings in the reference, referencing each quote by page, column and line number, and any relevant figure numbers.[3] The explanation **must not** lump together the proposed rejections or proposed combinations of references. See MPEP 2617.

The request does not clearly set forth what each reference teaches for every claim in each proposed rejection. The request fails to provide a basis for combining references and the statement that it would have been obvious for each of the proposed obviousness rejections. The request repetitively lumps together multiple proposed rejections to the point where it is unclear exactly what rejections are being proposed. Any new request must set forth the pertinency and manner of applying each reference for each proposed rejection to every claim for which reexamination is requested.

Accordingly, petitioner's arguments that the examiner was incorrect in denying reexamination because the requestor did not set forth the perinency and manner of applying the documents are unpersuasive for the reasons set forth above. In addition, petitioner's arguments that reexamination should be granted because of the provisions of 35 U.S.C. 317(b) would prevent the filing of another reexamination are not well founded. 35 U.S.C. 317(b) is not applicable to this situation because the reexamination proceeding was not instituted (e.g., the order was denied).

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *inter partes* reexamination of the '712 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). This decision is without prejudice to the right of the requester to file a new request for *inter partes*

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[2] i.e., a reason why the individual teachings of the cited references would be combined

[3] 35 U.S.C. 311(b) states in pertinent part:

> " (b) REQUIREMENTS.- The request shall-
> *****
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. ..."

reexamination to address the issues noted. The requester is not barred from filing a new request for *inter partes* reexamination as argued by the petitioner, because the estoppel provision of 35 U.S.C. 317(b) to not attach since the reexamination has not been instituted. Any such request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the '7516 proceeding (e.g., presenting Evan or Catta in a new light or in combination with other new prior art not considered in a prior examination).

The requester can file a new request for *inter partes* 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 1.915(b)(3). Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. Given the facts involved in this proceeding, and after a *de novo* review of the petition and the record as a whole, the request for *inter partes* reexamination of claims 1-15 of the '712 patent is found <u>not</u> to raise a substantial new question of patentability as to claims 1-15.

2. Accordingly, the PETITION is DENIED.

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

4. This decision is final and nonappealable. 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 the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

June 22, 2007
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Menlo Park,

(For Patent Owner)

MAILED
MAR 16 2006
REEXAM UNIT

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

(For Third Party Requester)

In re TV Interactive Data Corporation	:
Reexamination Proceeding	:
Control No.: 95/000,109	: **DECISION, *SUA SPONTE*,**
Filed: September 6, 2005	: **WAIVING 37 CFR 1.941**
For: U.S. Patent No. 6,418,532	:
	:

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration with respect to the improper amendment filed January 23, 2006.

Summary

In order to prevent any further delay of the reexamination proceeding and to ensure that it is conducted with special dispatch, the Office has *sua sponte* waived the requirements of 37 CFR 1.941 as it incorporates the requirements of 37 CFR 1.530(e), to the extent that the improper amendment of January 23, 2006 is accepted. This waiver is based solely on the present facts and circumstances, and is not to be taken as guidance as to any future waiver of the rules.

REVIEW OF SALIENT FACTS

1. A request for *inter partes* reexamination of U.S. Patent No. 6,418,532 (the '532 patent) was filed on September 6, 2005 and assigned control number 95/000,109 (the '109 *inter partes* reexamination proceeding).

2. Reexamination was ordered for the '109 *inter partes* reexamination proceeding on November 21, 2005.

3. Also on November 21, 2005, a non-final Office action, in which all patent claims were rejected, was mailed.

4. A timely response to the November 21, 2005 Office action was filed by patent owner on Monday, January 23, 2006.

5. On February 9, 2006, the third party requester filed timely comments after the January 23, 2006 patent owner response.

6. A review of the January 23, 2006 patent owner response by the Primary Examiner reveals that the response includes an amendment to the claims. However, the amendment fails to comply with the requirements of 37 CFR 1.530(e) as incorporated by 37 CFR 1.941.

DISCUSSION

35 U.S.C. § 314(c) provides:

> "SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

37 CFR 1.941 states:

"Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943."

37 CFR 1.530(e) states:

> "*Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, **and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.** (Emphasis supplied.)

MPEP § 2666.01 provides, in pertinent part:

> "*Amendment Entry* - Amendments which comply with 37 CFR 1.530(d)-(j) and 37 CFR 1.943 (and are formally presented pursuant to 37 CFR 1.52(a) and (b), and contain fees required by 37 CFR 1.20(c)) will be entered in the reexamination file pursuant to the guidelines set forth in MPEP § 2234."

Upon review of the amendment filed on January 23, 2006 by patent owner, as required by MPEP § 2666.01, the Primary Examiner has determined that the January 23, 2006 patent owner amendment fails to comply with 37 CFR 1.941 to the extent that the amendment does not contain the explanation required by 37 CFR 1.530(e) - of the support in the disclosure of the patent for the changes to the claims made by the amendment paper. However, the Primary Examiner has analyzed the claim changes made by patent owner's January 23, 2006 amendment by comparing those changes with the original patent specification. The Primary Examiner's analysis has found that support for the language added to the claims by patent owner's amendment is readily apparent from the specification of the patent as follows:

<u>Independent claim 1:</u>

"detecting insertion of a storage media into a peripheral coupled to a powered up and booted host device;" [see e.g., col. 21: "a user can place a storage media (such as CD-ROM 110) into a compatible peripheral of a powered up and booted host device," col. 22, line 10: "powers up," col. 22, line 15: "boots the operating system," col. 22, line 35: "detects insertion of a storage media"];

"continuing to detect insertion without rebooting the device;" [see e.g., col. 21, line 59: "To facilitate

automatic detection of insertion of a storage media, a host device is installed during booting with an autostart driver which periodically polls one or more peripherals of the host device."];

"checking [said] each storage media of a specified type, whose insertion has been detected," [e.g., see col. 22, line 35: "detects insertion of a storage media and upon detection of a storage media such as a CD-ROM ..."];

starting up said process, "wherein a process is started each time said checking step finds a file having a predetermined name that is compatible with said initialization file and containing a sequence of instructions to be executed to start up a process" [col. 22, line 45: " ... a file with second predetermined name ... must be present on a storage media to be compatible with an autostart driver which seeks a file of the second predetermined name ...."; see also col. 24, line 16: "the autostart driver starts up or spawns a new process which executes the instructions in DISGO.BAT]

Independent claim 9:

"detecting insertion of a storage media into a peripheral coupled to a powered up and booted host device;" [see e.g., col. 21: "a user can place a storage media (such as CD-ROM 110) into a compatible peripheral of a powered up and booted host device," col. 22, line 10: "powers up," col. 22, line 15: "boots the operating system," col. 22, line 35: "detects insertion of a storage media"];

"continuing to detect insertion without rebooting the device;" [see e.g., col. 21, line 59: "To facilitate automatic detection of insertion of a storage media, a host device is installed during booting with an autostart driver which periodically polls one or more peripherals of the host device."];

"checking for a file of a predetermined name on [said] each storage media, whose insertion has been detected," [col. 22, line 45: " ... a file with second predetermined name ... must be present on a storage media to be compatible with an autostart driver which seeks a file of the second predetermined name ...."]

"starting up a process from said file of said predetermined name, said step for starting up containing a sequence of instructions to be executed to start up said process, wherein a process is started up each time said step of checking finds a file having the predetermined name." [col. 22, line 51: "Every file having the second predetermined name ... contains a sequence of application start-up instructions to be executed to start an application for using selections encoded in the inserted storage media"].

Independent claim 17:

"detecting insertion of a storage media into a [said] peripheral coupled to a powered up and booted host device;" [see e.g., col. 21: "a user can place a storage media (such as CD-ROM 110) into a compatible peripheral of a powered up and booted host device," col. 22, line 10: "powers up," col. 22, line 15: "boots the operating system," col. 22, line 35: "detects insertion of a storage media"];

"continuing to detect insertion without rebooting the device;" [see e.g., col. 21, line 59: "To facilitate automatic detection of insertion of a storage media, a host device is installed during booting with an autostart driver which periodically polls one or more peripherals of the host device."];

"for each insertion detected, checking for a file other than said initialization file, said file other than said initialization file having a predetermined name that is compatible with said initialization file, said file other than said initialization file containing a sequence of instructions to be executed to start up a process" [see e.g., col. 22, line 51: "Every file having the second predetermined name ... contains a sequence of application start-up instructions to be executed to start an application for using selections encoded in the inserted storage media"; see also col. 24, line 10: "Once the application has terminated, control returns from the application to step 529 of autostart driver 510. Autostart driver 510 goes via branch 530 back to step 513 (described above) which allows autostart driver 510 to continue to be responsive to the insertion of a storage media into a peripheral of host device 120."; see also col. 24, line 16: "the autostart driver starts up or spawns a new process which executes the instructions in

DISGO.BAT];

"starting up said process in a host device, wherein a new process is [being] started up in response to each time said checking step finds a file [is found] having said predetermined name that is compatible with said initialization file and contains a sequence of instructions to be executed to start up a process [see e.g., col. 22, line 45: " ... a file with second predetermined name ... must be present on a storage media to be compatible with an autostart driver which seeks a file of the second predetermined name ...."; see also col. 24, line 16: "the autostart driver starts up or spawns a new process which executes the instructions in DISGO.BAT].

Based upon the Primary Examiner's review of the patent owner's amendment and analysis of the original patent specification, it is deemed appropriate to waive the requirements of 37 CFR 1.941 as it incorporates the requirements set forth in 37 CFR 1.530(e). Given (a) that the "support in the disclosure of the patent for the changes to the claims made by the amendment paper" can be, and has been, readily determined, and (b) the statutory mandate of 35 U.S.C. § 314(c) to conduct *inter partes* reexamination proceedings with special dispatch, *an extraordinary situation has been presented, where justice requires waiving of 37 CFR 1.530(e) to the extent, it has been waived in this decision*. This waiver will accelerate the examination of the '109 *inter partes* reexamination proceeding by eliminating the need set an additional period of time in which the patent owner would be required to comply with the requirements of 37 CFR 1.530(e), thereby advancing the prosecution to the next phase.

Parties should note that this waiver is based solely on the facts and circumstances that appear at the present stage of the '109 *inter partes* reexamination proceeding. Parties are advised that all future submissions filed in this proceeding are expected to comply with the statute and regulations, and that future *sua sponte* action to waive the requirements of the regulations should be neither expected nor relied upon.

CONCLUSION

1. With respect to the patent owner amendment filed on January 23, 2006, the requirements of 37 CFR 1.941 are *waived* insofar as 37 CFR 1.941 incorporates the requirements of 37 CFR 1.530(e) to the extent that the amendment filed on January 23, 2006 will be entered.

2. Jurisdiction over the '109 *inter partes* reexamination proceeding is forwarded to the Central Reexamination Unit for entry of the amendment filed on January 23, 2006.

3. Jurisdiction over the '109 *inter partes* reexamination proceeding will then be returned to Art Unit 3992 of the Central Reexamination Unit, for appropriate action on the patent owner amendment filed on January 23, 2006 and the third party requester response filed on February 9, 2006.

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

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

sm
March 15, 2006

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March 16, 2006

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(For Patent Owner)

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[Enclosure - Properly Formatted Copy of Claims 8 and 9 Filed January 20, 2006]

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(For Third Party Requester)

[Enclosure - Properly Formatted Copy of Claims 8 and 9 Filed January 20, 2006]

In re Creative Packaging Corp.	:
Reexamination Proceeding	:
Control No.: 95/000,111	: **DECISION, *SUA SPONTE*,**
Filed: September 16, 2005	: **WAIVING 37 CFR 1.941**
For: U.S. Patent No. 6,116,477	:
	:

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration with respect to the improper amendment filed January 20, 2006.

Summary

In order to prevent any further delay of the reexamination proceeding and to ensure that it is conducted with special dispatch, the Office has *sua sponte* waived the requirements of 37 CFR 1.941 as it incorporates the requirements of 37 CFR 1.530(d)(2) and 37 CFR 1.530(e), to the extent that the improper amendment of January 20, 2006 is accepted. This waiver is based solely on the present facts and circumstances, and is not to be taken as guidance as to any future waiver of the rules.

REVIEW OF SALIENT FACTS

1. A request for *inter partes* reexamination of U.S. Patent No. 6,116,477 (the '477 patent) was filed on September 16, 2005 and assigned control number 95/000,111 (the '111 *inter partes* reexamination proceeding).

2. Reexamination was ordered for the '111 *inter partes* reexamination proceeding on November 22, 2005.

3. Also on November 22, 2005, a non-final Office action, in which patent claims 1-3 and 5 were rejected and patent claims 4, 6 and 7 were confirmed, was mailed.

4. A timely response to the November 22, 2005 Office action was filed by patent owner on Friday, January 20, 2006.

5. On February 17, 2006, the third party requester filed timely comments after the January 20, 2006 patent owner response.

6. A review of the January 20, 2006 patent owner response by the Primary Examiner reveals that the response includes an amendment to the claims. However, the amendment fails to comply with the requirements of 37 CFR 1.530(d)(2) and 37 CFR 1.530(e) as incorporated by 37 CFR 1.941.

DISCUSSION

35 U.S.C. § 314(c) provides:

> "SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

37 CFR 1.941 states:

> "Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943."

37 CFR 1.530(d)(2) states:

> "*Making amendments in a reexamination proceeding.* A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to § 1.550(a) or § 1.937. ...
>
> *Claims.* An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim."

37 CFR 1.530(e) states:

> "*Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, **and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.** (Emphasis supplied.)

MPEP § 2666.01 provides, in pertinent part:

> "*Amendment Entry* - Amendments which comply with 37 CFR 1.530(d)-(j) and 37 CFR 1.943 (and are formally presented pursuant to 37 CFR 1.52(a) and (b), and contain fees required by 37 CFR 1.20(c)) will be entered in the reexamination file pursuant to the guidelines set forth in MPEP § 2234."

Upon review of the amendment filed on January 20, 2006 by patent owner, as required by MPEP § 2666.01, the Primary Examiner has determined that the January 20, 2006 patent owner amendment fails to comply with 37 CFR 1.941 to the extent that the amendment paper presents new claims 8 and 9 proposed to be added to the claims of the '477 patent, but these new claims do not include markings pursuant to 37 CFR 1.1530(f), *i.e.*, are not underlined. The Primary Examiner has also determined that the January 20, 2006 patent owner amendment fails to comply with 37 CFR 1.941 to the extent that the amendment does not contain the explanation required by 37 CFR 1.530(e) *i.e.*, an explanation of the support in the disclosure of the patent for new claims 8 and 9 added by the amendment paper. However, the Primary Examiner has indicated that he will undertake a detailed analysis of new claims 8 and 9 presented in patent owner's January 20, 2006 amendment by comparing those claims with the original patent disclosure, and that such can be properly done in this proceeding notwithstanding the lack of 37 CFR 1.530(e) input by the patent owner. It is noted that the February 17, 2006 third party requester comments in response to the patent owner's January 20, 2006 amendment contain comments with respect to the question of support for the new claims.

Based upon the fact that the Primary Examiner has indicated that he can, and will, undertake a detailed analysis of claims 8 and 9 without provision of patent owner's comments regarding support for these claims, that this analysis will be made of record, and also because only two claims require that analysis, it is deemed appropriate to waive the requirements of 37 CFR 1.941 as it incorporates the requirements set forth in 37 CFR 1.530(e). It is noted that only two claims are involved, and a copy of claims 8 and 9 containing markings as required by the regulation is being attached to the present decision, for entry into the record and inclusion in the Image File Wrapper (IFW) of the '111 *inter partes* reexamination proceeding. Given (a) that the "support in the disclosure of the patent for the changes to the claims made by the amendment paper" can, in this instance, be readily determined, (b) that new claims 8 and 9 in compliance with 37 CFR 1.530(d)(2) have been provided, (c) requester's comments with respect to the question of support for the new claims, and (d) the statutory mandate of 35 U.S.C. § 314(c) to conduct *inter partes* reexamination proceedings with special dispatch, *an extraordinary situation has been presented, where justice requires waiving of 37 CFR 1.530(d)(2) and 37 CFR 1.530(e) to the extent these regulations have been waived in this decision*. This waiver will accelerate the examination of the '111 *inter partes* reexamination proceeding by eliminating the need to set an additional period of time in which the patent owner would be required to comply with the requirements of 37 CFR 1.530(e), thereby advancing the prosecution to the next phase.

The parties should note that this waiver is based solely on the facts and circumstances that appear at the present stage of the '111 *inter partes* reexamination proceeding. The parties are advised that all future submissions filed in this proceeding are expected to comply with the statute and regulations, and that future *sua sponte* action to waive the requirements of the regulations should be neither expected nor relied upon.

CONCLUSION

1. With respect to the patent owner amendment filed on January 20, 2006, the requirements of 37 CFR 1.941 are *waived* insofar as 37 CFR 1.941 incorporates the requirements of 37 CFR 1.530(d)(2) and 37 CFR 1.530(e) to the extent that the amendment filed on January 20, 2006 will be entered.

2. Jurisdiction over the '111 *inter partes* reexamination proceeding is forwarded to the Central Reexamination Unit for entry of the amendment filed on January 20, 2006. The

attached page presenting properly formatted claims 8 and 9 will be entered in the IFW as a separate document encoded "CLM."

3. Jurisdiction over the '111 *inter partes* reexamination proceeding will then be returned to Art Unit 3993 of the Central Reexamination Unit, for appropriate action on the patent owner amendment filed on January 20, 2006 and the third party requester response filed on February 17, 2006.

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

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

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March 23, 2006

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March 28, 2006

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JUN 12 2007

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In re Kreiseder et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,111	:	UNDER 37 CFR 1.181
Filed: September 16, 2005	:	TO INVOKE THE SUPERVISORY
For: U.S. Patent No.: 6,116,477	:	AUTHORITY OF THE DIRECTOR

This is a decision on a petition filed by the patent owner on May 25, 2006. The petition is entitled PETITION TO RE-OPEN PROSECUTION UNDER 37 C.F.R. § 1.181, and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and reopen prosecution by withdrawing the Action Closing Prosecution issued on April 21, 2006.

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 May 25, 2006 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,111.

REVIEW OF FACTS

1. U.S. Patent No. 6,116,477 (hereinafter, the '477 patent) issued on September 12, 2000.

2. A request for *inter partes* reexamination, assigned control No. 95/000,111, was filed by a third party requester Bericap on September 16, 2005.

3. *Inter partes* reexamination was ordered for the '111 reexamination proceeding on November 22, 2005.

4. Also on November 22, 2005, a non-final Office action was mailed in the '111 reexamination proceeding.

5. A response to the non-final Office action was filed by the patent owner on January 20, 2006. The response cancelled patent claims 1, 2 and 5 and added new claims 8 and 9. The response failed to comply with USPTO rules and procedures but was entered by waiver of the rules set forth in the petition decision dated March 28, 2006 in the interest of acting with "special dispatch."

6. The third party filed comments on February 17, 2006 to the patent owner's response, and introduced additional prior art.

7. On April 21, 2006, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP no longer adopted the rejection of claim 3 based on prior art, and confirmed patentability of claims 4, 6 and 7. In addition, the ACP rejected the new claim 8 under: (1) 35 U.S.C. 112, first paragraph, and (2) 35 U.S.C. 103 based upon Lopez in view of two references that were cited by the third party requester on February 17, 2006, and one reference found by the examiner. The ACP rejected claim 9 under 35 U.S.C. 102(b) based on Lopez.

8. On May 25, 2006, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened and a response to the Action Closing Prosecution.

9. On June 21, 2006, the third party filed comments on patent owner's response to the Action Closing Prosecution, which included a request that prosecution be reopened, and also cited more additional prior art.

DECISION

The patent owner (petitioner) states that the Action Closing Prosecution dated April 21, 2006 "prematurely" cuts off prosecution, and that closing prosecution after the first substance response by patent owner creates a rigid "one and done" process. Patent

owner states that new claims 8 and 9 were added as soon as possible to obviate any delay in considering the merits of these claims. Patent owner further points out that there are limited opportunities to continue prosecution in an *inter partes* reexamination proceeding. Patent owner further alleges that reopening prosecution would not place undue burden on the examiner because only two claims (new claims 8 and 9) remain at issue. Because of these grounds, petitioner requests that prosecution be reopened.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds there are not good and sufficient reasons to do so for the reasons set forth below. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. As pointed out by the patent owner, the Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Accordingly, the Office's rules and procedures are not a rigid "one and done" process as alleged by patent owner.

Turning to the facts in this proceeding, patent owner submitted two new claims (claims 8 and 9) after the first Office action. Claims 8 and 9 are substantially similar to claim 1 in the patent. Claim 8 added the limitations that the spout is "frustoconical," and that the cap includes an arcuate projection extending from an inside surface that at least partially circumscribes the spout when the cap is closed. Claim 9 slightly modified the claim limitation pertaining to the circular channel. As pointed out above, claim 8 was rejected under 35 U.S.C. 112, first paragraph, for adding new matter (e.g., subject matter that did not have support in the patent). Claims 8 and 9 were also rejected under prior art. Claim 9 was rejected under 35 U.S.C. 102(b) over Lopez, which is the primary reference applied in the rejection of claims in the first Office action. Claim 8 was rejected under 35 U.S.C. 103(a) using Lopez as the primary reference teaching all but one of the claimed elements. Therefore, as Lopez was already before the patent owner with its applicability explained to claim 1, a claim substantially similar to claims 8 and 9, the patent owner already had notice as to what Lopez taught in regards to claims 8 and 9. In fact, the "new" prior art introduced in the ACP was cited for only a teaching of one element of claim 8, which involved the reversal of elements. Accordingly, the examiner appropriately mailed an ACP in the interest of "special dispatch."

In addition, patent owner's response to the ACP not only included amendments to claims 8 and 9 but also amendments to the specification and the drawings. Such amendments changing the specification, drawings and claims would require thorough review by the examiner to ensure no new matter has been added. Upon review of this proceeding's history, requiring the examiner to review these amendments is an undue burden to the examiner and hinders the Office's ability to act with special dispatch.

Further, it is noted that patent owner's response of May 25, 2006 is not compliant with USPTO rules and procedures. Specifically, the response fails to comply with 37 CFR 1.530(d)(1) for the amendments to the specification, 37 CFR 1.530(d)(3) for the amendments to the drawings, and 37 CFR 1.530(f) for the amendments to the claims. Accordingly, the response cannot be entered. Also, the patent owner showed support for the claim amendments by pointing to the specification as also amended. Such a circular showing is not particularly helpful to the examiner. A showing should be made to the disclosure of the patent in order to show proper support as required by 35 U.S.C. 112.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated April 21, 2006 and reopening of prosecution of the '111 reexamination proceeding is denied.

2. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Andres Kashnikow

for

Lissi Mojica Marquis, Director
Central Reexamination Unit

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In re Metzger	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,115	:	UNDER 37 CFR 1.181
Filed: November 28, 2005	:	
For: U.S. Patent No.: 6,523,333	:	

This is a decision on a petition filed by the third party requester on July 14, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 REQUESTING REVIEW OF THE PTO'S REFUSAL TO CONSIDER AN ISSUE OF OBVIOUSNESS" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and review the examiner's refusal to consider a new proposed rejection based on obviousness in the Action Closing Prosecution issued on May 14, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated July 14, 2009 is dimissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,523,333 (hereinafter, the '333 patent) issued on February 25, 2003.

2. A request for *inter partes* reexamination, assigned control No. 95/000,115, was filed by a third party requester on November 28, 2005. The request for reexamination included a statement of a substantial new question of patentability (SNQ) and a detailed explanation for how German reference 14,314 (hereinafter "DD '314") anticipated claims 1-9 of the '333 patent along with other SNQs and proposed rejections based on other references.

3. *Inter partes* reexamination was ordered for the '115 reexamination proceeding on January 19, 2006. The order determined that DD '314 raised a SNQ with respect to claims 1-9 of the '333 patent. See page 7 of the order. On the same day, a non-final Office action was mailed in the '115 reexamination proceeding. This Office action did not adopt the proposed anticipation rejection for claims 1-6 and 9, but did adopt the proposed rejection for claims 7 and 8. See pages 10-14 of the Office action.

4. The patent owner filed a response to the non-final Office action on March 20, 2006. The response included proposed new claims 10-21.

5. The third party filed comments on April 19, 2006 to the patent owner's response, which included comments regarding the examiner's interpretation of the "shaft" claim limitation and how DD '314 teaches a "shaft" and anticipates every claim of the '333 patent. See, e.g., pages 3-10 and 36-38 of the comments. The comments also introduced, for the first time, proposed obviousness rejections based on DD '314 (and other references) in view of admitted prior art, the '295 patent or the '508 patent. See pages 43-46 of the comments. The comments also included new proposed rejections for proposed new claims 10-21. See pages 47-48 of the comments.

6. On October 12, 2006, a Notice of Defective Paper was mailed to the patent owner because the amendment filed on March 20, 2006 was not compliant with 37 CFR 1.530.

7. On November 14, 2006, patent owner filed a response to the Notice of Defective Paper.

8. On December 11, 2006, the third party requester filed comments to the patent owner's response of November 14, 2006.

9. On July 27, 2007, the Office mailed a second non-final Office action that was responsive to the papers filed March 20, 2006, April 19, 2006, November 14, 2006, and December 11, 2006. The Office action maintained the no adoption of the proposed anticipation

rejection for claims 1-6 and 9, and the rejection for claims 7 and 8 based on DD '314. See pages 27-32 of the Office action.

10. On August 27, 2007, the paper owner filed a response to the second Office action, which included proposed new claims 22-27.

11. On September 26, 2007, the third party requester filed comments on the August 27, 2007 patent owner's response, which continued to argue the claim interpretation. See pages 2-11 of the comments. The comments also included statements that even if the examiner does not deem claims 1 and 9 anticipated by DD '314, the claims are obvious. See, e.g., page 14 of the comments.

12. On September 29, 2008, a Notice re Defective Paper was mailed to both the patent owner and the third party requester because both the August 27, 2007 and the September 26, 2007 papers failed to comply with *inter partes* reexamination rules and procedures.

13. On October 28, 2008, the patent owner filed a response to the Notice re Defective Paper, which included proposed new claims 22-27.

14. Also, on October 29, 2008, the third party requester filed two sets of comments in response to the Notice re Defective Paper. One set of comments argued that the Notice re Defective Paper was made in error and that the requester appropriately proposed an obviousness rejection based on DD '314 when the examiner did not adopt the proposed anticipation rejection set forth in the request for reexamination. The other set of comments did not contain such arguments or any proposed obviousness rejection based on DD '314.

15. On May 14, 2009, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP maintained the anticipation rejection based on DD '314 for claims 7 and 8 and the no adoption of the proposed anticipation rejection for claims 1-6 and 9, as set forth in the previous two Office actions. The ACP also addressed the proposed obviousness rejection based on DD '314 by stating that the proposed rejection is not responsive to issues raised in the Office actions or in the patent owner's responses, and therefore, is improperly raised. See pages 13-15 of the Office action.

16. On June 2 and 15, 2009, patent owner filed remarks in response to the ACP.

17. On July 14 and 15, 2009, the third party requester filed comments and the instant petition.

DECISION

The third party requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of the examiner's decision to not consider the new proposed rejection of claims 1-6 and 9 under 35 U.S.C. 103(a) based on DD '314. The petitioner contends the new proposed obviousness rejection should be considered because:

> "(1) applicable statutes, rules and regulations require the PTO to conduct a comprehensive patentability determination in every examination, including *inter partes* reexamination;
> (2) the Examiner's duty to fully determine all issues of patentability of claims 1-6 and 9 exists independent of Requester's Request and subsequent comments;
> (3) Requester's comments dated September 26, 2007 fully comply with 37 C.F.R. § 1.947;
> (4) there exists no authority precluding examination of the claims 1-6 and 9 for obviousness in view of DD '314; and
> (5) prior art reference DD '314 is highly pertinent to the subject matter of claims 1-6 and 9, as other claims were found to lack novelty over it and any distinction is not patentably significant."

See page 7 of the petition.

Legal Authority Citations:

37 CFR 1.181 states, in part:

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

37 CFR 1.947 states:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2666.05 states, in part:

> Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.
>
> As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.
>
> As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.
>
> As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.
>
> As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.
>
> Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

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 consider the proposed obviousness rejection was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the withdrawal request.

Turning to the facts in this proceeding, the proposed obviousness rejection based on DD '314 was not included in the request for reexamination. Instead, this proposed obviousness rejection was not mentioned until the third party requester comments submitted after the first Office action on the merits. See pages 43-46 of the April 16, 2006 comments.

In the petition, petitioner states five grounds in which the petitioner believes the examiner's refusal to consider the proposed obviousness rejection based on DD '314 to be in error. See page 7 of the petition. The first two grounds pertain to the Office's duty to provide a thorough and complete examination in *inter partes* reexamination. The third ground alleges that the proposed rejection was in accordance with 37 CFR 1.947. The fourth and fifth grounds state that there is no authority to preclude consideration of the proposed obviousness rejection and that DD '314 is highly pertinent to claims 1-6 and 9, respectively. Each ground will be addressed below.

Grounds 1 and 2:

In the petition, the petitioner states that the Office and the examiner have a duty to provide a thorough determination of patentability, which mandates that the examiner consider the proposed obviousness rejection based on DD '314. See pages 7-10 of the petition. In response, the director finds nothing in the record supports the petitioner's allegation that a thorough examination, in accordance with 37 CFR 1.104, has not been performed. The record clearly shows that the examiner considered all the proposed rejections set forth in the request for reexamination and provided an Office action which either adopted or not adopted the proposed rejections. All the Office actions articulated reasons for both the adoption and lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948. See the Office actions dated January 19, 2006, July 27, 2007 and May 14, 2009. The record also shows that there is nothing that prevented the petitioner from presenting the proposed obviousness rejection based DD '314 in the request for reexamination. 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) clearly require that the requester must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. In this case, the petitioner (third party requester) decided to provide only the pertinency and manner of applying DD '314 in a proposed anticipation rejection, and not to present the pertinency and manner of applying

DD '314 in a proposed obviousness rejection[1] in the request for reexamination. Furthermore, the record shows that every claim, both original and newly proposed, is currently under a rejection. Neither 37 CFR 1.104 nor *inter partes* reexamination laws and procedures require that examiners must consider and make every possible rejection, which are not set forth in a manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). Moreover, the petitioner's citation to MPEP 2658(IV)(B) pertaining to the Office having "discretion" to consider reexamining claims that have not been requested has little relevance to this issue. The fact that the Office has discretion to do a certain act does not require the Office to exercise that discretion in every case. Office laws and policies are clear that examiners are only required to consider whether the original patent claims define a novel and nonobvious invention over the prior art of record, and to articulate any grounds of rejection, or lack of an adoption to a proposed rejection, so that the patent owner and the third party requester can understand the grounds and appropriately reply to the Office action. See MPEP 706 and 2660. Therefore, the record does not support petitioner's view that a thorough examination of the claims was not performed unless the examiner explicitly considered and articulated reasons for adoption or lack of adoption of the new proposed obviousness rejection based on DD '314. Accordingly, grounds 1 and 2 are not persuasive that the examiner erred in her refusal to consider the new proposed obviousness rejection over DD '314.

Ground 3:

First, the petitioner alleges that the issue of obviousness of claims 1-6 and 9 was raised in the request for reexamination. The record does not support this statement for the reasons discussed in the paragraph above. Next, petitioner states that the new proposed obviousness rejection was made in accordance with 37 CFR 1.947. 37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. See MPEP 2666.05. The new proposed obviousness rejection based on DD '314 was not caused by the patent owner amendment in the paper of March 20,

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[1] For support for their statement that the issue of obviousness was raised in the request for reexamination, the petitioner is apparently relying on the statement that "[f]or at least the reasons set forth in this Request, and as shown in the claim charts attached as Attachments A-E, each of:
• United Kingdom Patent 1,471,971 (hereinafter, "the '971 patent") (DX-2),[-3]
• German Patent 72,624 (hereinafter, "the '624 patent") (DX-3),
• German Patent 14,314 (hereinafter, "the '314 patent") (DX-4),
• U.S. Patent No. 4,738,036 (hereinafter, "the '036 patent") (DX-5), and
• U.S. Patent No. 4,147,016 (hereinafter, "the 'Jensen patent") (DX-8),
whether taken alone or considered with Metzger's admissions or other relevant art cited herein, provides *independent and separate* grounds for finding the claims of the '333 Patent to be unpatentable." See page 1 of the request for reexamination and page 11 of the petition. The request does not provide the detailed explanation for how DD '314 renders claims 1-6 and 9 obvious. See pages 59-65 which only provides the detailed explanation for how DD '314 anticipates claim 1-9. Therefore, the request does not present the issue of claims 1-6 and 9 being rendered obvious by DD '314 in the manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3).

2006 because the amendment did not amend claims 1-6 and 9. In addition, the patent owner's remarks, dated March 20, 2009, does bring forth the issue of obviousness of claims 1-6 and 9 based on DD '314. See, e.g., pages 37-39 of the March 20, 2009 remarks. Therefore, the new proposed rejection cannot be said to be responsive to issues raised by the patent owner's remarks.

In the petition, the third party requester states that the new proposed obviousness rejection is responsive to the examiner's claim interpretation, which resulted in the examiner determining that DD '314 did not teach all of limitations in claims 1-6 and 9 of the '333 patent and not adopting the proposed anticipation rejection of claims 1-6 and 9. The petitioner states "...it would make no sense to require a requester to predict which feature of the claims the Examiner might find not to be present in a prior art disclosure where, as here, the Requester has made a detailed and substantial showing that the prior art fully anticipates the claimed invention." See page 12 of the petition. It is noted, however, that *inter partes* reexamination laws and policies clearly require the requester to set forth all the proposed rejections by supplying the manner and pertinency of applying the references to the claims for which reexamination is requested, with limited exceptions as prescribed in 37 CFR 1.947 and 1.948, in order to achieve "special dispatch" required in reexamination proceedings. 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. See MPEP 2666, 2672, and 2673. Accordingly, the Office's rules and procedures do not categorically deprive the third party requester of its statutory rights to present proposed rejections in reexamination proceedings. As explained in the paragraph above, the requester did not set forth a proposed obviousness rejection of claims 1-6 and 9 based on DD '314 in the request for reexamination. Therefore, to allow a requester to set forth additional proposed rejections only after the examiner determines that they did not meet their burden in establishing a prima facie case of unpatentability for certain proposed rejections would lengthen reexamination proceedings, which is clearly against the statutorily mandate of "special dispatch."

MPEP 2666.05 states, in part, that "...a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester." Similarly, a determination by the examiner that a reference does not anticipate a claim does not permit the requester to then present a new proposed rejection based on the same reference but under another ground. There is no doubt that the analysis performed in determining a prima facie case of anticipation is clearly different from the analysis performed in determining a prima facie case of obviousness. For evidence, see MPEP 706.02(a), 706.02(f) et seq., and 2131 to 2136 et seq. for policies regarding anticipation rejections and MPEP 706.02(l) et seq., and 2141 to 2144 et seq. for policies regarding obviousness rejections. Therefore, it cannot be said that the new proposed obviousness rejection based on DD '314 is responsive to the lack of the adoption

of the proposed anticipation rejection over DD '314 for claims 1-6 and 9. The requester's appropriate response to the lack of the adoption of the proposed anticipation rejection of claims 1-6 and 9 is to argue and present evidence why the examiner's claim interpretation is overly narrow and/or how DD '314 does indeed teach all the claim limitations. The requester presented such arguments in their comments. See, e.g., pages 3-10 and 36-38 of the April 19, 2006 comments. Accordingly, the requester was able present their comments in response to the lack of the adoption of the proposed anticipation rejection of claims 1-6 and 9 over DD '314 without the new proposed obviousness rejection, and nothing more is authorized by 37 CFR 1.947. Therefore, the new proposed obviousness rejection of claims 1-6 and 9 over DD '314 is not limited to issues raised by the patent owner or the Office action. Accordingly, the new proposed obviousness rejection is not authorized by 37 CFR 1.947, and the examiner did not err in not considering this new proposed rejection.

Ground 4:

The petitioner states that neither 37 CFR 1.947 nor MPEP 2666.05 precludes the requester's new proposed obviousness rejection of claims 1-6 and 9 over DD '314. For the reasons expressed above pertaining to Ground 3, both 37 CFR 1.947 and MPEP 2666.05 authorize the examiner to not consider the new proposed obviousness rejection in the interest of "special dispatch." Furthermore, as explained above in regard to Grounds 1 and 2, the request for reexamination did not raise the issue of obviousness of claims 1-6 and 9 over DD '314 because the request failed to provide the detailed explanation in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) for the proposed obviousness rejection. Therefore, this ground is not persuasive that the examiner erred in her refusal to consider the new proposed obviousness rejection of claims 1-6 and 9 over DD '314.

Ground 5:

The petitioner states that the "highly pertinent" nature of DD '314 requires the consideration of the new proposed obviousness rejection of claims 1-6 and 9 over DD '314. This argument essentially repeats the arguments made to support Grounds 1 and 2, and for same reasons expressed above, this ground does not show that the examiner erred in denying consideration of the new proposed obviousness rejection. Furthermore, to the extent that this ground is arguing the appropriateness of the examiner's claim interpretation, this issue touches on matters that are appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201. Specifically, MPEP 1202 states "[t]he line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition<, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

In conclusion, the examiner appropriately denied consideration of the new proposed obviousness rejection of claims 1-6 and 9 over DD '314 in the interest of "special dispatch." Accordingly, the examiner correctly applied Office policies and procedures in determining that the new proposed obviousness rejection is not appropriately raised. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not consider the new proposed obviousness rejection. Accordingly, the third party requester's petition is dimissed.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the examiner's refusal to consider the new proposed obviousness rejection of claims 1-6 and 9 over DD '314 is dimissed.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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(For Patent Owner)

MAILED

MAR 19 2010

CENTRAL REEXAMINATION UNIT

MARK BOLAND
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW, SUITE 800
WASHINGTON, DC 20037

(For Requester)

In re Metzger	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,115	:	UNDER 37 CFR 1.181
Filed: November 28, 2005	:	
For: U.S. Patent No.: 6,523,333	:	

This is a decision on a petition filed by the third party requester on October 21, 2009, which is requesting reconsideration of the decision mailed August 21, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 REQUESTING SUPERVISORY REVIEW AND RECONSIDERATION OF, AND FINAL AGENCY DECISION ON REQUESTER'S JULY 14, 2009 PETITION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and review the August 21, 2009 decision on the July 14, 2009 petition, and to issue a final agency decision.

The petition under 37 CFR 1.181 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for reconsideration of the November 18, 2009 decision.

The request for reconsideration petition under 37 CFR 1.181 is denied, for the reasons set forth herein. This decision is not a final agency decision in accordance with the policies set forth in MPEP 1002.02 and 1002.02(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,523,333 (hereinafter, the '333 patent) issued on February 25, 2003.

2. A request for *inter partes* reexamination, assigned control No. 95/000,115, was filed by a third party requester on November 28, 2005. The request for reexamination included a statement of a substantial new question of patentability (SNQ) and a detailed explanation for how German reference 14,314 (hereinafter "DD '314") anticipated claims 1-9 of the '333 patent along with other SNQs and proposed rejections based on other references.

3. *Inter partes* reexamination was ordered for the '115 reexamination proceeding on January 19, 2006. The order determined that DD '314 raised a SNQ with respect to claims 1-9 of the '333 patent. See page 7 of the order. On the same day, a non-final Office action was mailed in the '115 reexamination proceeding. This Office action did not adopt the proposed anticipation rejection for claims 1-6 and 9, but did adopt the proposed rejection for claims 7 and 8. See pages 10-14 of the Office action.

4. The patent owner filed a response to the non-final Office action on March 20, 2006. The response included proposed new claims 10-21.

5. The third party filed comments on April 19, 2006 to the patent owner's response, which included comments regarding the examiner's interpretation of the "shaft" claim limitation and how DD '314 teaches a "shaft" and anticipates every claim of the '333 patent. See, e.g., pages 3-10 and 36-38 of the comments. The comments also introduced, for the first time, proposed obviousness rejections based on DD '314 (and other references) in view of admitted prior art, the '295 patent or the '508 patent. See pages 43-46 of the comments. The comments also included new proposed rejections for proposed new claims 10-21. See pages 47-48 of the comments.

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9. On July 27, 2007, the Office mailed a second non-final Office action that was responsive to the papers filed March 20, 2006, April 19, 2006, November 14, 2006, and December

11, 2006. The Office action maintained the non adoption of the proposed anticipation rejection for claims 1-6 and 9, and the rejection for claims 7 and 8 based on DD '314. See pages 27-32 of the Office action.

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15. On May 14, 2009, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP maintained the anticipation rejection based on DD '314 for claims 7 and 8 and the non adoption of the proposed anticipation rejection for claims 1-6 and 9, as set forth in the previous two Office actions. The ACP also addressed the proposed obviousness rejection based on DD '314 by stating that the proposed rejection is not responsive to issues raised in the Office actions or in the patent owner's responses, and therefore, is improperly raised. See pages 13-15 of the Office action.

16. On June 2 and 15, 2009, patent owner filed remarks in response to the ACP.

17. On July 14 and 15, 2009, the third party requester filed comments and a petition under 37 CFR 1.181 requesting review of the examiner's decision to not consider the proposed obviousness rejection based on DD '314.

18. On August 21, 2009, a decision dismissing the petition under 37 CFR 1.181 was mailed.

19. On October 21, 2009, the third party requester filed the instant petition, requesting reconsideration of the August 21, 2009 decision.

DECISION

In the July 14, 2009 petition, the third party requester (petitioner) stated that the requester is seeking the director's review under 37 CFR 1.181 of the examiner's decision to not consider the new proposed rejection of claims 1-6 and 9 under 35 U.S.C. 103(a) based on DD '314. The petitioner contended the new proposed obviousness rejection should be considered because:

> "(1) applicable statutes, rules and regulations require the PTO to conduct a comprehensive patentability determination in every examination, including *inter partes* reexamination;
> (2) the Examiner's duty to fully determine all issues of patentability of claims 1-6 and 9 exists independent of Requester's Request and subsequent comments;
> (3) Requester's comments dated September 26, 2007 fully comply with 37 C.F.R. § 1.947;
> (4) there exists no authority precluding examination of the claims 1-6 and 9 for obviousness in view of DD '314; and
> (5) prior art reference DD '314 is highly pertinent to the subject matter of claims 1-6 and 9, as other claims were found to lack novelty over it and any distinction is not patentably significant."

See page 7 of the July 14, 2009 petition.

The instant petition for reconsideration alleges that the August 21, 2009 decision improperly dismissed the July 14, 2009 petition based on "... incorrect interpretation and application of applicable statutes, rules and guidelines." See page 2 of the petition. Specifically, the petition raises the following five issues in support of petitioner's position:

A. The proposed obviousness rejection based on DD '314 was included in the request for reexamination;
B. The PTO has an independent duty to provide a thorough and complete examination in *inter partes* reexamination;
C. The proposed obviousness rejection based on DD '314 was properly raised in accordance with 37 CFR 1.947;
D. Neither 37 CFR 1.947 nor MPEP 2666.04 authorizes refusal by the PTO to consider an issue pertinent to patentability; and

E. The highly pertinent nature of DD '314 requires consideration of the proposed obviousness rejection.

Legal Authority Citations:

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

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Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2666.05 states, in part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a

comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

Turning to the facts in this proceeding, the proposed obviousness rejection based on DD '314 was not included in the request for reexamination, as explained in further detail below. Instead, this proposed obviousness rejection was not mentioned until the third party requester comments submitted after the first Office action on the merits. See pages 43-46 of the April 16, 2006 comments.

In the petition, petitioner states five grounds in which the petitioner believes the August 21, 2009 decision to be in error. The first ground is based on the alleged fact that the request for reexamination included the proposed obviousness rejection based on DD '314. The second ground pertains to the Office's duty to provide a thorough and complete examination in *inter partes* reexamination. The third ground alleges that the proposed rejection was in accordance with 37 CFR 1.947. The fourth and fifth grounds state that there is no authority to preclude consideration of the proposed obviousness rejection and that DD '314 is highly pertinent to claims 1-6 and 9, respectively. Each ground will be addressed below.

Ground A:

In the petition, the petitioner states that the request for reexamination did include the proposed obviousness rejection based on DD '314. See pages 3-5 of the petition. For support for their statement that the issue of obviousness was raised in the request for reexamination, the petitioner is apparently relying on the statement that "[f]or at least the reasons set forth in this Request, and as shown in the claim charts attached as Attachments A-E, each of:

- United Kingdom Patent 1,471,971 (hereinafter, "the '971 patent") (DX-2),[-3]
- German Patent 72,624 (hereinafter, "the '624 patent") (DX-3),
- German Patent 14,314 (hereinafter, "the '314 patent") (DX-4),
- U.S. Patent No. 4,738,036 (hereinafter, "the '036 patent") (DX-5), and
- U.S. Patent No. 4,147,016 (hereinafter, "the 'Jensen patent") (DX-8),

whether taken alone or considered with Metzger's admissions or other relevant art cited herein, provides *independent and separate* grounds for finding the claims of the '333 Patent to be unpatentable." See page 1 of the request for reexamination and page 3 of the petition. The quoted statement above is not sufficient to clearly and explicitly identify the proposed obviousness rejection based on DD '314 because it is indefinite and unclear in scope. More importantly, the request does not provide the detailed explanation for how DD '314 renders claims 1-6 and 9 obvious. See, e.g., pages 59-65 which only provides the detailed explanation for how DD '314 anticipates claim 1-9. Therefore, the record is clear that the request for reexamination only provides the pertinency and manner of applying DD '314 in a proposed anticipation rejection, and not the pertinency and manner of applying DD '314 in a proposed obviousness rejection in the request for reexamination. In other words, the request for reexamination did not establish the proposed obviousness rejection based on DD '314 in accordance with the requirements of 35 U.S.C. 311(b)(2), and its implementing regulation of 37 CFR 1.915(b)(3).

Petitioner contends that the request established the proposed obviousness rejection expressly or by implication through the proposed anticipation rejection based on DD '314. In response, there is no doubt that the analysis performed in determining a prima facie case of anticipation is clearly different from the analysis performed in determining a prima facie case of obviousness. For evidence, see MPEP 706.02(a), 706.02(f) et seq., and 2131 to 2136 et seq. for policies regarding anticipation rejections and MPEP 706.02(l) et seq., and 2141 to 2144 et seq. for policies regarding obviousness rejections. Therefore, it cannot be said that the new proposed obviousness rejection based on DD '314 is "explicitly or implicitly" set forth via the detailed explanation for the proposed anticipation rejection over DD '314 for claims 1-6 and 9.

The petitioner argues that the content of the request for reexamination does not limit the scope of the examination during the reexamination proceeding. As discussed in more detail in response to Ground B below, while it is true that the Office has the discretion to make rejections that are not explicitly set forth in the request for reexamination, this discretion

does not give the third party requesters any rights to demand that proposed rejections that are not set forth in the request for reexamination in compliance with 35 U.S.C. 311 and 37 CFR 1.915 be adopted or not adopted by the examiner.

The petitioner also states that they could not have presented the proposed obviousness rejection based on DD '314 because they could not know which limitations the examiner would determine to be not taught by DD '314. Petitioner claims that if they had to identify and explain "... every possible permutation" of the proposed rejections, the request would "... increase by many orders of magnitude..." and would not serve the interest of special dispatch. See pages 4-5 of the petition. Petitioner argues that that burden must be placed on the Office. In response, piecemeal prosecution is not condoned and nothing in the reexamination statutes and regulations prevents the identification and explanation of alternative rejections. In fact, the reexamination statutes and regulations clearly demand presentation of all the issues regarding patentability, under both anticipation and obviousness, in the request for reexamination in order for patentability issues to be resolved with special dispatch. In accordance with reexamination laws and policies, the requester must select, identify, and explain the best proposed rejections in the request for reexamination, keeping in mind the requirement for special dispatch in resolving any issues of patentability. Therefore, this argument is not persuasive.

For all these reasons, the request for reexamination did not established the proposed obviousness rejection based on DD '314 in accordance with the requirements of 35 U.S.C. 311(b)(2), and its implementing regulation of 37 CFR 1.915(b)(3).

Ground B:

In the petition, the petitioner states that the Office and the examiner have a duty to provide a thorough determination of patentability, which mandates that the examiner consider the proposed obviousness rejection based on DD '314. See pages 5-8 of the petition. In response, the director finds nothing in the record supports the petitioner's allegation that a thorough examination, in accordance with 37 CFR 1.104, has not been performed. The record clearly shows that the examiner considered all the proposed rejections set forth in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination and provided an Office action which either adopted or not adopted these proposed rejections. All the Office actions articulated reasons for both the adoption and lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948. See the Office actions dated January 19, 2006, July 27, 2007 and May 14, 2009. As discussed above in regard to Ground A, the record also shows that there is nothing that prevented the petitioner from presenting the proposed obviousness rejection based DD '314 in the request for reexamination. 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) clearly require that the requester must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. In

this case, the petitioner (third party requester) decided to provide only the pertinency and manner of applying DD '314 in a proposed anticipation rejection, and not to present the pertinency and manner of applying DD '314 in a proposed obviousness rejection in the request for reexamination.

Furthermore, the record shows that every claim, both original and newly proposed, is currently under a rejection. Neither 37 CFR 1.104 nor *inter partes* reexamination laws and procedures require that examiners must explicitly consider on the record and explain why they are making or not making every possible rejection that is not set forth in a manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). Moreover, the petitioner's citation to MPEP 2658(IV)(B) pertaining to the Office having "discretion" to consider reexamining claims that have not been requested has little relevance to this issue. The fact that the Office has discretion to do a certain act does not require the Office to exercise that discretion in every case. Reexamination laws and policies are clear that examiners are only required to consider whether the claims define a novel and nonobvious invention over the prior art of record in order to answer the issues of patentability raised by the request, and to articulate any grounds of rejection, or reasons for patentability that meets the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), so that the patent owner and the third party requester can understand the grounds and appropriately reply to the Office action. See MPEP 706 and 2660. Therefore, the record does not support petitioner's view that a thorough examination of the claims was not performed unless the examiner explicitly considered on the record the proposed obviousness rejection based on DD '314, which did not meet the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination. Accordingly, for all these reasons, Ground B is not persuasive that the examiner erred in her refusal to consider the new proposed obviousness rejection over DD '314.

Ground C:

First, the petitioner alleges that the issue of obviousness of claims 1-6 and 9 were raised in the request for reexamination. The record does not support this statement for the reasons discussed in regard to Ground A above. Next, petitioner states that the proposed obviousness rejection was made in accordance with 37 CFR 1.947. 37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. See MPEP 2666.05. The new proposed obviousness rejection based on DD '314 was not caused by the patent owner amendment in the paper of March 20, 2006 because the amendment did not amend claims 1-6 and 9. In addition, the patent owner's remarks, dated March 20, 2009, does not bring forth the issue of obviousness of claims 1-6 and 9 based on DD '314. See, e.g., pages 37-39 of the March 20, 2009 remarks. Therefore, the new proposed rejection cannot be said to be responsive to issues raised by the patent owner's remarks.

In the petition, the third party requester states that the proposed obviousness rejection is responsive to the examiner's claim interpretation, which resulted in the examiner determining that DD '314 did not teach all of limitations in claims 1-6 and 9 of the '333 patent and not adopting the proposed anticipation rejection of claims 1-6 and 9. The petitioner shifts the burden to the Office by stating that the examiner had a duty to explicitly consider the proposed obviousness rejection on the record under 37 CFR 1.104. See page 8 of the petition. It is noted, however, that *inter partes* reexamination laws and policies clearly require the requester to set forth all the proposed rejections by supplying the manner and pertinency of applying the references to the claims for which reexamination is requested, with limited exceptions as prescribed in 37 CFR 1.947 and 1.948, in order to achieve "special dispatch" required in reexamination proceedings. 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. See MPEP 2666, 2672, and 2673. Accordingly, the Office's rules and procedures do not categorically deprive the third party requester of its statutory rights to present proposed rejections in reexamination proceedings. As explained in regard to Ground A above, the requester did not set forth a proposed obviousness rejection of claims 1-6 and 9 based on DD '314 in the request for reexamination. Therefore, to allow a requester to set forth additional proposed rejections only after the examiner determines that they did not meet their burden in establishing a prima facie case of unpatentability for certain proposed rejections would lengthen reexamination proceedings, which is clearly against the statutory mandate of "special dispatch." The petitioner argues that these policies resulted in "truncated patentability analyses and a discharge of the duties and obligations of the PTO." As explained in response to Grounds A and B, petitioner chose not to include the proposed obviousness rejection, in compliance with the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination. By failing to include the proposed obviousness rejection in the request, the requester has no right to demand that the examiner adopt or not adopt the proposed obviousness rejection. Furthermore, to the extent that this ground is arguing the appropriateness of the examiner's claim interpretation, this issue touches on matters that are appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201. Specifically, MPEP 1202 states "[t]he line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition<, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

MPEP 2666.05 states, in part, that "...a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester." Similarly, a determination by the examiner that a reference does not anticipate a claim does not permit the requester to then present a new

proposed rejection based the same reference but under another ground. Petitioner disagrees with this statement, but there is no doubt that the analysis performed in determining a prima facie case of anticipation is clearly different from the analysis performed in determining a prima facie case of obviousness. For evidence, see MPEP 706.02(a), 706.02(f) et seq., and 2131 to 2136 et seq. for policies regarding anticipation rejections and MPEP 706.02(l) et seq., and 2141 to 2144 et seq. for policies regarding obviousness rejections. Therefore, it cannot be said that the new proposed obviousness rejection based on DD '314 is responsive to the lack of the adoption of the proposed anticipation rejection over DD '314 for claims 1-6 and 9. The requester's appropriate response to the lack of the adoption of the proposed anticipation rejection of claims 1-6 and 9 is to argue and present evidence why the examiner's claim interpretation is overly narrow and/or how DD '314 does indeed teach all the claim limitations. The requester presented such arguments in their comments. See, e.g., pages 3-10 and 36-38 of the April 19, 2006 comments. Accordingly, the requester was able present their comments in response to the lack of the adoption of the proposed anticipation rejection of claims 1-6 and 9 over DD '314 without the new proposed obviousness rejection, and nothing more is authorized by 37 CFR 1.947. Therefore, the new proposed obviousness rejection of claims 1-6 and 9 over DD '314 is not limited to issues raised by the patent owner or the Office action. Accordingly, the new proposed obviousness rejection is not authorized by 37 CFR 1.947, and the examiner did not err in not considering this new proposed rejection.

Ground D:

The petitioner states that neither 37 CFR 1.947 nor MPEP 2666.05 precludes the requester's new proposed obviousness rejection of claims 1-6 and 9 over DD '314. For the reasons expressed above pertaining to Ground C, both 37 CFR 1.947 and MPEP 2666.05 authorize the examiner to not consider the new proposed obviousness rejection in the interest of "special dispatch." Furthermore, as explained above in regard to Ground A, the request for reexamination did not raise the issue of obviousness of claims 1-6 and 9 over DD '314 because the request failed to provide the detailed explanation in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) for the proposed obviousness rejection. In addition, as explained above in regard to Ground B, the record does not support petitioner's view that a thorough examination of the claims was not performed (or that a "truncated patentability analyses" was performed) because the examiner did not explicitly considered on the record the proposed obviousness rejection based on DD '314. The examiner has the discretion to not consider the proposed obviousness rejection because it did not meet the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) and 1.947. Therefore, this ground is not persuasive that the examiner erred in her refusal to consider the new proposed obviousness rejection of claims 1-6 and 9 over DD '314.

Ground E:

The petitioner states that the "highly pertinent" nature of DD '314 requires the consideration of the new proposed obviousness rejection of claims 1-6 and 9 over DD '314. This argument essentially repeats the arguments made to support Grounds A and B, and for same reasons expressed above, this ground does not show that the examiner erred in denying consideration of the new proposed obviousness rejection.

In conclusion, the examiner appropriately denied consideration of the new proposed obviousness rejection of claims 1-6 and 9 over DD '314 in the interest of "special dispatch." Accordingly, the examiner correctly applied Office policies and procedures in determining that the new proposed obviousness rejection is not appropriately raised. For the reasons set forth above, it is deemed that August 21, 2009 decision properly determined that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not consider the new proposed obviousness rejection. For all the reasons discussed above, the petition for reconsideration is **denied**.

REQUESTER'S RECOURSE

The third party requester has the following possible courses of action if the third party requester desires to bring the newly presented proposed rejections before the Office:

1. Initiate an *ex parte* reexamination of the '333 patent based on the proposed obviousness rejection based on DD '314 by filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.
2. File a petition under 35 U.S.C. 317(a) to authorize the filing of a new *inter partes* reexamination of the '333 patent based on the proposed obviousness rejection. If granted, the request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the examiner's refusal to consider the new proposed obviousness rejection of claims 1-6 and 9 over DD '314 is **denied**. This decision is **not** a final agency decision. See MPEP 1002.02 and 1002.02(c).

2. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361, or in his absence, to Gregory Morse, Director of the CRU, at (571) 272-3838.

Irem Yücel, Director
Technology Center 1600

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JUN 16 2010

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(Courtesy Copy)

In re Metzger	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,115	:	UNDER 37 CFR 1.181
Filed: November 28, 2005	:	
For: U.S. Patent No.: 6,523,333	:	

This is a decision on a petition filed by the patent owner on May 19, 2010. The petition is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the amendment filed June 15, 2009, which was filed in response to an Action Closing Prosecution (ACP).

The petition is before the Director of the Central Reexamination Unit. This decision also addresses the ineffective power of attorney and change of correspondence address filed May 19, 2010. In addition, this petition contains a second petition under 37 CFR 1.183, which is deemed improper because combining two distinct petitions is not compliant with 37 CFR 1.4.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated May 19, 2010 is <u>denied</u> with respect to entering the post-ACP amendment into the record of the *Inter Partes* reexamination proceeding 95/000,115.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,523,333 (hereinafter, the '333 patent) issued on February 25, 2003.

2. A request for *inter partes* reexamination, assigned control No. 95/000,115, was filed by a third party requester on November 28, 2005.

3. *Inter partes* reexamination was ordered for the '115 reexamination proceeding on January 19, 2006.

4. The patent owner filed a response to the non-final Office action on March 20, 2006. The response included proposed new claims 10-21.

5. The third party filed comments on April 19, 2006 to the patent owner's response.

6. On October 12, 2006, a Notice of Defective Paper was mailed to the patent owner because the amendment filed on March 20, 2006 was not compliant with 37 CFR 1.530.

7. On November 14, 2006, patent owner filed a response to the Notice of Defective Paper.

8. On December 11, 2006, the third party requester filed comments to the patent owner's response of November 14, 2006.

9. On July 27, 2007, the Office mailed a second non-final Office action that was responsive to the papers filed March 20, 2006, April 19, 2006, November 14, 2006, and December 11, 2006.

10. On August 27, 2007, the paper owner filed a response to the second Office action, which included proposed new claims 22-27.

11. On September 26, 2007, the third party requester filed comments on the August 27, 2007 patent owner's response.

12. On September 29, 2008, a Notice re Defective Paper was mailed to both the patent owner and the third party requester because both the August 27, 2007 and the September 26, 2007 papers failed to comply with *inter partes* reexamination rules and procedures.

13. On October 28, 2008, the patent owner filed a response to the Notice re Defective Paper, which included proposed new claims 22-27.

14. On October 29, 2008, the third party requester filed two sets of comments in response to the Notice re Defective Paper. One set of comments argued that the Notice re Defective Paper was made in error and that the requester appropriately proposed an obviousness rejection based on DD '314 when the examiner did not adopt the proposed anticipation rejection set forth in the request for reexamination. The other set of comments did not contain such arguments or any proposed obviousness rejection based on DD '314.

15. On May 14, 2009, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments.

16. On June 2 and 15, 2009, patent owner filed remarks in response to the ACP.

17. On April 15, 2010, the Office mailed a Right of Appeal Notice (RAN), which denied entry of the post-ACP amendment to the claims. See pages 1-2 of the RAN.

18. On May 19, 2010, the patent owner filed the instant petition, requesting entry of the post-ACP amendment. The patent owner also filed a Notice of Appeal on the same day.

POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

The power of attorney and change of correspondence address filed on May 19, 2010 in this reexamination proceeding is ineffective. The official correspondence address of record for the patent owner in this reexamination proceeding is the correspondence address as recorded in the patent file, application no. 09/731,145.[1] In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, is Leo A. Metzger, 4127 Dungan Rd., Circleville, OH 4313. A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Roger Gilcrest. In the absence of a filing of a change of power of attorney and correspondence address in the patent file, i.e., in application no. 09/731,145, however, any future correspondence in this reexamination proceeding will be mailed to the patent owner only at the official correspondence address of record in the patent file, application no. 09/731,145.

PETITION UNDER 37 CFR 1.183

The petition filed May 19, 2010 by the patent owner contain two distinct petitions, including a petition under 37 CFR 1.181 and a petition under 37 CFR 1.183 requesting an extension of time to filed the appeal brief via waiver of a rule.

[1] See 37 CFR 1.33(c) and MPEP 2622.

Only the petition filed under 37 CFR 1.181 is before the Central Reexamination Unit of the United States Patent and Trademark Office.

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Because petitions filed under 37 CFR 1.183 are decided by the Office of Patent Legal Administration while petitions filed under 37 CFR 1.181 are decided by the Central Reexamination Unit, the patent owner must submit the petition under 37 CFR 1.183 in a separate paper to avoid confusion and delay.

Only the petition under 37 CFR 1.181 is addressed in this decision.

DECISION ON PETITION UNDER 37 CFR 1.181

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed post-ACP amendment[2] because the proposed amendment "... substantially focuses and clarifies the issues on appeal by more concisely defining the invention over the prior art as described therein." See page 5 of the petition. The petitioner also states that the examiner fails to show how entry of the post-ACP amendment would be an "undue burden" on the examiner. See page 6 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed post-ACP amendment, the Director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Furthermore, MPEP 2673 states that:

> It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts

[2] The post-ACP amendment was originally filed on June 2, 2009 and resubmitted on June 15, 2009 with a paper showing support for the claim amendments to the proposed new claims 11, 14, 18, 22, 24, and 27.

> examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.
>
> Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.
>
> In view of the fact that the patent owner cannot 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 request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is encouraged to enter such an amendment unless the entry would cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden."

Turning to the facts in this proceeding, the record shows that there have been two non-final Office actions to which patent owner has responded with amendments that were entered into the record. New claims 10-21 were entered into the record prior to, and acted upon in the second non-final Office action on July 27, 2007. New claims 22-27 were filed as a supplemental amendment but not entered by the examiner prior to the second non-final Office action. See page 1 of the July 27, 2007 Office action. The ACP appears to set forth essentially the same grounds of rejection based on prior art as set forth in the first two non-final Office actions, and more importantly, does not introduce any new grounds of rejection not necessitated by amendments to the claims or proposed new claims.

In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed post-ACP amendment of June 15, 2009 because the proposed amendment would have clarified and focused the issues on appeal. The petition, however, fails to make any showing to support the statements that the post-ACP amendment do simply and clarify issues for appeal and could not have been earlier presented. Furthermore, the petition states that the examiner did not make the required showing that entry of the amendment is an "undue burden." However, the examiner did make such a showing. See page 2 of the RAN. Specifically, the examiner explained how entry of the post-ACP amendment would raise new issues under 35 U.S.C. 112, first paragraph (see paragraph 1a in the RAN) and how the proposed post-ACP amendment is not compliant with Office rules and policies in the presentation of claims amendments (see paragraph 3 in the RAN). Therefore, the record shows that the examiner did make a showing of "undue burden" to support her determination that entry of the proposed post-ACP amendment should not be entered in accordance with the statutory mandate of "special dispatch."

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the post-ACP amendments.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP amendment in the '115 reexamination proceeding is denied.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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MAILED

MAR 30 2009

OFFICE OF PETITIONS

OWEN K. DUKELOW (For Requester)
KOLISH HARTWELL PC
200 PACIFIC BUILDING
520 S.W. YAMHILL ST.
PORTLAND OR 97204

In re Murray	:	
Inter Partes Reexamination	:	
Certificate No. 6,553,794 C1	:	DECISION GRANTING PETITION
Certificate Issued: June 17, 2008	:	
Control No. 95/000,116	:	
Request Deposited: November 23, 2005	:	
Attorney Docket No. 14572P-002871US	:	
For: U.S. Patent No. 6,553,794	:	

This is a decision on the petition filed on August 25, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified reexamination certificate by way of a Certificate of Correction.

The request is **GRANTED**.

As the error was not made by the applicant, no fee is due for this request or for the issuance of a Certificate of Correction.

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

Telephone inquiries concerning this decision may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Anthony Knight
Supervisor
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Third Party Requester)

MAILED

JUN 07 2006

REEXAM UNIT

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,120
Filed: January 17, 2006
For: U.S. Patent No. 6,210,293

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

This is a decision on the April 13, 2006 patent owner petition entitled "PETITION TO VACATE REEXAMINATION ORDERS AS ULTRA VIRES" under 37 CFR 1.181. On April 27, 2006, the third party requester filed an opposition to the present petition entitled "ACUSHNET'S OPPOSITION TO PATENT OWNER'S PETITION TO VACATE REEXAMINATION ORDERS AS ULTRA VIRES."

Both the petition and the opposition are before the Office of Patent Legal Administration for consideration.

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

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,210,293 (the '293 patent) issued to Michael J. Sullivan on April 3, 2001, and is currently assigned to Callaway Golf Company.

2. A request for *inter partes* reexamination of the '293 patent was filed by a third party requester, Acushnet Company (hereinafter "Acushnet"), on January 17, 2006. The request was assigned Control No. 95/000,120 (the '120 *inter partes* reexamination proceeding).

3. On February 9, 2006, the patent owner filed suit against requester Acushnet in the United States District court for the District of Delaware. *Callaway Golf Company v Acushnet Company,* C.A. No. 06-91 (SLR) (February 9, 2006).

4. On February 15, 2006, the third party requester filed a paper purporting to withdraw a paper requesting suspension of the '120 *inter partes* reexamination proceeding stated to have been filed by third party requestor on January 23, 2006.

5. On March 29, 2006, the Office recognized the February 15, 2006 paper, and accepted the withdrawal of the January 23, 2006 paper, noting that, had the January 23, 2006 paper been before the Office, the Offcie would have taken that paper as a petition for suspension of action without rendering a decision on the petition.

6. On March 21, 2006, the patent owner filed a petition, requesting that the '120 *inter partes* reexamination proceeding be suspended.

7. On March 24, 2006, the third party requester filed an opposition to the March 21, 2006 patent owner petition.

8. On March 31, 2006, the Office issued a decision discarding the March, 2006 petition and opposition papers as improper because reexamination had not yet been ordered.

9. Reexamination was ordered for the '120 *inter partes* reexamination proceeding on April 7, 2006.

10. On April 13, 2006 the patent owner filed the present petition under 37 CFR 1.181 to vacate the reexamination orders as *ultra vires*.

11. On April 27, 2006 the third party requester filed an opposition to the April 13, 2006 patent owner petition pursuant to MPEP 2646 (I).

RELEVANT STATUTORY AND REGULATORY LAW AND PROCEDURE

35 U.S.C. § 311(a) provides:

> "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." [Emphasis supplied.]

35 U.S.C. § 312(a) provides in pertinent part:

> "Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director **shall** determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. ... " [Emphasis supplied.]

35 U.S.C. § 313 provides:

> "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination **shall** include an order for *inter partes* reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314." [Emphasis supplied.]

35 U.S.C. 314(c) provides:

c) SPECIAL DISPATCH.- Unless 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.

35 U.S.C. § 317 provides:

"a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION.- Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit ..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings."

37 CFR 1.907 provides in pertinent part:

" (b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office."

MPEP § 2646 (I) provides in pertinent part:

"A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

(A) the reexamination order is not based on prior art patents or printed publications;
(B) reexamination is prohibited under 37 CFR 1.907;
(C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
(D) reexamination was ordered for the wrong patent;
(E) reexamination was ordered based on a duplicate copy of the request; or
(F) the reexamination order was based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding)."

DECISION

Patent owner argues that the order granting reexamination is an *ultra vires* action on the part of the Office because the third party requester, Acushnet, lacked standing to file the *inter partes* request. Patent owner bases this argument on allegations that:

(1) Certain Stipulations of Dismissal resulted in a settlement agreement between patent owner's predecessor in interest, and requester Acushnet entered into a Settlement Agreement on November 10, 1990, for a term of ten years;

(2) The same parties executed a Settlement Agreement in 1996 that superseded the 1990 agreement, and the 1996 Settlement agreement provides, *inter alia,* that the exclusive forum for the third present party requester to resolve patent validity issues with the patent owner is the United States District Court for the District of Delaware; and

(3) The same (present) parties participated in the dispute resolution process pursuant to the 1996 Settlement Agreement, and while the mediation process was underway, Acushnet requester filed a request for the present *inter partes* reexamination proceeding. [1]

It is patent owner's position that filing of the present *inter partes* by requester Acushnet violates the aforementioned Settlement Agreement, and that Acushnet therefore does not have standing to file and maintain the present request for *inter partes* reexamination. [2] However, taking the facts as given by patent owner are accurate, and that there is a valid Settlement Agreement between patent owner and requester Acushnet, [3] patent owner has simply <u>not</u> established that the order granting the present *inter partes* reexamination proceeding is an *ultra vires* action on the part of the Office.

First, the reexamination statute governing *inter partes* reexamination permits the filing of a request for *inter partes* reexamination of a qualifying patent by **any party at any time**; [4] and it further <u>requires</u> the USPTO Director to (1) determine, within three months of the filing of the request, whether the request raises a substantial new question of patentability affecting any claim of the patent, [5] (2) order and conduct *inter partes* reexamination when such substantial new question is found, [6] and (3) conduct the *inter partes* reexamination proceeding with special dispatch. [7] Patent owner has not cited authority that holds that an agreement by parties in any way relieves the Office from the duty to faithfully follow the mandatory requirements of the *inter partes* reexamination statute, when a party files a request for *inter partes* reexamination. Neither has patent owner cited authority for the proposition that private parties, by agreement, may abrogate the statutory jurisdiction conferred upon the Office to decide the merits of a

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[1] See patent owner's Petition, pages 2-3.
[2] *Id.*, at pages 4-6
[3] Patent owner has not established the Office has jurisdiction to make a determination regarding the validity and applicability of the Settlement Agreement, or to make any findings regarding the facts alleged in patent owner's petition or the third party requester's opposition to patent owner's petition. No such determination has been, or will be, undertaken by the Office.
[4] 35 U.S.C. §311(a)
[5] 35 U.S.C. § 312(a)
[6] 35 U.S.C. § 313
[7] 35 U.S.C. § 314(c)

request for *inter partes* reexamination and to thereafter conduct an *inter partes* reexamination within the framework provided by the statutes and regulations.

Second, a contractual provision preventing a party from seeking reexamination would be void as being contrary to public policy [8]. In *Lear v. Adkins*, 395 U.S. 653, (1969), the United States Supreme Court determined that prohibiting licensees from challenging the validity of a patent that they had licensed runs afoul of public policy "in permitting full and free competition in the use of ideas which are in reality part of the public domain." *id.* at 670 . By analogy, preventing a third party requester (and a potential licensee of the subject patent) from requesting reexamination of a patent would be contrary to the public policy embodied in the *Lear v. Adkins* decision. It should also be noted that the settlement agreements entered into in 1990 and 1996 are prior to the enactment in 1999 of the statute authorizing *inter partes* reexamination. Thus it was not even possible for these settlement agreements to address preventing a party to the agreement from filing such a request for reexamination.

Third, MPEP § 2646 (I) sets forth examples of appropriate circumstances that would require the Office to vacate an order for *inter partes* reexamination after granting the order. These circumstances include (1) orders in which a substantial new question of patentability was found based on evidence other than prior art patents or printed publications, (2) circumstances in which estoppels established by 35 U.S.C. § 317(b) as implemented by 37 CFR 1.907 arise out of litigation between the parties **on the patent for which reexamination has been ordered** or the existence of a pending *inter partes* reexamination proceeding on a patent for which *inter partes* reexamination has again been requested by the same party or a party in privity with the requester, (3) the existence of a final, non-appealable Federal Court decision holding all claims of a patent for which *inter partes* reexamination has been ordered invalid, (4) an *inter partes* reexamination order for the wrong patent, or on duplicate copies of the same request for *inter partes* reexamination, and (5) an *inter partes* reexamination ordered based entirely upon the same question of patentability previously considered in an early concluded examination of the patent by the Office. These circumstances address either the issue of a statutory prohibition barring the grant of a request for *inter partes* reexamination, or the grant of an order for reexamination based upon a clear error of a clerical nature. Patent owner has not established that the present *inter partes* reexamination proceeding was ordered contrary to a statutory prohibition barring the order, or due to a clerical error.

Finally, while Congress did establish statutory estoppels requiring either the denial of a request for *inter partes* reexamination, [9] or the conclusion of a pending *inter partes* reexamination proceeding, [10] patent owner has not demonstrated the existence of 35 U.S.C. § 317 estoppel. If Congress had intended for any other basis for an estoppel to apply, it would have included such other basis in the statute. Congress did not provide for an "estoppel" arising out of a settlement agreement or other contractual agreement between parties.

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[8] *Bremen v. Zapata Off-Shore Co.*, 407 U.S. 1 (1972)(concluding that a forum selection clause, while generally enforceable, will not be enforced where it violates the strong public policy of the forum in which suit is brought); *Newton v. Rumery*, 480 U.S. 386,392 (1987) ("The relevant principle is well established: a promise is unenforceable if the interest in its enforcement is outweighed in the circumstances by a public policy harmed by enforcement of the agreement."); *Suter v. Munich Reinsurance*, 223 F.3d 150 (3d Cir. 2000) (citing *Bremen* for the proposition that federal forum selection clauses should not be enforced where they are contrary to public policy).

[9] 35 U.S.C. § 317(a)

[10] 35 U.S.C. § 317(b)

It is additionally noted that petitioner patent owner requests that the Office return jurisdiction to the District Court conducting the litigation. [11] It is to be observed, however, that Congress provided in 35 U.S.C. § 317(b) that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously. It is only when one proceeding finally ends, that the issues raised (or that could have been raised) with respect to the validity of a claim in that one proceeding can have estoppel effect on the same issues in the other proceeding. Such is not the case in the present instance. The Office is thus obligated to move forward in the instant *inter partes* reexamination with "special dispatch" despite the presence of the litigation. The present request to vacate/withdraw the instant *inter partes* reexamination request cannot be granted in view of the legislation and implementing rules which require that (1) once an *inter partes* reexamination request is filed, it will be decided, and (2) once the request is determined to raise a substantial new question of patentability of a claim of the patent, the request *will* result in an order for reexamination to resolve the substantial new question, which in turn *will* be followed by reexamination in accordance with 35 U.S.C. §§ 311-314. The statutory language is based on the **public interest** in resolving any reexamination proceeding that is filed.

Withdrawal of a requested and granted *inter partes* reexamination proceeding would leave both the public and the patent owner with an unresolved request for reexamination and unresolved substantial new question of patentability (found to be present via the decision ordering reexamination). The public has a right to such a resolution. Vacating, withdrawing, or otherwise abandoning or terminating the instant reexamination proceeding would abrogate this public right. Rather, the proceeding must continue according to the procedure mandated by the *inter partes* reexamination statute.

In *Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001), the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

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

The court went on to state:

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

After a review of the record, and based upon the above discussion, it is found that patent owner has not established that the Office "clearly exceeded its statutory authority," nor acted "in brazen defiance of its statutory authorization," in the Office's determination that the January 17, 2006 reexamination request properly raised a substantial new question of patentability and should go forward.

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[11] Presumably *Callaway Golf Company v Acushnet Company*, C.A. No. 06-91 (SLR) (February 9, 2006), discussed briefly above.

For the forgoing reasons, the order granting reexamination remains intact and the *inter partes* reexamination proceeding will continue in accordance with the procedure mandated by the *inter partes* reexamination statute.

CONCLUSION

1. The patent owner petition filed on April 13, 2006, is dismissed.

2. A copy of this decision will be made of record in the IFW of the '120 *inter partes* reexamination proceeding.

3. Jurisdiction over the '120 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit.

4. Telephone inquiries related to the present decision should be directed to Stephen Marcus, Legal Advisor, at 571-272-7743, or, in his absence, to Karen Hastings, Legal Advisor, at 571-272-7717.

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

kmh
June 1, 2006

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(For Patent Owner)

MAILED

JUL 19 2006

CENTRAL REEXAMINATION UNIT

Alan M. Grimaldi
Howrey LLP
1299 Pennsylvania Avenue NW
Washington, DC 20004

(For Third Party Requester)

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,120
Filed: January 17, 2006
For: U.S. Patent No. 6,210,293

: **DECISION DENYING**
: **PETITION**

This is a decision on the April 28, 2006 patent owner petition entitled "RENEWED PETITION TO SUSPEND INTER PARTES REEXAMINATION PROCEEDINGS." Also, on May 5, 2006, the third party requester filed a paper entitled "ACUSHNET'S OPPOSITION TO PATENT OWNER CALLAWAY'S RENEWED PETITION TO SUSPEND INTER PARTES REEXAMINATION PROCEEDINGS."

Inter partes reexamination control number 95/000,120, patent owner's renewed petition, and requester's opposition to patent owner's renewed petition are before the Office of Patent Legal Administration for consideration.

Patent owner's present petition is taken as a renewed petition under CFR 1.183 for waiver of 37 CFR 1.939, and as a petition under 37 CFR 1.182 for suspension of *inter partes* reexamination proceeding 95/000,120. Third party requester's opposition is also taken as a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.939, and as a petition 37 CFR 1.182 to oppose the patent owner's renewed petition.

FEES

As the fee for the originally filed patent owner petition was not charged, a petition fee of $400.00 under 37 CFR 1.17(f) will be charged to the patent owner's Deposit Account No. 06-1050 as authorized in the April 28, 2006 patent owner renewed petition.

As the fee for the originally filed third party requester opposition to patent owner's petition was not charged, a petition fee of $400.00 under 37 CFR 1.17(f) will be charged to the third party requester's Deposit Account No. 08-3038, as authorized in the May 5, 2006 third party requester renewed opposition.

SUMMARY

The respective 37 CFR 1.183 aspect of the petition of the patent owner to permit entry and consideration of the renewed patent owner petition as a petition to suspend the present *inter partes* reexamination proceeding, and of the third party requester to permit entry and consideration of the third party requester's opposition to the renewed petition to suspend, are granted.

The patent owner renewed petition under 37 CFR 1.182 to suspend the present *inter partes* reexamination proceeding is denied.

REVIEW OF FACTS

1. U.S. Patent No. 6,210,293 ("the '293 patent") issued to Michael J. Sullivan on April 3, 2001, and is currently assigned to Callaway Golf Company.

2. A request for *inter partes* reexamination of the '293 patent was filed by a third party requester, Acushnet Company, on January 17, 2006. The request was assigned Control No. 95/000,120 ("the '120 *inter partes* reexamination proceeding").

3. On February 9, 2006, the third party requester filed a paper purporting to withdraw a paper requesting suspension of the '120 *inter partes* reexamination proceeding stated to have been filed by third party requester on January 23, 2006.

4. On February 16, 2006, the Office recognized the requester's February 9, 2006 paper, and accepted the withdrawal of the January 23, 2006 paper, noting that, had the January 23, 2006 paper been before the Office, the Office would have taken that paper as a petition for suspension of action without rendering a decision on the petition.

5. On March 21, 2006, the patent owner filed a petition, requesting that the '120 *inter partes* reexamination proceeding be suspended.

6. On March 24, 2006, the third party requester filed an opposition to the March 21, 2006 patent owner petition.

7. On April 11, 2006, an Office decision was issued, discarding both the March 21, 2006 patent owner petition and the March 24, 2006 opposition thereto as being improper premature papers.

8. On April 6, 2006, reexamination was ordered for claims 1-6, i.e. all of the claims, of the '293 patent.

9. On April 13, 2006, patent owner filed a petition requesting that the order granting the present reexamination proceeding be vacated as being an *ultra vires* action.

10. On April 27, 2006, third party requester filed an opposition to patent owner's April 13, 2006 petition.

11. On April 28, 2006, patent owner filed the present renewed petition to suspend the '120 *inter partes* reexamination proceeding.

12. On May 5, 2006, third party requester filed the present opposition to the April 28, 2006 patent owner petition.

13. On June 7, 2006, the patent owner petition to vacate the '120 *inter partes* reexamination proceeding was dismissed by the Office.

DECISION

I. Relevant Law And Procedure

35 U.S.C. § 311(a) provides:

> 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." [Emphasis supplied.]

35 U.S.C. § 312(a) provides in pertinent part:

> "Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director **shall** determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. ... " [Emphasis supplied.]

35 U.S.C. § 313 provides:

> "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination **shall** include an order for *inter partes* reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314." [Emphasis supplied.]

35 U.S.C. § 314 (c) provides:

> "Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

37 CFR 1.132 provides:

> "When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section."

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 1.907 provides:

"(a) Once an order to reexamine has been issued under § 1.931, 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 under § 1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding."

37 CFR 1.913 provides:

"Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501."

37 CFR 1.935 provides:

"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(b) provides:

"The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided."

37 CFR 1.939 provides:

"(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." [Emphasis supplied.]

(b) Unless otherwise authorized, **no paper** shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination." [Emphasis supplied.]

37 CFR 1.987 provides:

"If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding."

With respect to suspension of *inter partes* reexamination, MPEP § 2684.04(III) provides that:

> "... 'good cause' might be present, for example, where there is an issue that cannot be decided in the reexamination proceeding but affects the resolution of the proceeding. Another example is where there is an issue common to the litigation and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power (e.g., an issue heavily dependent on presentation of conflicting/contested evidence by the two parties)."

II. Procedural Discussion *Re:* Patent Owner's Original (March 21, 2006) Petition To Suspend

On March 21, 2006, patent owner filed a petition to suspend the '120 *inter partes* reexamination proceeding. In the present petition, patent owner takes the position [1] that the original petition to suspend filed on March 21, 2006 was not entered in the '120 proceeding, and was instead discarded, because it was filed prior to issuance of a reexamination order. This position is inaccurate.

By its terms, 37 CFR 1.939(b) precludes the filing of any paper in an *inter partes* reexamination proceeding prior to "the initial Office action on the merits" in that proceeding, unless the filing of the paper is authorized. At the time of filing of that petition, and at the time of the decision thereon, not only had there been no decision on the request for reexamination, there had also been no Office action on the merits in the *inter partes* proceeding. The patent owner petition of March 21, 2006 was held to be an improper paper under 37 CFR 1.939 because it was filed prior to the issuance of the initial Office action in the reexamination proceeding. [2] Not only had *inter partes* reexamination not yet been ordered, no "initial Office action on the merits of the *inter partes* reexamination" had been promulgated in the '120 *inter partes* reexamination proceeding, and a paper prior to that point is barred by regulation unless authorized, in accordance with 37 CFR 1.939(b). [3]

Although patent owner's March 21, 2006 petition requested relief under 37 CFR 1.183, the regulatory provision that provides for waiver of the rules, [4] there was no specific identification of which regulation that patent owner was seeking to waive. However, even if waiver of the provisions of 37 CFR 1.939 had been specifically requested, the March 21, 2006 patent owner petition could not have been granted. As explained in the decision dated April 11, 2006 (by which the March 21, 2006 patent owner petition and third party requester opposition were discarded as being improper papers), U.S.C. § 312(a) requires, *inter alia,* that after a request for *inter partes* reexamination is filed, the Director shall, within three months of the filing of a request for *inter partes* reexamination, determine whether that request raises a substantial new question of patentability affecting any claim of the patent that is the subject of the request. Further, 35 U.S.C. § 313 **requires** that - when the Director does determine that a substantial new question of patentability is raised by the request, then the determination shall include an order for *inter partes* reexamination of the patent concerned.

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[1] See patent owner's "Renewed Petition to Suspend, page 2, second full paragraph.

[2] See Decision Discarding Improper Papers", April 11, 2006, page 2, paragraph styled "The Patent Owner Petition"

[3] It appears that petitioner patent owner is confusing the terminology "initial Office action on the merits" with the terminology "reexamination order." The terminology "action on the merits" means an action on the patentability of the claims of the patent being reexamined. See, for example, 37 CFR 1.935 which provides that "The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination." Clearly, a reexamination order and "the initial action on the merits of the reexamination are two different things. See also MPEP Chapter 700, wherein it is made clear that in examination proceedings, "action on the merits" is a term of art meaning an action in which a patentability determination is made.

[4] At page 2 thereof, the March 21, 2006 petition requested relief under a variety of regulations, as well as relief pursuant to 35 U.S.C. § 314(c), as does the present renewed petition.

It is clear that consideration of the substance of patent owner's March 21, 2006 petition, and granting it, would have, in effect, required a waiver of 35 U.S.C. §§ 312(a) and 313, because a suspension of the '120 *inter partes* reexamination proceeding would have precluded both a determination of the existence or absence of a substantial new question of patentability, and the promulgation of a reexamination order based on that determination within three months of the filing of the request for reexamination, as required by §§ 312(a) and 313. However, a waiver of the statutes is an action beyond the authority of the Director, and 37 CFR 1.183 expressly recognizes that a requirement of the statutes may not be waived. Therefore, a suspension of the '120 *inter partes* reexamination prior to the determination on the request for reexamination promulgation of the reexamination order, based upon any petition by the parties, was barred.

III. Procedural Discussion *Re:* The Present Patent Owner Renewed Petition To Suspend

In the present patent owner renewed petition, patent owner takes the position that because an Order granting *inter partes* reexamination has now been issued, the petition to suspend is a proper paper. Patent owner also takes the position that the present renewed petition, (as well as patent owner's March 21, 2006 petition to suspend), is proper because it is authorized by 37 CFR 1.987. [5]

A. Relief Pursuant to 37 CFR 1.939

Patent owner argues that the present patent owner petition to suspend the '120 reexamination proceeding is now timely under 37 CFR 1.939(b) as reexamination has already been ordered. This position is not persuasive because, as discussed in section II., *supra,* an order for *inter partes* reexamination is not the initial Office action on the merits of the *inter partes* reexamination proceeding. "Action on the merits" is a term of art, and as such, means an action on the patentability of claims. It is clearly so used in the reexamination regulations, for example, in 37 CFR 1.935. [6] Thus, it is clear that the filing of the present patent owner renewed petition to suspend is not authorized by 37 CFR 1.939(b), because the "initial action on the merits " of the '120 *inter partes* reexamination proceeding has not yet been issued by the Office.

B. Relief Pursuant to 37 CFR 1.987

The patent owner's argues that 37 CFR 1.987 independently authorizes the filing of the present petition to suspend. This too is not persuasive. The plain language of the regulation does not state or imply that it in any way authorizes the filing of a petition to suspend, particularly a petition that would be improper pursuant to one or more of the regulations that implement the *inter partes* reexamination statutes. 37 CFR 1.987 is merely declaratory of the Director's discretionary authority to *sua sponte* suspend an *inter partes* reexamination proceeding in certain circumstances, *i.e.,* when there is both: (a) litigation involving the patent which is the subject of the *inter partes* reexamination proceeding and (b) "good cause" to suspend. 37 CFR 1.987 in no way authorizes the filing of a petition to request such a suspension. The right of parties in this arena is the filing of a Notification of Existence of Prior or Concurrent Proceedings and Decisions pursuant to MPEP § 2686 to provide the Office with information which may, or may not, justify a suspension of action.

Patent owner has not cited a regulation that authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. In fact, no regulation implementing the *inter partes* reexamination statutes authorizes such a petition.

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[5] *Id.*, at footnote 1.
[6] See the discussion in footnote 3.

C. Relief Pursuant to Patent Owner's Petition Under 37 CFR 1.182 and 1.183

Note is taken that the present patent owner renewed petition requests relief under both 37 CFR 1.182 and 1.183. Notwithstanding that patent owner has again failed to specifically identify the regulations(s) for which a waiver under 37 CFR 1.183 is requested, the present renewed petition will be taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939 in order to permit the filing of a paper prior to the issuance of the initial Office action on the merits in the '120 *inter partes* reexamination proceeding. Further, the present renewed petition will also be taken as a petition under 37 CFR 1.182 for a situation "not specifically provided for in the regulations" to permit the filing of a petition to suspend the '120 *inter partes* reexamination proceeding.

1. 37 CFR 1.183 Waiver of 37 CFR 1.939

As discussed in sections I. and II (A), *supra*, 37 CFR 1.939(b) precludes the filing of any paper prior to the initial Office action on the merits of the '120 *inter partes* reexamination proceeding. As no initial Office action on the merits has yet been issued, no patent owner paper may be filed in the '120 *inter partes* reexamination proceeding at this point in the proceeding. However, *inter partes* reexamination has now been ordered. [7] Therefore, suspension of the '120 *inter partes* reexamination proceeding would not require the waiver of any provision of the *inter partes* reexamination statutes; only a waiver of 37 CFR 1.939(b) would be needed to provide for an entry right of the petition paper requesting suspension.

In this instance, it is determined to be in the interests of justice with respect to both parties to the '120 *inter partes* reexamination proceeding that a decision regarding suspension of the '120 *inter partes* proceeding be made as soon as possible, given that (1) a suspension of the proceedings would not impair compliance with the reexamination statutes, and (2) extraordinary circumstances are found to exist, including the fact that this proceeding is but one of four *inter partes* proceedings in which the present parties are involved, and that the present parties are actively involved in litigation with respect to the patents that are the subject of those four *inter partes* reexamination proceedings. Rather than requiring patent owner and third party requester to re-file the petition and opposition thereto after a first action on the merits, it is appropriate to consider the question of suspension now. Further, if suspension were in fact warranted, it would be in the interests of justice that such suspension takes place prior to an action on the patentability of the claims. Finally, there is a public interest, and an interest to be considered by the court in the ongoing litigation, to ascertain, as soon as practical, whether the '120 *inter partes* reexamination proceeding will continue to conclusion, or will presently be suspended pending the outcome of the parallel litigation involving the '293 patent, as well as such future circumstance that would demand that a suspension be lifted, if imposed.

Accordingly, based upon the facts of record and the current circumstances set forth, *supra*, the provisions of 37 CFR 1.939 are waived to the extent necessary to permit filing of the present patent owner renewed petition and the requester's opposition to the renewed petition, and consideration of the substance of both the petition and the opposition.

2. 37 CFR 1.182 Petition to Suspend the '120 *Inter Partes* Reexamination Proceeding

As discussed Section III(B), *supra*, neither 37 CFR 1.987 nor any regulation implementing the *inter partes* reexamination statutes authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. However, the present patent owner renewed petition does request

[7] See the "Order Granting *Inter Partes* Reexamination" dated April 6, 2006.

consideration pursuant to 37 CFR 1.182, and a proposed suspension of an *inter partes* reexamination proceeding is a situation not specifically provided for in the regulations. For the reasons set forth in the second paragraph of section III(C)(1), *supra*, and based upon the facts of record and the current circumstances, consideration will be given to the substance of the present patent owner renewed petition to suspend the '120 *inter partes* reexamination proceeding, as a situation not specifically provided for in the regulations.

IV. Procedural Discussion Of The Third Party Requester Renewed Opposition

The third party requester renewed opposition filed on May 5, 2006, lacks an entry right under 37 CFR 1.939(b) for the same reasons discussed with respect to the renewed patent owner petition. Further, the regulations implementing the *inter partes* reexamination statutes do not expressly provide for the filing of an opposition paper to a patent owner request to suspend an *inter partes* reexamination proceeding.

However, third party requester has submitted the instant opposition pursuant to 37 CFR 1.182 and 1.183. For reasons analogous to those discussed above with respect to the patent owner's renewed petition, the provisions of 37 CFR 1.939 are waived to the extent necessary to permit the filing of the instant opposition to the present patent owner's renewed petition prior to the initial Office action on the merits in the '120 *inter partes* reexamination proceeding. Although the regulations do not specifically provide for a third party requester opposition to a patent owner petition to suspend an *inter partes* reexamination proceeding, for reasons analogous to those discussed above with respect to the patent owner's renewed petition, consideration will be given, pursuant to 37 CFR 1.182, to the requester's opposition to the patent owner's renewed petition.

V. Findings And Analysis On The Merits Of Patent Owner's Renewed Petition to Suspend

A. Patent Owner's Substantive Position In Support Of Suspension of the '120 *Inter Partes* Reexamination Proceeding

Patent owner states that pursuant to 35 U.S.C. § 314 (c), and the procedure discussed in MPEP § 2686.04(III), there is good cause to suspend the '120 *inter partes* reexamination proceeding. Patent owner asserts the existence of matters to be raised in the concurrent litigation that are argued to affect the resolution of the '120 *inter partes* reexamination proceeding or potentially bar the proceeding. Patent owner also raises issues in which the District Court's discovery and subpoena powers are asserted to be important in deciding matters heavily dependent upon the evidentiary showings of the parties.

1. Matters Involving Privity And Assignor Estoppel [8]

Patent owner states that the sole inventor of the '293 patent is Michael J. Sullivan, who is now a Vice President of third party requester business entity. Patent owner urges that 37 CFR 1.913 [9] is facially broad enough to cover both current and former patent owners and current and former privies, to bar *inter partes* reexamination. Patent owner argues that Mr. Sullivan is a

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[8] See *Shamrock Technologies, Inc. v. Medical Sterilization, Inc. and Robert S. Luniewski*, 903 F.2d 789; USPQ2d 1728 (Fed. Cir. 1990), and compare *Acushnet Company v. Dunlop Maxfli Sports Corporation*, 2000 U.S. Dist. LEXIS 10123, Civ. A. No. 98-717-SLR, (D. Del June 29, 2000).

[9] Pursuant to 37 CFR 1.913, a request for *inter partes* reexamination can be filed by any person other than patent owner or its privies.

privy of a former patent owner [10] to whom the '293 patent was originally assigned, and that 37 CFR 1.913 should have precluded the filing of the '120 *inter partes* reexamination proceeding.

Patent owner further alleges that, as a Vice President of third party requester, Mr. Sullivan may well be a privy of third party requester. Patent owner argues that the third party requester would therefore be barred from challenging the validity of the '293 patent via the '120 *inter partes* reexamination proceeding by the doctrine of assignor estoppel.

Patent owner's position is that a suspension of the '120 *inter partes* reexamination proceeding is necessary, because these issues can only be resolved by evidence that can uniquely be obtained through the use of the District Court's discovery and subpoena power.

2. Additional Matters Requiring The District Court's Discovery And Subpoena Power

Patent owner also urges that the use of the District Court's discovery and subpoena power is required to permit full and fair evaluation of testing undertaken by third party requester that is relied upon by third party requester to support its allegations of patent invalidity. Patent owner points out that third party requester relies upon an invalidity argument under 35 U.S.C. § 103, that objective evidence of commercial success of both the patent owner and an alleged infringer (the third party requester) is relevant to § 103 nonobviousness. Patent owner argues that access to evidence that would establish commercial success of the third party requester's accused products could be obtained utilizing the District Court's discovery and subpoena powers.

B. Established Standards Demonstrating The Existence of "Good Cause" For Suspension Of *Inter Partes* Reexamination Proceedings

35 U.S.C. § 305 requires that all *ex parte* reexamination proceedings be conducted with special dispatch within the Office. It has been held that, based on the unequivocal statutory requirement for special dispatch, the Office may not suspend a pending *ex parte* reexamination proceeding merely because of the existence of concurrent litigation on the patent that is the subject of reexamination. [11] *Ethicon* discusses certain fundamental concepts regarding concurrent *ex parte* reexamination proceedings in the Office and litigation of the patent that is the subject of reexamination. For example the *Ethicon* court quoted extensively from the decision of the court in *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4, (Fed Cir. 1985) (in banc) to point out:

> "That:one challenging validity in court bears the burden assigned by [35 U.S.C.] § 282, that the same party may request reexamination upon submission of art not previously cited, and that, if that art raises a substantial new question of patentability, the PTO may during reexamination consider the same and new and amended claims in light of that art free of any presumption, *are concepts not in conflict.* On the contrary, those concepts are but further indication that *litigation and reexamination are distinct proceedings, with distinct parties, purposes, procedures, and outcomes.*" [Emphasis is the Court's.]

The *Ethicon* court also cited *Etter* in order to point out that when reexamination and litigation for the same patent are conducted concurrently:

> "...precise duplication of effort does not occur because the PTO and the courts employ different standards of proof when considering validity, and the courts, unlike the PTO during a reexamination of patent claims, are not limited to review of prior art patents or printed publications."

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[10] The present patent owner acquired rights to the '293 patent from the original owner, Top-Flite.

[11] *Ethicon, Inc., v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988)

Id., at 856, at 4.

In contrast to the 35 U.S.C. § 305 which applies only to *ex parte* reexamination, 35 U.S.C. § 314(c) expressly allows for the suspension of an *inter partes* reexamination proceeding within the Office "for good cause," notwithstanding that *inter partes* reexamination proceedings are to be conducted with "special dispatch." Therefore, the question of whether a petition to suspend an *inter partes* reexamination proceeding that is being conducted concurrently with litigation of the patent establishes "good cause" for the suspension of an *inter partes* reexamination proceeding presents a question that differs from the question of suspension of an *ex parte* reexamination proceeding. Pursuant to 35 U.S.C. § 314(c) and 37 CFR 1.987 that implements the statutory provision, the USPTO Director has authority to determine circumstances amounting to "good cause" for suspension of an *inter partes* reexamination proceeding, and to do so on a case-by-case basis.

In *inter partes* reexamination proceedings control numbers 95/000,093 and 95/000,094 (collectively referred to hereinafter as "the Immersion-Sony *inter partes* reexamination proceedings"), the Office granted a patent owner petition to stay the *inter partes* reexamination proceedings due to the existence of concurrent litigation of the patents that were the subject of the reexamination proceedings. [12] The decision suspension granting acknowledged that MPEP § 2684.04 set forth certain criteria as indicia of "good cause" for suspension of an *inter partes* reexamination proceeding, but pointed out that these criteria were merely exemplary. [13] The criteria relied upon by the Office in the Immersion-Sony *inter partes* reexamination proceedings to support a finding of "good cause" to suspend was upheld by the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. This criteria establishes a benchmark and standard which the Office can make use of to test the facts and circumstances of record in a given *inter partes* reexamination proceeding in order to determine whether there is "good cause" to suspend that *inter partes* reexamination proceeding, due to the existence of concurrent litigation of the patent being reexamined.

In the *Sony* scenario:

The patent claims for which *inter partes* reexamination was requested were not identical to the claims being litigated; there was one non-litigated patent claim (claim 1 in each instance) for which reexamination had been requested in each proceeding. The Office denied patent owner Immersion's first petition to suspend the *inter partes* reexamination proceedings, noting that even if the proceedings were suspended in the Office and judgment was rendered adverse to requester Sony in the concurrent litigation, that would not dispose of all claims in the existing *inter partes* reexamination proceedings, leading to a piecemeal reexamination, and a delay in reexamination of the non-litigated claims. [14] The patent owner then disclaimed claim 1 of each patent, whereby <u>identical patent claims</u> were the subject of both the *inter partes* reexamination proceedings and the concurrent litigation. The Office then granted patent owner Immersion's second petition to suspend the *inter partes* reexamination proceedings.

At the point in time that the Immersion-Sony *inter partes* reexamination proceedings were suspended, <u>the proceedings were at an early stage</u>; the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of

[12] See the '093 and '094 proceedings, Decision Granting Petitions To Suspend, November 17, 2005
[13] *Id.*, Decision Granting Petitions To Suspend", November 17, 2005, footnote 6.
[14] *Id.*, "Decision Denying Petitions", August 23, 2005, at page 6.

patentability. The concurrent litigation, on the other hand, was at an advanced stage: (a) a District Court had issued a decision adverse to requester Sony, holding the litigated patent claims to be valid, (b) an appeal of the District Court had been filed in the Court of Appeals for the Federal Circuit ("the Federal Circuit"), and (c) the matter had already been briefed. Thus, there was a substantial likelihood that suspension of the reexamination proceedings would serve to conserve Office of resources, since a final holding of claim validity would statutorily require termination of the Immersion-Sony *inter partes* prosecutions with respect to all of the claims subject to the litigation, which was also all the claims subject to reexamination in those proceedings. It was not in the Office's and parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation which was soon to be finally resolved. The substantial likelihood that the reexamination prosecutions would terminate and the proceedings be concluded, taken together with the identity of claims in the litigation and the *inter partes* reexamination proceedings, led the Office to conclude that on balance, there was "good cause" to suspend the Immersion-Sony *inter partes* reexamination proceedings, to await the decision by the Federal Circuit. The decision granting suspension noted that should circumstances change, *e.g.*, if the matter were remanded to the District Court by the Federal Circuit without a holding on claim validity, the third party would be free to petition for a resumption of the *inter partes* reexamination proceeding based upon the change in circumstances. The decision also noted that further *inter partes* proceedings on the claims not before the Office and the courts could subsequently be obtained by members of the public.

In the present instance:

The facts and circumstances in the '120 *inter partes* reexamination proceeding differ significantly from those present in the Immersion-Sony *inter partes* reexamination proceeding. In contrast to the Immersion-Sony *inter partes* reexamination proceedings, the litigation involving the '293 patent is at an early stage. For example, there is a pending order dated June 2, 2006, referring the matter to a Magistrate Judge for the purposes of exploring joinder of parties, setting September 29, 2006 as a due date for amended papers, and setting a discovery conference for October 18, 2006. The issue of claim construction is still pending, and there are apparently a number of preliminary motions pending. Thus, unlike the Immersion-Sony *inter partes* proceedings in which the litigation had resulted in an appealable holding of claim validity, with the appeal having been filed and briefed to the appellate court, in this instance, it is not even foreseeable when the District Court's holding on the issue of validity might be would be rendered, and what it might be. It certainly cannot be envisioned when the litigation involving the '293 patent will reach a final holding on the validity of the claims of the '293 patent, including any appeal to the Federal Circuit, let alone what that holding is likely to be.

Further, in the '120 *inter partes* reexamination proceeding, patent owner has not established that there that the litigation of the '293 patent will result in a decision on the validity of all of the claims being currently being reexamined, *i.e.*, claims 1-6 of the '293 patent. Thus, it is not even clear that a final holding of claim validity in the litigation would necessarily require conclusion of the '120 *inter partes* reexamination proceeding as to all the claims subject to reexamination.

As a final point, as to the difference:

In the Immersion-Sony *inter partes* proceedings Sony chose to permit the District Court litigation to proceed for three years before filing its requests for reexamination only after judgment was entered in Immersion's favor in the litigation. Had Sony filed its requests for reexamination earlier, the reexamination proceedings could have been much farther along in the process, and may likely have been completed at the Office before the district court issued its decision. Also,

the district court might have stayed the litigation to await the Office's decisions in the reexamination proceedings. In the present instance, the requester has filed the '120 *inter partes* reexamination well before the District Court litigation has advanced to conclusion, and the Office proceedings should be available for the District Court.

In conclusion as to this issue:

Congress specifically provided estoppel provisions when a "final decision" upholding the validity of patent claims has been reached in a civil action or in a prior *inter partes* reexamination. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims. *Id.* Accordingly, while Congress desired that the creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also contemplated in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other. Until that time, however, the Office is obligated to move forward in the *inter partes* reexamination with "special dispatch." Only "good cause" will permit the Office from deviating from that statutory mandate. In this instance, the litigation is at a preliminary stage so that it can not be determined when the litigation will reach a final holding on the issue of claim validity and what that decision is likely to be. Even if there should be a final holding on the issue of claim validity, the patent owner has not established that there is an identity of claims in the '120 *inter partes* reexamination proceeding and those subject to the litigation to thereby statutorily bar proceeding further with the entirety of the reexamination proceeding. Accordingly, the patent owner has not provided the USPTO Director with sufficient basis upon which to conclude that there is "good cause" to suspend the *inter partes* reexamination proceeding to await a final decision on claim validity in the litigation.

C. Other Patent Owner's Allegations That Good Cause For Suspension Exists

The factors alleged by patent owner to present "good cause" for suspension of the '120 *inter partes* reexamination proceeding have been thoroughly considered. However, for the reasons that follow, these factors do not establish "good cause" for suspension.

1. Privity and Assignor Estoppel

Patent owner argues that because Michael J. Sullivan, the sole inventor of the '293 patent, assigned the '293 patent to patent owner's predecessor in interest, the '120 *inter partes* reexamination proceeding was filed by a "former privy" of patent owner and is therefore barred under 37 CFR 1.913. The purpose of 37 CFR 1.913 is simply declaratory of the statutory mandate of 35 U.S.C. § 311(a) that provides that any third-party requester may, at any time, file a request for *inter partes* reexamination. [15] Patent owner has not established that 37 CFR 1.913,

[15] In the Notice of Proposed Rulemaking entitled "Rules To Implement Optional Inter Partes Reexamination Proceedings", 65 Fed. Reg.18154, 18167 (April 6, 2000) it is stated that proposed rule includes the language "an person other than the patent owner or its privies may ... file a request for *inter partes* reexamination." The commentary stated that the proposed rule "provides for any third-party requester ... to file a request for ... an *inter partes* reexamination ...." That is, the proposed rule was thought to simply echo the statutory language. However, the words "other than patent owner or its privies" were deleted from the final rule because a comment to directed proposed rule 1.913 had suggested that the Office had exceeded its authority in excluding patent owner or its privies

nor the statute upon which it is grounded, precludes the filing of a request for *inter partes* reexamination by a party who is a so-called "former privy" of patent owner, especially a party who assigned a patent to an entity other than the present patent owner. Absent citation of controlling authority to the contrary by patent owner, it would appear that the statutory language "any third-party requester" is broadly drawn and would permit a party not in direct privity with a patent owner, i.e., a "former privy" of patent owner, to file a request for *inter partes* reexamination.

Patent owner also argues that the doctrine of assignor estoppel should have precluded the filing of the '120 *inter partes* reexamination proceeding, because sole inventor Sullivan assigned the patent to patent owner's predecessor in interest, but is now a Vice President of the third party requester business entity. However, reexamination is not litigation to determine the validity of patent claims conducted before a court wherein the equitable doctrine of assignor estoppel is applicable. Rather, reexamination is an administrative proceeding to determine the patentability of patent claims, a determination that is not conducted under the equitable considerations attaching to a litigation in which claim validity is determined. As discussed above, *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4, (Fed Cir. 1985) (*en banc*) makes it clear that litigation and reexamination are distinct proceedings with distinct parties, purposes, procedures and outcomes. Stated differently, although the application of the assignor estoppel doctrine in litigation is a fact intensive issue requiring the finding of facts and the balancing of the equities by the court, [16] a reexamination proceeding is not a determination of patent validity and infringement of patent claims. [17] It is also to be noted that a patent owner is statutorily authorized to file a reexamination request to obtain an advisory opinion as to the applicability of a prior patent or printed publication; such an advisory opinion would be prohibited in litigation as lacking a "case or controversy." If a patent owner can request reexamination of a patent, a party who assigned to the patent owner should likewise be permitted to do so. Therefore, absent citation of authority holding that assignor estoppel applies to reexamination so as to bar a statutorily approved request for *inter partes* reexamination filed by "[A]ny third-party requester at any time," assignor estoppel would not appear to apply generally to reexamination, and specifically to the present *inter partes* reexamination proceeding. Patent owner has argued that a suspension of the '120 *inter partes* reexamination proceeding is necessary because the issue of whether the present requester was barred from filing the '120 *inter partes* reexamination proceeding based on assignor estoppel can only be resolved through

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because the language of 35 U.S.C. § 311(c) appeared to permit a patent owner to file a request for an *inter partes* reexamination proceeding. See Final Rule entitled "Rules To Implement Optional Inter Partes Reexamination Proceedings", 65 Fed. Reg. 76756, 76764 (December 7, 2000). However, Public Law 107-273, section 12101, 116 Stat. 1901 amended 35 U.S.C. § 311(c) clarify that only the third party requester, and not a patent owner, may file a request for *inter partes* reexamination. Thereafter, the language "other than patent owner or its privies" was added to 37 CFR 1.913. See Final Rule entitled "Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical amendments to the Patent Statute", 68 Fed. Reg. 70996, 70999 (December 22, 2003).

[16] Compare *Shamrock Technologies, Inc. v. Medical Sterilization, Inc. and Robert S. Luniewski,* 903 F.2d 789, 14 USPQ2d 1728 (Fed. Cir. 1990) holding that because inventor Luniewski who had assigned his patent to Shamrock was now a Vice President of MSI was in privity with MSI, that MSI was barred from asserting patent invalidity and unenforceability as defenses to patent infringement with *Acushnet Company v. Dunlop Maxfli Sports Corporation, Civ. A. No. 98-717-SLR, 2000 U.S. Dist., LEXIS 10123* (D. Del June 29, 2000) distinguishing *Shamrock* holding that where an inventor had assigned a patent to plaintiff and then became a Vice President of defendant accused infringer the facts and equities did not establish that the inventor was in privity with the defendant and that the defense of patent invalidity was, therefore, available to defendant.

[17] See also *Joy Technologies, Inv. v. Harry F. Manbeck, Jr.* 959 F.2d 226, 229 (Fed. Cir. 1992) "Trying to equate its appeal of the reexamination decision to an action analogous to a 'suit at common law,' Joy argues that the reexamination proceeding should be construed as most like a declaratory judgment action where the PTO is seeking a determination that Joy's patent is invalid. It admits, however, that the PTO could not bring such a suit. Thus, there is no basis to recharacterize the statutory procedure established by Congress in the reexamination statute."

evidence obtained through the use of the District Court's discovery and subpoena power to ascertain whether an assignor filed the present request. However, since patent owner has not established that the doctrine of assignor estoppel applies in the administrative reexamination of a patent, patent owner's argument has not been shown to establish "good cause" for suspension of the '120 *inter partes* reexamination proceeding.

2. Additional Matters Requiring The District Court's Discovery and Subpoena Power

Patent owner argues that, in addition to the issues of assignor estoppel and privity, the District Court's discovery and subpoena power is necessary for patent owner to secure objective evidence of commercial success of third party requester's infringing products. Patent owner also argues that patent owner will be able to question tests conducted by third party requester in support of third party requester's arguments of patent invalidity, and that patent owner will be able to obtain the information necessary to question these tests only through the District Court's discovery and subpoena powers. Thus, patent owner reasons that "good cause" exists warranting suspension of the '120 *inter partes* reexamination proceedings.

These arguments are unpersuasive for a number of reasons. First, the provisions of 37 CFR 1.132 apply to the '120 *inter partes* reexamination proceeding, as it does to all *inter partes* reexamination proceedings. Patent owner will in fact have an opportunity in the '120 *inter partes* reexamination proceedings to submit objective test evidence in support of nonobviousness to the same extent that third party requester may submit objective test evidence tending to show nonobviousness. Also, the parties can submit evidence rebutting each other's 37 CFR 1.132 showings. Further, patent owner has submitted no showing that sales of the accused infringer's products are secret data not available publicly, thereby enabling patent owner to secure this data by commissioning research of the matter, without the necessity of the District Court's subpoena and discovery. Speculative allegations that patent owner might require the District Court's subpoena and discovery power in aid of a position taken in litigation does not establish "good cause" for suspension of the '120 *inter partes* reexamination proceeding.

Of greater import, however, is that patent owner's position, if taken to its logical conclusion, would undercut the ability of a third party requester (and, for that matter, a patent owner) to obtain any final result in an *inter partes* reexamination proceeding. Thus, the purpose of the *inter partes* reexamination statutes would be frustrated. For if a party engaged in patent infringement/validity litigation could demonstrate "good cause" for a suspension of an *inter partes* reexamination proceeding merely by invoking the existence of a district court's subpoena and discovery power and coupling that invocation with allegations that the party might need to employ that power in the course of litigation, then any *inter partes* reexamination proceeding for a patent involved in litigation could be readily stayed. It is presumed that if Congress had desired this, Congress would have expressly so stated in the reexamination statutes. However, Congress instead enacted 35 U.S.C. § 314 (c) and the "good cause" standard, a far more flexible and fact specific test allowing the USPTO Director to determine on a case-by-case basis whether to stay a pending *inter partes* reexamination proceeding.

CONCLUSION

1. The patent owner renewed petition filed April 28, 2006, is granted with respect to the relief requested pursuant to 37 CFR 1.183, to the extent that the substance of patent owner's petition to suspend the '120 *inter partes* reexamination proceeding has been considered under 37 CFR 1.182.

2. The substance of the third party requester opposition filed on May 5, 2006, has been considered pursuant to 37 CFR 1.183.

3. The patent owner's petition under 37 CFR 1.182 to suspend the '120 *inter partes* reexamination is denied.

4. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

5. Telephone inquiries related to the present decision should be directed to the Stephen Marcus, Legal Advisor, at 571-272-7743, or, in his absence, to the undersigned at 571-272-7710.

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

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July 13, 2006

7-17-06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,120	01/17/2006	6210293	00634.0004.RXUS01	6322

7590 09/07/2006

Dorothy P. Whelan
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2006

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Alan M. Grimaldi
Howrey LLP
1299 Pennsylvania Avenue NW
Washington, DC 20004

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

REEXAMINATION CONTROL NUMBER *95/000,120*.

PATENT NUMBER *6,210,293*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3793*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

[Enclosure - "REPLY IN SUPPORT OF PETITION FOR RECONSIDERATION OF DECISION ON PETITION TO VACATE ORDER GRANTING REEXAMINATION"]

Alan M. Grimaldi
Howrey LLP
1299 Pennsylvania Avenue NW
Washington, DC 20004

(For Third Party Requester)

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,120
Filed: January 17, 2006
For: U.S. Patent No. 6,210,293

: **DECISION DENYING**
: **PETITION FOR**
: **RECONSIDERATION**
: **AND RETURNING**
: **IMPROPER PAPER**

This is a decision on the June 16, 2006 patent owner petition entitled "PETITION TO THE DIRECTOR FOR RECONSIDERATION" under 37 CFR 1.181(a)(3). On June 28, 2006, the third party requester filed an opposition to the present petition entitled "ACUSHNET'S OPPOSITION TO CALLOWAY'S PETITION TO DIRECTOR FOR RECONSIDERATION."

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

For the reasons set forth below, the patent owner petition under 37 CFR 1.181 is (a) granted to the extent that the prior decision has been fully reconsidered, and (b) denied as to the underlying request to vacate the order for reexamination (i.e., the underlying relief requested).

This decision also returns the patent owner paper filed on July 21, 2006 styled "REPLY IN SUPPORT OF PETITION FOR RECONSIDERATION OF DECISION ON PETITION TO VACATE ORDER GRANTING REEXAMINATION." The patent owner reply is being returned to patent owner without decision for the reasons set forth below.

FEES

A petition to vacate reexamination on the grounds that the order granting reexamination constitutes an *ultra vires* action on the part of the Office is considered pursuant to 37 CFR 1.181. Accordingly, no fee is due for the patent owner petition for reconsideration or for the third party requester opposition to the petition for reconsideration.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,210,293 (the '293 patent) issued to Michael J. Sullivan on April 3, 2001, and is currently assigned to Callaway Golf Company.

2. A request for *inter partes* reexamination of the '293 patent was filed by a third party requester, Acushnet Company (hereinafter "Acushnet"), on January 17, 2006. The request was assigned Control No. 95/000,120 (the '120 *inter partes* reexamination proceeding).

3. On February 9, 2006, the patent owner filed suit against requester Acushnet in the United States District court for the District of Delaware. *Callaway Golf Company v Acushnet Company*, C.A. No. 06-91 (SLR) (February 9, 2006).

4. On February 15, 2006, the third party requester filed a paper purporting to withdraw a paper requesting suspension of the '120 *inter partes* reexamination proceeding stated to have been filed by third party requestor on January 23, 2006.

5. On March 29, 2006, the Office recognized the February 15, 2006 paper, and accepted the withdrawal of the January 23, 2006 paper, noting that, had the January 23, 2006 paper been before the Office, the Office would have taken that paper as a petition for suspension of action without rendering a decision on the petition.

6. On March 21, 2006, the patent owner then filed a petition, requesting that the '120 *inter partes* reexamination proceeding be suspended.

7. On March 24, 2006, the third party requester filed an opposition to the March 21, 2006 patent owner petition to suspend reexamination.

8. On March 31, 2006, the Office issued a decision holding that the March 21, 2006 petition and the March 24, 2006 opposition papers would be discarded as being improper papers because they had been filed prior to reexamination being ordered.

9. Reexamination was ordered for the '120 *inter partes* reexamination proceeding on April 7, 2006.

10. On April 13, 2006 the patent owner filed a petition under 37 CFR 1.181 <u>to vacate</u> the reexamination order as *ultra vires* (which would in-effect vacate the proceeding).

11. On April 27, 2006 the third party requester filed, pursuant to MPEP 2646 (I), an opposition to the April 13, 2006 patent owner petition to vacate.

12. On April 28, 2006, patent owner filed a renewed petition <u>to suspend</u> the '120 *inter partes* reexamination proceeding.

13. On May 5, 2006 third party requester filed an opposition to the April 28, 2006 renewed patent owner petition to suspend reexamination.

14. On June 7, 2006, the Office dismissed patent owner's April 13, 2006 petition <u>to vacate</u> the '120 *inter partes* order for reexamination.

15. On July 19, 2006, the Office denied patent owner's April 28, 2006 renewed petition to suspend the '120 *inter partes* reexamination proceeding.

16. On June 16, 2006, patent owner filed a petition for reconsideration of the June 7, 2006 decision dismissing the patent owner petition to vacate the '120 *inter partes* order for reexamination.

17. On June 28, 2006, third party requester filed an opposition to the June 16, 2006 patent owner petition for reconsideration.

18. On July 21, 2006, patent owner filed a reply to the June 28, 2006 third party requester opposition.

RELEVANT STATUTES, REGULATIONS AND PROCEDURE

35 U.S.C. § 311(a) provides:

> "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." [Emphasis supplied.]

35 U.S.C. § 312(a) provides in pertinent part:

> "Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director **shall** determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. ... " [Emphasis supplied.]

35 U.S.C. § 313 provides:

> "If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination **shall** include an order for *inter partes* reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314." [Emphasis supplied.]

35 U.S.C. 314(c) provides:

> c) SPECIAL DISPATCH.- Unless 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.

35 U.S.C. §315(b) provides:

> "CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings."

35 U.S.C. § 317 provides:

"a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION.- Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit ..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action..., and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings."

37 CFR 1.907 provides in pertinent part:

" (b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an inter partes reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request inter partes reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such inter partes reexamination proceeding. "

MPEP § 2646 (I) provides in pertinent part:

"A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

(A) the reexamination order is not based on prior art patents or printed publications;
(B) reexamination is prohibited under 37 CFR 1.907;
(C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
(D) reexamination was ordered for the wrong patent;
(E) reexamination was ordered based on a duplicate copy of the request; or
(F) the reexamination order was based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding)

....

The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester." [Emphasis supplied.]

DECISION

I. Disposition Of The Patent Owner Opposition To Third Party Requester's Opposition To Patent Owner's Petition For Reconsideration

Neither the *inter partes* reexamination statutes nor the regulations implementing those statutes provide for the filing of a patent owner petition for vacatur of an order granting a request for *inter partes* reexamination. A patent owner petition for vacatur of an order granting a request for *inter partes* reexamination on the grounds that the grant of the order constituted an *ultra vires* action on the part of the Office is entertained pursuant to 37 CFR 1.181 in accordance with the practice set forth in MPEP § 2646(I). MPEP § 2646(I) concludes by stating that "[t]he filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester."

Consequently, the "REPLY IN SUPPORT OF PETITION FOR RECONSIDERATION OF DECISION ON PETITION TO VACATE ORDER GRANTING REEXAMINATION," filed by patent owner on July 21, 2006, is an improper paper that lacks an entry right in the present *inter partes* reexamination proceeding. Therefore the paper (apparently filed by facsimile transmission as a single paper directed to four *inter partes* reexamination proceeding) is being returned to patent owner as an attachment to the present decision. If additional copies directed to concurrent *inter partes* reexamination proceedings 95/000,121, 95/000,122 and 95/000,123 have been filed and are subsequently matched with the proceedings, such additional copies will be discarded rather than returned to patent owner.

II. Patent Owner's Position In Support of Vacatur

In the April 13, 2006 petition to vacate the reexamination order as being *ultra vires*, patent owner argued that the order granting reexamination is an *ultra vires* action on the part of the Office because the third party requester, Acushnet, lacked standing to file the *inter partes* request. Patent owner based this argument on allegations that:

(1) Patent owner's predecessor in interest and the present third party requester Acushnet entered into a Settlement Agreement on November 10, 1990, for a term of ten years;

(2) The same parties executed a Settlement Agreement in 1996 that superseded the 1990 agreement, and the 1996 Settlement agreement provides, *inter alia*, that the exclusive forum for the third present party requester to resolve patent validity issues with the patent owner is the United States District Court for the District of Delaware; and

(3) The same (present) parties participated in the dispute resolution process pursuant to the 1996 Settlement Agreement, but while the mediation process was underway, Acushnet requester filed a request for the present *inter partes* reexamination proceeding. [1]

It was apparently patent owner's position that by filing the present request for *inter partes* reexamination, requester Acushnet violated the aforementioned Settlement Agreement, and

[1] See patent owner's Petition, pages 2-3.

that Acushnet therefore does not have standing to have filed and to now maintain the present request for *inter partes* reexamination. [2]

In the present petition for reconsideration, patent owner argues that:

(1) The Office has the authority and duty to apply the 1996 Settlement Agreement to this case, and that enforcing the 1996 Settlement Agreement would not violate public policy;

(2) The exemplary language in the MPEP § 2646 does not limit the circumstances where the Office can vacate reexamination orders;

(3) Vacating the reexamination would not leave an unresolved substantial new question of patentability; and

(4) The Office's reliance on the decision in *Heinl v. Godici*, 143 F. Supp 2d 593 (District Court, E. D. VA), is inapposite to this case, because *Heinl* dealt with an entirely unrelated issue, and did not involve a settlement agreement.

III. Analysis and Findings

A. The Settlement Agreement Between Patent Owner and The Present Requester Does Not Preclude the Present *Inter Partes* Reexamination Proceeding:

Patent owner argues that a trademark cancellation proceeding is analogous to a reexamination proceeding, and seek to apply the decisions in *Selva & Sons v. Nina Footwear, Inc.*, 705 F.2d 1316 (Fed. Cir. 1983) and *Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386 (CCPA 1974) to assert that the Office erred in refusing to consider the settlement agreement between the present patent owner and requester in determining whether to proceed with the present reexamination proceeding. With respect to the *Selva & Sons* decision, patent owner opines that because the statute [3] governing trademark cancellation proceedings (that are *inter partes* in nature) states that "any person" is able to file a petition to cancel a registration, *Selva & Sons* is indistinguishable from the facts in the present reexamination proceeding. Patent owner also argues that in *Flex-Foot, Inc v. CRP, Inc.*, 238 F.3d 1362 (Fed. Cir. 2001) the Federal Circuit upheld a clause in a settlement agreement prohibiting a party from challenging the validity of a patent when that party had agreed to a dismissal, with prejudice, of a prior action, after entering into a settlement that included a promise to not challenge the validity of that patent.

However, the decisions in the *Selva & Sons* and *Danskin, Inc.* cases do not appear to be on point as to the question of whether a party to a settlement agreement is barred from requesting reexamination of a United States patent under 35 U.S.C. § 302 *et. seq.*. *Selvo & Sons* was an appeal from a decision of the Trademark Trial and Appeal Board in an *inter partes* trademark opposition proceeding. In *Selvo & Sons* , the court's decision was not grounded on the "any

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[2] *Id.*, at pages 4-6

[3] 15 U.S.C. § 1064, which states in pertinent part:
"A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by **any person** who believes that he is or will be damaged, including as a result of dilution under section 1125 (c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:..." [Emphasis added]

party" language of 15 U.S.C. § 1064. Rather, the court noted the existence of 15 U.S.C. § 1069, which states:

> "In all *inter partes* proceedings equitable principles of laches, estoppel and acquiescence, where applicable, may be considered and applied." *Id.* at 1323, 1324

There is no analogue in the reexamination statutes to 15 U.S.C. § 1069, a statute that broadly applies the equitable principles of laches, estoppel and acquiescence to *inter partes* trademark proceedings in the Office. Rather, the *inter partes* reexamination statute includes limited estoppel provisions that raise specific estoppels based upon the existence of a final (*i.e.*. nonappealable) court holding of patent claim validity [4] or the existence of an order granting reexamination. [5] If Congress had intended to make the broad equitable principles set forth in 15 U.S.C. § 1069 applicable to *inter partes* reexamination proceedings, then Congress would have so stated. [6] With respect to the *Danskin, Inc.* case (an appeal from a decision of the Trademark Trial and Appeal Board in an *inter partes* trademark opposition proceeding), it is noted that the language of 15 U.S.C. § 1069 would also apply, so that application of the broad equitable principles listed in the statute would have been mandated.

In the *Flex-Foot* decision, the court did *not address the issue of whether the Office would be barred from conducting a reexamination proceeding filed by that party.* The court's decision merely upheld that a clause in the settlement agreement would prohibit a party to the settlement agreement from challenging the validity of a patent (and accordingly, the opposing party would have remedies against the party that violated the agreement). The opinion in *Flex-Foot* does not discuss the affect of a reexamination filing by a party in violation of such a settlement agreement, as to whether the reexamination should continue. *Flex-Foot* does not require or suggest that an order granting a reexamination proceeding, based on such a filing, would be *ultra vires* due to the existence of a settlement agreement between a patent owner and third party requester. And, based on the discussion below, there is no reason to believe that an order granting a reexamination proceeding based on such a filing would be *ultra vires* action on the part of the Office.

B. Reexamination Case Law Does Not Support Vacatur Of The Present Reexamination Proceeding

The settlement agreement asserted by patent owner in the '120 reexamination proceeding does not explicitly address reexamination of a patent. Even if it did, relevant court precedent clearly demonstrates that - because the Office was not, and is not, a party to the settlement agreement, the Office was not, and is not, bound by the settlement agreement.

Joy Manufacturing Co. v National Mine Service Co, 810 F.2d 1127 (Fed. Cir. 1987) addressed the question of the effect, if any, that the existence of a settlement agreement between parties to an infringement/validity patent litigation had with respect to a request for *ex parte* reexamination subsequently filed by a party to that settlement agreement. Accused infringer National had entered into an agreement in settlement of an action brought against it for infringing a patent.

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[4] See 35 U.S.C. § 317(b).

[5] See 35 U.S.C. § 317(a).

[6] In light of the cases cited below in support of the Office's position vis-à-vis the effect of the settlement agreement in the present reexamination proceeding, it is also to be noted that with respect to *ex parte* reexamination, Congress has not mandated any estoppel with respect to the ability of "any person" to file a request for reexamination at "any time."

National agreed that it would not file any suit in any court challenging the validity of the patent. Thereafter, National filed a request for reexamination of the patent, and the patent owner requested an injunction preventing the third party requester from going forward in the reexamination proceeding. The District Court ruled against the patent owner, noting that the settlement agreement by its literal terms did not proscribe the conduct of which the patent owner complained. The Federal Circuit agreed, holding that:

> " ... the district court correctly refused to equate "a request for administrative reexamination . . . with filing a suit in a United States Court." Its reliance on *Etter* as support for this legal conclusion was entirely appropriate. The *Etter* decision turned on the precise issue here, namely, that reexamination and civil litigation were distinctly different proceedings. As stated therein:
>
> > The intent that reexamination proceedings and court actions involving challenges to validity be distinct and independent is reflected in the legislative history of § 303. . . . *756 F.2d at 857, 225 USPQ at 4.* The result in *Etter* is inseparable from the above-quoted premise. [Footnote omitted.]
>
> "In this connection, we also note that the principal relief which Joy seeks -- namely, stopping the reexamination of its patent -- is not available in these proceedings. *Accord* Manual of Patent Examining Procedure § 2210 (5th ed. 1983); *Houston Atlas, Inc. v. Del Mar Scientific, Inc.*, 217 U.S.P.Q. (BNA) 1032, 1034 (N.D. Tex. 1982), aff'd, 703 F.2d 555 (5th Cir. 1983). The decision by the Commissioner to institute reexamination is not subject to review, *Etter*, 756 F.2d at 857, 225 USPQ at 4; and the injunction sought against National would have no effect on reexamination since National, as the requestor, has no future role to play in that *ex parte* proceeding. "

In the present reexamination proceeding, patent owner has not established that Acushnet's request for reexamination violates the literal terms of the 1996 settlement agreement involved here. The settlement agreement does not facially preclude "administrative proceedings" of any sort, including reexamination within the Office. Further, as was noted in the previous decision dismissing the petition, the settlement agreement was entered into in 1996; prior to the enactment in 1999 of the statute authorizing *inter partes* reexamination. Thus, it is unlikely that the settlement agreement reflects an agreement between the parties thereto to forego administrative relief in the form of a request for *inter partes* reexamination (such *inter partes* proceeding made available after the settlement agreement), and at best, could only be asserted to inferentially contemplate that the parties to the settlement agreement would not seek *ex parte* reexamination (where there is no right to comment on patent owner responses and appeal). *Joy Manufacturing*, and the other cases relied on by the Office, *infra*, all involve *ex parte* examination proceedings. Moreover, even presuming that the settlement agreement between the patent owner and third party requester could be construed to be an agreement precluding the filing of a request for *ex parte* reexamination, the courts have uniformly held that such agreement is without binding effect on the Office and would not bar the Office from granting and conducting an *ex parte* reexamination proceeding, as will now be discussed.

In *Houston Atlas, Inc. et al v. Del Mar Scientific, Inc. et al.*, 217 USPQ 1032, 1037 (N.D. Tex. 1982), the district court considered the situation in which two parties had executed and had entered a consent judgment stating that a particular patent was valid. The consent judgment was entered prior to the enactment of the *ex parte* reexamination statutes. The court expressly addressed the subsequent effect the consent judgment would have on reexamination in the Office, if any. The court stated that private parties cannot bind the Office, or the public it represents, with respect to the validity of a patent, by merely executing the consent judgment and having it entered. The court noted that:

> "... the Patent Office was not a party to the original proceeding and, as discussed in section IV above, the consent judgment is not binding on the Patent Office or the public which it represents. Simply stated, **two private parties cannot bind the Patent Office with respect to the validity of a patent by merely executing, and having entered, a consent judgment stating that the patent is valid. The consent**

> **judgment is not *res judicata* on the Patent Office as there is no evidence that the Patent Office is privity with Defendants.** See *Vulcan, Inc. v. Fordees Corp., 658 F.2d 1106, 1109-10, 211 USPQ 852, 854-855 (6th Cir. 1981)* (party not in privity to executory of consent judgment is not bound by the judgment). Given that the consent judgment is not enforceable against the Patent Office as *res judicata*, the Court must determine whether the Patent Office, by its conduct of the reexamination proceedings and issuance of the order of reexamination is "in a position to frustrate the implementation of [the consent judgment] or the proper administration of justice." The clear answer to this question is in the negative. Section 303 of the Act expressly authorizes the Patent Office to conduct reexamination proceedings on their own initiative without a formal request for reexamination. If the reexamination proceedings in question had been instituted by the Commissioner as a consequence of a citation of prior art from a person other than Canterbury, or if a person other than Canterbury had requested reexamination of patent *3,464,799*, this Court would be without power to enjoin the proceedings for the simple reason that the consent judgment is binding only as to Plaintiffs and Defendants. **In short, Plaintiffs' compliant lies not with the institution of the reexamination process, but instead with who requested it.** For this reason, the Court is constrained to conclude that it has no jurisdiction under the All Writs Act to grant the Plaintiffs any relief against the Patent Office. " [Emphasis added]

Thus, even though the district court found one of the defendants in *Houston Atlas* to be in contempt of the consent judgment because that defendant had filed a request for reexamination, the district court noted that the Office was expressly authorized by statute to conduct reexamination. The court concluded that a consent judgment to which the Office was not a party could not bind the Office so as to preclude reexamination, even where such reexamination was requested by a party bound by the consent judgment. If such is true with respect to a consent judgment, it follows that a settlement agreement between two private parties to which the Office is not a party also does not bind the Office so as to preclude the Office from carrying out its statutory mandate to reexamine a qualifying patent once a substantial new question of patentability for that patent has been determined to exist for that patent. Therefore, even if one assumes that third party requester in the '120 reexamination proceeding is in violation of the settlement agreement with patent owner such that third party requester might be subject to sanctions by a court of competent jurisdiction for having filed the present request for *inter partes* reexamination, the settlement agreement would still not be binding on the Office so as to preclude the Office from conducting *inter partes* reexamination as requested, because the Office is not a party to that agreement.

Indeed, the courts have held that a final judgment against a party found to have infringed a patent does not prohibit that party from seeking *ex parte* reexamination of the involved patent. In *Kucala Enterprises, Ltd. V. Auto Wax Co., Inc. 2004 U.S. Dist. LEXIS 5723 (N.D. Ill., 2004)*, the accused infringer (Kucala) contended that there was no basis in law or fact, by which the judgment could preclude Kucala from filing a request for *ex parte* reexamination, relying on the language of 35 U.S.C. § 302 that permits "any person at any time" to request reexamination of a patent. The court pointed out that it could not bar third party Kucala from seeking reexamination, even under the circumstances of that case, where the third party was found guilty of misconduct such that the court found the patents asserted against the third party to be not invalid. The *Kucala Enterprises, Ltd.* opinion states:

> "...the issue here, whether a court can sanction a party by enjoining it from seeking reexamination. At the same time, the cases on which Auto Wax relies fail to address a sanction prohibiting reexamination. [Citations omitted].
>
> "The court is persuaded, in light of the parties' arguments and the court's purposes in the October decision, that the judgment should not bar Kucala from seeking reexamination. The sanction of dismissal conveys to Kucala, "Because of your misconduct, you lose on the claims you filed in this court." In other words, the court finds the patents in suit not invalid. **Under the lessons of *Ethicon*, this means only that the presumption of validity survives, not that the patents are valid. Although principles of claim preclusion would bar an adjudged infringer [*16] from filing or defending a future lawsuit relating to**

> **these patents, it would not bar the infringer from seeking reexamination.** Therefore, the court will not enjoin Kucala from seeking reexamination of Auto Wax's patents." *Id.* at page 13 of the Court's decision." [Emphasis added]

In *McNeil-PPC, Inc. v. The Procter & Gamble Co., 19 USPQ2d 1663 (U.S. District Court District of Colorado 1991*), Procter & Gamble sought leave from the court to file a request for reexamination in the Office of a patent in dispute. The court held that Procter & Gamble did not need permission from the court to file a request for reexamination, and that there does not appear to be any limit on a party's right to request reexamination, but for complying with the requirements of 35 U.S.C. § 302, directed to *ex parte* reexamination. Furthermore, the court observed:

> "First, unfair or not, McNeil-PPC points to no authority that would authorize me to prevent or limit P & G's request to the PTO for reexamination of Bradstreet '901 and its participation in that proceeding to the extent allowed by title 35. McNeil-PPC's only argument is that because P & G asked for leave to file the request, it concedes that it is required to do so. I disagree. It may be that P & G was under the erroneous assumption that I had some statutory or common law prerogative to intervene in the PTO reexamination request. **McNeil-PPC does not offer, however, any rationale why any such misinterpretation bestows unto me power over the PTO where the power is otherwise absent.** Furthermore, at oral argument, P & G took the position that the motion was filed as a courtesy notice and does not constitute any waiver.
>
> "Second, Congress authorizes challengers to take "two bites of the apple." **A nonpatent holder is permitted to both challenge a patent in the PTO and in the district court**. *See In re Etter, 756 F.2d 852, 857, 225 U.S.P.Q. (BNA) 1* (Fed. Cir.), *cert. denied, 474 U.S. 828, 88 L. Ed. 2d 72, 106 S. Ct. 88 (1985).* In *Ethicon, Inc. v. Quigg, 849 F.2d 1422, 7 U.S.P.Q.2D (BNA) 1152 (Fed. Cir. 1988),* a nonpatent holder was sued for patent infringement. While the action progressed, the nonpatent holder requested reexamination of the subject patent in the PTO. The Federal Circuit, in concluding that the PTO was without the power to stay the reexamination pending outcome of the action and allowing the reexamination and court action to proceed simultaneously, stated:
>
> > The awkwardness presumed to result if the PTO and court reached different conclusions is more apparent than real. The two forums take different approaches in determining invalidity and on the same evidence could quite correctly come to different conclusions. Furthermore, we see nothing untoward about the PTO upholding the validity of a reexamined patent which the district court later finds invalid. This is essentially what occurs when a court finds a patent invalid after the PTO has granted it. Once again, it is important that the district court and the PTO can consider different evidence. Accordingly, different results between the two forums may be entirely reasonable. And, if the district court determines a patent is not invalid, the PTO should continue its reexamination because, the two forums have different standards of proof for determining invalidity. *Ethicon, 849 F.2d at 1428-29.*
>
> "This structure does not automatically lead to inefficient use of judicial resources. Rather than impede jurisdictional efficiency, this dual process has greater potential to promote efficiency, because, as stated in *In re Etter:*
>
> > The innate function of the reexamination process is to increase the reliability of the PTO's action in issuing a patent by reexamination of the patents thought "doubtful." [Citation omitted]. When the patent is currently involved in litigation, an auxiliary function is to free the court from any need to consider prior art without the benefit of the PTO's initial consideration."
>
> [Emphasis added]

Thus, the court recognized that duality of the Congressionally enacted structure in which reexamination and litigation co-exist as non-mutually exclusive avenues in which a party may challenge a patent. It appears that insofar as the litigation approach may result in a settlement agreement, that the existence of a settlement agreement does not "sidetrack" a party thereto from pursuing reexamination.

It should also be noted that a contractual provision preventing a party from seeking reexamination would be void as being contrary to public policy. [7] In *Lear v. Adkins*, 395 U.S. 653, (1969), the United States Supreme Court determined that prohibiting licensees from challenging the validity of a patent that they had licensed runs afoul of public policy "in permitting full and free competition in the use of ideas which are in reality part of the public domain." *id.* at 670 . By analogy, preventing a third party requester (and a potential licensee of the subject patent) from requesting reexamination of a patent would be contrary to the public policy embodied in the *Lear v. Adkins* decision. As the settlement agreement entered into in 1996 is prior to the enactment in 1999 of the statute authorizing *inter partes* reexamination, it was not even possible for these settlement agreements to address preventing a party to the agreement from filing such a request for reexamination.

Finally, it is recognized that the decisions cited and discussed, *supra*, are not specifically directed to *inter partes* reexamination. However, it is clear that the precedents would apply to *inter partes* reexamination proceedings just as they do in *ex parte* reexamination proceedings. For *ex parte* reexamination, 35 U.S.C. § 302, provides that "[A]ny person at any time may file a request for reexamination by the Office of any claim of a patent ..." For *inter partes* reexamination, 35 U.S.C. § 311(a) provides that "IN GENERAL -Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent ..." [8]

Congress chose to not place any limitation on the ability of a third party requester to request an *ex parte* reexamination proceeding. Thereafter, Congress chose to provide only very limited estoppel provisions with respect to the ability of a third party requester to request an *inter partes* reexamination proceeding, only those estoppel provisions set forth in the statue. [9] Congress could have elected to enact provisions similar to 15 U.S.C. § 1069 so as to place broad estoppel limitations on the ability of a third party requester to seek reexamination in the Office. However, Congress chose not to do so! Moreover, to the extent that the estoppel provisions of 35 U.S.C. § 317(b) might be relevant to the '120 reexamination proceeding, patent owner has not alleged that there has ever been a relevant final (*i.e.* nonappealable) court decision holding that the '293 patent claims are valid. Indeed, patent owner's own statement of the facts indicates that the parties executed Federal Rule of Civil Procedure 41 Stipulations of Dismissal of the prior litigation that were filed in, and accepted by, the Delaware District Court, and that "[t]he Court specifically retained jurisdiction over the parties in relation to disputes arising under the 1996 Settlement Agreement." This clearly does not provide a final court decision regarding the validity of any of the patents covered in the settlement agreement.

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[7] *Bremen v. Zapata Off-Shore Co.*, 407 U.S. 1 (1972)(concluding that a forum selection clause, while generally enforceable, will not be enforced where it violates the strong public policy of the forum in which suit is brought); *Newton v. Rumery*, 480 U.S. 386,392 (1987) ("The relevant principle is well established: a promise is unenforceable if the interest in its enforcement is outweighed in the circumstances by a public policy harmed by enforcement of the agreement."); *Suter v. Munich Reinsurance*, 223 F.3d 150 (3d Cir. 2000) (citing *Bremen* for the proposition that federal forum selection clauses should not be enforced where they are contrary to public policy).

[8] The caveat ("IN GENERAL") in the statute refers to the estoppel provisions of 35 U.S.C. § 317(b) that would preclude a third party requester from filing a request for reexamination where it has not sustained its burden of proof of claim invalidity in litigation that has become final, or where such litigation has resulted in a final holding of claim validity, as well as the 35 U.S.C. § 317(b) limitation on the filing of co-pending *inter partes* reexaminations.

[9] The *inter partes* reexamination statute includes limited estoppel provisions that raise specific estoppels based upon the existence of a final (i.e.. nonappealable) court holding of patent claim validity or the existence of an order granting reexamination. See 35 U.S.C. § 317(a) and (b).

C. Vacatur Of The Present Reexamination Proceeding Is Not Supported By The Provisions Of MPEP § 2246(I):

Patent owner argues that the exemplary language in the MPEP § 2646 does not limit the circumstances in which the Office can vacate reexamination orders. To the extent that this is true, it is not relevant here, because the statutes, the case law and the facts in the present reexamination proceeding all indicate that vacatur of the present reexamination proceeding would run contrary to the reexamination statute. Patent owner's arguments to the contrary are not persuasive.

MPEP § 2646(I) addresses vacatur that would be required when a request for *inter partes* reexamination was improperly ordered due either to the existence of a statutory prohibition barring the grant of a request for *inter partes* reexamination, or the existence of a clear error of a clerical nature. Patent owner has not established that the present *inter partes* reexamination proceeding was ordered contrary to any statutory prohibition barring the order, or due to a clerical error. Rather, the *inter partes* reexamination statute clearly provides that when the Office is presented with a request for *inter partes* reexamination that (1) has been filed by a third party requester not subject to the estoppel provisions of 35 U.S.C. § 317, and (2) raises a substantial new question of patentability, the Office must order *inter partes* reexamination and thereafter reexamine the patent. [10] As set forth in Section III (B) of this decision, *supra*, the case law does not support the proposition that the Office has the duty to, or may at its option, disregard the statutory mandate to reexamine the patent due to the existence of a settlement agreement between a patent owner and a third party requester to which the Office is not a party. Indeed, the case law does not support that proposition even where the settlement agreement was reduced to a consent judgment and the third party requester has been held by the court to be in contempt of the consent judgment.

D. Vacating The Present Reexamination Proceeding May In Fact Leave An Unresolved Substantial New Question of Patentability

Patent owner argues that vacatur of the present reexamination proceeding would not leave a substantial new question of patentability unresolved, because such questions (and other questions of patentability beyond the scope of *inter partes* reexamination) will be resolved by the method, and in the forum, established by the parties in the settlement agreement.

This argument ignores two important points. *First*, there is in fact a public interest served by resolution of patentability issues via reexamination proceedings in the Office, and advantages attendant thereto. *Ethicon v. Quigg*, 878 F.2d 1422, 1428 (Fed. Cir. 1989); *In re Etter*, 756 F.2d 852, 856 (Fed. Cir. 1985). There is no assurance that resolution of the dispute between patent owner and third party requester in accordance with the settlement agreement would resolve the substantial new questions of patentability that have been found to exist in the present *inter partes* reexamination proceeding, or in any way result in a benefit to the public in the manner that a reexamination proceeding would. Any resolution in court, or such other forum chosen, may simply resolve the dispute between patent owner and third party requester without resolving the issues of patentability raised by the substantial new question of patentability (e.g., by settlement, or consent judgment, or dismissal without prejudice or based on a conduct issue). Vacatur of a requested and granted *inter partes* reexamination proceeding may well leave both the public and

[10] See 35 U.S.C. §§ 311, 312(a), 313(a) and 314(c).

the patent owner with an unresolved request for reexamination and unresolved substantial new question of patentability (found to be present via the decision ordering reexamination). The public has a right to such a resolution. Vacating, withdrawing, or otherwise abandoning or terminating the instant reexamination proceeding would abrogate this public right, to the detriment of the public interest. As discussed in Section III (B) above, ordering and conducting an *inter partes* reexamination proceeding is not optional for the Office. Rather, the *inter partes* reexamination proceeding must continue according to the procedure mandated by the *inter partes* reexamination statute, to carry out the purpose of the statute and resolve the substantial new question of patentability for the public.[11] The proceeding began with the filing of a request for *inter partes* reexamination that satisfied the requirements of 35 U.S.C. § 311. As **required** by 35 U.S.C. § 312, the request for reexamination has been considered. As a result of that consideration, it has been determined that the request raises a substantial new question of patentability for one or more patent claims. Thus, in accordance with 35 U.S.C. § 313, the present proceeding **shall** result in a determination of the patentability of the claims of the '293 patent in light of prior patents and printed publications, to the benefit of the public as well as to the benefit of patent owner and third party requester.

Second, while there is no assurance that the resolution of the dispute in accordance with the settlement agreement will be timely, the present reexamination proceeding **will** be conducted with special dispatch pursuant to 35 U.S.C. § 314(c). The public interest in resolving the issues raised in the present reexamination proceeding includes an interest in having those issues resolved in a timely fashion.

E. The Decision in *Heinl v. Godici* Is Clearly Apposite To This Reexamination Proceeding

Patent owner argues that the Office's reliance on *Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001) is misplaced. This argument is not persuasive.

Heinl was a case in which patent owner sought a decision terminating a reexamination proceeding based on the absence of a new question of patentability. The *Heinl* court stated:

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

The *Heinl* court then stated:

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

It is abundantly clear that the *Heinl* decision was not cited and discussed because it involved a previous settlement agreement between parties to a reexamination proceeding, and no reading of the Decision on Petition June 7, 2006 can lead to the belief that it was. Rather, *Heinl* was cited because it is clearly applicable to the doctrine of *"ultra vires"* reexamination proceedings in the sense that it provides a benchmark for looking into whether the Office has committed an *ultra*

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[11] The innate function of the reexamination process is to increase the reliability of the Office's action in issuing a patent by reexamination of patents thought "doubtful." House Report No. 66-1307, 96th Cong., 2d Sess. (1980), 3, reprinted in 1980 U.S. Code Cong. & Ad. News 6460, 6462. (This was emphasized in *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir.) (en banc), cert. denied, 474 U.S. 828, 88 L. Ed. 2d 72, 106 S. Ct. 88 (1985)).

vires act. That benchmark is a simple one. Where the Office orders reexamination, the decision of the Office to order reexamination cannot be attacked as being *ultra vires*, unless it is clearly established that the Office has exceeded its statutory authority to order reexamination.

In this instance:

(1) The reexamination statute fails to provide that the equitable doctrines of laches, estoppel and acquiescence can be raised to preclude the Office from ordering *inter partes* reexamination, other than the 35 U.S.C. § 317 exception, which is inapplicable on the facts in the present reexamination proceeding;

(2) The authorities cited and discussed above in Section III (A) clearly indicate that the existence of a settlement agreement (and even the existence of a consent judgment incorporating a settlement agreement) between a patent owner and a third party reexamination requester do not operate to preclude the Office from granting that third party's request for reexamination if the request otherwise satisfies the requirements of the reexamination statutes; and

(3) A public interest in resolving the substantial new question of patentability exists in the present reexamination proceeding, which may not necessarily be timely resolved, or resolved at all, by reason of the dispute resolution provisions of the settlement agreement, and will not be resolved using the standards applicable in reexamination as well as the expertise of the Office.

Thus, the guidance provided by the decision in *Heinl* supports the conclusion that petitioner has not advanced sufficient basis for holding the grant of reexamination in the present *inter partes* reexamination proceeding to be an *ultra vires* action by the Office. The Office has not "clearly exceeded its statutory authority" in the Office's determination that the January 17, 2006 reexamination request properly raised a substantial new question of patentability and should go forward.

For all the forgoing reasons, as well as those set forth in the June 7, 2006 decision, the order granting the present *inter partes* reexamination remains intact and the *inter partes* reexamination proceeding will continue in accordance with the procedure mandated by the *inter partes* reexamination statute and implementing regulations.

ADDITIONAL DISCUSSION

The undersigned notes that the patent owner and third party requester are adverse parties with respect to the present *inter* partes reexamination proceeding, and are currently engaged in litigation involving the underlying patent. While counsel should represent the respective parties zealously, and are entitled to benefit of all of the regulations implementing the *inter partes* reexamination statutes and the examining practice promulgated with respect to those regulations, counsel are reminded of their ongoing obligations to the Office as set forth in Part 10 of Title 37 of the Code of Federal Regulations. In particular, the provisions of 37 CFR 10.18(b)(2) and (c) should be noted. Adherence to the provisions of Part 10 will greatly assist the Office **in conducting this *inter partes* reexamination proceeding with special dispatch** as required by 35 U.S.C. § 314(c).

CONCLUSION

1. The patent owner's June 16, 2006 petition under 37 CFR 1.181 is (a) granted to the extent that the prior decision has been fully reconsidered, and (b) denied as to the underlying request to vacate the order for reexamination.

2. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

3. The patent owner's July 21, 2006 opposition to the third party requester opposition to the patent owner petition for reconsideration lacks an entry right in the present reexamination proceeding, and is being returned to patent owner.

4. Jurisdiction over the '120 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit.

5. Telephone inquiries related to the present decision should be directed to Stephen Marcus, Legal Advisor, at 571-272-7743, or, in his absence, to Karen Hastings, Legal Advisor, at 571-272-7717.

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

kmh/sm

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MAILED

APR 27 2007

CENTRAL REEXAMINATION UNIT

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,120
Filed: January 17, 2006
For: U.S. Patent No. 6,210,293

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,121
Filed: January 17, 2006
For: U.S. Patent No. 6,503,156

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,122
Filed: January 17, 2006
For: U.S. Patent No. 6,506,130

In re Callaway Golf Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,123
Filed: January 17, 2006
For: U.S. Patent No. 6,595,873

DECISION DISMISSING PETITION

This is a decision on the March 22, 2007 petition entitled "JOINT PETITION TO SUSPEND CERTAIN OF THE PROCEDURES SET FORTH IN MPEP § 724.04 GOVERNING THE HANDLING OF CONFIDENTIAL INFORMATION." The patent owner and third party requester jointly filed the petition,.

The petition is before the Office of Patent Legal Administration for consideration. The petition is being taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.59 as well as portions of the corresponding practice (MPEP § 724 *et seq*) promulgated under the rule. A petition fee of $ 400.00 under 37 CFR 1.17(f) will be charged to the patent owner's deposit account as authorized in the joint petition for each of the four *inter partes* reexamination proceedings. Accordingly, $ 1,600.00 ($ 400 x 4 = $ 1,600) is being charged to patent owner's Deposit Account No. 06-1050.

REVIEW OF SALIENT FACTS

1. On January 17, 2006, third party requester (Acushnet) filed four *inter partes* reexamination requests, each request being directed to one of four U.S. Patents owned by Callaway Golf.

2. The reexamination request for U.S. Patent No. 6,210,293 (the '293 patent) was assigned control no. 95/000,120 (the '120 *inter partes* reexamination request).

3. The reexamination request for U.S. Patent No. 6,503,156 (the '156 patent) was assigned control no. 95/000,121 (the '121 *inter partes* reexamination request).

4. The reexamination request for U.S. Patent No. 6,506,130 (the '130 patent) was assigned control no. 95/000,122 (the '122 *inter partes* reexamination request).

5. The reexamination request for U.S. Patent No. 6,595,873 (the '873 patent) was assigned control no. 95/000,123 (the '123 *inter partes* reexamination request).

6. On February 9, 2006, patent owner Callaway Golf filed suit against third party requester Acushnet in the United States District Court for the District of Delaware. Each of the '293, '156, '130 and '873 patents is involved in the suit.

7. Reexamination was ordered for each of the '122 and '123 *inter partes* reexamination proceedings on April 6, 2006.

8. Reexamination was ordered for each of the '120 and '121 *inter partes* reexamination proceedings on April 7, 2006.

9. A non-final Office action was mailed in each of the '122 and '123 *inter partes* reexamination proceedings on January 30, 2007.

10. A non-final Office action was mailed in each of the '120 and '121 *inter partes* reexamination proceedings on February 27, 2007.

11. In the District Court litigation, the patent owner and third party requester are subject to a protective order that anticipates the use of confidential information in the litigation, that anticipates that some of the confidential information may be relevant to the '120, '121, '122 and '123 *inter partes* reexamination proceedings, and permits submission of such material in these *inter partes* reexamination proceedings subject to certain procedures designed to protect the confidential nature of the information.

12. Patent owner and third party requester filed the present joint petition on March 22, 2007 seeking to waive certain aspects of Office practice governing the submission of confidential information that are deemed to conflict with certain provisions of the protective order.

DECISION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 151 provides, in part:

"If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned."

35 U.S.C. § 181 provides, in part:

"Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of an application or the grant of a patent therefor under the conditions set forth hereinafter."

35 U.S.C. § 316(a) provides:

"IN GENERAL.– In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable."

37 CFR 1.11(a), (c) and (d) provide:

"(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). If an application was published in redacted form pursuant to § 1.217, the complete file wrapper and contents
of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § 1.217 have been met in the application; and the application is still pending. See § 2.27 of this title for trademark files.

(c) All requests for reexamination for which all the requirements of § 1.510 or § 1.915 have been satisfied
will be announced in the Official Gazette. Any reexaminations at the initiative of the Director pursuant to § 1.520 will also be announced in the Official Gazette. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Director initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor."

37 CFR 1.59(a) and (b) provide:

"(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration
under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information
from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR 1.555 provides:

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the

preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c)."

37 CFR 1.933 provides:

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an inter partes reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

MPEP § 724.01 provides:

"It is the intent of the Office that the patent file wrapper be as complete as possible insofar as "material" information is concerned. The Office attempts to minimize the potential conflict between full disclosure of "material" information as required by 37 CFR 1.56 and protection of trade secret, proprietary, and protective order material to the extent possible.

The procedures set forth in the following sections are designed to enable the Office to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material."

MPEP § 724.02 provides, in part:

"Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." ...

Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)

...

C. "MATERIAL SUBJECT TO PROTECTIVE ORDER – NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK
OFFICE EMPLOYEE.
DO NOT SCAN
Tribunal Issuing Protective Order:
Civil Action or Other Identification No.:
Date of Order:

Current Status of Proceeding: (Pending, Stayed, etc.)
In re application of:
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17g) to expunge the information, if found not to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, should accompany the envelope or container. ..."

MPEP § 724.04(c) provides, in part:

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

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

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

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

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

II. Discussion re Expunging Information - General

A request for *inter partes* reexamination was filed by third party requester (Acushnet) on January 17, 2006 for each of the '293, '156, '130 and '873 patents owned by Callaway Golf. On February 9, 2006, patent owner filed an action in the United States District Court for the District of Delaware (the District Court) alleging, *inter alia*, that third party requester infringes certain claims of each of those patents. Reexamination for each of the patents was ordered in early April, 2006.

Joint petitioners (patent owner and third party requester) allege that a protective order has been issued by the District Court. Apparently, the protective order includes a provision permitting

submission of confidential information to the Office "provided that the USPTO enters an appropriate protective order or other order to preserve the confidentiality of the Designated Materials to the same degree as they are protected hereunder." Joint petitioners further allege that the examining practice pursuant to MPEP § 724.04 will, if complied with by the parties, effectively preclude both parties from submitting confidential information that may be relevant to the four *inter partes* reexamination proceedings, because the examining practice does not guarantee confidentiality of such submitted information once it is submitted to the Office. Accordingly, joint petitioners have requested a suspension of certain of the procedures set forth in MPEP § 724.04, such that all confidential material that is properly submitted to the Office will remain confidential during the *inter partes* reexamination proceedings, and will thereafter be expunged at the conclusion of the *inter partes* reexamination proceedings - regardless of the Office's findings as to the relevance of the material. The Office construes the requested suspension of examining procedures as a request to suspend 37 CFR 1.59 pursuant to the provisions of 37 CFR 1.183, along with the applicable examining practice under the rule that would be relevant in these *inter partes* reexamination proceedings.

Joint petitioners are correct with respect to the examining practice under MPEP § 724.04(c). The Office will <u>not</u> expunge confidential information that is submitted to the Office in a reexamination proceeding <u>unless</u> it is found by the examiner that the confidential information is not "important to a reasonable examiner in deciding whether or not a claim is patentable."

The basis for refusing to expunge information submitted to the Office when such information has been found to be important to a reasonable examiner in deciding whether or not a claim is patentable is that 35 U.S.C. §§ 151 and 181 require that the file of an issued patent be open and available to the public. And, 35 U.S.C. § 316(a) provides that the content of any reexamination certificate resulting from an *inter partes* reexamination proceeding is *incorporated into* the original patent.

35 U.S.C. § 151 requires that when it is determined that an applicant for patent is entitled to a patent, the patent shall issue, and the record of the patent shall be made open to the public, upon payment of the issue fee. This provision is qualified only by 35 U.S.C. § 181 which precludes "publication or disclosure" by "the grant of a patent" under certain circumstances, (*i.e.* for national security reasons), which are not relevant here. These provisions, when read together, make it clear that the grant of a patent is a publication of the information "disclosed" in the patent record, which includes the reexamination file for a reexamination proceeding. The availability of such information is thus a right that is statutorily provided to the public, and thus, a public interest. The public has a right to be aware of all information found to be important to a reasonable examiner in deciding whether or not claims are patentable.

In order to implement the statutory requirements regarding publication of patents and incorporation a reexamination proceeding, 37 CFR 1.11(a) provides, *inter alia*, that "[T]he specification, drawings, and all papers relating to the file of a patent" are "are open to inspection by the public" and that copies thereof may be obtained. 37 CFR 1.11(c) & (d) specifically provide that the public will be given notice of all requests for reexamination that have been given a filing date, and that all papers of record in the reexamination file are open to inspection by the general public. It is clear from these regulatory provisions that the record of a patent that has been reexamined and for which a reexamination certificate has been published will include the information of record in the reexamination file, and will be open to the public for inspection.

37 CFR 1.59 provides authority for the Office to expunge certain information from the record of a patent application, so that such information will not form part of the public record of any patent that issues from that application. MPEP § 724 *et. seq.* provides a mechanism to provisionally seal such information until the issue of expungment is addressed by the Office. This practice has been construed to apply to the record of a reexamination proceeding, so that information that would otherwise might be considered part of the patent, as "amended" by the reexamination certificate, could be submitted, and expunged from the file prior to the issue of the reexamination certificate when appropriate. MPEP § 724.02(c) provides the criteria for the filing of a petition under 37 CFR 1.59 to expunge information from the file of a reexamination proceeding. The Office may expunge information provided that such information has been determined to not be important to a reasonable examiner in deciding whether or not a claim is patentable. On the other hand, information that has been determined to be "important to a reasonable examiner..." will not be expunged. Rather, it will form part of the record of the issued patent, as amended by the resulting reexamination certificate, and this record will be a public record. Thus, the public will have the ability to review and understand the basis upon which patent claims were found patentable, as well as the basis upon which claims proposed during examination and/or reexamination were refused, and so will be better able to evaluate (for example), the scope of such claims and their strengths and weaknesses (e.g., what aspects of the claims were, and were not, taught by the art) .

III. Discussion re Expunging Identified Information Submitted By Patent Owner

37 CFR 1.933, which incorporates 37 CFR 1.555, provides that each individual associated with patent owner has a duty of "good faith and candor" in dealing with the Office throughout the course of the four pending *inter partes* reexamination proceedings. Patent owner, in any *inter partes* reexamination proceeding, must disclose to the Office "all" information known to each such individual to be material to patentability in that reexamination proceeding. 37 CFR 1.555 defines the meaning of information "material to patentability" as being a patent or printed publication that is non-cumulative and which (1) establishes, alone or in combination, a *prima facie* case of unpatentability of a claim pending in the reexamination proceeding, or (2) refutes a position taken by patent owner that opposes an argument of unpatentability relied upon by the Office, or (3) is inconsistent with a patent owner argument asserting patentability.

When patent owner brings to the attention of the examiner information in accordance with the definitions provided in 37 CFR 1.555, the examiner must consider this information, decide whether or not any of it is important to a determination of patentability of any pending claim, and as appropriate, either apply the information in the rejection of one or more claims, [1] or ultimately set forth in a reasons for patentability/confirmation statement, why one or more claims are patentable notwithstanding this information. [2]

As noted above in Section II of this decision, the patent statutes establish that the file of an issued patent and the file of a reexamination proceeding for a patent are public documents. The reexamination file is open to the public during the reexamination proceeding, and is considered to be part of the public file of the patent that has been reexamined following publication of the reexamination certificate. [3] The public is entitled to know, with respect to information that has been determined by the examiner to be non-cumulative and important to the question of

[1] See MPEP §§ 2660, 2672.02 and 2673 as to the requirements for complete actions that apply prior art to reject claims in an *inter partes* reexamination proceeding.
[2] See MPEP § 2688, Subsection IV for the requirement that the examiner explain reasons for patentability in an *inter partes* reexamination proceeding.
[3] See MPEP § 2632.

patentability of any pending claim, why that claim was considered to be either patentable or unpatentable in light of such information. Absent the ability to ascertain the "why" behind an examiner's holding of patentability or unpatentability of a given claim, the public may be unable to ascertain the true scope of the patent claims following issuance of the reexamination certificate. For example, important matters such as the existence, and extent, of file wrapper or prosecution estoppel, may be unclear to public. The availability of such information also permits evaluation of what aspects of the claims were, and were not, taught by the art, in the event there is knowledge of additional information to fill the gap in what was available to the skilled artisan at the time the invention was made. [4]

The existence of a protective order issued in connection with the present proceedings does not relieve the patent owner from compliance with its duty to disclose information material to patentability, even though the information in question is subject to the protective order. See *Mallinckrodt Inc. et. al. v. Masimo Corp. et. al*. [5] As stated by the *Mallinckrodt* District Court:

> "[Patentee] Masimo's attempt to demonstrate good faith was unconvincing. Masimo argued that the protective order governing the [prior] 642 litigation prohibited it from disclosing the litigation to the PTO. ... However, Masimo's counsel testified that he understood that he could have gone to the Masimo I Court and had material de-designated so that it would no longer be covered in the protective order. ... Masimo's counsel approached neither the Court nor Nellcor about withdrawing any material from the protective order in the 642 litigation for the purposes of disclosing it during the prosecution of the 830 patent. ... . Because Masimo made no attempt to overcome the barrier to disclosure presented by the protective order, this Court cannot find that it was more than a convenient excuse not to disclose. Had Masimo sought and been denied permission to disclose relevant information, the protective order would likely constitute evidence of good faith. But Masimo neither sought to withdraw material from the protective order, nor did it alert the PTO to the existence of material that could not be disclosed or even the fact that the litigation existed. The mere existence of the protective order is insufficient to demonstrate Masimo's good faith."

In the present *inter partes* reexamination proceedings, patent owner has a duty of "good faith and candor" in dealing with the Office. This duty requires patent owner to disclose all information known by each individual associated with patent owner that is material to patentability of the claims in these *inter partes* reexamination proceedings. 37 CFR 1.59 provides a mechanism, the procedure of which is explained in detail in MPEP § 724 *et seq*, for the submission of such information when the information is subject to a protective order. If patent owner follows the procedure, information submitted pursuant to that procedure will be maintained by the Office in a way that precludes public access to the information until such time as the information has been reviewed by the examiner. Where the examiner's review determines that such information <u>not</u> to be important to a patentability determination, the material will be expunged. If the material is determined by the examiner to be both non-cumulative to information of record and important to a patentability determination, the material must then become part of the publicly available record. Waiver of 37 CFR 1.59, and the practice thereunder, would undercut the statutory right of the public provided by 35 U.S.C §§ 151 and 316(a), by depriving the public of a complete record regarding patentability of the claims in the patents that are the subject of the present *inter partes* reexamination proceedings.

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[4] On the other hand, information that is determined by the examiner to not be important to the patentability of a pending claim in a reexamination proceeding is of no interest to the public, because the examiner has not made a detailed analysis thereof beyond the threshold determination that the information does not bear on the patentability of any of the claims proposed, or ultimately granted.

[5] *Mallinckrodt Inc. et. al. v. Masimo Corp. et. al.*, No. 00-6506 MRP (AJWx), 2004 U.S. Dist. LEXIS 28518, *86 (C.D. Cal., Cal., July 12, 2004) , aff'd-in-part,. Mallinckrodt Inc. *et. al.* v. Masimo Corp. *et. al.*, No. 04-1495, 04-1540, 147 Fed. Appx. 158, 181, 2005 U.S. App. LEXIS 19427 (Fed. Cir., September 7, 2005)(unpublished)

Accordingly, the Office will not waive 37 CFR 1.59 or any part of the examining practice associated therewith, notwithstanding the existence of the protective order.

To the extent that the patent owner deems that there is information subject to the protective order that patent owner must disclose to the Office pursuant to 37 CFR 1.933, and patent owner is concerned that this information will not be expunged based upon the above discussion, patent owner may seek modification of the protective order by the District Court to comply with the right of publication of information provided by the patent statute, by permitting the filing of such information in these *inter partes* reexamination proceedings notwithstanding that the information may become part of the public record.

IV. Discussion re Expunging Information Submitted By Third Party Requester

By its terms, 37 CFR 1.933 does not apply to a third party requester in an *inter partes* reexamination proceeding. Therefore, it appears that requester does not require relief in the form of waiving 37 CFR 1.59 and the associated examining practice under MPEP § 724 *et seq*, because third party requester may simply elect not to file information that third party requester knows to be subject to the protective order.

To the extent that third party requester could arguably be deemed to have a duty to disclose information in these proceedings, (*e.g.* information favorable to patentability or information that corrects or clarifies a previous submission by third party requester), the considerations stated in Sections II and III of this decision would apply with equal force to the requester. The public is entitled to access to all information that is submitted during the course of these *inter partes* reexamination proceedings that would be important to a reasonable examiner in determining patentability. Accordingly, the Office will not waive 37 CFR 1.59 or any part of the examining practice associated therewith, with respect to the requester, notwithstanding the existence of the asserted protective order.

If the third party requester deems it to be necessary to file information for consideration by the examiner that is subject to the protective order, then third party requester may seek modification of the protective order by the District Court to permit the filing of such information in these *inter partes* reexamination proceedings notwithstanding that the information may become part of the public record.

CONCLUSION

1. The joint patent owner and requester petition filed March 27, 2007, is dismissed.

2. Any request for reconsideration of this decision must be submitted within two months of the date of this decision, in accordance with 37 CFR 1.181(f).

3. Jurisdiction over each of the '120, '121, '122 and '123 *inter partes* reexamination proceedings is returned to the Central Reexamination Unit.

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

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

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