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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,203	01/16/2007	6,987,242	ITW 8637.62	3317

23721 7590 12/16/2009

CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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PAUL HASTING, JANOFSKY & WALKER LLP
875 15TH STREET N.W.
WASHINGTON, DC 20005-2003

Date:

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000203
PATENT NO. : 6987242
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.

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607 FOURTEEN STREET, NW
WASHINGTON, DC 20005-2003

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CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

(For Patent Owner)

PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15TH STREET N. W.
WASHINGTON, DC 20005

(For Third Party Requester)

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DEC 16 2009

CENTRAL REEXAMINATION UNIT

LINCOLN ELECTRIC COMPANY/PERKINS COIE LLP
607 FOURTEENTH STREET N.W.
WASHINGTON, DC 20005-2003

(Courtesy Copy)

In re: Geissler
Inter Partes Reexamination Proceeding
Control No. 95/000,203
Filed: January 16, 2007
For: U.S. Patent No. 6,987,242

: **DECISION GRANTING**
: **PETITION**
: **UNDER 37 CFR 1.182 AND**
: **37 CFR 1.183**

This is a decision on the October 30, 2009 patent owner petition entitled "PETITION PERSUANT TO 37 CFR 1.182 AND 1.183". The petition requests that the complete version of declaration under 37 CFR 1.131 by the inventor be allowed entry as evidence. All but one page of the declaration is attached to the appeal brief of October 30, 2009.

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

The petition fee of $400.00 pursuant to 37 CFR 1.16(f) for the petition under 37 CFR 1.182 will be charged to patent owner's Deposit Account No. 50-0599 pursuant to the authorization on page 1 of the petition.

The patent owner request to allow entry as evidence the complete version of the 37 CFR 1.131 declaration, pursuant 37 CFR 1.182 and 1.183, is **granted** for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On 17 January 2006, U.S. Patent No. 6,987,242 was granted to Geissler (the '242 patent).

2. On 13 December 2006, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,203 ('203 proceeding).

3. On 10 April 2007, an Order granting *inter parte* reexamination in the '203 proceeding was issued.

4. Also on 10 April 2007, the Office issued an Office action rejecting all claims of the '242 patent in view of U.S. Patent 6,365,868 (the '868 patent).

5. On 10 August 2007, the Patent Owner filed a *Response to the First Office Action for U.S. Patent 6329242* to the 10 April 2007 Office action. The response included an appendix containing a copy of a 37 CFR 1.131 declaration submitted to remove the '868 patent as prior art. The declaration was obtained from U.S. application 09/969,535 which had been expressly abandoned on October 27, 2003. U.S. Patent 6,987,242, the subject of the instant reexamination proceeding, is a continuation of 10/624,851 (now U.S. Patent 6,815,639) which is a continuation of 09/969,535.

6. On 7 September 2007, the Third Party Requester submitted *Comments to Patent Owner's Response Submitted Pursuant to 37 CFR 1.947 and 1.948*. The Third Party Requester addressed, in part, the 37 CFR 1.131 declaration (see Item #5 supra), arguing that the declaration did not overcome the '868 reference. The examiner adopted the Third Party Requester's position and issued an Action Closing Prosecution (ACP) on 20 February 2009.

7. On 24 March 2009, the Patent Owner filed an *Amendment and Response After ACP* and included a copy of the 37 CFR 1.131 declaration previously filed on 10 August 2007.

8. On 17 April 2009, the Third Party Requester filed *Comments to Patent Owner's Amendment and Response After ACP*. The Third Party requester asserted that the information in the declaration germane to the claims was not included in the 37 CFR 1.131 declaration provided and that information was missing from the declaration.

9. On 02 July 2009, the Office issued a Right of Appeal Notice (RAN).

10. On 30 October 2009, the Patent Owner filed the instant petition, along with an appellant brief under 37 CFR 41.67, attaching a complete version of the 37 CFR 1.131 declaration. In the instant petition, the Patent Owner, having reviewed the declaration in PAIR, affirms the Third Party Requester's assertion of 17 April 2009 (see Item #8 supra) that material is missing from the 37 CFR 1.131declaration. The Patent Owner contends that all but one page of the declaration is included in the 10 August 2007 version of the declaration. It is noted that the entire declaration is of record in the 09/969,535 application.

11. On 5 November 2009, the Third Party requester submitted, under 37 CFR 41.68, a respondent brief.

RELEVANT AUTHORITY

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.16(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 § 1.16(f).

37 CFR 1.951, Options after Office action closing prosecution in *inter partes* reexamination, provides:

(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 § 2672 II. OPTIONS AS TO WHICH ACTION TO ISSUE

(A) Right of Appeal Notice - Where no 37 CFR 1.951(a) submission has been filed by the patent owner, or where a submission under 37 CFR 1.951(a) (and 37 CFR 1.951(b)) has been filed and the examiner will not modify his/her position; the Examiner should issue a Right of Appeal Notice (RAN). See MPEP § 2673.02. If the patent owner 's submission included a proposed amendment, the RAN will indicate whether or not it was entered. Where a submission has been filed under 37 CFR 1.951(a) (or 37 CFR 1.951(b)) and that submission is incomplete or is defective, the examiner should notify the parties, in the RAN, that the submission has not been considered, and that no additional opportunity is available to correct the defect(s) in the submission, because 37 CFR 1.951(a) and (b) provide that comments may only be filed "once."

DECISION

I. Patent Owner's Petition of 05 October 2009

Petitioner requests waiver of the rules to allow the complete 37 CFR 1.131 declaration to be entered as evidence after the issuance of the RAN. (Pet. at p.1) Petitioner asserts that the declaration has been publicly available throughout the prosecution of the '203 proceeding.[1] Moreover, entering the missing page of the declaration is asserted to give the Board of Appeals the complete evidentiary record necessary to grant a decision. (Pet. at p.1). Petitioner further asserts that justice requires entry of the omitted page to provide a complete record. (Pet. at p.3). Petitioner states that it is not an undue burden or hardship to enter the complete declaration and for the Board of Appeals to consider the declaration in its entirety, as both the examiner and Third Party Requester have considered the merits of the declaration. (Pet at p.4).

II. Analysis and findings

The petition under 37 CFR 1.182 and 1.183 has been fully considered. The crux of the issue is whether the missing page of the § 131 declaration should be permitted entry even though the ACP and RAN have been issued by the Office. Petitioner states that entry of the declaration is warranted (even though the request for entry is being submitted after the ACP and RAN were issued) because the entire declaration has been publicly available since its initial filing on March 26, 2003 in application 09/969,535 (Pet. at p.2) A review of the record shows that the complete 37 CFR 1.131 declaration was filed in application 09/969,535, which was expressly abandoned on October 27, 2003. U.S. Patent 6,987,242, the subject of the instant reexamination proceeding, is a continuation of 10/624,851 (now U.S. Patent 6,815,639) which is a continuation of 09/969,535.

Application 10/826,534 is a continuation of application 09/540,567 which was granted as U.S. Patent 6,329,242, which is the subject of the instant reexamination proceeding. It is noted that the § 131 declaration was originally submitted to ante-date prior art reference U.S. Patent 6,365,868 cited during prosecution of the '535 application. The Third Party Requester relied on the same reference in this proceeding. Patent Owner filed the § 131 declaration from the '535 application to respond to the examiner's rejection relying on the '868 reference. During the proceeding and up to the ACP, the Third Party Requester discussed the merits of the § 131 declaration. After the ACP, the Third Party Requester argued the merits of the declaration and pointed out the omission of a page (Pet at p.2).

MPEP 2672 states that: "no additional opportunity is available to correct the defect(s) in the submission, because 37 CFR 1.951(a) and (b) provide that comments may only be filed "once."" In the instant situation, however, the § 131 declaration was timely filed in the reexamination, albeit with a missing page. The record shows that neither the Third Party

[1] The instant inter partes reexamination is one of three reexaminations from a single patent family. US Patent 6,329,636, US Patent 6,987,242 and US Patent 6,815,639 comprise the patent family. US Patent 6,987,242 is a continuation of 6,815,639 which is continuation of 09/969,535 (now abandoned), which is a continuation of US Patent 6,329,636.

Requester nor the examiner pointed out the defect during the proceeding, until after the ACP was issued. At that time, the Third Party Requester pointed out the missing page of the declaration. The complete declaration has been available to the public in the continuation application, 09/969,535, of the '242 patent since March 26, 2003.

When the competing interests are compared, and based on the specific facts and circumstances of this case, justice is best served by allowing the entry of the complete declaration into evidence. Patent Owner's submission of the declaration, without a page, appears to be an unintentional omission. Neither the Third Party Requester nor the examiner pointed out the omission in the earlier stages of the proceeding. No other avenue is open to the Patent Owner at this stage of the proceeding for resubmission of the entire declaration, other than via the relief requested in the instant petition. Allowing the entire declaration into evidence affords the Board of Appeals the complete record, as the § 131 declaration is a germane piece of evidence to the outcome of the proceeding.

The October 21, 2009 power of attorney and change of correspondence address is ineffective because it is not signed by an individual in the organization having apparent authority to sign on behalf of the organization. For example, an officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. A person having the title of Chief Counsel does not clearly set forth that person as an officer of the organization. See MPEP 324. Accordingly, the current address of record for the third party requester is the address appearing in the caption of this decision. A courtesy copy is being mailed to the address of PERKINS COIE LLP, 607 FOURTEENTH STREET N.W., WASHINGTON, DC 20005-2003. However, in the absence of a properly executed change of power of attorney, all future correspondence will be mailed to the address of record for the third party requester.

Accordingly, Patent Owner's petition under 37 CFR 1.182 and 1.183 is **granted**.

CONCLUSION

1. The Patent Owner petition under 37 CFR 1.182 and 1.183 is **granted**.

2. Requester is provided with a time period of 15 days from the mailing of this decision to supplement its respondent brief, solely directed to the added page of declaration evidence.

3. The October 21, 2009 power of attorney and change in correspondence address is **ineffective**. A courtesy copy of this decision is being mailed to the address of PERKINS COIE LLP, 607 FOURTEENTH STREET N.W., WASHINGTON, DC 20005-2003. In the absence of a proper submission of a power of attorney and change of correspondence address, all future correspondence in this reexamination proceeding will be mailed to the address of record for the third party requester.

4. Jurisdiction over the present reexamination proceeding is being forwarded 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

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23721 7590 01/27/2010
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APPLETON, WI 54915

EXAMINER	
NGUYEN, LINH M	
ART UNIT	**PAPER NUMBER**
3992	

MAIL DATE	DELIVERY MODE
01/27/2010	PAPER

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

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JAN 27 2010

CENTRAL REEXAMINATION UNIT

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PATENT NO. : 6987242
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ROBERT M. MASTERS
875 15TH STREET, NW
WASHINGTON DC 20005

MAILED

JAN 27 2010

CENTRAL REEXAMINATION UNIT

In re Application of :
Steven J. Geissler :
Control No. 95/000,203 (U.S. Patent 6,987,242) : DECISION ON PETITION
Filed: November 5, 2009 : TO WITHDRAW
Attorney Docket No. 70465.00008.003 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 5, 2009.

The request is **APPROVED**.

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

The request was signed by Randall Bateman on behalf of all attorneys of record. All attorneys/agents have been withdrawn.

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

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

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

Telephone inquiries concerning this decision should be directed to Denise Boyd at 571-272-0992.

cc: **Lincoln Electric Company/Perkins Coie LLP**
607 Fourteenth Street, NW
Washington, DC 20005-2003

Corrigan Law Office
5 Briarcliff CT
Appleton, WI 54915

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CENTRAL REEXAMINATION UNIT

George R. Corrigan
Corrigan Law Office
5 Briarcliff Court
Appleton, WI 54915

For Patent Owner

Paul J. Wilson
Paul Hasting Janofsky & Walker LLP
875 15th Street N.W.
Washington DC 20005

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,204
Filed: January 17, 2007
For: US Patent No. 6,815,639

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.956]

This is a decision on the petition filed May 14, 2007 to request a sixty (60) day extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed April 10, 2007.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated April 10, 2007, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(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 to date, Patent Owner and counsel have been coordinating and reviewing the materials at issue. The present reexamination is one of five (5) requests for reexamination on five separate patents for which reexamination was ordered on April 10, 2007. This has resulted in a large volume of materials to review. Additional time is necessary in order to undertake the required analysis of the cited art references and formulate and draft responses for each of the patents at issue. It is anticipated that Patent Owner will be unable to fully and completely respond to the instant Office action by the current due date. An extension of time for sixty (60) days is requested to provide Patent Owner with a fair opportunity to respond to the outstanding Office action.

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 two-month extension of time in which to file a response to the Office action. Accordingly, the response is due August 9, 2007. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of April 10, 2007 is **granted**.

2. The Patent Owner's response is due August 9, 2007.

3. Response may be submitted as follows:

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

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

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

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

for Lissi M. Marquis,
Director,
Central Reexamination Unit

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

CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

(For Patent Owner)

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15TH STREET N. W.
WASHINGTON, DC 20005

(For Third Party Requester)

LINDOLN ELECTRIC COMPNAY
PERKINS COIE LLP
607 FOURTEENTH STREET, NW
WASHINGTON, DC 2005-2003

(Courtesy Copy)

In re: Geissler
Inter Partes Reexamination Proceeding
Control No. 95/000,204
Filed: January 17, 2007
For: U.S. Patent No. 6,815,639

: **DECISION GRANTING**
: **PETITION**
: **UNDER 37 CFR 1.182 AND**
: **37 CFR 1.183**
:
:

This is a decision on the October 05, 2009 patent owner petition entitled "PETITION PERSUANT TO 37 CFR 1.182 AND 1.183". The petition requests that the complete version of declaration under 37 CFR 1.131 by the inventor be allowed entry as evidence. All but one page of the declaration is attached to the appeal brief of October 05, 2009.

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

The petition fee of $400.00 pursuant to 37 CFR 1.16(f) for the petition under 37 CFR 1.182 will be charged to patent owner's Deposit Account No. 50-0599 pursuant to the authorization on page 1 of the petition.

The patent owner request to allow entry as evidence the complete version of the 37 CFR 1.131 declaration, pursuant 37 CFR 1.182 and 1.183, is **granted** for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On 17 January 2006, U.S. Patent No. 6,815,639 was granted to Geissler (the '639 patent).

2. On 13 December 2006, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,204 ('204 proceeding).

3. On 27 February 2007, a filing date of 17 January 2007 was assigned to the proceeding.

4. On 10 April 2007, an Order granting *inter parte* reexamination in the '204 proceeding was issued.

5. Also on 10 April 2007, the Office issued an Office action rejecting 1-18 and 20-34 claims of the '639 patent in view of U.S. Patent 6,365,868 (the '868 patent) and other references.

6. On 10 August 2007, the Patent Owner filed a *Response to the First Office Action for U.S. Patent 6815,639* to the 10 April 2007 Office action. The response included an appendix containing a copy of a 37 CFR 1.131 declaration submitted to remove the '868 patent as prior art. The declaration was obtained from U.S. application 09/969,535 which had been expressly abandoned on October 27, 2003. U.S. Patent 6,815,639, the subject of the instant reexamination proceeding, is a continuation of 09/969,535.

7. On 7 September 2007, the Third Party Requester submitted *Comments to Patent Owner's Response Submitted Pursuant to 37 CFR 1.947 and 1.948*. The Third Party Requester addressed, in part, the 37 CFR 1.131 declaration (see Item #5 supra), arguing that the declaration did not overcome the '868 reference. The examiner adopted the Third Party Requester's position and issued an Action Closing Prosecution (ACP) on 20 February 2009.

8. On 24 March 2009, the Patent Owner filed an *Amendment and Response After ACP* and included a copy of the 37 CFR 1.131 declaration previously filed on 10 August 2007.

9. On 17 April 2009, the Third Party Requester filed *Comments to Patent Owner's Amendment and Response After ACP*. The Third Party requester asserted that the information in the declaration germane to the claims was not included in the 37 CFR 1.131 declaration provided and that information was missing from the declaration.

10. On 02 July 2009, the Office issued a Right of Appeal Notice (RAN).

11. On 05 October 2009, the Patent Owner filed the instant petition, along with an appellant brief under 37 CFR 41.67, attaching a complete version of the 37 CFR 1.131 declaration. In the instant petition, the Patent Owner, having reviewed the declaration in PAIR, affirms the Third Party Requester's assertion of 17 April 2009 (see Item #8 supra) that material is missing from the 37 CFR 1.131declaration. The Patent Owner contends that all but one page of the declaration is included in the 10 August 2007 version of the declaration. It is noted that the entire declaration is of record in the 09/969,535 application.

12. On 5 November 2009, the Third Party requester submitted, under 37 CFR 41.68, a respondent brief.

RELEVANT AUTHORITY

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.16(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 § 1.16(f).

37 CFR 1.951, Options after Office action closing prosecution in *inter partes* reexamination, provides:

(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 § 2672 II. OPTIONS AS TO WHICH ACTION TO ISSUE

(A) Right of Appeal Notice - Where no 37 CFR 1.951(a) submission has been filed by the patent owner, or where a submission under 37 CFR 1.951(a) (and 37 CFR 1.951(b)) has been filed and the examiner will not modify his/her position; the Examiner should issue a Right of Appeal Notice (RAN). See MPEP § 2673.02. If the patent owner 's submission included a proposed amendment, the RAN will indicate whether or not it was entered. Where a submission has been filed under 37 CFR 1.951(a) (or 37 CFR 1.951(b)) and that submission is incomplete or is defective, the examiner should notify the parties, in the RAN, that the submission has not been considered, and that no additional opportunity is available to correct the defect(s) in the submission, because 37 CFR 1.951(a) and (b) provide that comments may only be filed "once."

DECISION

I. Patent Owner's Petition of 05 October 2009

Petitioner requests waiver of the rules to allow the complete 37 CFR 1.131 declaration to be entered as evidence after the issuance of the RAN. (Pet. at p.1) Petitioner asserts that the declaration has been publicly available throughout the prosecution of the '203 proceeding.[1] Moreover, entering the missing page of the declaration is asserted to give the Board of Appeals the complete evidentiary record necessary to grant a decision. (Pet. at p.1). Petitioner further asserts that justice requires entry of the omitted page to provide a complete record. (Pet. at p.3). Petitioner states that it is not an undue burden or hardship to enter the complete declaration and for the Board of Appeals to consider the declaration in its entirety, as both the examiner and Third Party Requester have considered the merits of the declaration. (Pet at p.4).

II. Analysis and findings

The petition under 37 CFR 1.182 and 1.183 has been fully considered. The crux of the issue is whether the missing page of the 131 declaration should be permitted entry even though the ACP and RAN have been issued by the Office. Petitioner states that entry of the declaration is warranted (even though the request for entry is being submitted after the ACP and RAN were issued) because the entire declaration has been publicly available since its initial filing on March 26, 2003 in application 09/969,535 (Pet. at p.2) A review of the record shows that the complete 37 CFR 1.131 declaration was filed in application 09/969,535, which was expressly abandoned on October 27, 2003. U.S. Patent 6,815,639, the subject of the instant reexamination proceeding, is a continuation of 09/969,535. It is noted that the § 131 declaration was originally submitted to ante-date prior art reference U.S. Patent 6,365,868 cited during prosecution of the '535 application. The Third Party Requester relied on the same reference in this proceeding. Patent Owner filed the § 131 declaration from the '535 application to respond to the examiner's rejection relying on the '868 reference. During the proceeding and up to the ACP, the Third Party Requester discussed the merits of the § 131 declaration. After the ACP, the Third Party Requester argued the merits of the declaration and pointed out the omission of a page (Pet at p.2).

MPEP 2672 states that: "no additional opportunity is available to correct the defect(s) in the submission, because 37 CFR 1.951(a) and (b) provide that comments may only be filed "once."" In the instant situation, however, the § 131 declaration was timely filed in the reexamination, albeit with a missing page. The record shows that neither the Third Party Requester nor the examiner pointed out the defect during the proceeding, until after the ACP was issued. At that time, the Third Party Requester pointed out the missing page of the declaration. The complete declaration has been available to the public in the continuation application, 09/969,535, of the '639 patent since March 26, 2003.

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[1] The instant inter partes reexamination is one of three reexaminations from a single patent family. US Patent 6,329,636, US Patent 6,987,242 and US Patent 6,815,639 comprise the patent family. US Patent 6,987,242 is a continuation of 6,815,639 which is continuation of 09/969,535 (now abandoned), which is a continuation of US Patent 6,329,636.

When the competing interests are compared, and based on the specific facts and circumstances of this case, justice is best served by allowing the entry of the complete declaration into evidence. Patent Owner's submission of the declaration, without a page, appears to be an unintentional omission. Neither the Third Party Requester nor the examiner pointed out the omission in the earlier stages of the proceeding. No other avenue is open to the Patent Owner at this stage of the proceeding for resubmission of the entire declaration, other than via the relief requested in the instant petition. Allowing the entire declaration into evidence affords the Board of Appeals the complete record, as the § 131 declaration is a germane piece of evidence to the outcome of the proceeding.

The October 21, 2009 power of attorney and change of correspondence address is ineffective because it is not signed by an individual in the organization having apparent authority to sign on behalf of the organization. For example, an officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. A person having the title of Chief Counsel does not clearly set forth that person as an officer of the organization. See MPEP 324. Accordingly, the current address of record for the third party requester is the address appearing in the caption of this decision. A courtesy copy is being mailed to the address of PERKINS COIE LLP, 607 FOURTEENTH STREET N.W., WASHINGTON, DC 20005-2003. However, in the absence of a properly executed change of power of attorney, all future correspondence will be mailed to the address of record for the third party requester.

Accordingly, patent owner's petition under 37 CFR 1.182and 1.183 is **granted**.

CONCLUSION

1. The Patent Owner petition under 37 CFR 1.182 and 1.183 is **granted**.

2. Requester is provided with a time period of 15 days from the mailing of this decision to supplement its respondent brief, solely directed to the added page of declaration evidence.

3. The October 21, 2009 power of attorney and change in correspondence address is **ineffective**. A courtesy copy of this decision is being mailed to the address of PERKINS COIE LLP, 607 FOURTEENTH STREET N.W., WASHINGTON, DC 20005-2003. In the absence of a proper submission of a power of attorney and change of correspondence address, all future correspondence in this reexamination proceeding will be mailed to the address of record for the third party requester.

4. Jurisdiction over the present reexamination proceeding is being forwarded 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

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
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CENTRAL REEXAMINATION UNIT

George R. Corrigan
Corrigan Law Office
5 Briarcliff Court
Appleton, WI 54915

For Patent Owner

Paul J. Wilson
Paul Hasting Janofsky & Walker LLP
875 15th Street N.W.
Washington DC 20005

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,205
Filed: February 2, 2007
For: US Patent No. 7,049,546

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.956]

This is a decision on the petition filed May 14, 2007 to request a sixty (60) day extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed April 10, 2007.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated April 10, 2007, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(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 to date, Patent Owner and counsel have been coordinating and reviewing the materials at issue. The present reexamination is one of five (5) requests for reexamination on five separate patents for which reexamination was ordered on April 10, 2007. This has resulted in a large volume of materials to review. Additional time is necessary in order to undertake the required analysis of the cited art references and formulate and draft responses for each of the patents at issue. It is anticipated that Patent Owner will be unable to fully and completely respond to the instant Office action by the current due date. An extension of time for sixty (60) days is requested to provide Patent Owner with a fair opportunity to respond to the outstanding Office action.

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 two-month extension of time in which to file a response to the Office action. Accordingly, the response is due August 9, 2007. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of April 10, 2007 is **granted**.

2. The Patent Owner's response is due August 9, 2007.

3. Response may be submitted as follows:

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

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

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

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

/Deborah Jones/ for
Lissi M. Marquis,
Director,
Central Reexamination Unit

United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

George R. Corrigan
Corrigan Law Office
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Appleton, WI 54915

(For Patent Owner)

Bhaskar Kakarla
Paul, Hastings, Janofsky & Walker LLP
875 15th Street N. W.
Washington, DC 20005

(For Third Party Requester)

In re Thommes
Inter Partes Reexamination Proceeding
Control No. 95/000,205
Filed: February 2, 2007
For: U.S. Patent No. 7,049,546

: **DECISION**
: **DISMISSING PETITION**
: **AND EXPUNGING**
: **IMPROPER PAPER**

This is a decision on the December 2, 2008 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.182 –REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 C.F.R. § 1.943(b)." The present petition is taken as a petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b). The petition requests waiver of the 37 CFR 1.943(b) requirement that written comments by the third party requester not exceed fifty (50) pages in length, and it requests that the page limit be extended to eighty (80) pages to address the issues raised in the November 26, 2008 patent owner response and in the November 14, 2008 Action Closing Prosecution.

Third party requester subsequently filed written comments on December 29, 2008, entitled "REQUESTER'S REPLY TO PATENT OWNER'S AMENDMENT AND RESPONSE AFTER ACTION CLOSING PROCEEDING OF NOVEMBER 26, 2008," accompanied by Exhibits A-I attached to the comments. Third party requester concurrently filed an Information Disclosure Statement with the December 29, 2008 written comments, to cite references relied upon in the December 29, 2008 written comments.

The present petition and *inter partes* reexamination control number 95/000,205 are before the Office of Patent Legal Administration.

The petition to waive the page limit requirement is dismissed.

For reasons set forth below, the December 29, 2008 written comments and Information Disclosure Statement filed by third party requester are improper papers and are being expunged from the record without consideration by the examiner. Since the December 29, 2008 third party requester papers have been scanned into the Image File Wrapper (IFW) of the 95/000,205 *inter partes* reexamination proceeding, these papers are being expunged from the record by closing them and marking them "not public" in the IFW of the 95/000,205 *inter partes* reexamination proceeding.

REVIEW OF FACTS

1. U.S. patent No. 7,049,546 ("the '546 patent") issued to James M. Thommes on May 23, 2006, and is currently assigned to Illinois Tool Works Inc.

2. The '546 patent is the subject of civil litigation captioned *Lincoln Electric Company v. Miller Electric Mfg. Co. et al.*, U.S. District Court, Northern District of Ohio, Cleveland Division, Case No. 1:06cv2981, which commenced on December 13, 2006.

3. On February 2, 2007, a request for *inter partes* reexamination of the '546 patent, assigned control No. 95/000,205 (the '205 proceeding), was filed by a third party requester on behalf of the Lincoln Electric Company (hereafter "third party requester").

4. On February 15, 2007, a "NOTICE OF *INTER PARTES* REEXAMINATION REQUEST FILING DATE" was mailed by the Office.

5. On April 10, 2007, the Office issued an order granting the request for *inter partes* reexamination of claims 1-47, i.e., all of the '546 patent claims. A non-final Office action rejecting claims 1-47 was mailed concurrently with the order granting reexamination.

6. On May 14, 2007, patent owner filed a petition entitled "Petition for Extension of Time Pursuant to 37 C.F.R. § 1.956" to extend the time to respond to the Office action by 60 days, to August 9, 2007.

7. On June 4, 2007, the Office mailed a decision on the May 14, 2007 patent owner petition, extending the period to respond (to the April 10, 2007 Office action) to August 9, 2007.

8. On August 8, 2007, patent owner filed a timely response to the April 10, 2007 Office action.

9. On September 7, 2007, third party requester filed "REQUESTER'S REPLY TO OWNER'S RESPONSE TO FIRST OFFICE ACTION FOR U.S. PATENT NO. 7,049,546 OF AUGUST 8, 2007," accompanied by a Notice of concurrent proceedings pursuant to 37 CFR 1.985.

10. On November 14, 2008, the Office mailed an Action Closing Prosecution (ACP) rejecting claims 1-18, and 23-47 and confirming claims 19-22.

11. On November 26, 2008, patent owner filed an amendment and response after ACP.

12. On December 2, 2008, third party requester filed the present petition entitled "PETITION UNDER 37 C.F.R. § 1.182 –REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 C.F.R. § 1.943(b)."

13. On December 29, 2008, third party requester filed comments entitled "REQUESTER'S REPLY TO PATENT OWNER'S AMENDMENT AND RESPONSE AFTER ACTION CLOSING PROCEEDING OF NOVEMBER 26, 2008," accompanied by attached Exhibits A-I. An Information Disclosure Statement was also concurrently filed with the third party requester comments.

DECISION

I. DECISION EXPUNGING THIRD PARTY REQUESTER'S COMMENTS SUBMITTED DECEMBER 29, 2008

A. Relevant portions of the statute, regulations and MPEP are reproduced as follows:

35 U.S.C. § 314(b)(2) states:

(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 1.939(a) states:

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

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.

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 1.985(b) states:

Notwithstanding any provision of the rules, any person at any time may file a paper in an inter partes reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current inter partes reexamination proceeding. Any paper not so limited will be returned to the sender. [Emphasis added]

MPEP § 2672 (IV) (PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED) states:

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2). Such third party requester comments must be filed within 30 days from the **date of service** of the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP on the third party requester. If the third party requester's comments go beyond the scope of responding to the patent owner's comments, and/or proposed amendments, and/or the issues raised in the ACP, then the third party requester's comments will be returned as improper; 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 party that submitted the comments. No additional opportunity will be given for the third party requester 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. Any replacement third party requester comments under 37 CFR 1.951 (that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission. [Emphasis added]

MPEP § 2686 (NOTIFICATION OF EXISTENCE OF PRIOR OR CONCURRENT PROCEEDINGS AND DECISIONS THEREON) provides in pertinent part:

*****

Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office.

*****

B. Third party requester's comments filed December 29, 2008, are improper for not being limited to issues permitted in the reexamination proceeding

Third party requester's comments filed on December 29, 2008 are improper because they are not limited to issues permitted in the reexamination proceeding.

(1) The third party requester's written comments contain certain allegations regarding patent owner conduct, and such allegations are improper and are not permitted in the reexamination statute or rules. See, for example, page 3 of third party requester's comments, where requester discusses the Second Amended Complaint from the concurrent civil litigation attached as Exhibit C and makes certain allegations of patent owner's conduct. See particularly the paragraph on page 3 beginning with "After Owner's filing of an unsuccessful motion to dismiss..." Conduct allegations are improper in a reexamination proceeding, since they are not directed to the merits of the proceeding. Discussion of conduct has no bearing on how patents or printed publications relate to the patentability of the claims. There is simply no statutory authority for entry of conduct information into the patent by way of reexamination. [1] As such, the comments filed December 29, 2008, which would become part of the patent's record if retained, do not have an entry right, in accordance with 35 U.S.C. §§ 301 and 311.

It is understood that a third party requester may properly provide certain information pertaining to litigation involving the patent for which reexamination is being requested under policy set forth in the Office's rules and procedures. In an *inter partes* reexamination proceeding, parties may provide notice to the Office of prior or concurrent proceedings in which the patent (for which reexamination was requested) is or was involved, including interferences, reissues, reexamination, or litigations, and results of such proceedings. However, parties must comply with the requirements for such notice by the parties, as set forth in the portion of MPEP § 2686 cited above and 37 CFR 1.985(b). A discussion of litigation, including allegations of misconduct on the part of the patent owner goes well beyond what is permitted, and thus, is not entitled to entry right in the reexamination proceeding.

(2) The third party requester's comments are not limited to the patent owner's comments and proposed amendment filed on November 26, 2008, and issues raised in the ACP. See 35 U.S.C. § 314(b)(2) and MPEP § 2672 (IV) (PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED).

The ACP Mailed November 14, 2008

In the Action Closing Prosecution (ACP) mailed on November 14, 2008, the examiner acknowledged and responded to all of the rejections proposed by and comments made by third party requester on September 7, 2007 (see pages 6-19 of the ACP). On page 13 of the ACP, the examiner agreed with the patent owner's comments in view of the amendment to the claims and

[1] It is also observed that the presence of such information in the public record could potentially have a negative or prejudicial effect on the public perception of the patent, despite the fact that there is no statutory authority for entry of such information into the patent.

withdrew all of the prior art rejections applied in the non-final Office action. However, the examiner agreed with the third party requester that claims 1, 6, 14, 23, 26, 30, 32, 34, and 36-39 were indefinite and rejected these claims under 35 U.S.C. 112, second paragraph. The § 112 rejections were directed to amended claim limitations made by patent owner in response to the non-final rejection. On pages 19-22 of the ACP, the examiner set forth reasons as to why the 4 rejections under 35 U.S.C. 102 proposed by third party requester on September 7, 2007, were not adopted. On pages 22-43 of the ACP, the examiner agreed with the patent owner, for reasons set forth therein, that the prior art references applied in the 22 rejections under 35 U.S.C. 103 proposed by third party requester on September 7, 2007 were either not analogous art or did not teach the claimed limitations. On page 50 of the ACP, the examiner confirmed patentability of claims 19-22 and stated that patentability of claims 1-18 and 23-47 would be confirmed if patent owner amended the claims to overcome the rejections under 35 USC 112, 2nd paragraph for reasons set forth in the ACP.

Patent Owner's Response to the ACP

Patent owner's response filed on November 26, 2008 was limited to 2 pages of remarks and made amendments to the claims only in accordance with examiner's suggestions to overcome 112, second paragraph rejections in the ACP and to place the claims in condition for a finding of patentability.

Analysis of Requester's Comments filed December 29, 2008

On pages 20-44 of the written comments filed on December 29, 2008, third party requester proposes rejections under 35 U.S.C. 103 that are not limited solely to the issues raised (a) in patent owner's November 26, 2008 response after the ACP or (b) in the ACP itself. The following is a list of examples (which are not exhaustive) in which third party requester improperly addresses arguments in patent owner's prior response, submitted August 8, 2007 (referred to as "*Non-Final Amendment*" in third party requester's comments), but not submitted in patent owner's November 26, 2008 response:

> On pages 20, 26, and 29 of the comments, third party requester addresses patent owner's arguments at page 43 of the August 8, 2007 response;
>
> On page 22 of the comments, third party requester addresses patent owner's arguments at page 50 of the August 8, 2007 response;
>
> On page 30 of the comments, third party requester addresses patent owner's arguments at pages 35-36 of the August 8, 2007 response; and
>
> On page 31 of the comments, third party requester addresses patent owner's response at pages 33-36 of the August 8, 2007 response.

These are examples of comments not responsive to the ACP or to the patent owner's response to the ACP.

Furthermore, on pages 46-47 of the written comments, third party requester's proposed 35 U.S.C. 112 (second paragraph) rejections for claims 1-5, 23-25, and 30-38 are not limited to the

issues raised in patent owner's response to the ACP, or in the ACP itself. For example, after ACP, patent owner amended claim 1 by changing "peak" to "rectified magnitude" and made no other amendments to claim 1. Third party requester asserts that the recitation of "the input" in independent claim 1 has no antecedent basis. However, this proposed 35 U.S.C. 112 rejection for lack of antecedent basis by third party requester is not responsive to the ACP or patent owner's response, or patent owner's amendment after ACP, since this proposed rejection is directed to a portion of the claim not amended after ACP.

In view of the above discussion as to the comments filed December 29, 2008 being improper, the comments are expunged from the record in the manner described above.

II. DECISION DISMISSING PETITION TO WAIVE THE REQUIREMENTS OF 37 CFR 1.943(b)

A. Relevant portions of the regulations and MPEP are reproduced as follows:

37 CFR 1.183 states:

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

37 CFR 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(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

*****

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise,

> if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.
>
> *****

Petitioner states that, after the first Office action, all 47 claims stood rejected on the merits using over 25 prior art references and that many of the claims were rejected due to various §112 issues. Petitioner contends that, after the first Office action, a new Examiner withdrew the prior art rejections on the merits in reliance on patent owner's broad generalizations and conclusory statements that approximately 19 of these references were "non-analogous." The petitioner points out that, in patent owner's response after ACP, the patent owner amended the independent claims in apparent attempt to overcome the §112 rejections. Petitioner states that the response to owner's amendments will include proposed rejections for each of these 47 claims with combinations including these 19 references and possibly additional prior art. The petitioner states that the proposed rejections will include the reasons why the prior art is pertinent to the problem being solved and why the combination would have been obvious for one skilled in the art. Petitioner states that the length of the requestor's initial request for reexamination was over 182 pages (excluding attachments) and that there will be some reduction in length in the proposed response because reference can be made to arguments in prior submissions. Therefore, petitioner requests that the page limit be extended to 80 pages.

The ACP mailed on November 14, 2008 totaled 48 pages, not including 5 cover sheets, 1 page of correspondence information, and 1 signature page. The content of the ACP is discussed in Section I above.

Patent owner's response filed on November 26, 2008 after ACP included 2 pages of remarks, 16 pages of Appendix A listing all of the claims, and 8 pages listing only amended claims. Patent owner's response totaled 2 pages of substantive remarks, since claim appendices are excluded from the page count limit. The only amendments to the claims were made in accordance with examiner's suggestions to overcome §112, second paragraph, rejections in the ACP, and to place the claims in condition for confirmation.

A review of the third party requester comments filed on December 29, 2008, reveals that the comments exceed the length requirements as set forth by 37 CFR 1.943(b), which limits the response to 50 pages. The third party requester's comments comprise sixty-one pages of remarks and Exhibits A-I, which consist of data sheets, references, and two affidavits. The sixty-one page requester remarks include 11 pages of table of contents; thus the comments *per se* contain fifty pages of written comments that are subject to the 50-page limit set forth in 37 CFR 1.943(b).

It is noted that any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943. Thus, if a third party requester affidavit or declaration includes any legal argument as to how a rejection is

supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included in the page limit count.

Exhibit A is a 40-page declaration entitled "DECLARATION OF ROBERT A. MAMMANO IN SUPPORT OF REQUESTER'S REPLY TO PATENT OWNER'S "AMENDMENT AND RESPONSE TO ACTION CLOSING PROCEEDINGS" FOR PATENT NO. 7,049,546 OF NOVEMBER 26, 2008," and Exhibit B is a 15-page declaration entitled "DECLARATION OF PROFESSOR TED K. HIGMAN IN SUPPORT OF REQUESTER'S REPLY TO PATENT OWNER'S RESPONSE TO "AMENDMENT AND RESPONSE TO ACTION CLOSING PROCEEDINGS" FOR U.S. PATENT NO. 7,049,546 OF NOVEMBER 26, 2008." These two declarations do not contain any legal arguments or conclusions; therefore, they are not counted as remarks falling within the 37 CFR 1.943 page limit.

As discussed in Section I above, Exhibit C is a 62-page copy (excluding 1 cover page) of a proposed Second Amended Compliant from the concurrent civil litigation. The third party requester states on page 3 of the written comments that requester filed the Second Amended Complaint containing certain allegations regarding patent owner's conduct. Such allegations are improper in a reexamination proceeding since they are not directed to the merits of the proceeding. Therefore, **62 pages** of the Compliant are counted toward the 50 page count limit since the Complaint is neither an amendment, appendix of claims, or a reference material such as a prior art reference that is excluded in the page count limit in 37 CFR 1.943(b). Note however, that since such material is improper, and thus would not be allowed entry into the file, any resubmission of the comments presumably would not include these pages.

Exhibits D, E, F, and G are reference materials that are excluded from the page limit under 37 CFR 1.943(b).

Exhibits H and I are, respectively, a copy of patent owner's 47-page response to the first Office action in related reexamination proceeding 95/000,216 and a copy of the 25-page (excluding 5 pages of cover sheets) ACP in related reexamination proceeding 95/000,216. On page 1 of the third party requester's comments, requester asserts that claims with nearly identical scope were rejected by another examiner in related *inter partes* proceedings (i.e., 95/000,216).[2] Since Exhibits H and I concern legal arguments of claim rejections, **47 pages** of the patent owner response and **25 pages** of the ACP from the related *inter partes* proceeding 95/000,216 included as Exhibits in third party requester's comments are counted towards the 50-page limit.

Therefore, *in toto,* the third party requester comments filed on December 29, 2008 are 184 pages in length (50 pages in the remarks section, and 134 pages in the attached Exhibits) which greatly exceed the request in the present petition to extend the page limit to 80 pages.

In light of the equities of having to respond to patent owner's 2 pages of substantive remarks and claim amendments addressing only § 112 issues raised in the ACP and to the examiner's 48-page ACP adopting only third party requester's § 112, second paragraph, rejections and not adopting

[2] Third party requester incorrectly states in footnote 1 on page 1 in the third party requester written comments that the related *inter partes* proceeding Control No. is 95/000,205. Instead, the instant *inter partes* proceeding is 95/000,205, and the related *inter partes* proceeding is 95/000,216.

third party requester's proposed 26 prior art rejections, permitting a response of 184 pages does not balance the equities between the parties in an *inter partes* proceeding. In a balancing of the equities, the third party requester is not granted a waiver of the 50-page limit requirement under 37 CFR 1.943(b) up to the length of the December 29, 2008 response submitted by the third party requester, which by this decision is concluded to be 184-pages. Both the ACP and patent owner's response filed on November 26, 2008 each did not exceed 50 pages in substantive remarks. Thus, the present petition to waive the 37 CFR 1.943(b) requirement that written comments by the third party requester not exceed fifty (50) pages in length and request that the page limit be extended to 80 pages to address the issues raised in the November 26, 2008 patent owner response and those raised in the November 14, 2008 Action Closing Prosecution is not granted.

Therefore, the December 29, 2008 third party requester comments do not comply with the requirements of 37 CFR 1.943(b), since the written comments exceed fifty (50) pages. Accordingly, the written comments filed by the third party requester lack an entry right in the present '205 *inter partes* reexamination proceeding.

THIRD PARTY REQUESTER OPTIONS

For the reasons given above, the December 29, 2008 comments submitted by the third party requester are improper as not being limited to issues permitted in a reexamination proceeding (i.e., comments regarding patent owner's conduct that are inappropriate, and comments that are not limited to the patent owner's response to the ACP or issues raised in the ACP itself).

No additional opportunity will be given for the third party requester 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. Any replacement third party requester comments under 37 CFR 1.951 that are submitted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission. See section in MPEP § 2672 (IV) cited above.

As to any replacement written comments, the third party requester is limited to the 50-page limit requirement under 37 CFR 1.943(b). The requester **should review the entire replacement written comments** prior to filing the response for inappropriate/non-statutory comments or comments outside the scope of issues raised in the patent owner response after ACP or in the ACP itself, and **is not to limit the review to the specific pages mentioned as examples in the above discussion**.

Submissions notifying the Office of prior or concurrent proceedings in which the patent is or was involved will be accepted only if the statements are limited to bare notice of the prior or concurrent proceedings, and made in a separate paper.

As to the prior art or references directed to the comments, they are not counted against the page limit. The requester may request, in any replacement comments submission that may be made, that the closed copies of prior art or references be re-opened; copies need not be re-submitted. **However, the prior art submitted must be shown to comply with 37 CFR 1.948(a). Any**

response that does not include a discussion of this matter, to which the Central Reexamination Unit can refer, will be improper.

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 written comments (and attachments) by the third party requester.

ADVISORY

MPEP § 2609 states in part:

> Patent owners and third party requesters are cautioned that the reexamination statute, regulations, and published examining procedures do not countenance so-called "litigation tactics" in reexamination proceedings. The parties are expected to conduct themselves accordingly. For example, it is expected that submissions of papers that are not provided for in the reexamination regulations and/or appear to be excluded by the regulation will either be filed with an appropriate petition to accept the paper and/or waive the regulation(s), or not filed at all. Parties are advised that multiple submissions, such as a reply to a paper opposing a petition and a sur-reply directed to such a reply are not provided for in the regulations or examining procedures governing *inter partes* reexamination. It is expected that the parties will adhere to the provisions of 37 CFR 10.18(b) throughout the course of a reexamination proceeding.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is dismissed.

2. The third party requester comments paper filed on December 29, 2008 and the concurrently filed Information Disclosure Statement, are improper papers, will not be considered, and are being expunged from the record by closing them and marking them "not public" in the IFW of the present reexamination proceeding.

3. No copy of the third party requester papers filed on December 29, 2008 will be maintained in the record, or elsewhere in the Office.

4. A copy of this decision will be made of record in the IFW of the '205 *inter partes* reexamination proceeding.

5. No additional opportunity will be given for the third party requester to correct the defects pointed out above, unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation.

6. **The third party requester is given a period of thirty (30) days from the date of this decision to file a petition under 37 CFR 1.183 to waive 37 CFR 1.951 as to its one opportunity limitation, in order to file any replacement written comments to correct the defects as discussed above.**

7. The third party requester is reminded that under the requirements of 37 CFR 1.903, any paper submitted pursuant to this decision must be served on the patent owner.

8. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

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

By 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.

9. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711, or, in her absence, to Pinchus M. Laufer, Legal Advisor at 571-272-7726.

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.
95/000,205	02/02/2007	7049546	ITW 7188.64R	2817

23721 7590 04/20/2009

CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Bhaskar Kakarla

Paul Hasting Janofsky & Walker LLP

875 15th Street N.W.

Washington, DC 20005

MAILED

APR 2 0 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,205*.

PATENT NUMBER *7049546*.

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.

United States Patent and Trademark Office

Commissioner for Patent
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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APR 2 0 2009

CENTRAL REEXAMINATION UNIT

George R. Corrigan
Corrigan Law Office
5 Briarcliff Court
Appleton, WI 54915

(For Patent Owner)

Bhaskar Kakarla
Paul, Hastings, Janofsky & Walker LLP
875 15th Street N. W.
Washington, DC 20005

(For Third Party Requester)

In re Thommes
Inter Partes Reexamination Proceeding
Control No. 95/000,205
Filed: February 2, 2007
For: U.S. Patent No. 7,049,546

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 CFR 1.183**

This is a decision on the April 3, 2009, third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.183 REQUEST TO WAIVE REQUIREMENT OF ONE OPPORTUNITY TO SUBMIT COMMENTS UNDER 37 C.F.R. § 1.951(b)." The petition requests waiver of the 37 CFR 1.951(b) requirement that a third party requester may once file comments responsive to patent owner's comments following an action closing prosecution in an *inter partes* reexamination.

The present petition and *inter partes* reexamination control number 95/000,205 are before the Office of Patent Legal Administration.

The petition to waive the requirements of 37 CFR 1.951(b) is dismissed.

REVIEW OF FACTS

On March 17, 2009, the Office mailed a decision dismissing a December 2, 2008 third party requester petition to exceed page limit requirements under 37 CFR 1.943(b). The decision also expunged a December 29, 2008 third party requester improper paper. In the Office decision mailed March 17, 2009, third party requester was given a time period of thirty days to file a

petition under 37 CFR 1.183 to waive 37 CFR 1.951 as to its one opportunity limitation, to permit the filing of defect-free comments.

DECISION

37 CFR 1.183 states that a requirement of the regulations, which is not a requirement of the statutes, may be waived in an extraordinary situation when justice requires. Although the third party requester was invited to file a petition under 37 CFR 1.183 in this instance, the petition appears to be devoid of any statement of the circumstances upon which relief can be granted. For this reason, relief under 37 CFR 1.183 is unavailable to the third party requester. The requester is given a period of **fifteen (15) days** from the date of this decision to file a renewed petition under 37 CFR 1.183.

Jurisdiction over this proceeding will be retained by the Office of Patent Legal Administration. If no response from the third party requester is received within 15 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.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.951(b) is dismissed.

2. **The third party requester is given a period of fifteen (15) days from the date of this decision to file a renewed petition under 37 CFR 1.183 to waive 37 CFR 1.951(b) as to its one opportunity limitation, in order to permit the filing of defect-free comments.**

7. The third party requester is reminded that under the requirements of 37 CFR 1.903, any paper submitted pursuant to this decision must be served on the patent owner.

8. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

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

   By 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.

9. Telephone inquiries related to the present decision should be directed to the Michael Cygan, Legal Advisor, at 571-272-7700, or, in his absence, to Pinchus M. Laufer, Legal Advisor at 571-272-7726.

/Kenneth M. Schor/

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.
95/000,205	02/02/2007	7049546	ITW 7188.64R	2817

23721 7590 05/13/2009

CORRIGAN LAW OFFICE
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APPLETON, WI 54915

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Bhaskar Kakarla
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MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,205*.

PATENT NUMBER *7049546*.

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 Patent
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Alexandria, VA 22313-1450
www.uspto.gov

George R. Corrigan
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Appleton, WI 54915

(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Bhaskar Kakarla
Paul, Hastings, Janofsky & Walker LLP
875 15th Street N. W.
Washington, DC 20005

(For Third Party Requester)

In re Thommes
Inter Partes Reexamination Proceeding
Control No. 95/000,205
Filed: February 2, 2007
For: U.S. Patent No. 7,049,546

DECISION GRANTING RENEWED PETITION UNDER 37 CFR 1.183

This is a decision on the April 24, 2009 third party requester petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.183 REQUEST TO WAIVE REQUIREMENT OF ONE OPPORTUNITY TO SUBMIT COMMENTS UNDER 37 C.F.R. § 1.951(b)." The petition requests waiver of the 37 CFR 1.951(b) requirement that a third party requester may once file comments responsive to patent owner's comments following an action closing prosecution in an *inter partes* reexamination.

The present petition and *inter partes* reexamination control number 95/000,205 are before the Office of Patent Legal Administration.

The petition to waive the requirements of 37 CFR 1.951(b) is granted.

REVIEW OF FACTS

1. On March 17, 2009, the Office mailed a decision dismissing a December 2, 2008 third party requester petition to exceed page limit requirements under 37 CFR 1.943(b). The decision also expunged a December 29, 2008 third party requester improper paper. In the Office decision mailed March 17, 2009, third party requester was given a time period of thirty days to file a

petition under 37 CFR 1.183 to waive 37 CFR 1.951 as to its one opportunity limitation, to permit the filing of defect-free comments.

2. Third party requester filed such a petition on April 3, 2009, along with replacement comments to the patent owner's amendment and response after action closing proceeding. In a decision mailed by the Office on April 20, 2009, this petition was dismissed, for failing to address the requirements of 37 CFR 1.183. The April 20, 2009 decision set a 15 day period for the filing of a renewed petition under 37 CFR 1.183.

3. On April 22, 2009, the Office mailed a Right of Appeal Notice that addressed statements made in the third party requester's replacement comments paper of April 3, 2009.

4. On April 24, 2009, the third party requester filed the instant petition for the purpose of entry of the replacement comments paper of April 3, 2009.

DECISION

37 CFR 1.183 states, that a requirement of the regulations, which is not a requirement of the statutes, may be waived in an extraordinary situation when justice requires. Third party requester has presented, at pages 3-7 of the renewed petition, facts supporting a finding of the existence of an extraordinary situation requiring waiver of 37 CFR 1.951(b) in the interests of justice. Furthermore, third party requester notes, at page 7 of the April 24, 2009 petition, that the arguments advanced in the third party requester's reply, although denied entry into the file record, were fully addressed by the Office in the Right of Appeal Notice mailed on April 22, 2009. Requester points out that this situation, if not remedied through entry of the April 3, 2009 replacement comments paper, would cause confusion in the file history.

The third party requester's reply of April 3, 2009, meets the page limit requirements under 37 CFR 1.943(b), does not contain any improper statements as set forth in MPEP 2672(IV), and is a paper enterable into the file record. The Right of Appeal Notice of April 22, 2009, fully addressed the third party requester's reply which is now being entered. Taken as a whole, the circumstances of the case constitute an extraordinary situation for which the interests of justice require waiver of the requirements of 37 CFR 1.951(b), to permit the April 3, 2009 replacement comments paper to remain of record to correct the deficiency of the prior comments submission.

Therefore, the instant petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.951(b) is granted, and third party requester's April 3, 2009 replacement comments paper is entered, *nunc pro tunc*, as of its April 3, 2009 date. The April 22, 2009 Right of Appeal Notice thus stands as being supported by the record. The time period set forth in the Right of Appeal Notice will be extended to run for a period of thirty (30) days from the mailing date of this decision.

CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.951(b) is granted to permit the April 3, 2009 replacement comments paper to remain of record to correct the deficiency of the prior comments submission.

2. The time for each party to file a notice of appeal is extended to run for a period of thirty days from the mailing date of this decision.

3. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

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

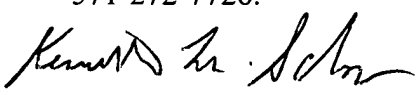
   By Mail to: Mail Stop *Inter Partes* Reexam
   Attn: Central Reexamination Unit
   Commissioner for Patents
   United States Patent & Trademark Office
   P.O. Box 1450
   Alexandria, VA 22313-1450

   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.

4. Telephone inquiries related to the present decision should be directed to the Michael Cygan, Legal Advisor, at 571-272-7700, or, in his absence, to Pinchus M. Laufer, Legal Advisor at 571-272-7726.



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

May 12, 2009
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CENTRAL REEXAMINATION UNIT

CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

: (For Patent Owner)

BHASKAR KAKARLA
875 15TH STREET NW
WASHINGTON, DC 20005

: (For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,205
Filed: February 2, 2007
For: U.S. Patent No. 7,049,546

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the third party requester paper entitled "PETITION UNDER CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)," filed on May 29, 2009.

The third party requester petition paper is before the Office of Patent Legal Administration.

Third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 from deposit account 50-2613.

The third party requester petition under 37 CFR 1.183 is **dismissed**.

REVIEW OF THE RELEVANT FACTS

1. On May 23, 2006, United States Patent Number 7,049,546 (the '546 patent) issued.

2. On February 2, 2007, a filing date was assigned to a request for *inter partes* reexamination of the '546 patent, assigned Reexamination Control No. 95/000,205 (the '205 proceeding), filed by third party requester The Lincoln Electric Company.

3. Prosecution proceeded until, on April 22, 2009, a Right of Appeal Notice was mailed, addressing a third party requester reply under 37 CFR 1.943(b) filed on April 3, 2009.

4. On May 11, 2009, third party requester timely filed a Notice of Appeal to the Board of Patent Appeals and Interferences.

5. On May 29, 2009, third party requester filed the instant petition paper entitled "PETITION UNDER CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)."

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(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 1.943(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

Third Party Requester's Petition of May 29, 2009

In the instant petition, petitioner requests waiver of 37 CFR 1.943(c), which limits third party requester responses to 30 pages or 14,000 words in length, to permit third party requester to file an appellant's brief not to exceed 50 pages in length. Pet. at 1. In support of waiver of the rule, third party requester submits that 50 pages are required to fully and sufficiently present third party requester's numerous proposed grounds of unpatentability. Pet. at 1. Petitioner states that there are 48 proposed rejections, including art, written description, and indefiniteness rejections that have not been adopted. Pet. at 4. Petitioner argues that the large number of rejections

cannot be fully addressed within a limit of 30 pages. Petitioner further provides a listing of potential harms to petitioner and the public that would ensue if petitioner chooses to provide only cursory treatment of some rejections in order to meet the regulatory page limit. Pet. at 5.

Third party requester further notes that the page limit for previous responses under 37 CFR 1.943(b) was 50 pages. Pet. at 2. Petitioner notes that the required listing of proposed rejections in the required "Issues To Be Reviewed On Appeal" section and as the headers in the "Argument" section will consume at least eight pages. Pet. at 4.

Analysis and Findings

The instant petition has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts to justify an increase in the number of pages available for third party requester to respond to an Office action, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(c). In this instance, petitioner seeks waiver of 37 CFR 1.943(c) to increase the page limit for third party requester's response to the outstanding Office action to 50 pages.

While the petitioner states that 48 proposed rejections are being appealed to the Board, many of the proposed rejections will stand or fall based upon a much smaller number of underlying issues, as can be seen from the file history record. With respect to the art rejections, the examiner addressed 28 separate grounds of rejection in the Right of Appeal Notice mailed April 22, 2009; however, many of these grounds of rejection merely refer back to an earlier ground for substantive analysis. See, for example, grounds A6-A11 on pages 15-17 of the Right of Appeal Notice. See also, for example, grounds C1-C4 on pages 33-34 of third party requester's April 2, 2009 comments after the ACP. Since an appeal to the Board is based upon "each issue presented for review," per 37 CFR 41.67(viii), petitioner has not provided a persuasive showing that the amount and complexity of the issues to be appealed would constitute an extraordinary situation.

Furthermore, the length of the appeal brief is set by regulation to be shorter than the length of the corresponding earlier third party requester comments. The regulations anticipate that a controversy requiring up to 50 pages of third party requester comments will require an appeal brief of only up to 30 pages. In the instant case, third party requester's comments met the 50 page limit in the earlier stages of the proceedings. Ordinarily, then, the regulations contemplate that the issues previously addressed in the proceedings should be addressable by a brief of no more than 30 pages. It is noted that 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). While petitioner has presented a listing of harms that would allegedly result from being required to adhere to the page limit, these harms are (1) general to the nature of an *inter partes* proceeding, and (2) are not alleged to be from any extraordinary amount and complexity of the issues to be appealed that would constitute a situation such that justice would require suspension of the page limits regulation. Based upon the above analysis, as petitioner has not presented a showing to

the contrary, the facts of this case are not found to present an extraordinary situation requiring waiver of the appeal brief page limits requirements.[1]

Perhaps the best showing petitioner can make to support a request for waiver of the 30-page limit of 37 CFR 1.943(c) is to attempt to draft a third party requester's response in compliance with the 30-page limit, and submit a proposed response that is in excess of 30 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) requesting entry of the submitted response. In this way, petitioner can rely on the proposed response for justification that more pages are needed to complete the response and to set forth an accurate determination of exactly how many additional pages are needed to complete the response. Note that if the Office does not grant the petition to the full extent of the proposed response, third party requester will be given a period of 15 days within which to submit a compliant response in accordance with the page limit set forth in the decision on the petition. *See* MPEP 2667(I)(A)(2).

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b), and the petition is dismissed.

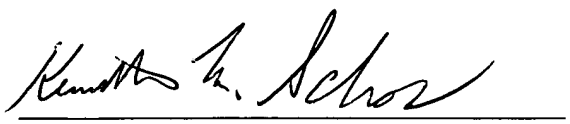
CONCLUSION

1. The third party requester petition under 37 CFR 1.183 is **dismissed**.

2. Any subsequently filed third party requester brief is not to exceed 30 pages in accordance with 37 CFR 1.943(c).

3. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

4. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726 or Michael Cygan, Legal Advisor, at 571-272-7700.



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

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[1] The instant situation appears instead to be the type of ordinary situation in which a controversy, having issues not requiring page limit waivers at the pre-appeal stage of the proceedings, will similarly not require page limit waivers at the appeal stage of the proceedings.

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CENTRAL REEXAMINATION UNIT

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Appleton, WI 54915

(For Patent Owner)

Bhaskar Kakarla
Paul, Hastings, Janofsky & Walker LLP
875 15th Street N. W.
Washington, DC 20005

(For Third Party Requester)

In re Thommes
Inter Partes Reexamination Proceeding
Control No. 95/000,205
Filed: February 2, 2007
For: U.S. Patent No. 7,049,546

: **DECISION GRANTING**
: **PETITION TO WAIVE**
: **PAGE LIMITS FOR**
: **APPELLANT BRIEF**
:

This is a decision on the July 10, 2009 third party requester petition entitled "PETITION UNDER 37 CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)." 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 in length. Third party requester timely filed an appellant brief concurrently with the petition.

The third party requester petition paper is before the Office of Patent Legal Administration.

Third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 from deposit account 50-2613.

The requester's petition to waive the restrictions under 37 CFR 1.943(c) is granted to the extent that the page limit for requester's appellant brief shall not exceed fifty-one (51) pages. [1]

[1] The decision, in section II *infra*, provides guidance on which portions of the brief are counted towards the page limit.

REVIEW OF THE RELEVANT FACTS

1. On May 23, 2006, United States Patent Number 7,049,546 (the '546 patent) issued.

2. On February 2, 2007, a filing date was assigned to a request for *inter partes* reexamination of the '546 patent, assigned Reexamination Control No. 95/000,205 (the '205 proceeding), filed by third party requester The Lincoln Electric Company.

3. The proceeding progressed to the point where, on April 22, 2009, a Right of Appeal Notice was mailed, addressing third party requester comments under 37 CFR 1.943(b) filed on April 3, 2009.

4. On May 11, 2009, third party requester timely filed a Notice of Appeal to the Board of Patent Appeals and Interferences.

5. On May 29, 2009, third party requester filed a petition entitled "PETITION UNDER 37 CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)."

6. On June 18, 2009, the Office mailed a decision dismissing the May 29, 2009 third party requester petition to exceed the page limit requirements under 37 CFR 1.943(c).

7. On July 10, 2009, third party requester filed the present petition entitled "PETITION UNDER 37 CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)." Third party requester timely filed an appellant brief concurrently with the present petition.

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. [Emphasis added.]

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. Third Party Requester's Petition of July 10, 2009

In the instant petition, petitioner requests waiver of 37 CFR 1.943(c), which limits third party requester appellant briefs to thirty (30) pages or 14,000 words in length, such waiver being requested to permit third party requester to file an appellant's brief not to exceed forty-six (46) pages in length. Pet. at 2. In support of waiver of the rule, third party requester submits that forty-six (46) pages are required to fully and sufficiently present third party requester's numerous proposed grounds of unpatentability. Pet. at 1. Petitioner states that the 48 proposed rejections, including prior art, written description, and indefiniteness rejections that have not been adopted are being appealed. Pet. at 3. Petitioner argues that, as shown in the accompanying appellant brief, providing substantive, comprehensive and coherent arguments for each of the issues on appeal requires more than thirty (30) pages. Pet. at 3. Petitioner requester asserts that it has grouped proposed rejections having similar issues, has endeavored to be efficient in its arguments, and has taken care not to duplicate repetitive arguments in the accompanying appellant brief. Pet. at 3. Petitioner further provides a listing of asserted potential harms to petitioner and the public that would ensue if petitioner is forced to provide only cursory treatment of some rejections in order to meet the regulatory page limit. Pet. at 4-6.

II. What is included or excluded from the page limit.

By its terms, 37 CFR 1.943(c) excludes 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 briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[2] 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, the entire section will be counted toward the page total. Partial pages will be tallied as whole pages for this purpose.

It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) are considered "reference materials," and are excluded from the page count only insofar as they are 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.

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[2] 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.

III. Application of the above discussion to the July 10, 2009 Third Party Appellant Brief

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 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 an appellant brief in compliance with the 30-page limit, and submitting the resulting appellant brief, which is in excess of 30 pages, concurrently with present petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c).

A review of the July 10, 2009 third party requester appellant brief[3] shows that the document contains seventy-three (73) pages, accompanied by four (4) attached Exhibits listed in Section IX (Evidence Appendix).

The following sections of the appellant brief are not counted toward the page limit:

> One (1) cover page, seven (7) pages for the table of contents, thirteen (13) pages of claims in Section VIII (Claims Appendix), and one (1) page for Section IX (Evidence Appendix).

The four attached Exhibits cited in Section IX (Evidence Appendix) do not contain legal arguments and have been entered in the record by the examiner.

The following sections of the appellant brief are counted toward the page limit:

> Forty-six (46) pages for Sections I-VII since Sections I-V occupy the same page (normally Sections I-IV would not count toward the page limit); four (4) pages of abbreviations used in the appellant brief; and one (1) page for Section X (Related Proceedings Appendix).

Section X lists documents in related reexam proceedings and the case number for the concurrent litigation. This section does not contain copies of decisions rendered by a court or the Board in related proceedings. Furthermore, this section also comments on an examiner interview in a related reexam proceeding. It is also noted that this section does not contain any of the cited documents that would count toward the page limit.

Therefore, the appellant brief is effectively substantively 51 pages in length.

Upon review of the submitted response for economizing, arrangement, and non-repetition of information already of record, it is found that 21 pages of arguments in the third party requester appellant brief which are in excess of the 30 page regulatory limit are not unreasonable in view of the present facts and circumstances.

---

[3] This decision is directed merely at the page-limit issue, and does not review the propriety of the appellant brief. The Central Reexamination Unit (CRU) will review that matter, when jurisdiction over the proceeding is returned to the CRU.

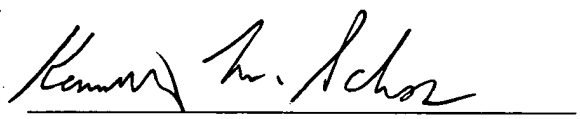
Accordingly, the third party requester petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(c) is waived as to the **twenty-one (21) pages** of the arguments portion of the appellant brief response that exceed the thirty (30) page limit.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is granted to the extent that the requester's appellant brief shall not exceed fifty-one (51) pages, excluding appendices of claims and reference materials, such as prior art references. This waiver makes the July 10, 2009 third party requester appellant brief page-length compliant.

2. Jurisdiction over the '205 reexamination proceeding is hereby returned to the of the Central Reexamination Unit.

3. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



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

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CENTRAL REEXAMINATION UNIT

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In re Thommes :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,205 : **DISMISSING**
Filed: February 2, 2007 : **PETITION**
For: U.S. Patent No. 7,049,546 :

This is a decision on the November 3, 2009 patent owner petition entitled "PETITION PURSUANT TO 37 CFR 1.182." The petition requests the Office to expedite a ruling on whether the third party requester's October 29, 2009 replacement appellant brief meets the page limit requirement.

The present petition and the above-captioned reexamination proceeding are before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was transmitted by EFS-Web on November 3, 2009.

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

REVIEW OF THE RELEVANT FACTS

1. On May 23, 2006, United States Patent Number 7,049,546 (the '546 patent) issued.

2. On December 13, 2006, a third party requester deposited a request for *inter partes* reexamination of claims 1-47 of the '546 patent. The deposited reexamination request was assigned control no. 95/000,205 (the '205 proceeding).

3. On January 22, 2007, a Notice of Failure to Comply with *Inter Partes* Reexamination Filing Requirements was mailed.

4. On February 2, 2007, the third party requester deposited a replacement request for *inter partes* reexamination of claims 1-47 of the '546 patent.

5. On February 15, 2007, a Notice of *Inter Partes* Reexamination Request Filing Date was mailed for the '205 proceeding. The notice assigned the filing date of February 2, 2007 to the request for *inter partes* reexamination.

6. On April 10, 2007, an order granting reexamination, and a first Office action on the merits, were mailed.

7. Prosecution progressed to the point where, on April 22, 2009, a Right of Appeal Notice (RAN) was mailed.

8. On May 11, 2009, the third party requester timely filed a Notice of Appeal to the Board of Patent Appeals and Interferences.

9. On May 29, 2009, the third party requester filed a petition entitled "PETITION UNDER 37 CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)."

10. On June 18, 2009, the Office mailed a decision dismissing the May 29, 2009 third party requester petition to exceed the page limit requirements under 37 CFR 1.943(c).

11. On July 10, 2009, third party requester filed a petition entitled "PETITION UNDER 37 CFR § 1.183 – REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)." The third party requester timely filed an appellant brief concurrently with the July 10, 2009 petition.

12. On August 7, 2009, the Office mailed a decision granting the July 10, 2009 third party requester petition to the extent that the page limit for requester's appellant brief shall not exceed fifty-one (51) pages. The decision stated at page 4 that the requester appellant brief is effectively substantively 51 pages in length. The waiver granted in the decision made the July 10, 2009 requester appellant brief page length compliant.

13. On September 8, 2009, the patent owner filed a petition entitled "PETITION UNDER 37 CFR § 1.183 -- REQUEST TO EXCEED THE PAGE LIMIT REQUIREMENTS OF 37 CFR § 1.943(c)." The patent owner timely filed a respondent brief concurrently with the September 8, 2009 petition.

14. On October 2, 2009, the Office issued a Notification of Non-Compliant Appeal Brief stating that the third party requester's appellant brief filed on July 10, 2009 failed to comply with the requirements of 37 CFR 41.61 in that the appellant's proposed claim rejections A-D, CC-EE, FF-II, MM-VV under Section VI of the brief were outside those listed in the RAN.

15. On October 29, 2009, third party requester submitted a replacement appellant brief that removed proposed grounds for rejection A-D, CC-EE, FF-II, and MM-VV under Sections VI and VII, as stated on page 1 of the replacement brief.

16. On November 3, 2009, the patent owner filed the present petition entitled "PETITION PURSUANT TO 37 CFR 1.182." The petition requests the Office to expedite a ruling on whether requester's October 29, 2009 replacement appellant brief meets the page limit requirement.

17. On November 6, 2009, the Office mailed a decision expunging the September 8, 2009 patent owner petition and respondent brief as improper papers and, *sua sponte*, waiving 37 CFR 1.943(c) to the extent that the page limit for patent owner's respondent brief shall not exceed twenty-two pages. The patent owner was given thirty days from the date of service of third party requester's October 29, 2009 replacement appellant brief or fifteen days from the mailing date of the November 6, 2009 decision, whichever is longer, to file a redacted respondent brief that meets the page limit granted in the November 6, 2009 decision.

RELEVANT AUTHORITY

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 1.181(a) provides:

> 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 1.182 provides:

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

DECISION

The November 3, 2009 patent owner petition requests the Office to expedite a ruling on whether the third party requester's October 29, 2009 replacement appellant brief meets the page limit requirement. Petitioner argues that the expedited ruling will 1) allow the Office to meet its obligation to conduct the present *inter partes* reexamination proceeding with "special dispatch," and 2) prevent the patent owner from incurring the undue expense of having to file three respondent briefs if the October 29, 2009 third party requester appellant brief needs to be edited to be the proper length.[1] Petitioner explains that if the Office rules quickly, the patent owner will be required to file two respondent briefs, not three.[2] Furthermore, petitioner alleges that the third party requester filed a replacement appellant brief that exceeds the page limit, and failed to petition for a waiver of the page limit, or include a word count certification.[3]

As an initial matter, the patent owner may file only one compliant respondent brief, not two or three, that does not exceed the page limit granted in the November 6, 2009 Office decision. With respect to the request for an expedited Office ruling on whether the third party requester's October 29, 2009 replacement appellant brief meets the page limit requirement, the Office conducts all reexamination proceedings with special dispatch. With respect to the page limit compliance of third party requester's replacement appellant brief, and contrary to the petitioner's allegation that the third party requester did not file a petition for a waiver of the page limit, the August 7, 2009 Office decision granted third party requester's July 10, 2009 petition to the extent that the page limit for requester's appellant brief shall not exceed fifty-one (51) pages. The August 7, 2009 decision stated at page 4 that the requester appellant brief is effectively substantively 51 pages in length. Therefore, the waiver of the provisions of 37 CFR 1.943(c) granted in the decision made the July 10, 2009 requester appellant brief page length compliant. The October 29, 2009 third party requester replacement appellant brief removed proposed grounds of rejection A-D, CC-EE, FF-II, and MM-VV under Sections VI and VII, as stated on page 1 of the replacement brief. Since the replacement requester appellant brief deleted pages

[1] Petition at pages 1 and 4.
[2] Petition at pages 1 and 4.
[3] Petition at page 3.

drawn to proposed rejections that were not listed in the Right of Appeal Notice, the replacement appellant brief is still within the page limit granted by the August 7, 2009 Office decision.

Finally, it is noted that 37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. Any renewed petition should be filed under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Director in this instance for expedited review of the page limit compliance of third party requester's replacement appellant brief. However, even as to that item of relief, the petition would be dismissed since, as noted above, the Office conducts all reexamination proceedings with special dispatch, and the August 7, 2009 Office decision already waived 37 CFR 1.943(c) to the extent that third party requester's appellant brief shall not exceed fifty-one pages.

Accordingly, the present petition is **dismissed**.

The October 21, 2009 power of attorney and change of correspondence address is ineffective because it is not signed by an individual in the organization having apparent authority to sign on behalf of the organization. For example, an officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. A person having the title of Chief Counsel does not clearly set forth that person as an officer of the organization. See MPEP 324. Accordingly, the current address of record for the third party requester is the address appearing in the caption of this decision. A courtesy copy is being mailed to the address of PERKINS COIE LLP, 607 FOURTEENTH STREET N.W., WASHINGTON, DC 20005-2003. However, in the absence of a properly executed change of power of attorney, all future correspondence will be mailed to the address of record for the third party requester.

CONCLUSION

1. The present petition under 37 CFR 1.182 is dismissed.

2. The October 21, 2009 power of attorney and change in correspondence address is **ineffective**. A courtesy copy of this decision is being mailed to the address of PERKINS COIE LLP, 607 FOURTEENTH STREET N.W., WASHINGTON, DC 20005-2003. In the absence of a proper submission of a power of attorney and change of correspondence address, all future correspondence in this reexamination proceeding will be mailed to the address of record for the third party requester.

3. Jurisdiction is being forwarded to the Central Reexamination Unit to process the October 29, 2009 third party requester replacement appellant brief.

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

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

By 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 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.

5. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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CENTRAL REEXAMINATION UNIT

MAILED
MAR 10 2008
CENTRAL REEXAMINATION UNIT

Morgan Lewis & Bockius, LLP (For Patent Owner)
1111Pennsylvania Avenue NW
Washington DC 20004

Hodgsdon Russ LLP
1800 One M & T plaza, Suite 2000
Buffalo, NY 14203 (For *Inter Partes* Requester)

In re LAKS et al.
Reissue Application
Application No. 11/390,537
Filed: March 28,2006
For: U.S. Patent No. 6,753,035

In re LAKS et al.
Inter partes Reexamination Proceeding
Control No. 95/000,206
Filed: December 13, 2006
For: U.S. Patent No. 6,753,035

: DECISION, *SUA SPONTE*.
: MERGING REISSUE *AND INTER*
: *PARTES* REEXAMINATION
: PROCEEDINGS AND WAIVING RULES

Reissue application number 11/390,537 and *inter partes* reexamination control number 95/000,206 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.

Summary: Reissue application number 11/390,537 and *inter partes* reexamination control number 95/000,206 are merged into a single proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,753,035 (the '035 patent) issued to Peter Laks et al., on June 22, 2004. No assignment has been recorded in the assignment records at the USPTO.

2. On March 28, 2006, the patent owner filed a "broadening" reissue application based on the '035 patent, which was assigned application number 11/390,537 (the '537 reissue application).

3. Concurrently with the filing of the '537 reissue application, claims 1, 11-12, 16-18 were amended and new claims 19-53 were added by preliminary amendment. None of the original patent claims were canceled. In a second preliminary amendment, filed May 9, 2006, patent owner amended claim 18 and added new claim 54. No claims were canceled.

4. On October 4, 2006, the law firm of Morgan, Lewis, & Bockius filed a petition to withdrawal as counsel for the patent owner in the '537 reissue application.

5. A request for ***inter partes*** reexamination of the '035 patent was filed by a third party requester on December 13, 2006, and the resulting reexamination proceeding was assigned Control Number 95/000,206 (the '206 reexamination proceeding). Osmose, Inc. is identified as the real party in interest for the requester.

6. On December 15, 2006, the USPTO denied the withdrawal petition of Morgan Lewis & Bockius to withdrawal as counsel for patent owner in the '537 reissue application.

7. On February 22, 2007, a Notice of Concurrent Proceedings was filed by the patent owner in the *inter partes* reexamination proceeding.

8. On March 8, 2007, an order granting the third party requester's request for *inter partes* reexamination was mailed by the USPTO.

9. At the time of mailing of this petition decision, the USPTO has not mailed an Office action in either the '537 reissue application or the '205 reexamination proceeding.

DECISION MERGING THE '537 REISSUE APPLICATION AND THE '206 *INTER PARTES* REEXAMINATION PROCEEDINGS

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> 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.

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.

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 1.906(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 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 § 2686.03 provides, in 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 underlying added.]

II. DISCUSSION REGARDING MERGER

As evidenced by the above review of facts, the '537 reissue application and the '206 *inter partes* reexamination proceeding are currently pending. The two proceedings are in their early stages of prosecution. Since reexamination has been ordered pursuant to § 1.931 in the '206 *inter partes* reexamination proceeding, a decision under § 1.991 is timely as to whether the '537 reissue application and the '206 *inter partes* reexamination proceeding 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. [1] 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 10/430,71 as paper PETDEC dated December 22, 2003).

In the *Allan* fact-situation, the *inter partes* reexamination proceeding was the first filed proceeding. 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. Patent owner then filed a petition requesting that the copending reissue application and *inter partes* reexamination not be merged and that the *inter partes* reexamination proceeding be suspended pending completion of the reissue application. Alternatively, patent owner requested that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding.

It was explained in the *Allan* December 22, 2003 decision on petition that the effect of granting the requested relief by patent owner to suspend the *inter partes* reexamination proceeding would have potentially precluded the reexamination requester from obtaining a final resolution in the *inter partes* reexamination proceeding, because patent owner could have theoretically filed a string of continuation applications based on the reissue application, and the *inter partes* reexamination proceeding would remain suspended while each continuation was sequentially prosecuted. Further, it was found that there was no good cause (which is required by 35 U.S.C. § 314(c)) for suspending the *inter partes* reexamination proceeding, because the alternative options of suspending the reissue proceeding and merging the copending proceedings were both available. It was deemed, in the *Allan* December 22, 2003 decision, to be appropriate to merge the copending reissue and *inter partes* reexamination proceedings, since suspension of the reissue application would unduly delay the ability of 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 broader claims that were obtained. Also, Office practice was

[1] In this instance, it is further noted that, 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 the *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 the level field intent of the *inter partes* reexamination statute.

(and is) to treat reissue applications as special, and suspension of the reissue application would have run counter to that policy.

On reconsideration in *Allan* to address patent owner's reconsideration petition, it was 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 22, 2003 merger decision provided that the "third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings."[2] Such would have erroneously permitted the *inter partes* reexamination requester to comment on broadened patent claims and to participate in the appeal process with respect to broadened patent claims in the merged proceeding, which runs counter to the ex parte nature of a reissue proceeding mandated by 35 U.S.C. 251.

37 CFR 1.991 provides that "[I]n 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." In *Allan*, this provision of the rules was construed too broadly so as to only preclude the third party requester from commenting on issues that were "reissue issues" such as recapture, the content of the reissue declaration and assignee consent.[3] The December 22, 2003 merger decision failed to preclude the third party requester from commenting in any way on the patentability of broadened claims presented in the reissue application. However, the reexamination requester of the *Allan inter partes* reexamination proceeding should have been precluded from commenting, in any fashion on the merits of the broadened claims present in the merged proceeding, [4] since the presence of such broadened claims is statutorily precluded in *inter partes* reexamination. 35 U.S.C. 314(a). Accordingly the *Allan* decision reversed the December 22, 2003 decision, and instead of merging the copending reissue application and *inter partes* reexamination proceedings, the reissue application was suspended.

The suspension of the reissue application was the appropriate remedy in *Allan*, since the reissue application was filed after the reexamination request, [5] patent owner had requested suspension of the

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[2] *In re Allan*, 71 USPQ2d at 1753.

[3] Page 4 of the December 22, 2003 decision merging the copending broadening reissue application and *inter partes* reexamination proceeding stated: "The third party requester does not gain any rights to participate with respect to issues that are not within the scope of *inter partes* reexamination. Specifically, with regard to petitioner's example of the issue of broadening the claims, note that the addition of broadened claims is not permitted in *inter partes* reexamination. Therefore, broadening issues would not be an issue within the scope of *inter partes* reexamination, and the third party requester would not be permitted to raise these issues in the merged proceeding. In other words, third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings. However, third party requester would NOT have the right to address broadening reissues, *e.g.*, the 2 yr. time limit, recapture, declaration, assignee consent, *etc.*, as these would not be patentability issues within the scope of *inter partes* reexamination."

[4] Beyond merely noting that such claims were in fact broader than the patent claims and therefore improper in the reexamination proceeding

[5] 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.

reissue as one alternative means of relief, [6] and patent owner's stated objective[7] 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) was achieved. The facts presented in the present instance with respect to the present '537 reissue application and the present '206 *inter partes* reexamination proceeding are, however, distinguishable from those in Allan. Initially, the '537 reissue application was the first filed proceeding. The '206 *inter partes* reexamination proceeding was filed more than four months after the filing of the '537 reissue application, and after a first Office action on the merits had been mailed in the '206 reissue application.

As to the reexamination proceeding, 35 U.S.C. 314(c) statutorily requires "special dispatch," unless the Director determines there is good cause for suspension. In this instance, if at all possible, it is desirable to prevent the delay in resolving the raised statutory new question of patentability while patent owner prosecutes the reissue application, and any continuation reissue applications that may be filed. Accordingly, a merger decision will be fashioned to be more specific than was the December 22, 2003 decision in *Allan*, whereby third party requester will be permitted to comment in the merged proceeding only on matters that could have been commented on in the '206 *inter partes* reexamination proceeding. By fashioning the merger decision more precisely, both the patent owner and the *inter partes* reexamination requester will be able to participate in the merged proceeding with respect to the same matters that they could have addressed in the '206 *inter partes* reexamination, if that proceeding were to have proceeded without having been merged, while the third party requester will be precluded from participating and commenting on issues that are unique to examination of a reissue application, including any issue of patentability of the broadened reissue claims.

It is to be noted that it is equitable that the third party requester not be permitted to comment on a broadened claim, since a reexamination filing cannot be used to give the third party requester access to those broadened claims. The present merger permits both proceedings to go forward at the same time, while preserving the rights of both parties. Also, if a reissue patent is subsequently granted on one or more of the broadened claims, the third party requester would have the right to file a request for reexamination of those claims of the reissue patent.

III. Decision Merging The '537 Reissue Application And The '206 *Inter Partes* Reexamination Proceeding

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the '537 reissue application and the '206 *inter partes* reexamination proceeding 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 reissue application and the *inter partes* reexamination file for purposes of the merged proceeding. In accordance with 37 CFR 1.991, the

[6] *In re Allan*, 71 USPQ2d at 1754.
[7] See *Id.*

maintenance of identical amendments in both files is required as long as the proceedings remain merged.

2. Presently, the claims in the '537 reissue application are not the same in as the claims in the '206 *inter partes* reexamination proceeding. Specifically, patent claim 1,11-12,16-18 has been amended and new, broadened claims 18-54 have been added in the '537 reissue application. **Therefore, an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, reissue Application No. 111/390,537, and *inter partes* reexamination Control No. 95/000,206. 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). The patent owner must not address any issues otherwise present in either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for both files (*i.e.*, the reissue application No. and the *inter partes* reexamination proceeding Control No.) and a signature. The housekeeping amendment must be filed in duplicate for entry into each of the reissue application file and the *inter partes* reexamination file. The housekeeping amendment must comply with the provisions of 37 CFR 1.173 (the rule governing amendments filed in reissue applications). [8] 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 amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

4. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) will not create a comment right for third party requester. Any comments paper filed by third party requester in response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

[8] Note that a "clean copy" of the amendment is not required by 37 CFR 1.173, and is not to be provided.

1. The regulatory provisions governing the examination of reissue applications include, *inter alia*, provisions equivalent the regulations relating to the conduct of *inter partes* reexamination proceedings, including that examination of a reissue application be examined expeditiously. Therefore, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, to the extent it is practical to do so. In addition, the third party requester in the '206 *inter partes* reexamination proceeding may participate in the merged proceeding to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be strictly limited to issues within the scope of *inter partes* reexamination. The examiner will apply the reissue statute, rules, and case law to the examination of the merged proceeding except as directed in paragraph 15 below.

2. Each Office action issued by the examiner will take the form of a single action which jointly applies to the '537 reissue application and the '206 *inter partes* reexamination proceeding. Each action will contain identifying data for both of the proceedings, *i.e.*, the reissue application and the *inter partes* reexamination proceeding. 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 response by the reissue applicant/patent owner must consist of a single response, with **a copy being filed for entry in 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 reissue Application Number and the *inter partes* reexamination proceeding Control 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 and 37 CFR 1.121(h) governing reissue applications. See MPEP § 1453 for a complete discussion of amendment practice in a reissue application. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

5. Any paper (e.g., comments, brief) filed by third party requester must consist of a single response, with **a copy being filed for entry in 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 reissue Application Number and the *inter partes* reexamination proceeding Control Number).

6. There will be no interviews in the merged proceeding, as the rules provide that *inter partes* reexamination will be conducted on the written record. [9]

7. 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).

8. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. Thereafter, with respect to the '206 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal rights have been exhausted. See 37 CFR 1.957(c).

9. If the applicant/patent owner files an express abandonment of the '537 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 '206 *inter partes* reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

10. Where the merged proceeding is dissolved based on abandonment of the reissue application and the '206 *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 (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant practice to 37 CFR 1.906(c).

11. If the merged proceeding is dissolved based on abandonment of the '537 reissue application and the '206 *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application of the '537 reissue application will be merged with the '206 *inter partes* reexamination proceeding (the continuation reissue application might be stayed pending conclusion of the '270 *inter partes* reexamination).

12. If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114, the reissue application will not be considered to have been expressly abandoned;

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[9] 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. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of paramount importance. A petition under 37 CFR 1.183 may be submitted to request an interview in the rare circumstances that an interview is deemed to be indispensable.

rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

13. 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.

14. The examiner in the merged proceeding will consult with OPLA (*i.e.*, the OPLA legal advisor assigned to the '206 *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner, as he/she would consult in an *inter partes* reexamination proceeding that is not merged.

15. Scope Of Third Party Requester's Participation In The Merged Proceeding:

37 CFR 1.991 provides that "[I]n 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. The following provides for preservation of that right:

a. Copies of all Office actions will be provided by the Office to the third party requester. Further, any paper filed by the applicant/patent owner in the merged proceeding must be served on the third party requester. Third party requester will be given an opportunity to comment on all patent owner replies (responses) to Office actions (as pointed out below). However, third party requester participation in the merged proceeding must be strictly limited to issues within the scope of *inter partes* reexamination. No third party comments can be advanced on issues appropriate for reissue, but not appropriate for reexamination, as, for example:

(1) Comments on any aspect of the patentability of broadened claims presented under the authority of the reissue statute (including but not limited to issues of whether broadening reissue was sought within two years of the issue date of the patent);

(2) Comments regarding the acceptability of any reissue declaration;

(3) Comments regarding assignee assent; and

(4) Comments regarding the recapture doctrine.

Third party comments 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. [10] Any such improper paper will be returned to the requester as an improper submission under 37 CFR 1.939, or

[10] Thus, for example, where a question 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 question.

expunged, if the paper is entered prior to discovery of the defect.

b. In the same manner that patent owner/applicant in the merged proceeding must serve the third party requester with correspondence filed in the Office, the third party requester must serve the patent owner/applicant with correspondence that requester files in the Office.

c. Prior to the issuance of any Notice of Allowability (Form PTOL-37) - (1) the procedure for issuing Office actions, (2) the forms used for actions, (3) any response by the patent owner/applicant, and (3) procedure, including requester comments, will 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 37 CFR 41.81 will govern appeals by the patent owner and requester to the Board of Patent Appeals and Interferences (Board), and to the Court of Appeals for the Federal Circuit. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to advise parties of same, and inform patent owner of the steps that must be taken (*e.g.*, payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out in Section (C)(7) above, the present *inter partes* reexamination proceeding would be concluded by the grant of such a reissue patent, and the reissue patent would serve as the certificate under 37 CFR 1.997.

d. Inherent in the 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 37 CFR 41.60 through 37 CFR 41.81 will govern, but only with respect to claims that are not broadened claims in the merged proceeding.

e. Requester's comments in all appeal papers must be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no appeal can be advanced by third party requester with respect to issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed above).

f. In view of the provisions 37 CFR 1.953(c), any filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to the final action, that is taken as being an equivalent to the Right of Appeal Notice under 37 CFR 1.953.

IV. 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...."

Above it is directed that:

> "(1)the procedure for issuing Office actions, (2) the forms used for actions, (3) any response by the patent owner/applicant, and (3) procedure, including requester comments, 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.

CONCLUSION

1. The '537 reissue application and the '2060 *inter partes* reexamination proceeding **are merged** into a single consolidated proceeding.
2. A copy of this decision will be placed in the IFW of the '606 reissue application and the '270 *inter partes* reexamination proceeding.

3. Jurisdiction of the '537 reissue application file and the '206 *inter partes* reexamination file will reside with the Central Reexamination Unit (CRU) to await the filing of a housekeeping amendment in accordance with Section III(B) of this Decision.

4. Once the housekeeping amendment is received, or the time for filing such housekeeping amendment has expired, jurisdiction of the merged reissue and *inter partes* reexamination proceeding will be forwarded via the Technology Center 3700 Group Director to an examiner for the preparation of an Office action in the merged proceeding. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '819 patent (e.g., by preparing/signing an action). See MPEP 2636. All further examination should be conducted in accordance with Sections III(B) and III(C) of this Decision.

5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this Decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

6. Telephone inquiries related to this decision and questions regarding procedural matters should

be directed to Kery A. Fries, Reexamination Legal Advisor, Office ofDeputy Commissioner for Patent Examination Policy 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

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October 9, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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Morgan Lewis & Bockius, LLP
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(For Patent Owner)

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MAY 01 2008

CENTRAL REEXAMINATION UNIT

Hodgsdon Russ LLP
1800 One M & T plaza, Suite 2000
Buffalo, NY 14203

(For *Inter Partes* Requester)

In re LAKS et al.
Reissue Application
Application No. 11/390,537
Filed: March 28,2006
For: U.S. Patent No. 6,753,035

In re LAKS et al.
Inter partes Reexamination Proceeding
Control No. 95/000,206
Filed: December 13, 2006
For: U.S. Patent No. 6,753,035

CORRECTED DECISION, *SUA SPONTE* MERGING REISSUE *AND INTERPARTES* REEXAMINATION PROCEEDINGS AND WAIVING RULES

The merger decision mailed March 10, 2008 is vacated as having been incorrectly issued. The following decision is issued as a corrected decision, in replacement of the March 10, 2008 merger decision, and it addresses the procedural aspect of the merged proceeding. It should be noted that, on April 10, 2008, in response to the March 10, 2008 merger decision, patent owner submitted the requested housekeeping amendment. Accordingly, this corrected decision will not reiterate the requirement for a housekeeping amendment.

Reissue application number 11/390,537 and *inter partes* reexamination control number 95/000,206 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.

Summary: Reissue application number 11/390,537 and *inter partes* reexamination control number 95/000,206 are merged into a single proceeding.

BACKGROUND

1. U.S. Patent No. 6,753,035 (the '035 patent) issued to Peter Laks et al., on June 22, 2004. No assignment has been recorded in the Office's assignment records.

2. On March 28, 2006, the patent owner filed a "broadening" reissue application based on the '035 patent, which was assigned application number 11/390,537 (the '537 reissue application).

3. Concurrently with the filing of the '537 reissue application, claims 1, 11-12, 16-18 of the '035 patent were amended and new claims 19-53 were added by preliminary amendment. None of the original patent claims were canceled. In a second preliminary amendment, filed May 9, 2006, patent owner amended claim 18 and added new claim 54. No claims were canceled.

4. On October 4, 2006, the law firm of Morgan, Lewis, & Bockius filed a petition for withdrawal as counsel for the patent owner in the '537 reissue application.

5. On December 13, 2006, a request for ***inter partes*** reexamination of the '035 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 95/000,206 (the '206 reexamination proceeding). Osmose, Inc. is identified as the real party in interest for the requester.

6. On December 15, 2006, the Office denied the petition for withdrawal of Morgan Lewis & Bockius as counsel for patent owner in the '537 reissue application.

7. On February 22, 2007, a Notice of Concurrent Proceedings was filed by the patent owner in the *inter partes* reexamination proceeding.

8. On March 8, 2007, an order granting the third party requester's request for *inter partes* reexamination was mailed by the Office.

9. On March 10, 2008, the Office mailed a decision merging the proceedings of reissue application 11/390,537 and reexamination proceeding 95/000,206.

10. On April 10, 2008, patent owner mailed, in response to the March 10th decision, the housekeeping amendment required in the decision.

11. The Office has not mailed an Office action in either the '537 reissue application or the '205 reexamination proceeding.

DECISION MERGING THE '537 REISSUE APPLICATION AND THE '206 *INTER PARTES* REEXAMINATION PROCEEDING

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> 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 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 § 2686.03 provides, in 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 underlying added.]

II. DISCUSSION REGARDING MERGER

As evidenced by the above review of facts, the '537 reissue application and the '206 *inter partes* reexamination proceeding are currently pending. The two proceedings are in their early stages of prosecution. Since reexamination has been ordered pursuant to 37 CFR 1.931 in the '206 *inter partes* reexamination proceeding, a decision under § 1.991 is

timely as to whether the '537 reissue application and the '206 *inter partes* reexamination proceeding 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. [1] 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 10/430,71 as paper PETDEC dated December 22, 2003).

In the *Allan* fact-situation, the *inter partes* reexamination proceeding was the first-filed proceeding. 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. Patent owner then filed a petition requesting that the copending reissue application and *inter partes* reexamination not be merged, and that the *inter partes* reexamination proceeding be suspended pending completion of the reissue application. Alternatively, patent owner requested that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding.

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[1] In this instance, it is further noted that, 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 the *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 the level field intent of the *inter partes* reexamination statute.

It was explained in the *Allan* December 22, 2003 decision on petition that the effect of granting the requested relief by patent owner to suspend 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 patent owner could have theoretically filed a string of continuation applications based on the reissue application, and the *inter partes* reexamination proceeding would remain suspended while each continuation was sequentially prosecuted. Further, it was found that there was no good cause (which is required by 35 U.S.C. § 314(c)) for suspending the *inter partes* reexamination proceeding, because the alternative options of suspending the reissue proceeding and merging the copending proceedings were both available. It was deemed, in the *Allan* December 22, 2003 decision, to be appropriate to merge the copending reissue and *inter partes* reexamination proceedings, since suspension of the reissue application would unduly delay the ability of 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 broader claims that were obtained. Also, Office practice was (and is) to treat reissue applications as special, and suspension of the reissue application would have run counter to that policy.

The *Allan* decision reported at 71 USPQ2d 1751 addressed the patent owner's reconsideration petition. It was 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 22, 2003 merger decision provided that the "third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings." [2] Such would have erroneously permitted the *inter partes* reexamination requester to comment on the propriety of the broadening in the broadened claims presented in the reissue application and to fully participate in the appeal process with respect to same, in the merged proceeding; this runs counter to the *ex parte* nature of a reissue proceeding mandated by 35 U.S.C. 251. Accordingly the reported *Allan* decision reversed the December 22, 2003 merger decision. Based on the facts and circumstances of that case, the reissue application was suspended.

The suspension of the reissue application was the appropriate remedy in *Allan*, since the reissue application was filed after the reexamination request, [3] patent owner had requested suspension of the reissue as one

[2] *In re Allan*, 71 USPQ2d at 1753.

[3] 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.

alternative means of relief, [4] and patent owner's stated objective [5] 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) was achieved. The facts presented in the present instance, however, are distinguishable from those in *Allan*. The '537 reissue application is the first filed proceeding. The '206 *inter partes* reexamination proceeding was filed more than eight months after the filing of the '537 reissue application. Further, there has been no request by patent owner to suspend the reissue proceeding. Thus, if merger is not to be carried out and one of the proceedings is suspended, it is the '206 *inter partes* reexamination proceeding which should be suspended. If an earlier-filed broadening reissue application would be the one suspended, a requester observing that a patent owner has filed a broadening reissue application could then simply file an *inter partes* reexamination, to stop the earlier-filed reissue application. 35 U.S.C. 314(c) does call for "special dispatch,"however, it also permits the Director to determine that there is good cause for suspension. Addressing the problem of a requester bringing a reissue application to a halt will provide such good cause, unless there is some way to merge the two proceedings, so that they both can proceed at the same time. Such merger can be effected, if merger guideline requirements can be fashioned to be more specific than was the December 22, 2003 decision in *Allan*, whereby third party requester will be permitted to comment in the merged proceeding only on matters that could have been commented on in the '206 *inter partes* reexamination proceeding. Such merger guideline requirements will be provided in this decision.

37 CFR 1.991 provides that "[I]n 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." In the December 22, 2003 merger of *Allan*, this provision of the rules was construed too broadly so as to only preclude the third party requester from commenting on issues that were "reissue issues," such as recapture, the content of the reissue declaration and assignee consent. [6] The

[4] *In re Allan*, 71 USPQ2d at 1754.

[5] See *Id.*

[6] Page 4 of the December 22, 2003 decision merging the copending broadening reissue application and *inter partes* reexamination proceeding stated: "The third party requester does not gain any rights to participate with respect to issues that are not within the scope of *inter partes* reexamination. Specifically, with regard to petitioner's example of the issue of broadening the claims, note that the addition of broadened claims is not permitted in *inter partes* reexamination. Therefore, broadening issues would not be an issue within the scope of *inter partes* reexamination, and the third party requester would not be permitted to raise these issues in the merged proceeding. In other words, third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings. However, third party requester would NOT have the right to address broadening reissues, *e.g.*, the 2 yr. time limit, recapture, declaration, assignee consent, *etc.*, as these would not be

December 22, 2003 merger guideline requirements failed to preclude the third party requester from commenting on the propriety of the broadening in the broadened claims presented in the reissue application. The reexamination requester of the *Allan inter partes* reexamination proceeding should have been precluded from commenting, in any fashion on the propriety of the broadened claims present in the merged proceeding, [7] since the presence of such broadened claims is statutorily precluded in *inter partes* reexamination. 35 U.S.C. 314(a). The present decision will remedy this defect of the *Allan* December 22, 2003 merger decision; see part III.C.15.d below.

By fashioning the merger decision more precisely, both the patent owner and the *inter partes* reexamination requester will be able to participate in the merged proceeding with respect to the same matters that they could have addressed in the '206 *inter partes* reexamination, if that proceeding were to have proceeded without having been merged, while the third party requester will be precluded from participating and commenting on issues that are unique to examination of a reissue application, including any issue of propriety of any claim broadening effected via reissue.

As pointed out above it is equitable that the third party requester not be permitted to comment on the propriety of any broadening, since a reexamination filing cannot be used to give the third party requester access to the propriety of the broadening in those broadened claims. The present merger permits both proceedings to go forward at the same time, while preserving the rights of both parties.

III. Decision Merging The '537 Reissue Application And The '206 *Inter Partes* Reexamination Proceeding

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the '537 reissue application and the '206 *inter partes* reexamination proceeding 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 reissue application and the *inter partes* reexamination file for purposes of the merged proceeding. In accordance with 37 CFR 1.991, the

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patentability issues within the scope of *inter partes* reexamination."

[7] Beyond merely noting that such claims were in fact broader than the patent claims and therefore improper in the reexamination proceeding

maintenance of identical amendments in both files is required as long as the proceedings remain merged.

2. The required housekeeping amendment making the claims the same in both files has been submitted by the patent owner on April 10, 2008.

3. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) does not create a comment right for third party requester. The regulations governing the filing of requester written comments, 37 CFR 1.947 and 1.951(b) (which are grounded 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 requester will then have an opportunity to comment on the claims, as amended by the housekeeping amendment, 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 patent owner does not file any response to an Office action and claims added or amended by the housekeeping amendment have been indicated as patentable, the third party requester may appeal on issues that the examiner decides in favor of the patent owner.

Any comments paper filed by third party requester in response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. The merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, *to the extent*

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 '206 *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 '537 reissue application and the '206 *inter partes* reexamination proceeding. Each action will contain identifying data for both of the proceedings, *i.e.*, the reissue application and the *inter partes* reexamination proceeding. 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 in 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 reissue Application Number and the *inter partes* reexamination proceeding Control 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 and 37 CFR 1.121(h) governing reissue applications. See MPEP § 1453 for a complete discussion of amendment practice in a reissue application. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

5. There will be no interviews in the merged proceeding, as the rules provide that *inter partes* reexamination will be conducted on the written record. [8]

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 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 '206 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue, 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 not 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 all parties' appeal rights have been exhausted.

8. If the applicant/patent owner files an express abandonment of the '537 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 '206 *inter partes* reexamination proceeding.

9. Where the merged proceeding is dissolved based on abandonment of the reissue application and the '206 *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

[8] 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. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of paramount importance. A petition under 37 CFR 1.183 may be submitted to request an interview in the rare circumstances that an interview is deemed to be indispensable.

applicable under *inter partes* reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant practice to 37 CFR 1.906(c).

10. If the merged proceeding is dissolved based on abandonment of the '537 reissue application and the '206 *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application of the '537 reissue application will be merged with the '206 *inter partes* reexamination proceeding (any such continuation reissue application may be stayed pending conclusion of the '270 *inter partes* reexamination).

11. If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114, the reissue application will not be considered to have been expressly abandoned; rather the finality of the Office action would be withdrawn, and the merged proceeding could continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application. However, in the event that applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114, the merger may be severed, and the reissue application stayed pending conclusion of the '270 *inter partes* reexamination.

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. The examiner in the merged proceeding will consult with OPLA (*i.e.*, the OPLA legal advisor assigned to the '206 *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner, as he/she would consult in an *inter partes* reexamination proceeding that is not merged.

14. Scope of Third Party Requester's Participation in Merits of the Merged Proceeding:

37 CFR 1.991 provides that "[I]n 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, 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, as to all issues appropriate for reissue, but not appropriate for reexamination. [9] Examples of such issues that requester is precluded from addressing are:

a. The acceptability of any reissue declaration;

b. Assignee assent;

c. The recapture doctrine; and

d. Any aspect of the propriety of the claim broadening (enlargement of the claim scope) effected by patent owner under the authority of 35 U.S.C. § 251. Specifics are as follows:

(1) Requester is precluded from arguing that the presentation of broadened patent claims in the merged proceeding is impermissible, even though enlargement of the claim scope is precluded in a non-merged *inter partes* reexamination by 35 U.S.C. § 314(a).

(2) Requester is precluded from commenting on whether broadening reissue was sought within two years of the issue date of the patent, pursuant to the last paragraph of 35 U.S.C. § 251.

(3) Requester is precluded from arguing a lack of support, enablement, or description as to any broadening effected by patent owner with respect to the claim scope existing prior to reexamination. Likewise, argument that the broadening limitations are not clear

[9] NOTE: This does not, in any way, preclude the requester from participating in the reissue aspect of this merged proceeding in the capacity of a 37 CFR 1.291 protester. More particularly, 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 merged within the present merged proceeding. Thus, requester's rights have been retained as to both individual proceedings, while permitting concurrent examination that does not contravening the reexamination and reissue statutes.

or indefinite (i.e, that they fail to particularly point out the invention) is precluded.[10]

(4) Requester is permitted to comment as to a change in the broadened claims that narrows the claim scope existing prior to reexamination, which requester believes not to be supported, enabled, or described via the original disclosure, and on the clarity of such a change.

(5) Requester is permitted to comment as to the prior art applied to the broadened claims, as long as requester does not argue the broadening aspect of the claims to open the claims to the prior art.

Requester's comments in all pre-appeal and appeal papers must be limited to matters appropriate to *inter partes* reexamination. [11] Requester comments 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. [12] Any such improper paper will be returned to the requester as an improper submission under 37 CFR 1.939, or expunged, if the paper is entered prior to discovery of the defect.

15. Procedural Participation in the Merged Proceeding:

a. The patent owner/applicant 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 patent owner/applicant and to the requester of the reexamination.

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[10] The rights to comment on all patent owner responses and appeal as to the propriety of reissue broadening were statutorily beyond requester's reach prior to merger, and merger does not change that statutory-based fact.

[11] Note that no appeal can be advanced by third party requester with respect to issues appropriate for reissue and not appropriate for inter partes reexamination, as discussed above.

[12] Thus, for example, where a question 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 question.

b. Prior to the issuance of any Notice of Allowability (Form PTOL-37) - (1) the procedure for issuing Office actions, (2) the forms used for actions, (3) any response by the patent owner/applicant, and (4) procedure, including requester comments, will 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 37 CFR 41.81 will govern appeals by the patent owner and requester to the Board of Patent Appeals and Interferences (Board), and to the Court of Appeals for the Federal Circuit. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to advise parties of same, and inform patent owner of the steps that must be taken (*e.g.*, payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out in Section (C)(6) above, the present *inter partes* reexamination proceeding would be concluded by the grant of such a reissue patent, and the reissue patent would serve as the 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 37 CFR 41.60 through 37 CFR 41.81 will govern.

d. In view of the provisions 37 CFR 1.953(c), any filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to the final action, which action is taken as being an equivalent to the Right of Appeal Notice under 37 CFR 1.953.

IV. 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...."

Above it is directed that:

> "(1)the procedure for issuing Office actions, (2) the forms used for actions, (3) any response by the patent owner/applicant, and (4) procedure, including requester comments, 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.

CONCLUSION

1. The '537 reissue application and the '206 *inter partes* reexamination proceeding **are merged** into a single consolidated proceeding.

2. A copy of this decision will be placed in the IFW of the '537 reissue application and the '206 *inter partes* reexamination proceeding.

3. Jurisdiction over the merged reissue and reexamination proceeding is forwarded via the Technology Center 3700 Group Director to an examiner for the preparation of an Office action in the merged proceeding. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '035 patent (e.g., by preparing/signing an action). See MPEP 2636. All further examination should be conducted in accordance with Sections III(B) and III(C) of this Decision.

4. Telephone inquiries related to this decision and questions regarding procedural matters should be directed to Kery A. Fries, Reexamination Legal Advisor, Office of Deputy Commissioner for Patent Examination Policy at (571) 272-7757.

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

May 1, 2008
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(For Patent Owner)

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JUN 19 2007

CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
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(For Requester)

In re Andrew E. Meyer et al.
Reexamination Proceeding
Control No.: 95/000,209
Filed: January 25, 2007
For: U.S. Patent No.: 6,984,791

: DECISION
: DENYING
: PETITION

This is a decision on the May 8, 2007 patent owner petition titled "Petition under 37 C.F.R. § 1.182" to terminate the instant *inter partes* reexamination proceeding. In addition, on May 25, 2007, requester filed an opposition titled "Third Party Requestor's Opposition to Patentee's Petition Under 37 CFR § 1.182/183."

The petition and opposition are before the Office of Patent Legal Administration for consideration.

The petition is denied for the reasons set forth below.

SUMMARY

Essentially, the patent owner contends that its patent should not be eligible for *inter partes* reexamination, because its patent did not issue from "an original application" (as that term is used in the Effective Date provision for *inter partes* reexamination) filed after November 29, 1999. However, the petition is denied because (1) the Office has long used "original application" in its regulations and Manual of Patent Examining Procedure as a term of art synonymous with the statutory phrase "application for original patent" (as opposed to a reissue patent), and (2) the patent in question issued from an application for original patent that was filed in 2003. Moreover, the Office's interpretation of "original application" in the Effective Date provision was essentially ratified by Congress when, in 2002, Congress amended the *inter partes* reexamination provisions, *including its effective date provision*, without revising or correcting the Office's interpretation. Each of the petitioner's arguments has been considered and addressed, but are unpersuasive. In fact, accepting petitioner's proposed interpretation of

"original application" would lead to illogical results, as explained below. The Office's interpretation, on the other hand, is consistent with the common understanding that Congressional acts should have prospective effect, by ensuring that all patents issuing from applications filed after November 29, 1999, are subject to *inter partes* reexamination.

BACKGROUND

1. U.S. Patent No. 6,984,791 (hereinafter, the '791 patent) issued on January 10, 2006.

2. The '791 patent issued from Application Serial No. 10/412,683 (the '683 application), filed April 14, 2003.

3. (a) The '683 application is a continuation application of Application Serial No. 10/198,963 (the '963 application), filed July 22, 2002 (abandoned).

   (b) The '963 application is a continuation application of Application Serial No. 08/821,760 (the '760 application), filed March 20, 1997. The '963 application issued as U.S. Patent No. 6,504,103 on January 7, 2003.

   (c) The '760 application is a continuation application of Application Serial No. 08/262,460 (the '460 application), filed on June 20, 1994 (abandoned).

   (d) The '460 application is a continuation-in-part application of Application Serial No. 08/038,335 (the '335 application), filed on March 10, 1993 (abandoned).

4. On June 14, 2006, patent owner Cooper Technologies, Inc. (hereinafter "Cooper") filed suit against Thomas and Betts Corporation (hereinafter "T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas.

5. An *inter partes* request for reexamination, assigned control No. 95/000,209 (the '0209 proceeding), was filed by a third party requester on behalf of T&B on December 21, 2006. T&B will be referred to as the "requester" of the '0209 proceeding.

6. On January 17, 2007, a "NOTICE OF FAILURE TO COMPLY WITH *INTER PARTES* REEXAMINATION REQUEST FILING REQUIREMENTS (37 CFR 1.915(d))" was mailed by the Office to the requester.

7. On January 25, 2007, a "REPLACEMENT STATEMENT AND EXPLANATION UNDER 37 C.F.R § 1.915(B)(3) FOR REQUEST FOR *INTER PARTES* REEXAMINATION OF U.S. PATENT No. 6,984,791" was filed by the requestor.

8. On February 6, 2007, a "NOTICE OF *INTER PARTES* REEXAMINATION REQUEST FILING DATE was mailed by the Office, assigning the request a January 25, 2007 filing date.

9. On April 13, 2007, the Office issued an order granting the '0209 request for *inter partes* reexamination. The order was accompanied by the initial Office action, rejecting claims 1-30.

10. On May 8, 2007, the patent owner filed a petition pursuant to 37 CFR § 1.182 to terminate the instant *inter partes* reexamination proceeding.

11. On May 10, 2007, the Office issued a Notice, providing the third party requester a period of 15 days to respond to the patent owner petition.

12. On May 25, 2007, the requester submitted, in response to the May 10th Notice, a paper titled "Third Party Requestor's Opposition to Patentee's Petition 37 CFR § 1.182/183."

DECISION

I. The Patent Reexamination System

In 1980, Congress added an administrative procedure within the Office known as *ex parte* reexamination. 35 U.S.C. §§ 301-307. *Ex parte* reexamination allows anyone (including patent owners themselves) to call to the Office's attention new prior art that the examiner did not consider during the initial examination and that might affect a patent's validity. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601 (Fed. Cir. 1985) (*Patlex I*). Such reexamination helps to ensure "a strong, dependable patent system" by testing the validity of issued patents in view of new evidence, and weeding out dubious patents. *Id.* at 601-02. The Office's expertise in science and technology as well as examining patentability issues places the agency in a unique position to assess a patent's validity correctly and efficiently. *Id.* at 602. Thus, reexamination was designed to "settle validity disputes more quickly and less expensively than the often protracted litigation involved in such cases." *Id.*

Conventional *ex parte* reexamination, however, differs from litigation because it does not provide a meaningful opportunity for the requester to participate once reexamination is ordered. 35 U.S.C. §§ 301-307. As a result "reexamination had been used infrequently," as opposed to its potential for use, since it was enacted in 1980. 145 Cong. Rec. S14720 (Nov. 17, 1999). To encourage greater use of reexamination, Congress amended Title 35 in 1999 to add provisions for *inter partes* reexamination "as an option to the existing *ex parte* reexamination proceedings." *See* The American Inventors Protection Act of 1999 (the AIPA), §§4604-08, Public Law 106-113, 113 Stat. 1501, 1501A-567 through 1501A-572, codified as 35 U.S.C. §§ 311-18. "With

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).

Compared to *ex parte* reexamination, *inter partes* reexamination expands the ability of reexamination requesters to participate in the reexamination proceeding by permitting requesters to: (i) submit a written comment each time the patent owner files a response to an "Office action" on the merits issued by the Office; (ii) appeal a decision by the patent examiner to the Board of Patent Appeals and Interferences (BPAI); and (iii) fully participate in a patent owner's appeal to the BPAI.[1] 35 U.S.C. §§ 314, 315; *see also Sony Computer Entertainment Am., Inc. v. Dudas*, 2006 WL 1472462 at *4 (E.D.Va. 2006) (explaining requester's statutory participation rights in *inter partes* reexamination).

Finally, the AIPA provides that the *inter partes* reexamination provisions apply prospectively to patents issuing from certain applications. Thus, the "Effective Date" provision of the "Optional Inter Partes Reexamination Procedure" portion of the AIPA, section 4608, states that the *inter partes* reexamination provisions "shall take effect on the date of enactment of this Act [November 29, 1999] and *shall apply to any patent that issues from an original application* filed in the United States on or after that date." (Emphasis added). Petitioner challenges the meaning of the term "original application."

II. The Office's Longstanding Interpretation of "Original Application"

Shortly after the enactment of the AIPA, the Office issued a notice in the Office's *Official Gazette* (OG), interpreting "original application" in Section 4608 of the AIPA. The notice published at 1233 OG 54, 56 (April 11, 2000), and it was entitled "*Interpretation of the term "original application" to clarify the application of the Optional Inter Partes Reexamination Procedure.*" That notice provided, in part:

> The phrase "original application" is interpreted to encompass utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications. This interpretation is consistent with the use of the phrase in 35 U.S.C. 251 and the federal rules pertaining to reexamination. In addition, section 201.04(a) of the Manual of Patent Examination and Procedure (MPEP) defines an original application as "an application which is not a reissue application." Section 201.04(a) of the MPEP further states that "[a]n original application may be a first filing or a continuing application." Therefore, the Optional Inter Partes Reexamination Procedure is applicable to patents which issue from all applications (except for reissues) filed on or after November 29, 1999.

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[1] This requester right of appeal, and participation in patent owner's appeal, was expanded to the Court of Appeals for the Federal Circuit by the "Patent and Trademark Office Authorization Act of 2002," enacted in Public Law 107-273, 21st Century Department of Justice Appropriations Authorization Act, 116 Stat. 1758 (2002).

Id. As explained in that OG notice, the Office interprets "original application" to include any and all applications for an original patent, thereby excluding reissue applications. That interpretation is consistent with the term's statutory use, as well as the preexisting Office understanding of the distinction between applications for original patents (i.e., "original applications") and applications for reissue patents (i.e., "reissue applications"). The Manual of Patent Examination Procedure (MPEP) provision cited in that OG notice, section 201.04(a), has included the above-quoted language for nearly twenty-five years. *See* MPEP, § 201.04(a) (5th ed. 1983). Interpreting "original applications" to mean applications for an original patent and excluding reissue applications ensures that the *inter partes* reexamination provisions apply prospectively to any patent that issues from an application for an original patent filed on or after the effective date of the originally enacted *inter partes* reexamination provisions. That interpretation further ensures that a patent issuing from a reissue application will only be subject to *inter partes* reexamination if its corresponding original application was filed after the AIPA effective date.

Consistent with MPEP § 201.04(a), the Office incorporated its interpretation provided in the April 11, 2000 OG notice into section 2611 of the MPEP, as well as into the final rule implementing the *inter partes* reexamination proceedings. *See Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76756, 76757 (December 7, 2000). Petitioner now challenges that interpretation.

III. Petitioner's Arguments

It is undisputed that petitioner's patent issued from an application for original patent (Application Serial No. 10/412,683) filed in 2003, well after the effective date for *inter partes* reexamination. Petitioner points out, however, that the '683 application was a "continuation application" of a chain of earlier-filed applications beginning with an application filed in 1994, and the '683 application claimed the benefit of the filing date of the 1994 application. In petitioner's view, only the 1994 application is an "original application." Petitioner thus contends that the 2003 application that issued as the '791 patent was not an "original application," and therefore not subject to *inter partes* reexamination.[2]

Thus, the issue presented is whether the correct interpretation of "original application" is: (1) any application for an original patent, i.e., any non-reissue application, including continuation applications that claim the benefit of the filing date of an earlier application; or (2) only an

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[2] Petitioner does not dispute that the '791 patent is subject to the *ex parte* reexamination procedures enacted in 1980. Hypothetically, if this petition had been granted, then the Office could have simply terminated the *inter partes* reexamination and initiated an *ex parte* reexamination, given that the Office has not only found a substantial new question of patentability, but has also rejected patent claims 1-30 in the April 13, 2007 initial Office action. *See* 35 U.S.C. § 303 (granting the Director the power to authorize an *ex parte* reexamination "[o]n his own initiative"). Thus, the present petition is not about whether the Office will reexamine the '791 patent, but whether it be reexamined subject to the *ex parte* or *inter partes* reexamination provisions.

application for an original patent that does not claim the benefit of the filing date of any earlier application, and thus not a continuation application.

In support of the second interpretation, Petitioner makes the following arguments:

(1) The ordinary meaning of "original application" is the earliest filed application in a series of applications (Petition at 4);

(2) 35 U.S.C. § 121 uses the term "original application" in a way that is inconsistent with the Office's interpretation of that term (Petition at 6-7); and

(3) The Office's interpretation would nullify Congress's intent to distinguish "original applications" and "any applications" as that latter term is used in other parts of the AIPA (Petition at 7).

IV. "Original Application" Means any Application for an Original Patent, Including a Continuation Application

A. Title 35 Distinguishes Between Two Types of Applications: Applications for Original Patents and Applications for Reissue Patents

35 U.S.C. § 251 ("Reissue of defective patents") permits a patent owner to return an issued patent to the Office in order to correct certain errors in the "original patent." Under section 251, the patent owner files an "application for reissue," and if that application is successful, patent owner receives a "reissued patent." Further, 35 U.S.C. § 252 provides that"[t]he surrender of the original patent shall take effect upon the issue of the reissued patent ...." Thus, in sections 251 and 252, Congress uses the terms "original" and "reissue" as alternatives to distinguish regularly issued patents from patents that have issued to correct errors under section 251.

The "original" versus "reissue" distinction set forth in section 251 is mirrored in 35 U.S.C. § 41, which sets forth various application filing fees, and, in so doing, distinguishes between applications for original and reissue patents. While 35 U.S.C. § 41(a)(1)(A) sets the filing fee for "each application for an original patent," section 41(a)(1)(E) sets the filing fee for "each application for the reissue of a patent." Likewise, while section 41(a)(3)(A) sets the examination fee "for each application for an original patent," section 41(a)(3)(E) sets the examination fee "for each application for the reissue of a patent." *See also* 35 U.S.C. § 41(d)(1)(B) (specifying, in different subsections, search fees for applications for both original and reissue patents). Thus, like the reissue provisions, the structure of the statute's patent fee provisions makes clear that Congress identifies U.S. utility patent applications in <u>two</u> categories—applications for original patents, and applications for reissue patents.

35 U.S.C. § 120 does not create a third category of applications. Rather, it merely permits an applicant to claim the benefit of the filing date of an earlier-filed and still-pending application for purposes of overcoming "prior art" that might be applied against the later-filed application. Such a claim under section 120 is known as a claim for "priority" to the earlier application; the

application in which the priority claim is made is commonly referred to as a "continuation" application. Section 120 provides the statutory basis for priority, and it treats the continuation as a new, and separate, application: "*An application for patent* for an invention disclosed . . . in an application previously filed in the United States . . . shall have the same effect . . . as though filed on the date of the prior application . . . ." 35 U.S.C. § 120 (emphasis added).

The advantage of claiming priority under section 120, i.e., the advantage of filing a continuation, is that it permits an applicant to file a later, distinct application while maintaining the benefit of the earlier filed application's filing date for prior art purposes. *See, e.g., Racing Strollers, Inc. v. TRI Indus., Inc.*, 878 F.2d 1418, 1421 n.* (Fed. Cir. 1989) (explaining that prior art against a continuation application is determined by referring to the filing date of the earlier filed application). Thus, when an examiner issues a final rejection, one way the applicant can continue to pursue a patent is by filing a new application with a section 120 priority claim to the earlier, rejected application. The newly filed application has a new serial number, is a new file, and has a new filing date.[3] That "response" to a final rejection is contrasted by a different option, the filing of a request for continued examination ("RCE") under 37 CFR 1.114. Under 37 CFR 114, an applicant can pay a fee and request that examination continue without actually filing a new application. When such an RCE is filed, no new serial number, filing date, or file is created, making it unlike a continuation application. For an RCE, prosecution merely proceeds from the final rejection, as part of the same application. Moreover, an application in which an RCE is filed can result in only a single patent, whereas a continuation application can issue as a patent regardless of whether the parent application also issues as a separate patent.

In this instance, petitioner, Cooper Technologies, filed a patent application in 1994, and then filed a series of continuations applications in 1997, 2002, and 2003 (of which the 1997 application issued as the '103 patent), each time choosing to re-enter the examination system. When it chose to re-enter the system April 14, 2003, it was aware, or should have been aware, that its new application would be subject to the laws in effect at the time it filed that particular application.

In short, the statute provides for only two categories of utility patent applications: applications for original patents and applications for reissue patents. An application that claims priority to an earlier application, i.e., a continuation filed under section 120, is itself an application for an original patent.

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[3] Of course, there is no requirement that a section 120 continuation application be filed only in response to a final rejection. Priority benefit can be claimed any time that two applications are pending at the same time, provided other statutory requirements are met. Moreover, both applications may issue as separate patents. Thus, while continuations are sometimes filed in the form of a "chain" of applications with the patent issuing at the end of the chain, that is not always the case. *Indeed, in the present case*, petitioner's chain of applications has resulted in two patents: (1) U.S. Patent No. 6,984,791, which issued from application No. 10/412,683. (2) U.S. Patent No. 6,504,103, which issued from application No.10/198,963. Since the '963 application filing date is March 20, 1997, the resulting '103 patent is not eligible for *inter partes* reexamination, unlike the later-filed '791 patent, which is eligible for *inter partes* reexamination.

B. **The Terms "Application for Original Patent" and "Application for Reissue Patent" are Synonymous with the Terms "Original Application" and "Reissue Application"**

The USPTO Rules in effect at time of AIPA enactment (November 29, 1999) demonstrate the terms "original application" and "reissue application" are recognized synonyms for the terms "application for original patent" and "application for reissue patent," respectively. For example, 37 CFR 1.16, the regulation implementing the statutory fee provisions in 35 U.S.C. § 41, refers to "an application for original patent" and then subsequently uses the shorthand "original application." *Compare* 37 CFR 1.16(a) (1999) ("application for original patent") with 37 CFR 1.16(b), (c), and (d) (1999) (each time referring to "original application"). Likewise, those fee provisions refer to an application for reissue patent only with the shorthand "reissue application." 37 CFR 1.16 (h), (i), and (j) (1999); *see also,* 37 CFR 1.179 (1999) (using the terms "application for reissue" and "reissue application" synonymously). In addition, the regulations use the terms "original application" and "reissue application" in a categorical way to distinguish one from the other. 37 CFR 1.176 (1999) (noting that a "reissue application" "will be examined in the same manner as original applications"); 37 CFR 1.104(c)(5) (1999) (making the distinction between an "original application" and "reissue application"). Accordingly, the regulations contemplate two categories of applications: (1) original applications and (2) reissue applications.

In addition, the Office elsewhere has made clear, long before the AIPA was enacted, that the term "original application" encompassed continuations and was an alternative to a reissue application. *See MPEP* § 201.04(a) (5th ed. 1983) ("'Original' is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a 'first' filing or a continuing application."); *Notice Regarding Implementation of 37 CFR 1.56*, 1095 OG 16 (Oct 11, 1988) (notifying the public that the PTO will "no longer investigate and reject original and reissue applications under" 37 CFR 1.56) (emphasis added). Thus, when the AIPA was enacted, it was clear from the Office's rules, MPEP, and OG notices, that "original application" was a term of art synonymous with "application for original patent," and that "reissue application" was synonymous with "application for reissue."

Moreover, courts have used the term "original application" in the same way. *See In re Etter*, 756 F.2d 852 (Fed. Cir. 1985) ("The same policies warranting the PTO's approach to claim interpretation when an original application is involved have been held applicable to reissue proceedings . . . .") (quoting *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984); *In re Geisler*, 121 F.2d 537 (CCPA 1941) (quoting with approval language from a Board decision that contrasted "claims presented by reissue" with claims presented "in an original application"). Thus, the Office's interpretation of "original application" was well-established in the law when the AIPA was enacted.

C. **Congress Is Presumed to Have Legislated with Awareness of the Office's Terminology, and It Is Therefore Reasonable to Construe the AIPA Consistent with that Terminology**

Congress is presumed to know about pertinent existing law when it enacts legislation. *Bristol-Myers Squibb Co. v. Royce Lab.*, 69 F.3d 1130, 1136-37 (Fed. Cir. 1995). That presumption of existing law includes agency regulations. *California Indus. Prods., Inc. v. United States*, 436 F.3d 1341, 1354 (Fed. Cir. 2006) (citing *Minneapolis & St. Louis Ry. Co. v. United States*, 361 U.S. 173, 187 (1959) (presuming that Congress was aware of applicable railroad regulations when enacting pertinent legislation)). Thus, the Office's then-existing regulations are appropriately considered when construing the AIPA. *See id.* Because Congress was presumably aware of the Office's use of the terms "original application" and "reissue application," it follows that Congress used those terms consistently with the Office's use of them. Moreover, the Office's longstanding administrative construction of "original application" is entitled to significant weight. *Saxbe v. Bustos*, 419 U.S. 65, 74 (1974) ("A longstanding administrative construction is entitled to great weight").

Any doubt that Congress used the phrase "original application" in a way inconsistent with the Office's longstanding definition is dispelled by Congress's failure to correct the Office. After the AIPA was passed, the Office published its interpretation of "original application." *See Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 65, at 76756, 76757 (quoting 1233 OG 54, 56 (April 11, 2000). In that Final Rule, the Office specifically criticized language in the AIPA that allowed a patentee to request *inter partes* reexamination of its own patent, because it would be illogical for a patentee to request anything other than *ex parte* reexamination. *Id.*, at 76764-65. Congress subsequently passed the "Intellectual Property and High Technology Technical Amendments of 2002." Pub. L. 107-273, § 13202, 116 Stat. 1758, 1901 (2002) ("the 2002 Amendment"). In so doing, Congress modified the *inter partes* reexamination provisions to clarify that a patentee cannot request *inter partes* reexamination of its own patent. *Id.*

Moreover, the 2002 Amendment altered the scope of the Effective Date provision in section 4608 of the AIPA without modifying the "original application" language. In section 13202(d) of the 2002 Amendment, Congress changed the effective date for certain provisions in the AIPA relating to the appeals process for reexaminations from what was provided in the AIPA, so that those statutory appeal provisions "shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106-113 [AIPA]." Notably, Congress did not modify the "original application" language. Thus, Congress's further legislation in the *inter partes* reexamination area in 2002, and specifically with respect to the effective date provision, again confirmed and essentially ratified that the Office is correct in its position that "original application" means "application for original patent." *See San Huan New Materials High Tech, Inc. v. Int'l Trade Comm'n*, 161 F.3d 1347, 1355 (Fed. Cir. 1999) (recognizing that Congress ratifies agency practice when it legislates in the area of law covered by that practice and does not change or refer to that practice); *Mudge v. United States*, 308 F.3d 1220, 1232 (Fed. Cir. 2002) ("[W]e presume that Congress was aware of any administrative or judicial interpretations of the statute.").

V. Petitioner's Arguments in Favor of Limiting the Term "Original Application" to Only the First in a Series of Applications Are Not Persuasive

A. Petitioner's Ordinary Meaning Argument is not Consistent with the Context of the AIPA's Section 4608

Despite the established and longstanding meaning of "original application," petitioner argues that the term instead means the first in a series of applications, and does not include a continuation application. Petitioner supports that argument with reference to a number of dictionary definitions. Petitioner's argument fails because it confuses the occasional contextual use of the term "original" with the categorical use of that term in the AIPA. Thus, while the term "original" might be used in context to refer to the first of a series of applications, that use fails to make sense when only one application is being referred to. In the AIPA provision, only a single application is being referred to: "any patent that issues from an original application." AIPA, § 4608. Because the statute is not directed to a series of applications, there is no reason for the presence of a modifier meant to distinguish the first from series of applications. Instead, Congress was using the term "original" in its categorical sense—to specify the category of applications it was referring to: applications for original patents.

In 35 U.S.C. § 121, cited by petitioner, the statute identifies "one application" and then introduces a subsequently filed divisional application. Only after both applications are introduced does Congress use the term "original." Thus, that word is not used to identify a category of applications, but instead used contextually to refer back to the first application identified in the provision. Furthermore, if "original" in section 121 meant only the first filed application in a chain of applications, as Petitioner urges, rather than the immediate "parent" of a divisional application (which the context of section 121 suggests), the result would be inconsistent with the recognized effect of that section. The third sentence of section 121 states:

> A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

35 U.S.C. § 121 (emphasis added). That sentence has been construed to mean that where an application is subject to a restriction requirement, and a divisional application is filed, the restricted and divisional applications cannot be used against one another, either in the Office or in court. *See Studiengesellschaft Kohle mbH v. N. Petrochemical Co.*, 784 F.2d 351, 357-360 (Fed. Cir. 1986) (Newman, J. concurring) (providing a detailed explanation of the meaning of the third sentence of section 121) (cited with approval by *Gerber Garment Tech., Inv. v. Lectra Sys., Inc.*, 916 F.2d 683, 688 (Fed. Cir. 1990)). That construction requires the term "an application with respect to which a requirement for restriction under this section has been made" to be synonymous with the subsequent term "the original application." In other words, "original application" must mean the restricted application and not the first application in a series of

applications. If it were otherwise, then in any situation where an application in a series of applications is subject to a restriction requirement, the restricted patent application could potentially be used against the child divisional application because, under petitioner's theory, the restricted parent application in such a series might not be the "original," and hence first application. Stated another way, using petitioner's asserted construction of 35 U.S.C. § 121, a divisional application filed after restriction was made in a parent application, *which parent is itself a continuing application,* would not be covered by, i.e., not protected by, 35 U.S.C. § 121.

Further, in a clear conflict with petitioner's theory, the Federal Circuit has confirmed that a first-filed application in a series of applications can be used against a subsequently-filed divisional application, if the restriction requirement was not present in each of the series to generate the next divisional application. *See Bristol-Myers Squibb Co. v. Pharmachem, B.V.*, 361 F.3d 1343, 1348-49 (Fed. Cir. 2004) (holding that a patent issuing from the first application in a series of applications can be used against a later-filed divisional if the restriction requirement that triggered the filing of the divisional application was made in a subsequent, and not the first, application in the series). Contrary to *Bristol-Myers*, petitioner's asserted construction would produce the illogical result that a divisional application would be insulated from rejections based *only* on the first application in a series of applications (since that would be the "original application" under petitioner's theory) despite the fact that no restriction requirement was made in that case, and not from the application in which the restriction requirement was actually made (which would not be the "original application" under petitioner's theory) where protection from the paent should be prvided. Hence, Petitioner's argument is not persuasive. Section 121 uses the term "original application" in context to refer to a previously-discussed application (which may or not be a continuing application, i.e., need not be the first application in the series), and not to refer to a particular category of applications. Thus, section 121's usage of "original application" does not support petitioner's proposed interpretation.

It is acknowledged that, in the Federal Register notice cited by petitioner, the Office indicated that it "was aware of case law which suggests that the Office has no authority to place an absolute limit on the number of copending applications originating from an original application." Fed. Reg. Vol. 71, No. 1, at 50 (Jan. 3, 2006). However, as with section 121, the context of that notice confirms that use of the term "original" was not to identify a category of applications, in its technical sense, but was merely used colloquially to refer to the first in a series of applications.

Although the term "original" is used in that notice in the context of the first filed application in a series of applications, it does not follow that that usage controls the meaning of that term in all other contexts. Where, as in section 4608 of the AIPA, no such series of applications is mentioned, adopting the contextual use of the term "original" advanced by petitioner makes little sense. The more logical conclusion is that Congress used the term "original application" consistent with the Office's longstanding and well-documented meaning: an application for original patent.

B. Petitioner's Argument Regarding the "Any Application" Language in Section 4405 Ignores the Proper Scope of the Section

Petitioner makes much of the AIPA's section 4405, which states that changes made by that act to patent terms "shall apply to *any application* filed on or after the date that is 6 months after the date of the enactment of this Act." AIPA, Pub. L. No. 106-113, § 4405, 113 Stat. 1501, at 1501A-561 (emphasis added). Although it is not completely clear, petitioner seems to argue that the phrase "any application" in section 4405 is somehow inconsistent with the existence elsewhere in the AIPA of the phrase "original application," when that latter phrase is given the Office's construction. Petitioner's contention appears to be that under the Office's construction of "original application," both phrases would mean the same thing, and it would thus be illogical for Congress to have used two different phrases when referring to the same type of applications. Petitioner's argument fails to appreciate that section 4405 is necessarily already limited to original applications because it applies to patent term adjustments. A reissue patent is only subject to the patent term adjustment available to its respective original patent; there is no such adjustment based on the prosecution and handling of the reissue application. The patent term provisions of the AIPA therefore only apply to original patent terms, and thus to original applications. *See* 35 U.S.C. § 154(b)(1)(A) (providing patent term extension "if the issue of an *original patent* is delayed due to the failure of the Patent and Trademark Office to" handle the application for the original patent in a timely manner) (emphasis added); 35 U.S.C. § 154(b)(1)(B) (providing patent term extension "if the issue of an *original patent* is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States") (emphasis added); 35 U.S.C. § 154(b)(1)(C) (providing patent term extension "if the issue of an *original patent* is delayed due to" certain events occurring within the Office) (emphasis added). In view of the express terms of section 154, there was no need for Congress, in the effective date provision for the patent term adjustment regime, to make any distinction between applications for original patents (i.e. original applications) and reissue applications, like it did for the *inter partes* reexamination regime. Petitioner's argument therefore fails.

C. Petitioner's Proposed Interpretation Leads to Irrational Results

Petitioner argues that the only patents potentially subject to *inter partes* reexamination are those that issue from applications filed on or after Nov. 29, 1999, in which the application is the very first application in a series of applications. That interpretation would lead to the odd result that an applicant could insulate a patent from *inter partes* reexamination by simply filing a continuation application, even where both applications were filed years after the AIPA's effective date. There is no apparent reason why would Congress would enact an effective date provision that applied only to "initial" applications filed after the effective date, but not to subsequently filed continuation applications based on the "initial" applications. The far more reasonable interpretation is that Congress was referring to any application for an original patent filed on or after the effective date of the *inter partes* reexamination statute.

Courts generally presume that effective dates operate prospectively unless Congress plainly expresses otherwise. *See, e.g., Martin v. Hadix*, 527 U.S. 343, 361 (1999). Contrary to petitioner's assertion (Pet. 7), the Office's construction of "original application" is consistent with that principle, because it applies *inter partes* reexamination only to patents that issue from

applications filed on or after the effective date of AIPA. Moreover, the Office's construction of "original application," which excludes reissue applications, is consistent with the presumed prospective application of the AIPA. Where *only* a reissue application was filed after the enactment of the AIPA, it is reasonable to exclude that application from the *inter partes* reexamination provisions, because the original application would have been filed prior to the enactment of the AIPA and so would itself not have been subject to those provisions. On the other hand, where an applicant voluntarily chooses to file a continuation application after the enactment of the AIPA, it is reasonable to expect that the application will be subject to existing law as of its filing date.

In summary, the proper interpretation of "original application," as that term is used in section 4608 of the AIPA, is an application for original patent after taking into account: all of petitioner's arguments, the statutory framework, the regulatory framework, the historical interpretation of that term reflected in the MPEP and other OG notices, case law recitations of the term, and Congress's actions subsequent to the AIPA. Because Petitioner's patent resulted from an application for original patent filed in 2003, the patent is subject to the *inter partes* reexamination provisions of the AIPA.

CONCLUSION

1. The May 8, 2007 patent owner petition under 37 CFR. 1.182 is **DENIED**.

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 (CRU).

3. Telephone inquiries related to this decision should be directed to Samuel Broda, Legal Advisor, at (571) 272-7711, 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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6-19-07

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(For patent owner)

MAILED

JUL 11 2007

CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
c/o Kaye Scholer LLP
901 15th Street, N. W.
Washington, DC 20005

(For Requester)

In re Meyer *et al*
Inter partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: DECISION DENYING
: PETITION FOR SECOND
: EXTENSION OF TIME
: (37 CFR 1.956)

This is a decision on the July 2, 2007 patent owner "Request for Extension of Time." requesting that the time for responding to the Office action dated April 13, 2007, be extended by one additional month.

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

The petition is denied for the reasons set forth below.

Decision

The Patent Owner requests a second extension of time in which to file a response to the Office action dated April 13, 2007, which set a two month date for filing a response thereto. The Office action in question is a non-final Office action, and the request for extension is the second request for an extension of time with respect to the outstanding Office action. The requested extension of time is to permit the Office to act on a patent owner petition filed on June 26, 2007. The present petition for extension of time was timely filed on July 2, 2007, together with authorization to debit a deposit account for the $200.00 petition fee as set forth in 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.*

Addressing the requirement of 37 CFR 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

The patent owner has stated that the patentee requests an extension of time to respond to the current Office action while the USPTO decides the patentee's petition to suspend the reexamination. On balance it has not been demonstrated that there is "sufficient cause" to grant the extension of time.

The patent owner previously requested, and has received, a one month extension of time for the purpose of extending the time to respond to the April 13, 2007 Office action in order to permit time for the Office to decide the May 8, 2007 petition before patent owner filed the response. (The May 8, 2007 petition was denied in a decision mailed on June 19, 2007.) The grant of a second one month extension of time requires a strong showing of why the patent owner could not have prepared an appropriate response given the previously extended response time. The patent owner had the opportunity to have filed a combined petition rather than filing the petitions serially. There is no showing of sufficient cause for why this was not filed earlier, given that petitioner has been aware since April 13, 2007 of the references it wishes to challenge as not being "printed publications," yet only recently a second petition (requesting suspension of the present reexamination proceeding).

The patent owner should not interpret the denial of the present request for a second extension of time as a prejudgment by the Office of the petition to suspend the present reexamination proceeding. The petition to suspend the present reexamination proceeding will be addressed separately on its own merits.

When patent owner files a response to the April 13, 2007 Office action, the patent owner should make whatever arguments it feels are warranted as to the legal effect of the challenged references in the response which is due July 13, 2007. Regardless of whether the proceeding is temporarily suspended, the patent owner will have the opportunity during the pendency of the prosecution to supplement the response should the patent owner learn anything more about the challenged references through the discovery process in the

concurrent litigation. It is noted that the references are pertinent only if the rejections are maintained by the Office during prosecution of the reexamination of the patent before the Office.

Conclusion

1. The patent owner's petition for extension of time filed on July 2, 2007 is denied.

2. 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 Reinhart//

Mark J. Reinhart
SPE Art Unit 3992

for Lissi Mojica Marquis
Director, Central Reexamination Unit

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000209	01/25/07	6,984,791	

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EXAMINER
ROLAND FOSTER

ART UNIT	PAPER
3992	

DATE MAILED:

09/05/07

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.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KEVIN W. JAKEL
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Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination

REEXAMINATION CONTROL NUMBER *95/000,209*.

PATENT NUMBER *6,984,791*.

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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SEP 05 2007

CENTRAL REEXAMINATION UNIT

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In re Meyer et al :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,209 : **DISMISSING**
Filed: January 25, 2007 : **PETITION**
For: U.S. Patent No. 6,984,791 :

This is a decision on the June 26, 2007 patent owner petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAM," (the "Petition"). In addition, third party requester filed a paper on July 30, 2007 entitled "THIRD-PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 IN OPPOSITION TO PATENTEE'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION UNDER 37 C.F.R. § 1.987" (the "Opposition").

The Petition, the Opposition, and *inter partes* reexamination control number 95/000,209 are before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the patent owner Petition is granted to the extent that the petition has been considered, but is dismissed with respect to granting the relief requested.

FEES

The patent owner Petition is taken as a petition under 37 CFR 1.182 because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be dismissed or stayed. The Petition is also taken as a petition under 37 CFR 1.183 to waive the provisions 37 CFR 1.939. A single petition fee of $400.00 is required for the petition, and is being charged to Deposit Account No. 06-2380 as authorized by petitioner patent owner. [1,2]

[1] 37 CFR 1.182 and 1.183 each require a petition fee as set forth in 37 CFR 1.17(f). Effective October 16, 2006, the fee pursuant to 37 CFR 1.17(f) is $400.00.
[2] See patent owner's Petition at page 7.

The third party requester Opposition also requires a waiver of the provisions of 37 CFR 1.939. Accordingly, a $400.00 petition fee is being charged to Deposit Account No. 50-0988 as authorized by third party requester. [3]

REVIEW OF FACTS

1. U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("CTI").

2. On June 14, 2006, patent owner CTI sued Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas.

3. An *inter partes* request for reexamination, assigned control No. 95/000,209 (the "'0209 proceeding"), was filed by a third party requester on behalf of T&B (the "requester") on December 21, 2006.

4. On January 17, 2007, a "NOTICE OF FAILURE TO COMPLY WITH *INTER PARTES* REEXAMINATION REQUEST FILING REQUIREMENTS (37 CFR 1.915(d))" was mailed by the Office to the requester.

5. On January 25, 2007, a "REPLACEMENT STATEMENT AND EXPLANATION UNDER 37 C.F.R § 1.915(B)(3) FOR REQUEST FOR *INTER PARTES* REEXAMINATION OF U.S. PATENT No. 6,984,791" was filed by the requester.

6. On February 6, 2007, a "NOTICE OF *INTER PARTES* REEXAMINATION REQUEST FILING DATE" was mailed by the Office to the requester.

7. On April 13, 2007, the Office issued both an order granting the request for *inter partes* reexamination and an accompanying Office action rejecting claims 1-30.

8. On May 10, 2007, patent owner CTI filed a petition entitled "PETITION UNDER 37 C.F.R § 1.182" and a petition entitled "PETITION FOR TIME-EXTENSION UNDER 37 C.F.R. § 1.956."

9. On May 25, 2007, a petition entitled "THIRD-PARTY REQUESTER'S OPPOSITION TO PATENTEE'S PETITION UNDER 37 C.F.R. § 1.182/1.183" was filed by the requester.

10. On June 19, 2007, a notice entitled "DECISION DENYING PETITION" was mailed by the Office to patent owner CTI.

11. On June 26, 2007, a petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAM" was filed by patent owner CTI.

12. On July 9, 2007, a petition entitled "PETITION FOR TIME EXTENSION UNDER 37 C.F.R. § 1.956" was filed by patent owner CTI.

13. On July 11, 2007, a notice entitled "DECISION DENYING PETITION FOR SECOND EXTENSION OF TIME" was mailed by the Office to patent owner CTI.

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[3] See third party requester's Opposition at page 16.

14. On July 31, 2007, a petition entitled "THIRD-PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 IN OPPOSITION TO PATENTEE'S PETITION TO SUSPEND INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.987" was filed by the requester.

DECISION

I. Relevant Statute, Regulations, and Examining Procedure

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."

35 U.SC. § 317(b) provides:

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

37 CFR 1.987 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."

MPEP § 2686.04 ("Reexamination and Litigation Proceedings") provides, in pertinent part:

"III. Reexamination With Concurrent Litigation But Ordered Prior to Federal Court Decision

In view of the statutory mandate to make the determination on a request for reexamination within 3 months, the determination on the request based on the record before the examiner will be made without awaiting a decision by the Federal Court. It is not realistic to attempt to determine what issues will be treated by the Federal Court prior to the Court's decision. Accordingly, the determination on the request will be made without considering the issues allegedly before the Court. If reexamination is ordered, the reexamination generally (see discussion immediately below) will continue until the Office becomes aware that a court decision has issued. At such time, the request will be reviewed in accordance with the guidelines set forth below.

...

35 U.S.C. 314 provides for *inter partes* reexamination the clause, "[U]nless otherwise provided by the Director for good cause, " which clause is not present in 35 U.S.C. 305 for *ex parte* reexamination. Accordingly, where there is good cause for the Director of the USPTO to suspend (stay) reexamination proceedings pending the conclusion of litigation, a suspension will be effected. 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). In addition, see subsection V. below for the situation where there is pending litigation having the potential to terminate a reexamination prosecution under 35 U.S.C. 317(b).

...

V. Discussion of Affect of Litigation Where Requester Was a Party to Litigation

... the following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.

(A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims.

Where there are non-litigated claims for which reexamination had been requested in the inter partes reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).

(B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request.

If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued.

If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding
if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

(D) Is there a concurrent *ex parte* reexamination proceeding for the patent?

As stated in MPEP § 2286: "The issuance of a final Federal Court decision upholding validity during an ex parte 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." If there is a concurrent *ex parte* reexamination proceeding having overlapping issues with an *inter partes* reexamination proceeding where the estoppel has the potential to attach, but no final decision has been issued, then the Office may in some instances (depending on the individual facts and circumstances), to go forward with statutorily required "special dispatch" as per *Ethicon* in a merged proceeding containing both the inter partes reexamination and the *ex parte* reexamination. This is a matter of administrative convenience to avoid rework and make the process more efficient. Again, OPLA should be consulted.

(E) Some examples of where this estoppel issue was actually addressed by the Office.

In reexamination control numbers 95/000,093 and 95/000,094 (the '093 and '094 proceedings), action was suspended based on ongoing litigation. After a District Court decision adverse to requester, it was determined that "good cause" existed to wait for the outcome of the Federal Circuit appeal, because the reexamination proceedings were only at their beginning stages, while the concurrent litigation was potentially near its final resolution. It was noted that requester had chosen to permit the District Court litigation to proceed for three years before filing its requests for reexamination, the filing taking place only after judgment was entered in patent owner's favor in the litigation. Had requester filed its requests for reexamination earlier, the reexamination proceedings would 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 requester 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, requester was not in a position to complain that a suspension of the '093 and '094 reexamination proceedings would deprive requester of a chance to obtain the Office's decision, when there was a strong possibility that the Federal Circuit's decision would estop the Office from issuing any decision at all. In short, requester could not have it both ways. Requester 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 could in no way be affected by any decision on its reexamination requests. Requester's delay was the reason that the '093 and '094 reexaminations could very well be mooted before any reexamination decision issued and the USPTO Director found "good cause" to suspend the proceedings. Requester chose its route and had to deal with the consequences of its decision, i.e., a suspension of the reexamination proceedings.

On the other hand, see reexamination control numbers 95/000,020, 95/000,071 and 95/000,072, for decisions in which action was not suspended, because the specific facts dictated otherwise. [All emphasis in the original.]"

II. Patent Owner's Position

Patent owner's petition may be summarized as being based upon receipt of a first Office action (see "Review of Facts" item #7 above) in which the Examiner considered four references supplied by requester as prior art "printed publications" and applied the references to reject claims 1-30. For three of the references patent owner disputes the characterization of these references as prior art printed publications based, in part, on document headers including the phrase "Internal Correspondence." Patent owner disputes the characterization of the fourth reference as a prior art printed publication because the document appears to be minutes of a meeting held between a party, now a division of the requester, and its customers.

Along with the references supplied by requester, the requester also supplied declarations by individuals related to the references; these declarations attempt to provide factual support for the assertion by requester that the references constitute prior art printed publications. Patent owner seeks a stay in the *inter partes* reexamination to in order to depose the declarants, arguing this situation satisfies the "good cause" standard in MPEP Section 2686.044 III, with suspension by the Director in accordance with 37 CFR 1.987. Patent owner also seeks suspension of the *inter partes* reexamination at least until a decision in the litigation between patent owner and requester is issued by the United States District Court for the Eastern District of Texas.

III. Requester's Position

Requester's petition argues patent owner has failed to show good and sufficient cause to stay the reexamination, alleging patent owner has already discussed and analyzed the four references at issue in an *ex parte* Examiner interview in Application No. 11/275,491 (the "'491 application"), which is a continuation of the '791 patent.

Requester cites prior Office petition decisions in which the Office used the "good and sufficient cause" requirements of 37 CFR § 1.103(a)(1) for a suspension of action, and argues patent owner fails to meet this standard. Requester asserts that patent owner failed to seek discovery during the prosecution of the '491 application, and patent owner's failure to seek a suspension of the '491 application along with patent owner's representations to the Examiner in the '491 application regarding the references constitutes a breach of its duty of candor to the Office.

Requester also cites *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988) and prior Office petition decisions for the assertion that it is in the "public interest" for reexamination to continue despite concurrent litigation. Regarding patent owner's principal argument for discovery regarding the four references, requester argues that no discovery is necessary to correctly determine these references constitute prior art printed publications.

Note that requester's additional arguments regarding the inconsistent results created by the combination of a grant of patent owner's request for stay and the issuance of the '491 application are moot in view of the Office's withdrawal from issuance of the '491 application and need not be considered here.

IV. Analysis and Findings

35 U.S.C. § 314(c) requires that the USPTO Director conduct an *inter partes* proceeding with special dispatch, unless there exists "good cause" not to do so. Pursuant to Section 314(c), 37 CFR 1.987 provides that USPTO Director may determine whether to suspend an *inter partes* reexamination, in which the patent that is being reexamined is concurrently in litigation.

Initially, it is noted that patent owner has not advanced any grounds upon which the present '209 *inter partes* reexamination proceeding should be "dismissed." Patent owner has not asserted that the Order granting the request for *inter partes* reexamination was in any way improper (*e.g., ultra vires*). Therefore, the request to that effect must be summarily dismissed. The sole issue remaining for consideration is whether patent owner has established that there is good cause for suspension of the '209 *inter partes* reexamination proceeding in accordance with the provisions of 37 CFR 1.987.

The decision in *Sony Computer Entertainment America Inc., et al v. Jon W. Dudas,* No. 1:05cv1447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006), ("*Sony*"), is instructive with respect to the question of whether good cause exists to support suspension of an *inter partes* reexamination proceeding. In *Sony,* the court reviewed the propriety of a decision by the Office to suspend two (related) *inter partes* reexamination proceedings in light of concurrent litigation involving the validity of the patents that were the subjects of the two proceedings. The court held, *inter alia,* that the 35 U.S.C. § 314 authorizes the USPTO Director to suspend an *inter partes* reexamination proceeding "for good cause," and that 37 CFR 1.987 was a proper exercise of the Director's rule making authority to the extent that concurrent litigation of a patent subject to an existing *inter partes* reexamination proceeding may provide good cause to suspend the *inter partes* reexamination proceeding. *Id.*, at *18.

The court analyzed the facts and circumstances that existed in the *Sony* situation, to determine whether the Office had properly found that good cause existed to suspend the two *inter partes* reexamination proceedings in question. The court recognized that while the *inter partes* reexamination statute provides for concurrent litigation and *inter partes* reexamination of the same patent, 35 U.S.C. §§ 315(c) and 317(b) also provide that the completion of one proceeding will estop the other parallel proceeding. *Id.*, at *19. The court held that in light of the fact that the litigation was at the stage in which the Court of Appeals for the Federal Circuit was about to decide an appeal, while the *inter partes* reexamination proceedings were just beginning, the suspension of the two *inter partes* reexamination proceedings was a proper exercise of the USPTO Director's discretion. *Id.*, at *20. This holding was rendered notwithstanding the possibility that a determination of the appeal by the Federal Circuit would not necessarily have amounted to a "final" decision, because the Director had correctly determined that, on balance, that possibility did not outweigh the factors favoring suspension. *Id.* The basis for the court's ratification of the position taken by the USPTO Director was that to decline to suspend the *inter partes* reexamination proceedings would have risked wasting Office resources, as well as wasting resources of the parties, to conduct administrative proceedings that could soon be mooted by the conclusion of the concurrent litigation. *Id.* The court further held that the Director has wide discretion with respect to *inter partes* reexamination, and may reexamine less than all of the patent claims after ordering *inter partes* reexamination. Thus, even if the litigation in *Sony* would result in a disposition of fewer than all of the patent claims that were the subject of the suspended *inter partes* reexamination proceedings, the reexamination proceedings could

then have been resumed with respect to the remaining claims, in the event that the litigation was to be resumed at the District Court level. *Id.*, at *21-*37.

Unlike the circumstances that existed in *Sony*, [4] the litigation between patent owner and third party requester involving the instant '791 patent is in a relatively preliminary stage. The parties are still conducting discovery in the District Court, with the District Court issuing an order referring the case to a mediator on August 17, 2007. If a trial is necessary, or even if summary judgment were to be granted for all of the claims of the '791 patent that remain in the '209 *inter partes* reexamination proceeding, there is a substantial likelihood that the litigation will not become "final" (so as to trigger the estoppel provisions of 35 U.S.C. § 317(b)) based upon the trial result or the summary judgment. Rather, post-judgment motions and/or post-trial motions would be available, and ultimately an appeal may be filed.

Thus it is clear that there is presently no "good cause" to dismiss or stay the '209 *inter partes* reexamination proceeding. The concurrent litigation has been on-going for a little over one year and is not so near to conclusion as to make it likely that a final (*i.e.* non-appealable) decision in the litigation as to all of the '791 patent claims will be forthcoming in the near future. [5] Therefore, it is premature to suspend the '209 *inter partes* reexamination proceeding because it is unlikely that the estoppel provisions of the reexamination statute will apply to all of the '791 patent claims in the near future.

Aside from the timing issues, it is to be noted, that in *Sony*, the District Court had provided a decision for the patent owner, which was final for purposes of the District Court, and was subject to appeal in the Federal Circuit. Unlike the *Sony* scenario, in this instance, no judgment has been rendered by any tribunal in patent owner's favor, which would provide a substantial likelihood of patent owner's success.

Notwithstanding that 35 U.S.C. § 314(c) allows for suspension of an *inter partes* reexamination for good cause, the statute still requires that the Office treat *inter partes* reexamination proceedings with special dispatch *absent good cause for suspension*. Thus, even though identical claims are being reexamined and litigated, identical issues with respect to those claims are being raised in reexamination and litigation, and no *ex parte* reexamination exists,[6] there is simply no good cause, at present, to suspend the '209 *inter partes* reexamination proceeding. Patent owner remains free to renew a petition for an appropriate (*i.e.*, partial or complete) suspension of the '209 *inter partes* reexamination proceeding if circumstances change such that it appears likely that the provisions of 37 CFR 317(b) will be triggered with respect to some or all of the claims in the '209 *inter partes* reexamination proceeding substantially in advance of the termination of prosecution in the present '209 *inter partes* reexamination proceeding. In this regard, patent owner should also note the provisions of 37 CFR 1.985. Further, it is to be noted that any petition for

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[4] In *Sony*, the two *inter partes* reexamination requests were filed after trial had been completed, on the day that Sony's post-verdict motions were denied. An appeal to the Court of Appeals for the Federal Circuit was thereafter filed within one month, and the Decision on Petition by which Office suspended the two *inter partes* reexamination proceedings was mailed five months later. *Sony*, at *4-*9.

[5] The estoppel provisions of 35 U.S.C. § 317(b) appeal on a claim-by-claim basis, so that a decision in favor of the validity of fewer than all of the '791 patent claims would not oust the jurisdiction of the Office to conduct *inter* partes reexamination of the remaining patent claims for which reexamination has been ordered in the '209 *inter partes* reexamination proceeding.

[6] If an *ex parte* reexamination proceeding was ongoing as to the '791 patent, a final, non-appealable holding of validity in the litigation would not completely preclude reexamination proceedings in the Office, because 35 U.S.C. § 305 provides a non-qualified requirement for special dispatch in *ex parte* reexamination proceedings.

suspension will be dismissed if there is an outstanding Office action requiring patent owner response.

For completeness, it is pointed out that none of third party requester's three procedural bases for opposing the renewed patent owner petition (that the renewed petition is precluded by 37 CFR 1.939, that extraordinary circumstances do not exist so as to support a waiver of 37 CFR 1.939, and that 37 CFR 1.103 provides for a six month suspension only, with suspensions to be granted only if a reply to an Office action is not outstanding) is persuasive.

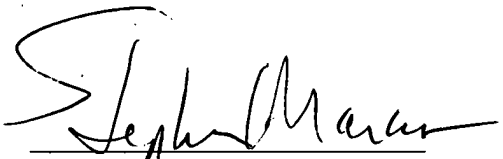
CONCLUSION

1. The patent owner petition is dismissed.

2. Any request for reconsideration of this Decision must be filed in accordance with the provisions of 37 CFR 1.181(f).

3. Jurisdiction over the present *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit for appropriate action.

4. Telephone inquires related to this decision should be directed to Samuel Broda, Legal Advisor, at (571) 272-7711, or in his absence, to the undersigned at (571) 272-7743.



Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

sb
August 27, 2007

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In re Meyer et al
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the September 19, 2007 patent owner petition under 37 CFR 1.182 requesting reconsideration of the Office's September 5, 2007 decision dismissing patent owner's June 26, 2007 petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAM," (the "Petition"). In addition, third party requester filed a paper on October 19, 2007 entitled "THIRD-PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 IN OPPOSITION TO PATENTEE'S PETITION UNDER 37 C.F.R. § 1.182" (the "Opposition").

The petition for reconsideration, the Opposition, and *inter partes* reexamination control number 95/000,209 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition is granted to the extent that the petition has been reconsidered, but is dismissed with respect to granting the underlying relief requested.

BACKGROUND

1. U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("CTI").

2. On June 14, 2006, patent owner Cooper Technologies, Inc. (hereinafter "Cooper") filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas.

3. On December 21, 2006, an *inter partes* request for reexamination of the '791 patent, assigned control No. 95/000,209 (the '0209 proceeding"), was filed by a third party

requester on behalf of T&B (the "requester"). T&B will be referred to as the "requester" of the '0209 proceeding.

4. On January 17, 2007, a "NOTICE OF FAILURE TO COMPLY WITH *INTER PARTES* REEXAMINATION REQUEST FILING REQUIREMENTS (37 CFR 1.915(d))" was mailed by the Office.

5. On January 25, 2007, a "REPLACEMENT STATEMENT AND EXPLANATION UNDER 37 C.F.R § 1.915(B)(3) FOR REQUEST FOR *INTER PARTES* REEXAMINATION OF U.S. PATENT No. 6,984,791" was filed by the requester.

6. On February 6, 2007, a "NOTICE OF *INTER PARTES* REEXAMINATION REQUEST FILING DATE" was mailed by the Office.

7. On April 13, 2007, the Office issued an order granting the request for *inter partes* reexamination, and an accompanying Office action rejecting claims 1-30.

8. On May 10, 2007, patent owner Cooper filed a petition entitled "PETITION UNDER 37 C.F.R § 1.182" and a petition entitled "PETITION FOR TIME-EXTENSION UNDER 37 C.F.R. § 1.956."

9. On May 25, 2007, the requester filed a petition entitled "THIRD-PARTY REQUESTER'S OPPOSITION TO PATENTEE'S PETITION UNDER 37 C.F.R. § 1.182/1.183."

10. On June 19, 2007, the Office mailed a decision denying the May 10, 2007 patent owner petition.

11. On June 26, 2007, a petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAM" was filed by patent owner Cooper.

12. On July 9, 2007, patent owner Cooper filed a petition entitled "PETITION FOR TIME EXTENSION UNDER 37 C.F.R. § 1.956."

13. On July 11, 2007, the Office mailed a decision denying the July 9, 2007 petition for extension of time.

14. On July 13 2007, patent owner filed a timely response to the April 13 2007 Office action.

15. On July 31, 2007, the requester filed a petition entitled "THIRD-PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 IN OPPOSITION TO PATENTEE'S PETITION TO SUSPEND INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.987."

16. On August 13, 2007, the requester filed comments to patent owner's response as authorized under 37 USC 1.947

17. On September 5, 2007, the Office mailed a decision dismissing the June 26, 2007 patent owner petition for suspension of the reexamination proceeding.

18. On September 19, 2007, patent owner Cooper filed a petition under 37 CFR 1.182, requesting reconsideration of the Office's September 5, 2007 decision.

19. On October 19, 2007, third party requester filed an Opposition to patent owner's petition under 37 CFR 1.182 of September 19, 2007.

20. On November 1, 2007, the Office mailed an action closing prosecution (ACP) in the '209 reexamination proceeding again rejecting all the claims of the '791 patent.

DECISION

I. Relevant Statute, Regulations, and Examining Procedure

The relevant portions of the statute, regulations and MPEP have been quoted in the September 5, 2007 decision and will not be reproduced here.

II. Patent Owner's Position

The April 13, 2007 Office action (see "Review of Facts" item #7 above), sets forth that the Examiner considers four of the references supplied by requester to be prior art "printed publications" and applies these four references to reject claims 1-30. For three of the references, (the 1987 Demonstration Memorandum, the 1984 Meeting Memorandum, and the 1988 Larson Correspondence) patent owner disputes the characterization of these references as prior art printed publications based, in part, on document headers including the phrase "Internal Correspondence." Patent owner disputes the characterization of the fourth reference (the 1988 Conference Minutes) as a prior art printed publication, because the document appears to be minutes of a meeting held between a business entity, now a division of the requester, and its customers.

Along with the references supplied by requester, the requester also supplied declarations by individuals related to the references; these declarations attempt to provide factual support for the assertion by requester that each of the four contested references constitutes prior art printed publications. Patent owner seeks a stay of the present *inter partes* reexamination proceeding in order to depose the declarants; patent owner argues that this situation satisfies the "good cause" standard in MPEP Section 2686.044 III, for suspension by the Director in accordance with 37 CFR 1.987. Patent owner also seeks suspension of the *inter partes* reexamination at least until a decision in the litigation between patent owner and requester is issued by the United States District Court for the Eastern District of Texas.

III. Requester's Position

Requester's opposition to the initial petition argues that patent owner has failed to show good and sufficient cause to stay the reexamination, alleging patent owner has already discussed and analyzed the four references at issue in an *ex parte* Examiner interview in Application No. 11/275,491 (the "'491 application"), which is a continuation of the '791 patent.

Requester cited prior Office petition decisions in which the Office used the "good and sufficient cause" requirements of 37 CFR § 1.103(a)(1) for a suspension of action, and argues patent owner fails to meet this standard. Requester asserts that patent owner failed to seek discovery during the prosecution of the '491 application, and patent owner failed to seek a suspension of the '491 application.

Requester also cited *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988) and prior Office petition decisions for the assertion that it is in the "public interest" for reexamination to continue despite concurrent litigation. Regarding patent owner's principal argument for discovery regarding the four references, requester argues that no discovery is necessary to correctly determine these references constitute prior art printed publications.

IV. Decision mailed September 5, 2007

The Office rendered a decision on September 5, 2007, dismissing [1] patent owner's requests for relief in the form of (a) dismissing the reexamination proceeding in its entirety or (b) suspending the reexamination proceeding until a decision is reached in the District Court litigation.

V. Patent Owner's Request for Reconsideration of the September 5, 2007 Decision

Patent owner's request for reconsideration does not challenge the Office's dismissal of patent owner's call for dismissal of the entire reexamination proceeding. Patent owner contends [2] that the previous decision did not address the stated grounds for good cause for suspension, and instead "cited how the present situation is not in alignment with a case that asserted different grounds for suspension." Patent owner reiterates its argument that the need of deposition testimony to resolve the issue of the four contested documents constitutes "good cause" for suspending the reexamination proceeding. In support of this position, patent owner emphasizes [3] the MPEP 2686.04 III statement that:

> A "good cause" [to suspend an *inter partes* reexamination] 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).

Patent owner further points out that the requester's July 13, 2007 opposition to the initial petition was accompanied with supplemental declarations in support of the requester's position that the various documents qualify as prior art publications, and that this further evidences that the issue is best addressed by resort to the District Court. A review of the record reveals that the dates of execution of these declarations are subsequent to both the

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[1] The extensive detailed analysis of that decision will not be fully reproduced here, as this decision will focus on the particular issues raised in the request for reconsideration.

[2] Request for reconsideration at page 4.

[3] Request for reconsideration at page 5.

filing date of the June 26th petition to suspend and the patent owner's July 13th timely response to the Office action.

VI. Requester's Opposition to Patent Owner's Request for Reconsideration

In the Opposition to the request for reconsideration (filed October 19, 2007), the requester further argues that (a) patent owner has had subpoena power available since June but has taken no action directed to acquiring the information they are now alleging as being necessary to get a fair hearing on the issue at hand; (b) there are four other rejections of record in this reexamination proceeding and thus resolution of the status of the contested references would not resolve the entire proceeding; and (c) because this very same issue is present in three other Office proceedings (two patent applications and one *ex parte* reexamination proceeding), the Office which will be making the determination of whether these qualify as prior art references even if this proceeding were to be suspended.

VII. Office Action of November 1, 2007

The Office issued an ACP on November 1, 2007. In this Office action the Examiner applied four different rejections to all pending claims (1-30) under 35 USC 102(b) and 103(a) over four references[4] whose status as prior art is uncontested. Upon consideration of the arguments presented by patent owner and requester, the Examiner analyzed the evidence of record in light of the relevant case law and withdrew the rejections predicated upon the 1987 Demonstration Memorandum (Issues 5 & 6), the 1984 Meeting Memorandum (Issue 7), the 1988 Conference Minutes (Issue 10), and the 1988 Larson Correspondence (Issue 9). That is, the examiner has withdrawn all rejections that were based on the contested references.

VIII. Analysis and Findings

35 U.S.C. § 314(c) requires that the USPTO Director conduct an *inter partes* proceeding with special dispatch, unless there exists "good cause" to do otherwise. Consistent with 35 U.S.C. § 314(c), 37 CFR 1.987 provides that USPTO Director may determine whether to suspend an *inter partes* reexamination, in which the patent that is being reexamined is concurrently in litigation.

In *Sony Computer Entertainment America Inc., et al v. Jon W. Dudas,* No. 1:05cv1447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006), the court upheld the Office's position that, *inter alia,* 35 U.S.C. § 314 authorizes the USPTO Director to suspend an *inter partes* reexamination proceeding "for good cause," and that 37 CFR 1.987 was a proper exercise of the Director's rule making authority to the extent that concurrent litigation of a patent subject to an existing *inter partes* reexamination proceeding may provide good cause to suspend the *inter partes* reexamination proceeding. *Id.*, at *18. Notwithstanding that 35 U.S.C. § 314(c) permits suspension of an *inter partes* reexamination for good cause, the statute still requires that the Office treat *inter partes* reexamination proceedings with special dispatch *absent good cause for suspension.*

[4] (1) a 1974 Sales Brochure, (2) a Japanese patent publication, (3) RTE Manual, and (4) a 1973 paper to Stanger.

As a preliminary matter, it is noted that in light of the most recent Office action , dated November 1, 2007, there are no pending rejections[5] based upon the contested references. Rather, the examiner maintained rejections of all the claims in view of several other prior art references that the patent owner does not contest are "printed publications". Accordingly, at this time, there is no basis for suspending action for the purpose of allowing patent owner to gather evidence to ascertain the viability of the references as prior art publications.

Furthermore, even though there are no pending rejections based on the contested references, it should be noted that the patent owner did not provide sufficient information as to its showing as to "good cause" to permit the Office to evaluate that showing. For example,

1. The pending petition does not specify what exactly petitioner intends to accomplish through discovery that will materially affect the reexamination -- what questions will it ask of the individuals it seeks to depose? What information does it expect to gather that will impact each of the pending rejections in the reexamination? As of the record in front of the Office at this time, petitioner's stated desire for discovery appears speculative as to what it seeks to accomplish during the discovery process.

2. The pending petition does not explain why petitioner has been unable to gather the pertinent discovery over the past four months that it now says it intends to gather sometime in the future. Petitioner attached Exhibits H-J to its initial petition to suspend, dated June 26, 2007, to show some correspondence, all dated June 2007, between (patent owner) Cooper and the third party requester, Thomas & Betts, regarding the availability of certain witnesses. It is not clear from the present petition what efforts Cooper has undertaken since June 2007 to depose those witnesses, and thereby obviate its current desire for suspending the reexamination. For example, has Cooper subpoenaed any of the witnesses for a deposition? Has Cooper filed any motions with the district court for depositions? If so, has the court ruled on such motions, and with what result? Does Cooper have confirmed dates from when the depositions will take place? How long has discovery been available in the district court litigation? When does the window for discovery close? While the Office recognizes that district court discovery can be a drawn-out process, the Office nevertheless needs to know what efforts Cooper has made to-date in order to assess whether it is justified in being accorded additional time, over and above the past 4 months, to depose these witnesses.

3. The pending petition makes no showing that petitioner has a reasonable expectation of obtaining and completing such discovery on the relevant issues in a reasonable time period.

4. The pending petition does not set forth how long a period of suspension is requested. As indicated above, the Office cannot assess the merits of suspension without some indication of the time period contemplated.

5. The petition expresses the purpose of the suspension as the need for depositions and discovery in order to provide patentee with a "full and fair opportunity to compile necessary facts and documentation" with respect to the four contested documents. The petition does not, however, address why suspension is

[5] See Section VII *supra*.

> warranted to address the rejections based upon the four contested references, while other prior art rejections are outstanding against every one of the claims under reexamination and the resolution of these other rejections would be delayed by suspension of the reexamination proceeding. As to the other rejections, there is no allegation that they are based on common issues to be resolved in the District Court.

The request for reconsideration correctly asserts that the situation in *Sony* is but one example of what qualifies as good cause for suspending reexamination. Patent owner's argument for suspension is predicated on the MPEP statement that "an issue common to the litigation and the reexamination that can best be decided in court..." provides good cause for a suspension. However, although the petition asserts that " [t]he issues surrounding the asserted prior art documents are common to the litigation and the reexamination proceeding ...," the petition does not further specify what the common issue is and how and when that common issue will be resolved in the current litigation.

Without information as to the above matters, with supporting evidence made of record as part of the petition, the Office has no ability to evaluate whether the asserted common issue that may be better addressed in the court proceeding justifies suspension of the present proceeding.

As a final point, the petition seeks suspension of the *inter partes* reexamination at least until a decision in the litigation between patent owner and requester is issued by the United States District Court for the Eastern District of Texas. The litigation between patent owner and third party requester involving the instant '791 patent is in a relatively preliminary stage. The parties are still conducting discovery in the District Court, with the District Court issuing an order referring the case to a mediator on August 17, 2007. **There is no indication of the expected time period for resolution of this litigation.** The statutory mandate of special dispatch is not consistent with an indefinite, undetermined, and unlimited period of suspension. In order to evaluate whether a suspension is warranted, a reasonable showing of the expected duration of the requested period of suspension is needed.

IX. Dismissal, Rather Than Denial

Petitioner has requested [6] that the decision be designated a FINAL AGENCY DECISION "in the event that the Director continues to disagree with Patentee's position."

As set out above, the showing of the petition is incomplete; petitioner has not provided sufficient information as to its showing as to "good cause" to enable the Office to evaluate that showing and render a final decision. Such deficiency was apparently not made clear to petitioner in the previous decision, which is urged not to have fully addressed the nature of patent owner's representation of "good cause" for suspension. Thus, in order not to prejudice patent owner by cutting off the ability to present such evidence in a renewed petition, this decision is not being designated as a final agency decision. The petition accordingly is dismissed.

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[6] Request for reconsideration at page 8.

CONCLUSION

1. The patent owner petition is dismissed.

2. Telephone inquires related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Washington, DC 20005

(For Third Party Requester)

MAILED

FEB 08 2008

CENTRAL REEXAMINATION UNIT

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

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

This is a decision on the patent owner paper, denominated "Petition Under 37 C.F.R. 1.182 for the Patent Office to Enforce the Rules and Return Third Party Requester's Comments After ACP," submitted January 16, 2008.

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

The petition is dismissed as moot.

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al. on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas.

An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting inter-partes reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") rejecting all pending claims of the '791 patent and setting a 30 day period for response was mailed on November 1, 2007.

On Monday December 3, 2007, patent owner filed a paper entitled "Comments on Action Closing Prosecution." On January 2, 2008, third party requester filed Comments under 37 C.F.R. 1.951.

DECISION

The paper filed by patent owner which is the subject of this decision requests that the paper filed by third party requester on January 2, 2008, not be entered into the record because it goes beyond the scope of what is permissible under the governing regulation - 37 CFR 1.951(b).

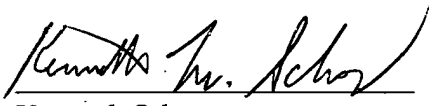
The requester's submission of January 2, 2008, entitled "Third-Party Requester's Comments Under 37 C.F.R. 1.951(b), " has not been entered because it is not a proper paper under the rules governing reexamination. Accordingly, there is no action for which patent owner need be granted relief and therefore, the petition is dismissed as moot.

It is further noted, that the filing of a petition to "Enforce the Rules" prior to the Office acting in a manner in contravention of the rules merely increases the burden of paperwork on the Office. Until such time as an action is taken which petitioner deems to be in violation of Office rules or procedure, such a petition is inappropriate.

CONCLUSION

1. The January 16, 2008 patent owner reply paper is dismissed as moot.

2. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.



Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

29053 7590 02/13/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2008

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

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CENTRAL REEXAMINATION UNIT

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In re: Meyer *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: DECISION ON PETITION
: FILED UNDER 37 CFR 1.181

This is a decision on the November 30, 2007, patent owner petition entitled "PETITION UNDER 37 CFR 1.181 TO FIND THE ACP PREMATURE". The petition is before the Director of the Central Reexamination Unit for consideration.

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. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper").

2. On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the-United States District Court for the Eastern District of Texas.

3. On December 21, 2006, an *inter partes* request for reexamination of the '791 patent, assigned control No. 95/000,209 ("the '209 reexamination"), was filed by a third party requester on behalf of T&B (the "requester").

4. On January 17, 2007, a "NOTICE OF FAILURE TO COMPLY WITH INTER PARTES REEXAMINATION REQUEST FILING REQUIREMENTS (37 CFR 1.915(d))" was mailed by the Office.

5. On January 25, 2007, a "REPLACEMENT STATEMENT AND EXPLANATION UNDER 37 C.F.R § 1.915(B)(3) FOR REQUEST FOR INTER PARTES REEXAMINATION OF U.S. PATENT No. 6,984,791" was filed by the requester.

6. On February 6, 2007, a "NOTICE OF INTER PARTES REEXAMINATION REQUEST FILING DATE" was mailed by the Office.

7. On April 13, 2007, the Office issued an order granting the request for *inter partes* reexamination, and an accompanying Office action rejecting claims 1-30.

8. On May 10, 2007, patent owner Cooper filed a petition entitled "PETITION UNDER 37 C.F.R § 1.182" and a petition entitled "PETITION FOR TIME-EXTENSION UNDER 37 C.F.R. § 1.956."

9. On May 25, 2007, the requester filed a petition entitled "THIRD-PARTY REQUESTER'S OPPOSITION TO PATENTEE'S PETITION UNDER 37 C.F.R. § 1.182/1.183."

10. On May 31, 2007, the Office mailed a decision granting the May 10, 2007 patent owner petition for an extension of time.

11. On June 19, 2007, the Office mailed a decision denying the May 10, 2007 patent owner petition.

12. On June 26, 2007, a petition entitled "PETITION TO SUSPEND INTER PARTES REEXAM" was filed by patent owner Cooper.

13. On July 9, 2007, patent owner Cooper filed a petition entitled "PETITION FOR TIME EXTENSION UNDER 37 C.F.R. § 1.956."

14. On July 11, 2007, the Office mailed a decision, denying the July 9, 2007 petition for extension of time.

15. On July 13 2007, patent owner Cooper filed a timely response to the April 13, 2007 Office action.

16. On July 31, 2007, the requester filed a petition entitled "THIRD-PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 IN OPPOSITION TO PATENTEE'S PETITION TO SUSPEND INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.987."

17. On August 13, 2007, the requester filed comments to patent owner's response as authorized under 37 CFR 1.947.

18. On September 5, 2007, the Office mailed a decision dismissing the June 26, 2007 patent owner petition for suspension of the reexamination proceeding.

19. On September 19, 2007, patent owner Cooper filed a petition under 37 CFR 1.182, requesting reconsideration of the Office's September 5, 2007 decision.

20. On October 19, 2007, third party requester filed an Opposition to patent owner's petition under 37 CFR 1.182 of September 19, 2007.

21. On November 1, 2007, the Office mailed an action closing prosecution (ACP) in the '209 reexamination proceeding again rejecting all the claims of the '791 patent.

22. On November 16, 2007, the Office mailed a decision dismissing the September 19, 2007 patent owner petition for suspension of the reexamination proceeding.

23. On November 30, 2007, patent owner filed a petition under 37 CFR 1.181 to find the ACP premature.

24. On December 3, 2007, patent owner timely filed comments on the ACP.

DECISION

Patent Owner requests withdrawal of the Action Closing Prosecution action (hereinafter ACP) dated November 1, 2007. The petition is considered pursuant to 37 CFR 1.181, and, thus, no fee is required.

I. Patent Owner Petitioner's Position:

The Patent Owner argues that, in the November 1, 2007 ACP "[b]y heavily relying on newly submitted evidence, Examiner failed to develop clear issues prior to issuing the ACP. The ACP should be deemed premature and Examiner should be ordered to issue a new Nonfinal Office Action."

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 rejection which 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.

III. Analysis and Findings

The allegation that the November 1, 2007 Office Action is an improper ACP as it heavily relies on newly submitted evidence is not deemed persuasive.

The courts have explained that there is no "new ground" where "[t]he basic thrust of the rejection [is] the same" and the Patent Owner has "had fair opportunity to react to that rejection." See *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976) (cited in MPEP 1207.03).

In the present proceeding, the examiner has not included a new ground of rejection in the ACP because the "basic thrusts" of the rejections are the same and Patent Owner has had a fair opportunity to react to that rejection. For example, although petitioner argues that the examiner's reference to the Siebens declaration creates a new rationale for the rejection (see page 4 of the instant petition), the ACP (mailed November 1, 2007) merely states on page 44 that the Siebens declaration describes operation that is consistent with the bushing and terminator disclosed in the 1974 Sales Brochure. The ACP does not use the declaration as a new rationale. Specifically, the rejection in the non-final office action (mailed April 13, 2007) on pages 7-14 is repeated on pages 5-11 of the ACP. The actual rejection of the claims does not mention the

declaration. The rejection in the non-final office action details (among other features) that the transition line "O" is visible before the elbow terminator "A" is fully seated on the bushing plug insert "B". This is the same position taken in the ACP.

The mention of the Siebens declaration on page 44 is in the "RESPONSE TO PATENT OWNER AND THIRD PARTY ARGUMENTS" section. The point being made in the response to the arguments section is that the Siebens declaration is consistent with the reading of the reference used in the rejection. The rejection of the claims did not change between the non-final office action and the ACP. There is no new rationale set forth in the rejection in the ACP. Thus, there is no new ground of rejection and Patent Owner has had a fair opportunity to react to the rejection.

Similarly, petitioner argues that mentioning the Thue declaration is a reliance on new evidence. However, again, the rejection is the same in both the non-final office action and the ACP and, again, the declaration is not part of the actual rejection. The Thue declaration is mentioned in the "RESPONSE TO PATENT OWNER AND THIRD PARTY ARGUMENTS" section. The first passage from page 56 of the ACP cited on page 5 of the petition merely reinforces that the references are combinable. The combinability of the two references is a point that had been made in the rejection in the non-final Office action and was subsequently maintained in the ACP. The second passage cited by petitioner on page 5 of the petition refers to the position that one of ordinary skill in the art would look to the teachings in the secondary reference to modify the primary reference. This point was addressed in the rejections in both the non-final office action and the ACP. Thus, neither passage of the ACP cited by petitioner changes the basic thrust of any of the examiner's rejections made in the non-final Office action and maintained in the ACP. Therefore there is no new ground of rejection.

Regarding the Stepniak and Larson declarations, petitioner states that "[w]hile Examiner eventually ruled that the internal memoranda discussed in the Stepniak and Larson Declaration did not qualify as printed publications, Examiner made several intermediate determinations in the ACP rejecting Patent Owner's arguments based on statements in the Stepniak and Larson Declarations." A review of the relevant section of the ACP (pages 63-66) finds no rejection – let alone a new one – nor any change in the rationale of any pending rejection based upon the evidence of the Stepniak and Larsen documents.

Lastly, it is pointed out that the Patent Owner has an avenue of procedure available under Rule 951 which provides that:

> 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 1.951. The Patent Owner has taken this course of action. Specifically, Patent Owner filed "COMMENTS ON ACTION CLOSING PROSECUTION" on December 3, 2007 including

additional evidentiary exhibits (some of which were submitted under seal). On pages 19-21 of Petitioner's December 3 submission, Patent Owner makes their comments on the issues raised by the examiner in the "RESPONSE TO PATENT OWNER AND THIRD PARTY ARGUMENTS" section of the ACP regarding the Siebens declaration and the rejection based on the 1974 Sales Brochure. On pages 27 and 28 of Petitioner's December 3 submission, Patent Owner makes their comments on the issues raised by the examiner in the "RESPONSE TO PATENT OWNER AND THIRD PARTY ARGUMENTS" section of the ACP regarding the Thue declaration and the rejection based on the combination of the 1974 Sales Brochure and JP-63-93081. Accordingly, Patent owner had more than ample opportunity to respond to the basic thrust of the rejection.

In view of the above, the petition is DISMISSED.

CONCLUSION

1. Patent Owner's request to find the ACP mailed November 1, 2007 premature is dismissed.

2. The proceeding is being forwarded to the Examiner for appropriate action.

3. Any response to this decision should be directed to:

By Mail:	Mail Stop *Ex Parte* Reexam" Attn: Central Reexamination Unit Commissioner for Patents P. O. Box 1450 Alexandria VA 22313-1450
By hand:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314

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

Lissi M. Marquis
Director, Center Reexamination Unit

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In re Meyer et al. : **DECISION ON**
Inter Partes Reexamination Proceeding : **PETITION UNDER**
Control No. 95/000,209 : **37 CFR 1182 TO REFUSE**
Filed: January 25, 2007 : **ENTRY OF DOCUMENTS**
For: U.S. Patent No. 6,984,791 : **SUBMITTED UNDER SEAL**

This is a decision on the paper titled "Third-Party Requester's Petition under 37 C.F.R. § 1.182 in Opposition to Patentee's Petition under 37 C.F.R. § 1.59(b) "submitted January 2, 2008. As explained below, the paper is being taken as a petition to strike patent owner's response of December 3, 2007.

The papers are before the Office of Patent Legal Administration.

The requester's petition is **DISMISSED**.

SUMMARY

This is one of four decisions, issued on the same day, directed to patent owner Cooper's submission of information to the USPTO that is also subject to a protective order by the United States District Court for the Eastern District of Texas, *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Tex. June 14, 2006). Cooper's first submission came with a petition filed on December 3, 2007 requesting that the submitted information be considered and expunged if not found relevant or material to patentability. Third party requester T&B responded with its own petition requesting that the information submitted on December 3rd be immediately expunged, without consideration of its relevance. On December 21, 2007, in support of its petition to suspend, Cooper submitted information, largely duplicative of the information submitted on December 3rd, and again petitioned that the information be considered and expunged if not relevant or material. In response, T&B again petitioned to have the December 21st information expunged, without consideration of it relevance.

In the first decision, Cooper's December 3rd petition is dismissed because no relevance or materiality determination has yet been made, and therefore the request to expunge the information is premature. In this second of four decisions, T&B's petition responsive to Cooper's December 3rd petition is also dismissed. This second decision explains that it is not clear whether Cooper's evidentiary submissions are in compliance with the District Court's protective order and gives T&B thirty days to resolve any necessary issues with the District Court. The USPTO has taken this approach because it appears that the District Court may not be aware that there is no way for the USPTO to both consider relevant information and expunge it. Only non-material information can be expunged and information supporting patentability is almost always material. In a third decision, Cooper's December 21st petition is granted because the information submitted with that petition is either duplicative of the December 3rd information, or does not address issues relevant to patentability in the pending *inter partes* reexamination proceeding. Finally, in a fourth decision, T&B's petition in response to Cooper's December 21st petition is dismissed as moot because all of the information submitted with the December 21 submission will be expunged, as explained in the third decision.

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas. [1]

An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting inter-partes reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

On Monday December 3, 2007, in response to the ACP, patent owner, Cooper, filed a paper entitled "Comments on Action Closing Prosecution." This paper was submitted under seal as per MPEP § 724, accompanied by a redacted version not under seal, a "Transmittal Letter under M.P.E.P. § 724," and a petition under 37 C.F.R. § 1.59 to expunge the documents submitted under seal. On January 2, 2008, third party requester, T&B, filed a paper in opposition to Cooper's December 3, 2007 petition to expunge. The January 2, 2008 paper is the subject of this decision.

Cooper, in the petition to expunge filed December 3, 2007, requests that the documents submitted "by Patent owner under seal on November 30, 2007" be expunged from the record if they are found not to be material to examination.[2] Cooper states that the

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[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

[2] The actual date of the submission under seal was December 3, 2007 as reflected in the signature block on the papers. Patent owner is urged to take care with dates in order to keep the record from being muddled.

information is subject to a protective order, [3] the information has not been made public, and patent owner commits to retain the information for the period of the patent.

DECISION

Requester T&B, in the instant petition, asks the Director to "immediately expunge" the sealed documents from the record without submitting them for consideration to the examiner of record. Thus, T&B's petition is requesting that Cooper's petition submitted under seal on December 3, 2007, be refused entry and be struck from the record.

Petitioner, T&B, argues that the documents were only provided to Cooper subject to a protective order, [4] that Cooper's Submission of these documents was improper under MPEP § 724 because they are favorable to patentability, and thus they should be "expunged from the record immediately without consideration as to their importance to a reasonable examiner." In support of this proposition, petitioner cites to the district court decision [5] in *Newell Furnishings,* condoning patent owner's failure to disclose material favorable to patentability.

I. MPEP 724 - Submissions under Seal

724 Trade Secret, Proprietary, and Protective Order Materials

> Situations arise in which it becomes necessary, or desirable, for parties to proceedings in the Patent and Trademark Office relating to pending patent applications or reexamination proceedings to submit to the Office trade secret, proprietary, and/or protective order materials. Such materials may include those which are subject to a protective or secrecy order issued by a court or by the International Trade Commission (ITC). While one submitting materials to the Office in relation to a pending patent application or reexamination proceeding must generally assume that such materials will be made of record in the file and be made public, the Office is not unmindful of the difficulties this sometimes

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[3] The papers refer to a protective order issued November 20, 2007, by the U.S. District Court, Eastern District of Texas in Civil action No 2:06-CV-242 signed by Charles Everingham IV, U.S. Magistrate Judge. It is noted that this order was not supplied by petitioner patent owner, but a copy of an unsigned standard protective order dated June 12, 2007 was provided as part of unsealed Exhibit D.

[4] T&B does not provide a copy of the protective order, referring instead to that submitted by Cooper. See previous note.

[5] *Newell Window Furnishings, Inc. v. Springs Window Fashions Div., Inc,* 1999 U.S. Dist. LEXIS 17273; at 113; 53 USPQ2D (BNA) 1302, 1331 (N.D. Ill. 1999) ("In particular, this section indicates that the procedures for submitting sensitive materials are not to be invoked where the material is only favorable to patentability; the preference is clearly that such material not be submitted at all. Presumably, this reveals a distaste for the burden of maintaining materials in confidence, and thus limits the procedure to materials which are most pertinent in an examination -- materials which tend to negate patentability.").

imposes. The Office is also cognizant of the sentiment expressed by the court in *In re Sarkar*, 575 F.2d 870, 872, 197 USPQ 788, 791 (CCPA 1978), which stated:

> [T]hat wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is *most* benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution.

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations **are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public**. (Emphasis added.)

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials

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." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP §121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

...

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 1.17(g)) to expunge the information, if found not to be **>material to patentability<, should accompany the envelope or container.

724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02

> The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. **If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.** (Emphasis added.)

The Office has established procedures for submission of information under seal. The provisions, read in context, are designed for an applicant or patent owner to comply with the duty of disclosure by submitting information that may be adverse to patentability, while still providing protection for information should the information be deemed by the Office not to be material to patentability. MPEP 724 is an implementation of 37 CFR 1.56 and 1.555 that affords an applicant for patent (or a patent owner in a reexamination) the ability to submit information that might be required under the duty of disclosure, while attempting to protect applicant's concerns for confidentiality. (See discussion in MPEP 724 cited above.)

An applicant's duty of disclosure does not extend to requiring disclosure of information favorable to patentability. Accordingly, the procedures outlined in MPEP 724 to assist applicant in complying with the duty of disclosure were not implemented for situations where the information is favorable to patentability, and applicant is advised that such information "will be made of record and not be given any special status." (MPEP 724.03). The determination as to whether to submit such information is a choice applicant is free to make, weighing the interest of obtaining patent protection against the interest of maintaining such information confidential.

However, in the present situation, the patent owner is not being put to a choice on whether to give up some confidentiality in exchange for the possibility of obtaining patent protection. Instead, patent owner is choosing to submit ***someone else's confidential information.*** It would be inappropriate to permit the patent owner to reveal another's proprietary information, and make it public, to obtain a benefit that accrues to patent owner and to the likely detriment of the other party's interest. This assumes that the information is protected, and that matter will now be addressed.

II. The Protective Order

An "Amended Agreed Protective Order" was issued on November 20, 2007, by the U.S. District Court, Eastern District of Texas in Civil action No 2:06-CV-242, and signed by Charles Everingham IV, U.S. Magistrate Judge. This order provides:

> 10. A party may submit another party's information designated as CONFIDENTIAL or ATTORNEYS' EYES ONLY for filing with the United States Patent Office ("USPTO") as part of *Inter Partes* Reexamination of U.S. Patent No. 6,984,791, Reexamination Control Number 95/000,209, but only if the information is filed under seal at the USPTO. The party submitting the information shall take all available measures, under USPTO procedures and regulations and applicable

> law, to ensure that the CONFIDENTIAL or ATTORNEYS' EYES ONLY information is maintained under seal by the USPTO. ... The party intending to submit information produced in this litigation to the USPTO shall identify to the producing party the information that it intends to submit at least seven (7) business days before submission, regardless of whether the information has been designated as CONFIDENTIAL, ATTORNEYS' EYES ONLY, or not designated. Nothing herein shall prevent the producing party from challenging the party's submission on substantive or procedural grounds.

The requester, T&B, does not contend that the submission of the information by Cooper is in violation of the protective order, nor does T&B indicate that they have petitioned the District Court to prevent this disclosure by Cooper to the Office.

Note that the order appears to prohibit either party to submit information obtained through discovery to the Office for consideration in this proceeding, unless the submitting party takes all measures consistent with Office regulations and procedures to ensure that the documents are maintained under seal.

As explained above, however, there currently are no procedures that would preserve the confidential nature of protected information submitted in support of patentability, because, in the ordinary course of business, the information presented by parties seeking patent protection is their own information and such parties are given the choice of disclosure or non-submission. The rationale for not treating information favorable to patentability under the procedures of MPEP 724 is that such information is almost always material and would ultimately be unsealed. That is, if the information carries the day in making a case for patentability, then it must be made public, and if the examiner persists in rejecting the claims in the face of such evidence, the examiner must clearly articulate on the record the reasons why the proffered evidence did not overcome the *prima facie* case of obviousness. The only other possibility is that the evidence is not relevant to the patentability determination, and the Office has no interest in being burdened by irrelevant information.

Taking the above into account, it is unclear to the Office from the wording of the protective order whether it authorizes submission of information to the Office where there is no provision to preserve such information in confidence.

Accordingly, the documents submitted by patent owner, Cooper, on December 3, 2007 will be provisionally sealed (and kept inaccessible to the public) to afford the third-part requester, T&B, to obtain clarification from the District Court as to the permissibility of such a submission in this proceeding, given the almost certain public disclosure of the information.

If, at the end of the 30-day period, no clarification is forthcoming or the District Court approves of the submission of T&B's proprietary information despite the likelihood of public disclosure, then the Office will enter the documents into the record and treat the information in the same manner as information adverse to patentability submitted under the procedures of MPEP 724.

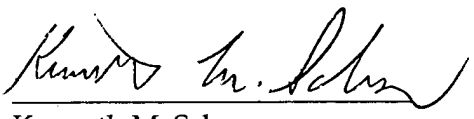
CONCLUSION

1. The petition to refuse entry of the sealed version of the December 21, 2007 "Comments on the Action Closing Prosecution" is **dismissed**.

2. The sealed version of the December 3, 2007 "Comments on the Action Closing Prosecution" will remain temporarily sealed.

3. Third party requester is given **30 days from the mail date of this decision** to petition the District Court for direction as to the submission of the papers governed by the protective order of November 20, 2007.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.



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

2-12-08
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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

29053 7590 02/22/2008

FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2008

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,209	01/25/07	6984791	
71518/P001RE/1070644			

EXAMINER
FOSTER, ROLAND

ART UNIT	PAPER
3992	

KEVIN W. JAKEL
KAYE SCHOLER LLP
901 FIFTEENTH STREET NW
WASHINGTON DC 20005

DATE MAILED:

02/22/08

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

Kevin W. Jakel
Kaye Scholer LLP
901 Fifteenth Street, N.W.
Washington, DC 20005

(For Third Party Requester)

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.59(b) TO**
: **EXPUNGE MATERIAL**
: **SUBMITTED UNDER SEAL**

This is a decision on patent owner Cooper's December 21, 2007 petition under 37 C.F.R. § 1.59(b) to expunge information submitted pursuant to MPEP 724.02.

The papers are before the Office of Patent Legal Administration.

The patent owner's petition is **GRANTED**.

SUMMARY

This is one of four decisions, issued on the same day, directed to patent owner Cooper's submission of information to the USPTO that is also subject to a protective order by the United States District Court for the Eastern District of Texas, *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Tex. June 14, 2006). Cooper's first submission came with a petition filed on December 3, 2007 requesting that the submitted information be considered and expunged if not found relevant or material to patentability. Third party requester T&B responded with its own petition requesting that the information submitted on December 3rd be immediately expunged, without consideration of its relevance. On December 21, 2007, in support of its petition to suspend, Cooper submitted information, largely duplicative of the information submitted on December 3rd, and again petitioned that the information be considered and expunged if not relevant or material. In response, T&B again petitioned to have the December 21st information expunged, without consideration of it relevance.

In the first decision, Cooper's December 3rd petition is dismissed because no relevance or materiality determination has yet been made, and therefore the request to expunge the information is premature. In a second decision, T&B's petition responsive to Cooper's

December 3rd petition is also dismissed. That second decision explains that it is not clear whether Cooper's evidentiary submissions are in compliance with the District Court's protective order and gives T&B thirty days to resolve any necessary issues with the District Court. The USPTO has taken this approach because it appears that the District Court may not be aware that there is no way for the USPTO to both consider relevant information and expunge it. Only non-material information can be expunged and information supporting patentability is almost always material. In this third of four decisions, Cooper's December 21st petition is granted because the information submitted with that petition is either duplicative of the December 3rd information, or does not address issues relevant to patentability in the pending *inter partes* reexamination proceeding. Finally, in a fourth decision, T&B's petition in response to Cooper's December 21st petition is dismissed as moot because all of the information submitted with the December 21 submission will be expunged, as explained in this third decision.

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas.[1]

An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting inter-partes reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response. On November 16, 2007 the Office mailed a decision dismissing Cooper's petition to suspend the '209 proceeding.

On Monday December 3, 2007, in response to the ACP, patent owner, Cooper, timely filed a paper entitled "Comments on Action Closing Prosecution." This paper was submitted under seal as per MPEP § 724, accompanied by a redacted version not under seal, a "Transmittal Letter under M.P.E.P. § 724," and a petition under 37 C.F.R. § 1.59 to expunge the documents submitted under seal.

On December 21, 2007, patent owner, Cooper, filed a paper entitled "Response to November 16, 2007 Dismissal of Patentee's Prior Petition to Suspend and Renewed Petition under 37 C.F.R. § 1.182 to Suspend Inter Partes Proceeding." This paper was submitted under seal as per MPEP § 724, accompanied by a redacted version not under seal, a "Transmittal Letter under M.P.E.P. § 724," and a petition under 37 C.F.R. § 1.59 to expunge the documents submitted under seal. This petition is the subject of the instant decision.

DECISION

Cooper requests that the documents submitted "by Patent owner under seal on November 30, 2007," as part of the entitled "Response to November 16, 2007 Dismissal of Patentee's Prior Petition to Suspend and Renewed Petition under 37 C.F.R. § 1.182 to Suspend Inter

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

Partes Proceeding," be expunged from the record if they are found not to be material to examination.[2] Cooper states that the information is subject to a protective order, [3] the information has not been made public, and Cooper commits to retain the information for the period of the patent. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The documents submitted under seal fall into two categories:

1) All the documents in Appendix 2 have already been submitted under seal with the response to the ACP filed on December 3, 2007. Accordingly, these duplicate copies are of no relevance to examination and may be expunged.

2) The remainder of the information relates to communications between the representatives of patent owner Cooper and requester T&B, documenting attempts to obtain discovery from the third party, and is properly submitted in support of the petition to suspend activity in the '209 proceeding. This information will be considered in rendering a decision on the December 21, 2007 patent owner petition for suspension of the '209 proceeding. However, such information has no bearing on the patentability of the claims.[4] Therefore, the information can be expunged.

In summary, the information in question has been determined by the Office not be material to the examination of the instant application.

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

The expunged material will be returned with the decision on Cooper's December 21, 2007 renewed petition to suspend which has not yet been addressed.

Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.

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

2-12-08
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[2] The actual date of the submission under seal was December 21, 2007 as reflected in the signature block on the papers. Patent owner is urged to take care with dates in order to keep the record from being muddled.

[3] The papers refer to a protective order issued November 20, 2007, by the U.S. District Court, Eastern District of Texas in Civil action No 2:06-CV-242 signed by Charles Everingham IV, U.S. Magistrate Judge . It is noted that this order was not supplied by petitioner patent owner, but a copy of an unsigned standard protective order dated June 12, 2007 was provided as part of unsealed Exhibit D.

[4] The examiner of record reviewed the materials in Appendix 1 on February 6, 2008, and determined that they are not considered important to a determination of patentability of the claims.

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Kevin W. Jakel (For Third Party Requester)
Kaye Scholer LLP
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Washington, DC 20005

In re Meyer et al. : **DECISION ON**
Inter Partes Reexamination Proceeding : **PETITION UNDER**
Control No. 95/000,209 : **37 CFR 1.59(b) TO**
Filed: January 25, 2007 : **EXPUNGE MATERIAL**
For: U.S. Patent No. 6,984,791 : **SUBMITTED UNDER SEAL**

This is a decision on patent owner Cooper's December 3, 2007 petition under 37 C.F.R. § 1.59(b) to expunge information submitted pursuant to MPEP 724.02.

The papers are before the Office of Patent Legal Administration.

The patent owner's petition is **DISMISSED**.

SUMMARY

This is one of four decisions, issued on the same day, directed to patent owner Cooper's submission of information to the USPTO that is also subject to a protective order by the United States District Court for the Eastern District of Texas, *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Tex. June 14, 2006). Cooper's first submission came with a petition filed on December 3, 2007 requesting that the submitted information be considered and expunged if not found relevant or material to patentability. Third party requester T&B responded with its own petition requesting that the information submitted on December 3rd be immediately expunged, without consideration of its relevance. On December 21, 2007, in support of its petition to suspend, Cooper submitted information, largely duplicative of the information submitted on December 3rd, and again petitioned that the information be considered and expunged if not relevant or material. In response, T&B again petitioned to have the December 21st information expunged, without consideration of it relevance.

In this first of four decisions, Cooper's December 3rd petition is dismissed because no relevance or materiality determination has yet been made, and therefore the request to

expunge the information is premature. In a second decision, T&B's petition responsive to Cooper's December 3rd petition is also dismissed. That second decision explains that it is not clear whether Cooper's evidentiary submissions are in compliance with the District Court's protective order and gives T&B thirty days to resolve any necessary issues with the District Court. The USPTO has taken this approach because it appears that the District Court may not be aware that there is no way for the USPTO to both consider relevant information and expunge it. Only non-material information can be expunged and information supporting patentability is almost always material. In a third decision, Cooper's December 21st petition is granted because the information submitted with that petition is either duplicative of the December 3rd information, or does not address issues relevant to patentability in the pending *inter partes* reexamination proceeding. Finally, in a fourth decision, T&B's petition in response to Cooper's December 21st petition is dismissed as moot because all of the information submitted with the December 21 submission will be expunged, as explained in the third decision.

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An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting inter-partes reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

On Monday December 3, 2007, in response to the ACP, patent owner, Cooper, filed a paper entitled "Comments on Action Closing Prosecution." This paper was submitted under seal as per MPEP § 724, accompanied by a redacted version not under seal, a "Transmittal Letter under M.P.E.P. § 724,"and a petition under 37 C.F.R. § 1.59 to expunge the documents submitted under seal.

DECISION

I. Petition to Expunge

Petitioner Cooper requests that the documents submitted "by Patent owner under seal on November 30, 2007" be expunged from the record if they are found not to be material to examination.[2] Cooper states that the information is subject to a protective order,[3] the

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

[2] The actual date of the submission under seal was December 3, 2007 as reflected in the signature block on the papers. Patent owner is urged to take care with dates in order to keep the record from being muddled.

information has not been made public, and Cooper commits to retain the information for the period of the patent. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified documents are considered to be "material." After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, the petition to expunge may be renewed by patent owner. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. In addition, the **requester is cautioned to call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued. A failure to timely call up the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

II. Requirement to further Redact the December 3, 2007 "Comments on Action Closing Prosecution."

The redacted version of the December 3, 2007 "Comments on Action Closing Prosecution" is being provisionally sealed. Patent owner, Cooper, must supply a substitute paper, for immediate entry, that more fully redacts the references to the sealed documents. Note that examination will not be delayed to await this submission, since the examiner will be reviewing the version that is currently under seal.

The following is a selection of instances of text that should be further redacted; these instances specifically reference sealed documents and/or reveal the existence and tenor of sealed information, presumably relevant to the issue at hand: (1) the last sentence on page 5; (2) the remainder of the paragraph at the top of page 6; (3) the lead-in phrase to the redacted material on page 12 (and similar lead-in phrases elsewhere); (4) the entirety of section 4b (on pages 16-18).

This is not a comprehensive list. It is patent owner's responsibility to provide a redacted version fully compliant with the guidance in the preceding paragraphs.

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[3] The papers refer to a protective order issued November 20, 2007, by the U.S. District Court, Eastern District of Texas in Civil action No 2:06-CV-242 signed by Charles Everingham IV, U.S. Magistrate Judge . It is noted that this order was not supplied by petitioner patent owner, but a copy of an unsigned standard protective order dated June 12, 2007 was provided as part of unsealed Exhibit D.

III. Inappropriate Remarks in the Response.

The parties are reminded that 37 CFR 1.3 requires attorneys or agents to "conduct their business with the United States Patent and Trademark Office with decorum and courtesy." Pejorative remarks about the conduct of other parties are not appropriate and will not be tolerated. The rule directs that "papers presented in violation of the rule will not be entered," and the Office intends to strictly enforce the rule in any future submissions in this proceeding.

For example, referring to a paper as a "purported declaration" is inappropriate unless supported by documentary evidence explaining why it is believed that the document is not a declaration (e.g., it was not properly executed). Disagreement with the content does not change the fact that, on its face, it is a declaration made by the declarants.

Furthermore, an *inter partes* reexamination must not include information that is not permitted to be entered into the record. 35 U.S.C. 311 only establishes reexamination based upon prior art as provided for in 35 U.S.C. 301. Nothing in the law permits disclosure of material that contains allegations of impropriety and improper behavior that does not go to the merits of the patentability of any of the claims, and only pertains to issues beyond those statutorily permitted in reexamination proceedings. A discussion of litigation, including allegations of fraud and misconduct on the part of another party (conduct issues) goes beyond what is statutorily permitted and thus, it is not entitled to entry in a patent, by reexamination request, or by any other vehicle. Parties may present factual statements for the record, but must refrain from characterizing the actions or conduct of any party.

CONCLUSION

1. The petition to expunge the sealed version of the December 3, 2007 "Comments on the Action Closing Prosecution" is **dismissed** as premature.

2. Patent owner, Cooper, may re-submit a petition to expunge the sealed information once the issue of materiality of the information is resolved. Requester, T&B, is cautioned to call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a NIRC is issued. **A failure to timely call up the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The redacted version of the "Comments on Action Closing Prosecution," submitted December 3, 2007, will be provisionally sealed. Since this paper has previously been incorporated into the IFW, it will be marked as "closed" and "non-public" in the IFW record of the present reexamination proceeding.

4. Patent owner, Cooper, is **required** to re-submit a more fully redacted version of the December 3, 2007 "Comments on the Action Closing Prosecution" in accordance with the guidance set out above within 30 days of this decision.

5. The "Transmittal Letter Under M.P.E.P. §724" and the "Petition to Expunge Under 37 C.F.R. § 1.59(b)" submitted December 3, 2007 have been entered in the record.

6. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.

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

2-12-08
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Washington, DC 20005

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.182 TO REFUSE**
: **ENTRY OF DOCUMENTS**
: **SUBMITTED UNDER SEAL**

This is a decision on the paper denominated "Third-Party Requester's Petition under 37 C.F.R. § 1.182 in Response to Patentee's Petition Under 37 C.F.R. § 1.59(b) "submitted January 22, 2008. As explained below the paper is being treated as a petition to strike patent owner's response of December 21, 2007.

The papers are before the Office of Patent Legal Administration.

The requester's petition is **DISMISSED** as moot.

SUMMARY

This is one of four decisions, issued on the same day, directed to patent owner Cooper's submission of information to the USPTO that is also subject to a protective order by the United States District Court for the Eastern District of Texas, *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Tex. June 14, 2006). Cooper's first submission came with a petition filed on December 3, 2007 requesting that the submitted information be considered and expunged if not found relevant or material to patentability. Third party requester T&B responded with its own petition requesting that the information submitted on December 3rd be immediately expunged, without consideration of its relevance. On December 21, 2007, in support of its petition to suspend, Cooper submitted information, largely duplicative of the information submitted on December 3rd, and again petitioned that the information be considered and expunged if not relevant or material. In response, T&B again petitioned to have the December 21st information expunged, without consideration of it relevance.

In the first decision, Cooper's December 3rd petition is dismissed because no relevance or materiality determination has yet been made, and therefore the request to expunge the information is premature. In a second decision, T&B's petition responsive to Cooper's December 3rd petition is also dismissed. That second decision explains that it is not clear whether Cooper's evidentiary submissions are in compliance with the District Court's protective order and gives T&B thirty days to resolve any necessary issues with the District Court. The USPTO has taken this approach because it appears that the District Court may not be aware that there is no way for the USPTO to both consider relevant information and expunge it. Only non-material information can be expunged and information supporting patentability is almost always material. In a third decision, Cooper's December 21st petition is granted because the information submitted with that petition is either duplicative of the December 3rd information, or does not address issues relevant to patentability in the pending *inter partes* reexamination proceeding. Finally, in this fourth of four decisions, T&B's petition in response to Cooper's December 21st petition is dismissed as moot because all of the information submitted with the December 21 submission will be expunged, as explained in the third decision.

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas. [1]

An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting inter-partes reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

On Monday December 3, 2007, in response to the ACP, patent owner, Cooper, timely filed a paper entitled "Comments on Action Closing Prosecution." This paper was submitted under seal as per MPEP § 724 , accompanied by a redacted version not under seal, a "Transmittal Letter under M.P.E.P. § 724," and a petition under 37 C.F.R. § 1.59 to expunge the documents submitted under seal.

On December 21, 2007 patent owner, Cooper, filed a paper entitled "Response to November 16, 2007 Dismissal of Patentee's Prior Petition to Suspend and Renewed Petition under 37 C.F.R. § 1.182 to Suspend Inter Partes Proceeding." This paper was submitted under seal as per MPEP § 724, accompanied by a redacted version not under seal, a "Transmittal Letter under M.P.E.P. § 724", and a petition under 37 C.F.R. § 1.59 to expunge the documents submitted under seal. On January 22, 2008 third party requester, T&B, filed a paper [2] in opposition to Cooper's December 21, 2007 petition to expunge. The January 22, 2008 paper is the subject of this decision.

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[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

[2] This paper was timely, as January 21, 2008, was a Federal Holiday in the District of Columbia.

Cooper, in a petition filed December 21, 2007, requests that the documents submitted "by Patent owner under seal on November 30, 2007" be expunged from the record, if they are found not to be material to examination.[3] Cooper states that the information is subject to a protective order, [4] the information has not been made public, and Cooper commits to retain the information for the period of the patent.

DECISION

Requester T&B, in the instant petition, asks the Director to "immediately expunge" the sealed documents from the record without submitting them for consideration to the examiner of record. The petition includes, as an attachment, an "Amended Agreed Protective Order" in Civil Action NO. 2:06-CV-242, executed November 20, 2007. Thus, T&B's petition is requesting that Cooper's petition submitted under seal on December 21, 2007, be refused entry and struck from the record.

The papers submitted under seal, in support of Cooper's petition to suspend filed December 21, 2007 will be returned in due course; see decision mailed on even date, rendered in response to the patent owner's concurrently filed petition under 37 C.F.R. § 1.59. The decision found that the papers were either (a) duplicative of material previously[5] submitted or (b) were documents relating to efforts to obtain discovery, and accordingly found the papers not to be important to a reasonable examiner[6] in determining whether the claims are patentable.

Since the documents have been removed from the record, the petition to strike is moot. Accordingly, the petition is **DISMISSED**.

CONCLUSION

1. The petition to expunge the sealed portions of Cooper's paper submitted December 21, 2007, is **dismissed** as moot.

2. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.

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[3] The actual date of the submission under seal was December 3, 2007 as reflected in the signature block on the papers. Patent owner is urged to take care with dates in order to keep the record from being muddled.

[4] The papers refer to a protective order issued November 20, 2007, by the U.S. District Court, Eastern District of Texas in Civil action No 2:06-CV-242 signed by Charles Everingham IV, U.S. Magistrate Judge. It is noted that this order was not supplied by petitioner patent owner, but a copy of an unsigned standard protective order dated June 12, 2007 was provided as part of unsealed Exhibit D.

[5] The earlier submission was also under seal and is the subject of a separate decision.

[6] The materials that were duplicative of previously submitted material were not reviewed by the Examiner of record.

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

2-12-08
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
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901 Fifteenth Street, N.W.
Washington, DC 20005

(For Third Party Requester)

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.59(b) TO**
: **EXPUNGE MATERIAL**
: **SUBMITTED UNDER SEAL**

This is a decision on patent owner Cooper's March 28, 2008 petition under 37 CFR 1.59(b) to expunge information submitted November 30, 2007 pursuant to MPEP 724.02.

The petition, and the papers containing the information for which expungment is requested, are before the Office of Patent Legal Administration.

The patent owner's petition is **DISMISSED**.

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas. [1]

An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting *inter partes* reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

On March 28, 2008, patent owner Cooper submitted a sealed envelope with an information disclosure statement (IDS) and a document submitted in accordance with the procedures of MPEP 724 accompanied by the present petition to expunge under 37 CFR 1.59(b).

DECISION

Petitioner Cooper requests that the documents submitted "by Patent owner under seal on November 30, 2007" be expunged from the record if they are found not to be material to examination. Cooper's petition later identifies the paper in question as "an INFORMATION DISCLOSURE STATEMENT (IDS), filed March 28, 2008" and the transmittal letter under MPEP 724 identifies it as an IDS filed March 27, 2008. Cooper states that the information is subject to a protective order, the information has not been made public, and Cooper commits to retain the information for the period of the patent. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified documents are considered to be "material." After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, the petition to expunge may be renewed by patent owner. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. In addition, the **parties desiring expungment are cautioned to ensure that a petition under 37 CFR 1.59 is re-submitted for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued. A failure to timely re-submit the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

CONCLUSION

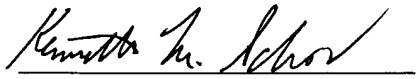
1. The petition to expunge "documents submitted by Patent owner under seal on November 30, 2007" which is being treated as a petition to expunge the IDS submitted March 28, 2008 is **dismissed** as premature.

2. Patent owner, Cooper, may re-submit a petition to expunge the sealed information once the issue of materiality of the information is resolved. Parties desiring expungment are cautioned to ensure that a petition under 37 CFR 1.59 is re-submitted for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the

examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a NIRC is issued. **A failure to timely re-submit the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The "Transmittal Letter Under M.P.E.P. §724" and the "Petition to Expunge Under 37 C.F.R. § 1.59(b)" submitted March 28, 2008 have been entered in the record.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.



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In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.59(b) TO**
: **EXPUNGE MATERIAL**
: **SUBMITTED UNDER SEAL**

This is a decision on patent owner Cooper's March 28, 2008 petition under 37 CFR 1.59(b) to expunge information submitted March 28, 2008 pursuant to MPEP 724.02.

The petition, and the papers containing the information for which expungment is requested, are before the Office of Patent Legal Administration.

The patent owner's petition is **DISMISSED**.

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas. [1]

An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting *inter partes* reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

On March 28, 2008, patent owner Cooper submitted a sealed envelope with an information disclosure statement (IDS) and multiple documents submitted in accordance with the procedures of MPEP 724 accompanied by the present petition to expunge under 37 CFR 1.59(b).

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

DECISION

Petitioner Cooper requests that the documents submitted "by Patent owner under seal on March 28, 2008" be expunged from the record if they are found not to be material to examination. Cooper's petition later identifies the paper in question as "an IDS and copies off cited references containing documents under a protective order." [2] Cooper states that the information is subject to a protective order, the information has not been made public, and Cooper commits to retain the information for the period of the patent. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified documents are considered to be "material." After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, the petition to expunge may be renewed by patent owner. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. In addition, the **parties desiring expungment are cautioned to ensure that a petition under 37 CFR 1.59 is re-submitted for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued. A failure to timely re-submit the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

CONCLUSION

1. The petition to expunge "documents submitted by Patent owner under seal on March 28, 2008" is **dismissed** as premature.

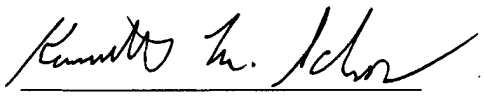
2. Patent owner, Cooper, may re-submit a petition to expunge the sealed information once the issue of materiality of the information is resolved. Parties desiring expungment are cautioned to ensure that a petition under 37 CFR 1.59 is re-submitted for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a NIRC is issued. **A failure to timely re-submit the**

[2] This submission is distinct from a separate IDS submitted under seal and petition to expunge also filed on March 28, 2008. That submission is the subject of a separate decision.

petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

3. The "Transmittal Letter Under M.P.E.P. §724" and the "Petition to Expunge Under 37 C.F.R. § 1.59(b)" submitted March 28, 2008 have been entered in the record.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.



Kenneth M. Schor
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(For Third Party Requester)

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION**
: **DISMISSING**
: **PETITION**
: **UNDER 37 CFR 1.183**

This is a decision on the February 6, 2008 third party requester (T&B) petition titled "Third-Party Requester's Petition Under 37 C.F.R. §1.182 in Opposition to Patentee's Petition Under 37 C.F.R. §1.182 and Alternatively Third-Party Requester's Petition Under 37 C.F.R. §1.183" (the "Petition"). In addition, patent owner Cooper filed a paper on February 14, 2008, titled "petition Under 37 C.F.R. §1.182 in Opposition to Third-Party Requester's Petition to Allow Comments under 37 C.F.R. §1.183" (the "opposition").

The petition, the opposition, and *inter partes* reexamination control number 95/000,209 are before the Office of Patent Legal Administration.

The petition is dismissed.

BACKGROUND

1. U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al. on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas. [1]

2. An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting *inter partes* reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

3. On Monday December 3, 2007, patent owner Cooper filed a paper titled "Comments on Action Closing Prosecution" Under 37 CFR 1.951(a). On January 2, 2008, third party requester T&B, filed a comments paper under 37 C.F.R. 1.951(b). On January 16, 2008, Cooper filed a petition requesting the Office to return T&B's January 2, 2008 submission for failure to adhere to 37 CFR 1.951.

4. The Office, in a paper mailed February 8, 2008, informed the parties that the requester T&B's submission of January 2, 2008, titled "Third-Party Requester's Comments Under 37 C.F.R. 1.951(b)," had not been entered because it was not a proper paper under the rules governing reexamination. In accordance with that action, patent owner Cooper's January 16, 2008 petition was dismissed as moot.

5. On February 6, 2008, requester T&B submitted a paper titled "Replacement Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," a petition to enter replacement comments, and a sealed envelope with documents submitted in accordance with the procedures of MPEP 724. On February 14, patent owner Cooper submitted an opposition to the T&B February 6th petition. The February 6th petition and the February 14th opposition are the subject of this decision.

DECISION

A. Petition Under 37 CFR 1.182 in Opposition to Cooper's Petition Under 37 CFR 1.182

In a paper mailed February 8, 2008, the Office dismissed patentee Cooper's January 16, 2008 petition as moot. Therefore, there remains nothing for third-party requester T&B to oppose. Accordingly the petition (under 1.182) in opposition is dismissed as moot.

B. Petition to waive 37 C.F.R. 1.951(b) and to Allow entry of Replacement Comments

I. T&B's position

On February 6, 2008, requester T&B submitted "Replacement Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," a petition to enter the comments, and a sealed envelope with documents submitted in accordance with the procedures of MPEP 724.

The petition argues that the originally filed Comments paper was compliant, and asks that if the original is not granted entry, that the Office waive 37 CFR 1.951(b) and enter the replacement paper which removed the allegedly non-compliant remarks.

II. Cooper's position.

Cooper, in its opposition filed February 14, 2008, asserts that T&B's request for waiver of rule 951(b) should be denied because (1) the replacement paper contains remarks beyond the scope of Cooper's response to the ACP and thus is still non-compliant and (2) in any

event, this is not an "extraordinary situation" in which "justice requires" the waiver of the rule.

III. Applicable Regulation And Practice Regarding Comments After Action Closing Prosecution:

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 2672

> Section IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED TO RESPONDING TO PATENT OWNER'S SUBMISSION
>
> Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments and/or proposed amendment. Such third party requester comments must be filed within 30 days from the date of service of the patent owner's comments and/or proposed amendment on the third party requester. If the third party requester's comments go beyond the scope of responding to the patent owner's comments and/or proposed amendments, then the third party requester's comments will be returned. No additional opportunity will be given for the third party requester 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.

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).

IV. Adequate cause to waive 37 CFR 1.951(b) and allow replacement comments has not been established.

Petitioner T&B makes no direct case for waiving the rule to allow entry of the replacement set of comments. Instead, T&B notes in a footnote [2] that the Office, in the ACP issued November 1, 2007, *sua sponte* waived 37 CFR 1.943(b) page limit on Cooper's response filed July 13, 2007.

Cooper, in the opposition filed February 14, 2008, points out that (a) the waiver of 37 CFR 943(b) was consistent with special dispatch as it avoided an additional 45 days of delay; and (b) that T&B's petition for waiver does establish the existence of an "extraordinary situation" in which "justice requires" that 37 CFR 951(b) be waived for its set of facts.

In addressing this matter, it is pointed out that waiver is not intended to be routine and an individual situation 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 shown that either condition exists in this case. T&B has not carried its burden of demonstrating that justice requires waiver of the rule. Petitioner has not demonstrated that the failure of T&B's January 2, 2008 "Third-Party Requester's Comments Under 37 C.F.R. 1.951(b)," to be limited to responding to patent owner's comments and/or proposed amendments was caused by "extraordinary circumstances," such that the February 6, 2008 "Replacement Third-Party Requester Comments Under 37 C.F.R. §1.951(b)" should now be entered by waiver of the rule. [3] Furthermore, justice does not require waiver of the rule to

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[2] Petition filed February 6, 2008 at note 1, page 3

[3] In this context, the following are some examples of situations defining high threshold level of an "extraordinary situation" that "justice so requires" a waiver under § 1.183. *See e.g., Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D. D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of § 1.10(c) in order to grant filing date to patent application, where applicant failed to produce Express Mail customer receipt or any other evidence that application was actually deposited with USPS as Express Mail); *Nitto Chemical Industry. Co., Ltd. v. Comer*, No. 93-1378, 1994 U.S. Dist. LEXIS 19211, at *13-14 (D. D.C. Mar. 7, 1994) (Commissioner's refusal to waive requirements of § 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of § 1.10 is an `avoidable' oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under § 1.183); *Vincent v. Mossinghoff*, 230 USPQ 621 (D. D.C. 1985) (Misunderstanding of § 1.8 not unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of § 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (Since certificate of mailing procedure under § 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation)." See PTO comments at 61 Fed. Reg. 56442-43.

enter the replacement comments; petitioner has not shown why the information of the replacement comments which would be proper if it were submitted in a comments paper having an entry right cannot be submitted in a subsequent appeal by requester. Thus, petitioner has failed to demonstrate either of the two prongs required for waiver. Insofar as T&B points out that the Office previously waived the length limitation on a response by patent owner Cooper, T&B has not made any showing as to how this would justify a waiver of the rule 37 CFR 1.951(b) stricture that requester "may ***once*** file comments" to allow a replacement filing. Accordingly, the petition to waive rule 951(b) must be dismissed.

V. T&B's submission of documents a sealed envelope in accordance with MPEP § 724

On February 6, 2008, requester T&B submitted documents which included, *inter alia*, "Replacement Third-Party Requester Comments Under 37 C.F.R. §1.951(b)", a petition to enter the comments, and a sealed envelope with documents submitted in accordance with the procedures of MPEP 724.

The cover letter on this transmission listed documents numbered 1-8, of which #7 was identified as a "Transmittal Letter Under MPEP § 724" and #6 as "Sealed Envelope Documents (2 pages)".

The "Transmittal Letter Under MPEP § 724" states that "the materials in the accompanying envelope contain materials subject to a protective order" and "[t]he documents subject to the Protective Order are Appendix I, the Declaration of Frank Stepniak, and Exhibit F thereto, TB 0164881."

a. There appears to be a discrepancy in the submitted documentation. The envelope, consistent with the listing for item 6, contains a total of two pages, TB 0168841 and a cover page; the description of the documents subject to the protective order is far more extensive.

b. The document, although submitted under seal, is not accompanied by a petition to expunge under 37 CFR 1.59 Without such a petition, if the document is entered in the record, it will eventually be made public at the close of proceedings. T&B can not rely on earlier petitions with respect to other papers submitted under seal by patent owner Cooper.

c. The petition for waiver of 37 CFR 1.951(b) is being dismissed. Accordingly, the Replacement Comments and all its attachments are not being entered in the file and are not part of the record. Those papers that have already been scanned into the Image File Wrapper (IFW) system will be marked as "closed" and "non-public" to prevent ant public access to the papers. The documents submitted under seal were not scanned and are being returned with this decision.

d. Finally, it is noted, that even if a waiver of 37 CFR 1.951(b) were granted to allow replacement comments to be entered, the paper submitted under seal would not be allowed entry. Waiver of the rule to allow replacement comments is solely to rectify the non-compliance of the original filing to the extent that it went beyond the scope of a permitted response. The filing of "Replacement Comments" with a petition for entry is not an opportunity to add to the original comments. In this instance, the original comments which were returned for failure to comply with 37 CFR 1.951(b) did not include the information

now being presented under seal. Therefore, such material will not be allowed entry into the record.

Additional Discussion

Cooper identifies two instances in the replacement comments which it contends "go beyond the scope of responding to patent owner's comments" and thereby render the comments improper under MPEP 2672. Each of these instances will be addressed for the sake of completeness.

a. Cooper objects to T&B's arguments on page 9 of the replacement comments, that the 1987 Demonstration Memorandum and the 1988 Larson Correspondence qualify as printed publications, are "beyond the scope" because "Patent Owner did not comment on this issue."[4]

However, patent owner Cooper did comment on this issue. Specifically, patent owner stated: [5]

> However, Patent Owner does not admit that any given reference is entitled to a publication date and reserves the right to refute a publication date as facts become available to Patent Owner. Further, Patent Owner refers to portions of the 1984 Meeting Memorandum, the 1987 Demonstration Memorandum, the 1987 Larson Correspondence, and the 1988 Conference Minutes (collectively, the "Internal Memoranda") to clarify the evidence of record. However, Patent Owner does not admit to any alleged teaching in such Internal Memoranda, nor does Patent Owner vouch for its, authenticity, completeness, accuracy, or truthfulness of such Internal Memoranda.

These comments are directed to the status of the Internal Memoranda and whether they are proper printed publications. Therefore, Cooper raised the issue in their Comments to ACP, and T&B could have legitimately responded within its comments under rule 951(b), if such were presented in comments not barred by the rules. These issue may also be raised on appeal, should patent owner continue with its position stated in the above-quoted matter.

b. Cooper further objects to Section III(A)(2)(a) of the Supplemental Comments which is reproduced here in its entirety:

> **2. The 1974 Sales Brochure Anticipates Claims 1-30**
>
> **a. Patentee Concedes that the Color Band is Formed on the Bushing and Other Side by the Shoulder Wall**
>
> Requester briefly notes that the Patentee, in its Comments, failed to contest the Examiner's conclusion that the term "color band" reads on a color band defined on one side by the color transition line "O" on the bushing insert and the other side by the bushing shoulder wall. [6]

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[4] Opposition at page 4.

[5] "Comments on Action Closing Prosecution" filed December 3, 2007 at page 4.

[6] "Replacement Third-Party Requester's Comments Under 37 C.F.R. 1.951(b)" filed February 6, 2008 at page 14.

Cooper contends that since patent owner did not comment on this specific point, the comments by third-party are improper. [7] Cooper would read the right to respond afforded third-party requester by 37 C.F.R. 1.951(b) to be limited ***not to the rejection,*** but to the *specific comment made by patent owner* with respect to the rejection.

Cooper's position is not correct. In the ACP issued November 1, 2007, the examiner rejected claims 1-30 as anticipated by the 1974 sales brochure. Cooper responded to this rejection with arguments to controvert the examiner's finding of anticipation. Thus, T&B had the right to "file comments responsive to patent owner's comments" regarding the propriety of the anticipation rejection, in a comments paper having an entry right. T&B is not limited to arguing merely the particular features that patent owner Cooper challenges in the traversal of the rejection. T&B's right to respond is to comments on the traversal of the grounds and reasoning of the Examiner and can properly address the full scope of the rejection. A case for anticipation or obviousness can not be made by focusing on a single claim element to the exclusion of others and it is reasonable to allow the third party to address the claim in its entirety. [8]

CONCLUSION

1. The February 6, 2008 petition by third-party requester T&B in opposition to Patentee Cooper's petition to refuse entry of T&B's comments under 1.951(b) (filed January 2, 2008) is dismissed as moot .

2. The February 6, 2008 petition under 37 C.F.R. 1.183 by third-party requester T&B to waive 37 C.F.R. 1.951(b) and to enter the replacement comments is dismissed.

3. The papers submitted under seal are being returned herewith.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.

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

3-3-08
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[7] Opposition at page 5

[8] Furthermore, in this instance, T&B does not comment at length with respect to the claim features or claim construction that Cooper did not challenge. T&B merely noted the lack of challenge in making its case for anticipation.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

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EXAMINER	
ART UNIT	PAPER NUMBER

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Kevin W. Jakel c/o Kaye Scholer LLP
901 15th Street, N.W.
Washington, DC 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,209*.

PATENT NUMBER *6,984,791*.

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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(For Third Party Requester)

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION**
: **DISMISSING**
: **PETITION**
: **UNDER 37 CFR 1.183**

This is a decision on the February 29, 2008 third party requester (T&B) petition titled "Third-Party Requester's Petition Under 37 C.F.R. §1.183 to Waive 37C.F.R. §1.951(b) as to its One Opportunity Limitation" (the "Petition"). In addition, patent owner Cooper filed a paper on March 28, 2008, titled "Patent Owner's Petition Under 37 C.F.R. §1.182 in Response to Third-Party Requester's Petition to Suspend the Requirement of 37 C.F.R. §1.951 to Allow Third Party Requester's Supplemental Comments to be Entered After the Proper Response Period" (the "opposition").

The petition, the opposition, and *inter partes* reexamination control number 95/000,209 are before the Office of Patent Legal Administration.

The petition is dismissed. The "Supplemental Comments" will not be entered into the '209 reexamination proceeding.

BACKGROUND

1. U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al. on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas.[1]

2. An order in reexamination control no. 95/000,209 ("the 209 proceeding") granting *inter partes* reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B, was mailed on April 13, 2007. Prosecution of the proceeding has progressed to the stage that an action closing prosecution ("ACP") was mailed on

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

3. On Monday December 3, 2007, patent owner Cooper filed a paper titled "Comments on Action Closing Prosecution" Under 37 CFR 1.951(a). On January 2, 2008, third party requester T&B, filed a comments paper under 37 C.F.R. 1.951(b). On January 16, 2008, Cooper filed a petition requesting the Office to return T&B's January 2, 2008 submission for failure to adhere to 37 CFR 1.951.

4. The Office, in a paper mailed February 8, 2008, informed the parties that the requester T&B's submission of January 2, 2008, titled "Third-Party Requester's Comments Under 37 C.F.R. 1.951(b)," had not been entered because it was not a proper paper under the rules governing reexamination. In accordance with that action, patent owner Cooper's January 16, 2008 petition was dismissed as moot.

5. On February 6, 2008, requester T&B submitted a paper titled "Replacement Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," a petition to enter replacement comments, and a sealed envelope with documents submitted in accordance with the procedures of MPEP 724. On February 14, patent owner Cooper submitted an opposition to the T&B February 6th petition. A decision dismissing T&B's petition was mailed April 10, 2008.

6. On February 29, 2008, requester T&B submitted a paper titled "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," a petition to enter the supplemental comments, and two sealed envelopes with documents submitted in accordance with the procedures of MPEP 724. On March 28, patent owner Cooper submitted an opposition to the T&B February 29th petition. On March 28, 2008, patent owner Cooper also submitted an Information Disclosure Statement and two sealed envelopes with documents submitted in accordance with the procedures of MPEP 724. The February 29th petition and the March 28th opposition are the subject of this decision.

DECISION

A. Petition to waive 37 C.F.R. 1.951(b) and to Allow entry of Supplemental Comments

I. T&B's position

On February 29, 2008, requester T&B submitted "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b),"[2] a petition to enter the comments, and two sealed envelopes with documents submitted in accordance with the procedures of MPEP 724.

T&B argues[3] that the documents provided first became available recently as a result of discovery and thus are entitled to entry under 37 CFR 1.948(a)(3), that the 1989 status report qualifies as prior art and is relevant to the claimed invention, the other documents are relevant in that they contradict assertions and arguments made by patent owner to support

[2] T&B refers to the comments as "Supplemental" and requests waiver of the "one opportunity" limitation of 37 CFR 1.951(b). Since neither the original comments nor the "replacement" comments were entered, this is not strictly a supplemental response. However, a waiver of 951(b) would still be necessary to allow entry of these comments as the rule limits requester to file comments "once". See MPEP 2672.

[3] The discussion is actually found in the Supplemental Comments – not the petition.

patentability. The petition requests that the Office waive 37 CFR 1.951(b) and enter the submitted documents along with the supplemental comments explaining the relevance of these documents.

II. Cooper's position.

Cooper, in its opposition filed March 28, 2008, asserts that T&B's request for waiver of rule 951(b) should be denied because the submission by Cooper on that date makes the relevant documents of record.[4] Cooper argues that because the documents have now been made of record and are available to the examiner this is not an "extraordinary situation" in which "justice requires" the waiver of the rule to admit comments by T&B explaining the relevance of the submitted documents.

III. Applicable Regulation And Practice Regarding Comments After Action Closing Prosecution:

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.

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.

[4] Cooper does not submit all the documents that T&B provided. See the discussion below.

MPEP 2672

> Section IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED TO RESPONDING TO PATENT OWNER'S SUBMISSION
>
> Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments and/or proposed amendment. Such third party requester comments must be filed within 30 days from the date of service of the patent owner's comments and/or proposed amendment on the third party requester. If the third party requester's comments go beyond the scope of responding to the patent owner's comments and/or proposed amendments, then the third party requester's comments will be returned. No additional opportunity will be given for the third party requester 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.

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).

IV. Relationship between 37 CFR 1.948 and 37 CFR 1.951(b).

37 CFR 1.948(a)(3) allows a third party requester in an *inter partes* reexamination proceeding to submit additional prior art "which for the first time became known or available to third party requester after the filing of the request" if it filed as part of comments under 37 CFR 1.947 or 37 CFR 1.951(b). In such a situation, the submission "must include a discussion of the pertinency of each reference to the patentability of at least one claim."

37 CFR 1.951(b) permits comments by the third party requester only if the comments are solely "responsive to the patent owner's comments" to the action closing prosecution filed under 37 CFR 1.951(a).

As part of the February 29, 2008 submission, T&B provides a copy of the 1989 Status report and 3 appendices (numbered 7-9) explaining in detail why the claims of the '791 patent are obvious over either the 1989 report standing alone or over the report in combination with other art already of record. In the supplemental comments, T&B focuses on compliance with 37 CFR 1.948(a)(3) to justify entry of the status report and the supporting comments and explanation.

In this instance, however, the submission of the 1989 status report is not in response to any patent owner comment, - instead it is new art brought forward to assert new grounds of rejection – and thus it is not sanctioned by 37 CFR 1.951(b). Consequently, the supplemental comments paper does not meet the requirements set forth in the first sentence of 37 CFR 1.948(a). Thus, even assuming *arguendo* that the circumstances surrounding the 1989 document qualify as being "first became known or available," thus satisfying the criterion of 37 CFR 1.948(a)(3), waiver of 37 CFR 1.951(b) is still needed to enter the 1989 reference with the "discussion of the pertinency of each reference to the patentability of at least one claim".

V. Adequate cause to waive 37 CFR 1.951(b) and allow supplemental comments has not been established.

The discussion of the parties' submissions, in some instances, is tailored in a manner not to reveal information that is currently not open to the public.

A. T&B's Submissions

On February 29, 2008, requester T&B submitted a paper titled "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," a petition under 37 CFR 1.183 to waive 37 CFR 1.951(b) and enter the supplemental comments, and two sealed envelopes with documents submitted in accordance with the procedures of MPEP 724. A redacted version of each of these papers was also submitted and these papers were scanned into the image file wrapper (IFW) of the '209 proceeding.

The sealed envelope accompanying the petition contains a transcript of a depositions of J. Makal[5] with supporting exhibits[6], a transcript of a deposition of C. Wahlgren[7], a 1986 memorandum[8], two sets of drawings[9], and an affidavit of Frank Stepniak[10] executed December 12, 2007. The sealed envelope with the unredacted "Supplemental Comments" contains all the supporting documents in the other envelope and also includes claim charts detailing the manner of applying the 1989 status report to the claims of the '791 patent.[11]

T&B argues that an extraordinary circumstance exists, because discovery, which was delayed until after the response under 37 CFR 1.951(b) was due, has resulted in the disclosure of information in direct contradiction to Cooper's statement in support of patentability and which establishes that the 1989 status report is prior art. Accordingly, T&B requests that the new evidence be made of record and that "Requester be permitted to file Supplemental Comments detailing this key evidence."[12]

B. Cooper's Submissions

On March 28, patent owner Cooper submitted an opposition to the T&B February 29th petition, a paper titled "Information Disclosure Statement (IDS)" including a form listing six

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[5] Appendix 1
[6] Exhibit 19 to the Makal deposition is a fax dated July 15, 1991 including, *inter alia*, a fax cover letter and a copy of 1989 status report.
[7] Appendix 2
[8] Appendix 3
[9] Appendix 4 and Appendix 5
[10] Appendix 6"\
[11] Appendices 7, 8, and 9
[12] Petition at 6

(6) documents in a sealed envelope, and a second sealed envelope containing the same IDS along with the documents listed therein. Both sealed envelopes were submitted in accordance with the procedures set forth in MPEP 724.

The patent owner's submission designates the submitted documents as "CA" through "CF." Document "CA" corresponds to Exhibit 19 of the Makal deposition, and "CB"-"CF" correspond to T&B's Appendices 1-5 respectively. Cooper did not provide all the supporting exhibits of the Makal deposition, contending that the omitted exhibits are not relevant to the issues at hand.[13] However, Cooper has offered to provide them upon request of the Examiner.[14] Additionally, the declaration of Frank Stepniak executed December 21, 2007 (Appendix 6 of T&B's submission) was not provided by Cooper.

Cooper, in its opposition filed March 28, 2008, contends that there are no longer extraordinary circumstances for entry of T&B's supplemental comments, since Cooper has independently submitted the 1989 status report and the deposition testimony of Mr. Makal and Mr. Wahlgren into the record.[15]

C. Analysis

Whether waiver of the rule would have been appropriate given the circumstances at the time T&B filed the petition is not before the Office. The question to be decided is whether under the circumstances as they now stand, there exists extraordinary circumstances in which justice requires waiver of the rules to allow the third party requester to enter supplemental comments in the record, which contain far more than mere presentation of the materials obtained via discovery.

Cooper has submitted the 1989 status report and all the documentation that the requester submitted for entry into the record other than Exhibits of the Makal deposition that Cooper contends are not relevant. The omitted exhibits are not referenced in any of T&B's papers nor in any of the testimony T&B is relying on, thus supporting Cooper's assertion. In any event, Cooper has offered to submit those documents as well. Since Cooper may submit the documents (without discussing them) without recourse to waiver of the rules, there is no need to waive 37 CFR 1.951(b) to allow the entry of such documents.

With respect to the Stepniak declaration and the comments explaining how to apply the art to compose rejections of the claims of the '791 patent, no extraordinary circumstances currently exist. All claims are presently under rejection, therefore there is no harm to the third party requester at this point. Should the situation change such that some claims are confirmed (found patentable), the requester may consider filing a further petition under 37 CFR 1.183 to have the comments directed to the manner of applying the art entered into the file and placed before the examiner for consideration.

Finally, justice does not require that the particular *explanations in the comments as to how* the newly discovered evidence contradicts the assertions made by patent owner Cooper in the comments after ACP be entered. Cooper's submission identifies the general argument proffered by T&B and specifically directs the examiner to the documents and pages that

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[13] Neither party submitted *all* the exhibits. Exhibits 1, 7, 10-12 and 22 to the Makal deposition were submitted by T&B, but not by Cooper.

[14] See note 1 on page 2 of the IDS submitted under seal.

[15] Opposition at page 3

T&B relies on for these assertions. Although, the framing of the argument by requester can be of assistance to the examiner in appreciating T&B's position, that is not enough to justify waiver of the rule to allow commentary, when all the *facts* are properly before the examiner.

In addressing this matter, it is pointed out that waiver is not intended to be routine and an individual situation 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 shown that these conditions exist in the present case. T&B has not carried its burden of demonstrating that justice requires waiver of the rule. Petitioner has not demonstrated that the February 29, 2008 "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)" should now be entered by waiver of the rule.[16] Accordingly, the petition to waive rule 951(b) must be dismissed.

The petition for waiver of 37 CFR 1.951(b) is being dismissed. Accordingly, the Supplemental Comments of February 29, 2008, and all its attachments are not being entered in the file and are not part of the record. Those papers that have already been scanned into the Image File Wrapper (IFW) system will be marked as "closed" and "non-public" to prevent any public access to the papers. The documents submitted under seal were not scanned and are being returned to the requester (T&B) with this decision.

B. Information Disclosure Statement Submitted by Cooper March 28, 2008.

It is noted that the Information disclosure document providing the list of documents to be considered by the examiner has been submitted under seal. In order to have a proper record of the examiner's consideration of the cited documents and to have the documents

[16] In this context, the following are some examples of situations defining high threshold level of an "extraordinary situation" that "justice so requires" a waiver under § 1.183. *See e.g., Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D. D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of § 1.10(c) in order to grant filing date to patent application, where applicant failed to produce Express Mail customer receipt or any other evidence that application was actually deposited with USPS as Express Mail); *Nitto Chemical Industry. Co., Ltd. v. Comer*, No. 93-1378, 1994 U.S. Dist. LEXIS 19211, at *13-14 (D. D.C. Mar. 7, 1994) (Commissioner's refusal to waive requirements of § 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of § 1.10 is an 'avoidable' oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under § 1.183); *Vincent v. Mossinghoff*, 230 USPQ 621 (D. D.C. 1985) (Misunderstanding of § 1.8 not unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of § 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (Since certificate of mailing procedure under § 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation)." See PTO comments at 61 Fed. Reg. 56442-43.

printed on the reexamination certificate Cooper is called upon to provide a copy of the form listing of documents that is not submitted as protected matter.[17]

CONCLUSION

1. The February 29, 2008 petition under 37 C.F.R. 1.183 by third-party requester T&B to waive 37 C.F.R. 1.951(b) and to enter the replacement comments is dismissed.

2. The February 29, 2008 "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)" is refused entry into the record. The redacted version of the papers that have already been scanned into the Image File Wrapper (IFW) system will be expunged by marking them as "closed" and "non-public" to prevent any public access to the papers.

3. The version of the "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)" submitted by requester T&B under seal on February 29, 2008 are being returned herewith.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.

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

4-15-08
C:\kiva\kenpet6\ 95_209_petition & opposition to waive 951(b) for supplemental_draft.doc

[17] This assumes the documents are not found to be material, Should the examiner find the documents material they will be made public and they will be listed on the certificate even if no replacement is provided.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

29053 7590 04/16/2008

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R. Ross Viguet (For Patent Owner)
Fullbright & Jaworski L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, TX 75201-2784

Kevin W. Jakel (For Third Party Requester)
Kaye Scholer LLP
901 Fifteenth Street, N.W.
Washington, DC 20005

In re Meyer et al. : **DECISION ON**
Inter Partes Reexamination Proceeding : **PETITION UNDER**
Control No. 95/000,209 : **37 CFR 1.59(b) TO**
Filed: January 25, 2007 : **EXPUNGE MATERIAL**
For: U.S. Patent No. 6,984,791 : **SUBMITTED UNDER SEAL**

This is a decision on requester T&B's March 3, 2008 petition under 37 C.F.R. § 1.59(b) to expunge information submitted February 29, 2008 pursuant to MPEP 724.02.

The papers are before the Office of Patent Legal Administration.

The petition is **DISMISSED**.

BACKGROUND

On February 29, 2008, requester T&B submitted a paper titled "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," a petition to waive 37 CFR 1.951 and enter the supplemental comments, and two sealed envelopes with documents submitted in accordance with the procedures of MPEP 724.

On March 3, 2008, requester T&B filed a petition under 37 C.F.R. § 1.59(b) to expunge information submitted February 29, 2008 pursuant to MPEP 724.02. The March 3, 2008 petition is the subject of this decision.

DECISION

I. Expungement of the "Supplemental Comments" filed February 29, 2008

In a decision mailed on even date herewith, the February 29th papers titled "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)" are refused entry in the present reexamination proceeding and are being returned to requester T&B. Accordingly, the petition to expunge the supplemental comments is **DISMISSED** as moot.

II. Expungement of the Petition to Waive 37 CFR 1.951 filed February 29, 2008

As to the Petition to Waive 37 CFR 1.951, the petition to expunge the sealed version of that document is premature, because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified documents are considered to be "material." After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, the petition to expunge may be renewed by patent owner. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. In addition, the **requester is cautioned to call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued. A failure to timely call up the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

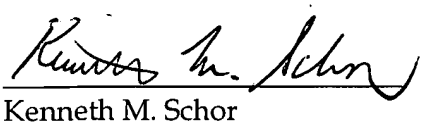
CONCLUSION

1. The petition to expunge the sealed version of the February 29, 2008 paper titled "Supplemental Third-Party Requester Comments Under 37 C.F.R. §1.951(b)," is **dismissed** as moot.

2. The petition to expunge the sealed version of the February 29, 2008 paper titled "Third-Party Requester's Petition Under 37 C.F.R. §1.183 to Waive 37C.F.R. §1.951(b) as to its One Opportunity Limitation," is **dismissed**.

3. The "Transmittal Letters Under M.P.E.P. §724" and the "Petition to Expunge Under 37 C.F.R. § 1.59(b)" submitted February 29, 2008 and March 3, 2008 respectively, have been entered in the record.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.



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

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29053 7590 06/24/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KEVIN W. JAKEL
KAYE SCHOLER LLP
901 FIFTEENTH STREET, NW
WASHINGTON, DC 20005

MAILED

JUN 24 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,209*.

PATENT NUMBER *6,984,791*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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(For Patent Owner)

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JUN 24 2008

CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
Kaye Scholer LLP
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Washington, DC 20005

(For Third Party Requester)

In re Meyer et al
Inter Partes Reexamination Proceeding
Control No. 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the December 21, 2007 patent owner petition titled "RESPONSE TO NOVEMBER 16, 2007, DISMISSAL OF PATENTEE'S PRIOR PETITION TO SUSPEND AND RENEWED PETITION UNDER 37 C.F.R. § 1.182 TO SUSPEND INTER PARTES PROCEEDING," (the "Petition"). In addition, on January 22, 2008, third party requester filed a paper titled "Requester's Petition Under 37 C.F.R. §1.182 in Opposition to Patentee's Response to November 16, 2007 Dismissal of Patentee's Prior Petition to Suspend and Renewed Petition Under 37 C.F.R. §1.182 to Suspend *Inter Partes* Proceeding" (the "Opposition").

The renewed patent owner petition, the requester opposition, and *inter partes* reexamination control number 95/000,209 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition is dismissed as moot.

RELEVANT BACKGROUND

1. U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al. on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper"). On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the '791 patent in the United States District Court for the Eastern District of Texas. [1]

2. An order was mailed on April 13, 2007, in reexamination control no. 95/000,209 ("the 209 proceeding"), granting *inter partes* reexamination for claims 1-30 of the '791 patent, based on a request filed by third-party requester T&B. Prosecution of the proceeding has progressed

[1] *Cooper Techs., Inc. v. Thomas & Betts Corp.*, No. 2:06cv242 (E.D. Texas June 14, 2006)

to the stage that an action closing prosecution ("ACP") was mailed on November 1, 2007, rejecting all pending claims of the '791 patent and setting a 30 day period for response.

3. Patent owner, Cooper, filed a petition requesting suspension of the '209 proceeding on June 26, 2007, and the requester, T&B, filed a petition in opposition to Cooper's petition on July 31, 2007. The Office mailed a decision dismissing the patent owner petition for suspension of the reexamination proceeding on September 5, 2007.

4. On September 19, 2007, Cooper filed a petition requesting reconsideration of the Office's September 5, 2007 decision, and T&B filed an Opposition to this request for reconsideration on October 19, 2007. On November 16, 2007, the Office mailed a decision dismissing the September 19, 2007 patent owner petition for suspension of the reexamination proceeding.

5. Cooper filed a renewed petition requesting suspension of the reexamination proceeding on December 21, 2007, and third party requester filed an Opposition to patent owner's petition on January 22, 2008.

6. The parties have filed multiple papers and petitions, resulting in many Office communications including eleven (11) decisions [2] on petitions and five (5) papers refusing entry of improper papers since February of 2008.

DECISION

I. Patent Owner's Renewed Petition for Suspension Filed December 21, 2007

Patent Owner Cooper filed a renewed request for suspension of the reexamination on December 21, 2007. This filing takes into account the direction provided in the Office's November 16, 2007 decision and attempts to address the issues raised therein.

Cooper sets forth, as the basis for suspension, that discovery will be conducted (in the related litigation) on "many critical issues common to this proceeding and the district court litigation."[3] In support of the petition, Cooper also has provided evidence as to activities undertaken to obtain discovery and what it expects to learn from such discovery.

The petition specifies [4] that discovery is set to conclude "no later than May 23, 2008," and it requests suspension of the reexamination proceeding until June 23, 2008, in order to allow the parties time to consider the discovered information and to provide any material evidence to the Office.

II. Third Party Requester's Opposition Filed January 22, 2008

Third Party Requester filed an opposition to Cooper's petition on January 22, 2008. T&B's submission opposes suspension and requests that the reexamination proceeding be carried out in accordance with the statutory mandate of special dispatch. T&B argues that Cooper, has not limited its renewed petition to the original basis of the request for suspension – i.e., the availability of the four disputed references as publications, but has now injected new

[2] Some of the decisions addressed more than one petition and more than one issue.
[3] Petition at 10.
[4] Petition at 3. and at 22.

issues into the latest request for suspension. In support of its opposition, T&B supplies documents to contest Cooper's characterization of the discovery efforts to date.

III. Analysis and Findings

As of the date of issuance of this decision, the period for which suspension was requested has passed. Cooper's petition for a suspension of action until June 23, 2008, is accordingly dismissed as moot.

CONCLUSION

1. The patent owner petition is dismissed.

2. Telephone inquires related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

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

06-24-08
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

29053 7590 08/20/2008

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000209	01/25/07	6984791	
71518/P001RE/10706444			

Kevin W. Jakal
c/o Kaye Scholer LLP
901 Fifteenth Street, NW
Washington, DC 2005

EXAMINER
FOSTER, ROLAND G.

ART UNIT	PAPER
3992	

DATE MAILED:

08/20/08

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

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(For Patent Owner)

MAILED

AUG 20 2008

CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
C/O KAYE SCHOLER LLP
901 FIFTEENTH STREET, NW
WASHINGTON, DC 20005

(For Third Party Requester)

PETITION DECISION
TO ACCEPT PAPERS
AS TIMELY FILED UNDER
37 CFR § 1.181 (a)(3)

In re Andrew E Meyer *et alia*
Inter partes Reexamination Proceeding
Control No. 95/000,209
Deposited: 25 January 2007
For: U.S. Patent No. 6,984,791

This is a decision on the 11 August 2008 patent owner "Petition Under 37 CFR § 1.181 To Acknowledge That Patent Owner's July 25, 2008 Notice of Appeal Was Timely Filed."

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

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

SUMMARY OF RELEVANT FACTS

1. On 10 January 2006 US Patent No. 6,984,791 was granted to Andrew E. Meyer *et alia.*

2. On 25 January 2007 a request was deposited requesting reexamination of US Patent No. 6,984, 791 by a Third Party Requester.

3. On 13 April 2007 the Order granting reexamination was mailed with a Non-Final Office action.

4. On 1 November 2007 an Action Closing Prosecution under 37 CFR § 1.949 was mailed.

5. On 25 June 2008 a Right of Appeal Notice under 37 CFR § 1.953 was mailed.

6. On 11 August 2008 the patent owner "Petition Under 37 CFR § 1.181 To Acknowledge That Patent Owner's July 25, 2008 Notice of Appeal Was Timely Filed." was received by the USPTO.

DISCUSSION

On 11 August 2008 the Patent Owner petitioned the director of the Central Reexamination Unit under 37 CFR § 1.181 to acknowledge and accept as timely the Patent Owner's 25 July 2008 Notice of Appeal as being timely filed. The Patent Owner provided supporting evidence in the form of the Transmittal Form, Notice of Appeal with appropriate fees, a copy of the certificate of service, a copy of the date stamped "Express Mail" label date stamped by the USPS on 25 July 2008, and the USPS tracking form indicating that the papers were signed for by USPTO employee S. Dyar.

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.

§ 1.10 Filing of correspondence by "Express Mail." (in part)

(a)

(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date in" on the "Express

Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

....

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office o Addressee" service prior to the last scheduled pickup for that day; and,

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

On balance the Patent Owner has provided all the required documentation to support a decision by the Director of the CRU to accept the mailing date and papers as timely filed by the Patent Owner, as required pursuant to 37 CFR § 1.10(e). The Patent Owner has provided with the petition filed 11 August 2008 under 37 CFR § 1.181 the "Express Mail" label date stamped by the USPS carrying the mailing date of 25 July 2008. Evidence that the correct fees were included in the original correspondence mailed on 25 July 2008 were included.

Lastly, the Patent Owner provided the Track and Confirm documentation from the USPS indicating that the "Express Mail" was deposited on Friday, 25 July 2008 and that the papers were received by S. Dyar on the USPTO on Monday, 28 July 2008, one business day following the deposit into the USPS.

As such the Notice of Appeal filed on 25 July 2008 will be accepted as timely filed. Because the original check provided in the papers mailed was not received by the USPTO the appropriate fees will be charged to the deposit account provided in the petition filed 11 August 2008.

CONCLUSION

1. The patent owner's petition filed under 37 CFR § 1.181 to acknowledge the Patent Owners Notice of Appeal as timely filed is hereby **granted.**

2. The Patent Owner' deposit account will be charged for the Notice of Appeal fee.

3. The time for filing a Patent Owner's Appeal Brief continues to run from the date of the mailing of the Notice of Appeal **25 July 2008**.

4. Future correspondence may be submitted as follows:

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

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

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

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

/Mark Reinhart/ for

_____

Gregory Morse,
Director,
Central Reexamination Unit

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2200 Ross Avenue
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Dallas, TX 75201-2784

(For patent owner)

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NOV 18 2008

CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
c/o Kaye Scholer LLP
901 15th Street, N. W.
Washington, DC 20005

(For Requester)

In re Andrew E. Meyer et al	:	
Inter Partes Reexamination Proceeding	:	DECISION
Control No.: 95/000,209	:	GRANTING
Filed: January 25, 2007	:	PETITION
For: U.S. Patent No. 6,984,791	:	
	:	

This is a decision addressing the October 16, 2008 patent owner petition styled as "Petition Under 37 C.F.R. §1.181 (or Alternatively Under 37 C.F.R. § 1.182) to Seal or Strike From Public View the Third party Requester's October 10, 2008 Cross Appeal Brief" ("the patent owner petition"). This decision also addresses the October 24, 2008 third party requester petition entitled "Requester's Petition Under 37 C.F.R. § 1.182 (or Alternatively Under 37 C.F.R. § 1.183) in Response to Patent Owner's October 16, 2008 Petition" ("the requester opposition paper"). Patent owner has also filed a petition on October 29, 2008 directed to the October 24, 2008 requester opposition paper. The October 29, 2008 patent owner petition ("the opposition petition") will be treated in a separate decision.

The October 16, 2008 patent owner petition, the third party requester opposition paper, and *inter partes* reexamination control number 95/000,209, are before the Office of Patent Legal Administration for decision.

FEES

The present patent owner petition requests relief (to strike or seal a party paper) that is not provided for by the regulations. Accordingly, the petition is being taken as a petition pursuant to 37 CFR 1.182, a rule that provides for treatment by way of petition

in "all situations not provided for" by Part I of Title 37 of the Code of Federal Regulations. If necessary, the patent owner petition is also taken pursuant to 37 CFR 1.183, a rule that would authorize waiver of any rule precluding the filing of the present patent owner petition. Petitioner patent owner has authorized a charge against a Deposit Account No. 06-2380 of "any fee determined to be necessary" for the present petition. Accordingly a single petition fee of $400.00 as established by 37 CFR 1.17(f) will be charged to Deposit Account No. 06-2380.

The requester opposition paper requests relief under 37 CFR 1.182, or, in the alternative, under 37 CFR 1.183. Requester has remitted a check for $400.00, which is the required single petition fee.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,984,791 ("the '791 patent") issued on January 10, 2006.

2. The papers requesting *inter partes* reexamination of the '791 patent were deposited by a third party requester on December 21, 2006, and were assigned control No. 95/000,209.

3. The request papers were deemed to be informal, and a substitute request for *inter partes* reexamination of the '791 patent was filed by the third party requester on January 17, 2007, accepted as proper, and accorded a filing date of January 17, 2008 as the date of filing of the request.

4. Reexamination was ordered in *inter partes* reexamination control No. 95/000,209 ("the '209 reexamination proceeding") on April 13, 2007.

5. Prosecution progressed to the point when on November 1, 2007, the Office issued an Action Closing Prosecution.

6. On June 25, 2008, the Office mailed a Right of Appeal Notice ("RAN") whereby the patent owner and the third party requester were notified of their entitlement to each file a notice of appeal to the Board of Patent Appeals and Interferences within one month or thirty days from the date of the RAN. The RAN also notified the parties that if one party filed a notice of appeal within the one month or thirty day period, the other party was entitled to file a notice of cross appeal within fourteen days of service of the opposing party's filing of its notice of appeal.

7. On July 25, 2008, patent owner filed a Notice of Appeal from the rejection of patent claims 1-30, together with the appeal fee.

8. It then appeared that the Office had not properly received, or had received but then mishandled, patent owner's notice of appeal. Accordingly, patent owner filed a petition on August 11, 2008, supported by copies of the July 25, 2008 papers requesting acceptance of the July 25, 2008 notice of appeal, and acknowledgement

of that acceptance by the Office. The papers attached to the petition included a Certificate of Service stating that patent owner had served a copy of the notice of appeal on third party requester on July 25, 2008. [1]

9. On August 1, 2008, third party requester filed a Notice of Cross Appeal from the examiner's decision to not adopt certain claim rejections that had been proposed by third party requester.

10. On August 20, 2008, the Office mailed a decision granting the July 25, 2008 patent owner petition. The decision accepted July 25, 2008 as the filing date of patent owner's Notice of Appeal. [2]

11. On October 1, 2008, patent owner filed its "Appeal Brief of Patent Owner Cooper Technology Company" ("Appeal Brief").

12. On October 10, 2008, third party requester filed its "Cross Appeal Brief of Requester Thomas & Betts Corporation" ("Cross Appeal Brief").

13. On October 16, 2008, patent owner filed the present petition to seal or strike requester's Cross Appeal Brief.

14. On October 24, 2008, requester filed the present requester opposition paper.

RELEVANT AUTHORITY

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.953(a) provides:

> 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

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[1] See: Exhibit A, attached to the patent owner petition filed on August 11, 2008.

[2] See: "Petition Decision to Accept Papers as Timely Filed ... ," page 1 and page 4, second paragraph.

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.

37 CFR 1.959 provides:

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

Subpart C of Part 41 of Title 37 of the Code of Federal Regulations is entitled "*Inter Partes* Appeals and includes the following relevant rules:

37 CFR 41.60 provides, in part:

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.

...

Owner means the owner of the patent undergoing *inter partes* reexamination under § 1.915 of this title.

...

Requester means each party, other than the owner, who requested that the patent undergo *inter partes* reexamination under § 1.915 of this title.

...

37 CFR 41.61 provides, 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.

...

(e) The time periods for filing a notice of appeal or cross appeal may not be extended.

...

37 CFR 41.66 provides, in part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for

filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.
(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.
...

DECISION

I. Preliminary Discussion

Following acceptance of a corrected request for *inter partes* reexamination on January 25, 2007, reexamination was ordered for claims 1-30, (*i.e.*, all of the claims), of the '791 patent. Prosecution progressed to the point where a RAN (37 CFR 1.953(a)) was mailed by the Office on June 25, 2008. The RAN triggered the right of the patent owner to appeal from the rejection of claims pending in the '209 reexamination proceeding by filing a notice of appeal. [3] Similarly, the RAN triggered the right of the requester to appeal from the examiner's holding favorable to claim patentability, including a refusal to adopt any claim rejection that had been proposed by the third party requester, by filing a notice of appeal. [4] Pursuant to 37 CFR 41.61(b)(1) and (2), where either party was the first to timely file a notice of appeal as provided in either of 37 CFR 41.61(a) or (b), the other party had a period of fourteen days running from the date of service of the first filing party's notice of appeal in which to file its notice of appeal. [5]

On July 25, 2008, patent owner filed its Notice of Appeal, together with a Certificate of Service dated July 25, 2008 that evidenced service of patent owner's Notice of Appeal on requester. However, it appears from the record that the patent owner's July 25, 2008 filing was received in the Office, but was misplaced. These facts are set forth in the patent owner petition filed on August 11, 2008, which includes evidence showing that the patent owner had deposited such papers (the notice of appeal, a check for the appeal fee, a certificate of service, a transmittal form and a return receipt post card) with the United States Postal Service as Express Mail Post Office to Addressee ("Express Mail") on July 25, 2008, and that the papers had arrived at the Office on July 28, 2008. [6] In a Decision on Petition dated August 20, 2008, the Director of the Central Reexamination Unit (the "CRU") accepted patent owner's showing. [7] The decision specifically noted that the patent owner's notice of appeal was considered to have been filed on July 25, 2008, in accordance with the provisions of 37 CFR 1.10, a regulation governing the filing of correspondence with the Office utilizing Express Mail. [8]

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[3] See: 37 CFR 41.61(a)(1)

[4] See: 37 CFR 41.61(a)(2)

[5] The party filing the first notice of appeal is deemed be the appellant and is said to have filed a notice of appeal, while the party filing second is deemed to have filed a notice of cross appeal. See: 37 CFR 41.60 & 41.61(b)(1) and (2). For purposes of filing an appellant brief and the present petition, the order of filing of the appeals and the terminology attaching to a party by reason of the order of filing are not relevant.

[6] A printout of a Track & Confirm page for the Express Mail filing was submitted as part of the August 11, 2008 petition. The petition also included a Certificate of Service on the requester, which was dated August 11, 2008.

[7] The August 20, 2008 Decision on Petition was signed by a supervisor in the CRU as delegated by the CRU Director.

[8] See: "Petition Decision to Accept Papers as Timely Filed Under 37 CFR § 1.181(a)(3), August 20, 2008 and in particular, pages 2-3 and Conclusion No. 3.

On August 1, 2008, the requester filed its notice of appeal. Significantly, the August 1, 2008 filing by requester was styled as "Notice of Cross Appeal From the Examiner to the Board of Patent Appeals and Interferences." It appears, therefore, that requester had recognized that, pursuant to the provisions of 37 CFR 41.60 and 41.61(b)(2), it was filing a "notice of cross appeal" because requester had in fact received service of the July 25, 2008 patent owner Notice of Appeal that had been mailed to the Office on that date via Express Mail.

37 CFR 41.66(a) provides that the time for each party to file its appellant's brief is two months from the date of the last-filed notice of appeal or cross appeal. [9] As patent owner has filed its Notice of Appeal on July 25, 2008, and requester had filed its Notice of Cross Appeal on August 1, 2008, the last-filed notice of appeal was filed by requester on August 1, 2008. Therefore, pursuant to 37 CFR 41.66(a), the last day for both parties to file their respective appellant's briefs was October 1, 2008. Patent owner filed its appellant's brief on October 1, 2008. [10] However, requester's appellant's brief was not filed until October 10, 2008. Requester's appellant's brief was thus not timely filed within the time set by 37 CFR 41.66(a). [11]

Patent owner's petition takes the position that the requester's Cross Appeal Brief should be stricken/sealed from public view because it was not timely filed. Requester's opposition paper argues that its Cross Appeal Brief was timely filed in accordance with 37 CFR 41.66(a), because it was filed two months from the filing date (August 11, 2008) of the "last-filed" notice of appeal. In the alternative, requester seeks waiver under 37 CFR 1.183 of the rules to accept its Cross Appeal Brief as having been timely filed, based on the two notices of appeal filed by patent owner having "created an unusual and confusing circumstance that meets the meaning of the extraordinary situation requirements of 37 CFR 1.183."[12]

II. Requester's Cross Appeal Brief Was Not Timely Filed

It is clear from the facts, as discussed in Section I., *supra*, that patent owner did not in fact file two notices of appeal, despite requester's argument that its Cross Appeal Brief was in fact timely filed because the patent owner filed a "second" notice of appeal on August 11, 2008. Requester's arguments notwithstanding, the record clearly shows that patent owner filed only a single notice of appeal, and that patent owner's Notice of Appeal was filed on July 25, 2008 pursuant to the provisions of 37 CFR 1.10. The record

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[9] The rule also provides for the circumstance in which only one of the parties files a notice of appeal, a circumstance not relevant in this proceeding.

[10] Those papers have been marked "closed" pending a formalities review by the CRU. It is noted for example, that the brief may exceed the permitted number of pages for an appellant's brief, and does not appear to have been accompanied by a certificate stating the number of words in the brief. See: 37 CFR 1.943(c).

[11] Requester's appellant's brief has been marked "closed" pending the present decision, and if necessary, a formalities review by the CRU for compliance with requirements of 37 CFR 1.943(c) and other matters of form.

[12] "Requester's Petition Under 37 C.F.R. § 1.182 (or Alternatively, Under 37 C.F.R. § 1.183) ... ," October 24, 2008, page 2, last paragraph.

contains a Decision on Petition mailed by the Office on August 20, 2008 so holding. The record also clearly shows that requester was quite aware that patent owner filed a notice of appeal on July 25, 2008, as evidenced by both the included Certificate of Service and by requester having styled its own notice of appeal filed on August 1, 2008, as a Notice of Cross Appeal. If requester had not believed that there had been a filing by patent owner of a notice of appeal prior to the filing of requester's notice of appeal, the requester would not have styled its notice of appeal as a Notice of Cross Appeal. [13] Moreover, if patent owner had not filed its notice of appeal prior to the filing of requester's notice of appeal, requester's August 1, 2008 appeal would itself have been untimely filed, since requesters Notice of Cross Appeal was would have been the first filed notice of appeal, but was filed more than one month after the June 25th RAN was issued by the Office.

Thus, a review of the present record compels a conclusion that patent owner did not file two notices of appeal as alleged by requester, but instead filed a Notice of Appeal on July 25, 2008 that had been misplaced in the Office and then was replaced by a copy of that Notice of Appeal, which was accorded a filing date of July 25, 2008. Further, a review of the record also compels a conclusion that requester was well aware of this circumstance, and should have been aware that the Office had treated the copy of the July 25, 2008 notice of appeal and associated papers that were attached to the August 11, 2008 petition as part of a showing that patent owner had originally filed those items on July 25, 2008. Certainly, such was clearly stated in the August 20, 2008 Decision on Petition. [14] Since patent owner filed but one notice of appeal, which was accorded a date of July 25, 2008, and requester filed but one notice of (cross) appeal, which was accorded a date of August 1, 2008, it is clear that the last-filed notice of appeal was filed on August 1, 2008. Accordingly, requester's Cross Appeal Brief, filed on October 10, 2008, was not timely filed within the period set by 37 CFR 41.66(a), because it was filed more than two months after the last filed notice of appeal.

III. Requester Has Not Demonstrated That the Rules Should Be Waived To Accept Requester's Cross Appeal Brief As Having Been Timely Filed

37 CFR 41.66(e) provides that the time period for filing an appellant's brief in an *inter partes* reexamination proceeding will not be extended. Accordingly, waiver of that provision would be required for the Office to accept requester's October 10, 2008 cross appeal brief as having been timely filed. Although requester points out that patent owner filed two notices of appeal, causing confusion that now warrants waive of the rules to accept requester's Cross Appeal Brief as having been timely filed, [15] requester does not present any compelling arguments in support of this position.

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[13] Further, requester has not alleged that it was not served with a copy of the notice of appeal filed by patent owner on July 25, 2008, or that it was not in receipt of a copy of the August 20, 2008 Decision on Petition which quite clearly states that patent owner's July 25, 2008 notice of appeal and appeal papers had been initially misplaced, but that patent owner had demonstrated that those papers had in fact been mailed via Express Mail and had been accorded a July 25, 2008 filing date.

[14] See note 2, *supra*.

[15] See note 12, *supra*.

Requester's reliance on the fact that the parties in the present reexamination proceeding "calculated different due dates for filing their respective appellant's briefs based upon whether the 'last filed' appeal notice was the August 1, 2008 Notice of Cross Appeal or the August 11, 2008 Notice of Appeal" [16] speaks only to the fact that requester did not properly calculate the proper due date for filing its appellant's brief (i.e., requester's Cross Appellant's Brief filed on October 10, 2008. Miscalculation of a due date during the prosecution of proceedings in the Office is, unfortunately, something that is not a rare occurrence, and is hardly an unusual or extraordinary circumstance. Such a miscalculation is addressed by a petition to revive where a date is missed by a patent owner. Unfortunately, there is no statutory basis for a requester's filing of a petition to revive.

Requester's reliance on the failure of the August 20, 2008 Decision on Petition to specifically "address the time period for filing *Requester's* Cross Appeal Brief" is equally unpersuasive. The August 20, 2008 Decision on Petition dealt with the issue of the filing of patent owner's notice of appeal, where it appeared that such had not been received by the Office. Patent owner had been contacted by Office technical support personnel with respect to whether patent owner had filed its notice of appeal. [17] Pursuant to the provisions of 37 CFR 1.10, patent owner then filed a petition to obtain a filing date of July 25, 2008, for the Notice of Appeal that it had in fact filed on July 25, 2008. The Office issued a Decision on Petition on August 20, 2008 that addressed the relief requested by patent owner, and simply accorded a filing date of July 25, 2008 to the patent owner's notice of appeal. Additionally, the requester was aware of the August 20, 2008 Decision on Petition accepting the filing date of patent owner's notice of appeal as July 25, 2008, well before an appeal brief was due. At that point in the matter, the date for both parties to file their respective appellant's briefs became fixed by operation of 37 CFR 41.66(a) as being October 1, 2008, *i.e.*, two months from the filing date of the last-filed notice of appeal, which in this instance, was August 1, 2008, the date on which requester had actually filed its own notice of cross appeal. Again, it is to be noted that requester styled its notice of appeal as a Notice of Cross Appeal. That requester failed to understand or appreciate that its Notice of Cross Appeal was the second-filed notice of appeal in the '209 reexamination proceeding, (with the first filed notice of appeal being patent owner's July 25, 2008 Notice of Appeal), is not persuasive to establish an extraordinary situation.

It is further to be noted that utilization of the procedures under 37 CFR 1.10, including the filing of a petition necessary to secure the proper filing date for papers filed under those procedures, is hardly an unusual circumstance so as to create an extraordinary situation warranting a waiver of the rules. Indeed, it is simply not the case that a registered practitioner would reasonably consider the filing of a second copy of a paper (or of an entire patent application) as part of a showing that a first copy of the paper (or application) was entitled to an earlier date pursuant to the provisions of 37 CFR 1.10 to be a first and second filing of the same paper (or application).

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[16] *Id.*, at page 3, first sentence.

[17] "Petition Under 37 C.F.R. § 1.181 to Acknowledge that Patent Owner's July 25, 2008 Notice of Appeal was Timely Filed," August 11, 2008, page 2.

The decision in *In re Reck*, 227 USPQ 488 (Comm'r Pat. 1985) is instructive with respect to facts analogous to those presented by the present patent owner petition and requester opposition paper. In *Reck*, following a decision in an *ex parte* reexamination proceeding by the Board of Patent Appeals and Interferences ("BPAI") affirming the examiner's rejection of all patent claims, patent owner Akzona failed to file a request under 37 CFR 1.197(b) for rehearing of the BPAI's decision. The failure to file either a request for rehearing, or a request for extension of the time in which to file a request for rehearing, resulted in the mailing by the Office of a Notice of Intent to Issue Reexamination Certificate ("NIRC"). Akzona petitioned for relief, requesting that no Reexamination Certificate be permitted to issue pursuant to the NIRC until it filed its request for rehearing under 37 CFR 1.197(b). Akzona's petition was considered under the provisions of 37 CFR 1.182, but that petition was denied.

Patent owner Akzona then petitioned for reconsideration, requesting entry of a petition for rehearing filed together with the petition for reconsideration. In the petition for reconsideration, patent owner requested waiver of the provisions of 37 CFR 1.197(b) and 1.550(c). The Assistant Commissioner for Patents noted that Akzona now acknowledged that it had erred in its belief that it could secure an extension of time under 37 CFR 1.136 for filing its request for rehearing. Akzona relied on its mistake in understanding the rules to establish an extraordinary situation where justice required waiver of the rules.

The Assistant Commissioner for Patents denied the petition for reconsideration, holding that:

> Counsel's apparent oversight with respect to §1.136 and unawareness with respect to §§ 1.197(b) and 1.1550(c) does not make this an extraordinary situation for a grant of the relief sought. Compare *Nugent v. Yellow Cab Co.*, 295 F.2d 794 (7th Cir. 1961) cert denied, 369 U.S. 828 (1962) (counsel's mistake in overlooking and not being aware of rule not basis for waiving rule); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978) (Markey C.J. CCPA sitting on designation) (unawareness of PTO rules is no basis for finding unavoidable delay); and *Williams v. The Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (Citing Nugent v. Yellow Cab Co., *supra*, attorney neglect due to absence from office, pressure of other work, etc. not excusable neglect). Counsel is presumed to know the rules. Compare *In re Jones*, 542 F.2d 65, 68, 191 USPQ 249, 252 (CCPA 1976) (attorneys appearing before Court are presumed to have knowledge of the provisions of the current rules). It follows, then, that Akzona's oversight and unawareness do not establish that justice requires waiver of any provisions of § 1.550(c) and (d). See *In re Sivertz*, 227 USPQ 255, Reexamination 90/000,286 (Comm'r Pat. 1985). [18] [Emphasis added.]

The Assistant Commissioner for Patents also addressed arguments by Akzona:

> (1) that justice requires that the present petition be granted in order to ensure complete and thorough review of the claims before relinquishing previously granted rights and (2) that justice would be frustrated by termination of the reexamination based solely on a procedural error rather than on the merits and patentees substantive arguments and evidence. [19]

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[18] 227 USPQ at 489.

[19] Id.

The Assistant Commissioner for Patents held those arguments to be:

> ... unacceptable insofar as they assumed that the merits of Akzona's claims were denied a complete and thorough review by the examiner and board. Moreover, it would be incumbent upon Akzona to present all of its arguments and evidence before the PTO tribunals within the allotted time periods. A request for untimely presentation of arguments and evidence in this case would be incompatible with the practice of expeditious resolution of reexamination cases. Compare *Richards v. Kletzer*, 1902 C.D. 62 (Comm'r 1902). See also 35 U.S.C. § 305 and 37 CFR §1.550(a). [20]

As in *Reck*, it is not seen that counsel's mistake in failing properly understand the record and the rules governing the filing of its notice of appeal warrants waiver of the rules in the interest of justice. Requester, via counsel, is presumed to know the rules. Further, requester had sufficient time (following receipt of the Decision on Petition dated August 21, 2008) to seek clarification as to the deadline for filing its Cross Appeal Brief, if there was any uncertainty or doubt as to how the circumstances attendant to the filing of patent owner's July 25, 2008 Notice of Appeal would bear on the interpretation of 37 CFR 41.66(a) to establish the due date for filing of requester's Cross Appeal Brief. [21] Therefore, requester is not entitled to entry of its Cross Appeal Brief based upon a waiver of the provisions of the rules.

III. Patent Owner is Entitled to Have Requester's Cross Appeal Brief Sealed

Patent owner has requested requester's Cross Appeal Brief be stricken from the record, or sealed. As discussed in Section II., supra, it has been determined that requester's Cross Appeal Brief is not entitled to consideration in the '209 reexamination proceeding, because it was not timely filed and the facts do not establish a sufficient basis to support waiver of the rules in order to do so.

Requester has confined its arguments in the opposition paper to addressing the issue of whether its Cross Appeal Brief was timely filed, and if not, why the rules should be waived to admit the Cross Appeal Brief into the record. Requester has not advanced any logical basis for permitting a non-entered document in which substantive arguments bearing on issues in the '209 reexamination proceeding to be subject to public scrutiny. Requester has merely asserted that patent owner is, by its petition, "attempting to block Requester's right to cross appeal," without "lack of prejudice" to patent owner. [22] First, it is noted that the '209 reexamination proceeding is open to the public, and that the Cross Appeal Brief contains substantive arguments by requester directed to patentability issues. Accordingly, there does appear to be prejudice to patent owner to the extent that arguments raised by third party requester, which are otherwise not entitled to entry into the public record, would be permitted to remain in the public record. Second, it is not patent owner who has blocked entry of requester's Cross Appeal Brief into the record. Rather, it is the fact that the Cross Appeal Brief was

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[20] Id.

[21] While 37 CFR 1.955 precludes any interviews in *inter partes* reexamination proceedings directed to the merits of the proceeding, the rule does not preclude a party for seeking procedural guidance in general that is not directed to substantive patentability issues.

[22] "Requester's Petition Under 37 C.F.R. § 1.182 (or Alternatively, Under 37 C.F.R. § 1.183) ... ," October 24, 2008, page 3, last paragraph.

not timely filed, and the fact that no extraordinary circumstance warranting waiver of the rules to permit entry of the Cross Appeal Brief exists, which have "blocked" entry of the Cross Appeal brief. Further, as discussed in Section I, note 9, *supra*, requester's Cross Appeal Brief does not comply with the limitation on the number of pages permitted for an appellant's brief in an *inter partes* reexamination proceeding that is established by 37 CFR 1.943(c). Accordingly, requester's Cross Appeal Brief is being sealed by marking the same "closed" and "non-public" so that the papers are inaccessible to the public and are not considered as having been entered into the official record of the '209 reexamination proceeding. [23]

CONCLUSION

1. The patent owner petition to seal requester's Cross appeal brief is granted.

2. The third party opposition paper is dismissed.

3. Patent owner's Appeal Brief is also being sealed, pending a formalities review by Central Reexamination Unit personnel.

4. As papers cannot be physically removed from an electronic Image File Wrapper the respective party appeal briefs are being "sealed" by coding the papers "closed" and "non-public." The "sealed" briefs do not form any part of the official record of the '209 reexamination proceeding.

5. The '209 reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for further review not inconsistent with this decision.

6. Telephone inquiries related 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

11-13-08
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[23] It should further be noted that patent owner's Appeal Brief has also been sealed pending review by the CRU for compliance with formatting requirements. See: Section 1, notes 8 and 9. The Appeal Brief and the Cross Appeal Brief may be "unsealed" electronically if it is demonstrated that the party having filed a sealed brief is entitled to have its brief entered into the record.

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95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

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EXAMINER	
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(For Patent Owner)

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NOV 21 2008

CENTRAL REEXAMINATION UNIT

Kevin W. Jakel
Kaye Scholer LLP
901 15th Street, N. W.
Washington, DC 20005

(For Requester)

In re Andrew E. Meyer et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

DECISION DISMISSING PETITION

This is a decision on the patent owner's November 7, 2008 "Petition for Extension of Time Under 37 C.F.R. § 1.956." This decision also addresses patent owner's November 7, 2008 "Petition Under 37 C.F.R. § 1.183 to Provide a One Month Period for Filing a Respondent's Brief from any Decision to Enter the Third Party Requester's Untimely Cross Appeal Brief."

The patent owner petitions and *inter partes* reexamination control number 95/000,209, are before the Office of Patent Legal Administration for decision.

FEES

Patent owner has remitted the $200.00 fee required for an extension of time under 37 CFR 1.956. See: 37 CFR 1.17(g). Patent owner has also remitted the $400.00 petition fee required for a petition for relief under 37 CFR 1.183. See: 37 CFR 1.17(f).

BACKGROUND

U.S. patent No. 6,984,791 ("the '791 patent") issued to Andrew E. Meyer et al. on January 10, 2006, and is currently assigned to Cooper Technologies, Inc. ("Cooper").

On June 14, 2006, Cooper filed suit against Thomas and Betts Corporation ("T&B") for infringement of the "791 patent in the United States District Court for the Eastern District of Texas.

An order in reexamination control no. 95/000,209 ("the '209 reexamination proceeding") granting *inter partes* reexamination for claims 1-30 of the '791 patent, based on a request filed by a third party requester, was mailed on April 13, 2007. Prosecution of the '209 reexamination proceeding then progressed to the stage that a Right of Appeal Notice ("RAN"), was mailed on November 1, 2007. Thereafter, the parties each filed a notice of appeal (37 CFR 41.61) and an appellant's brief (37 CFR 41.66).

On October 16, 2008, patent owner filed a petition to strike or seal the requester's appellant's brief ("requester's Cross Appeal Brief") as having been untimely filed. That petition set forth patent owner's analysis of the facts and the governing rules, and patent owner's conclusions based thereon. On October 24, 2008, requester filed an opposition petition directed to rebutting the October 16, 2008 patent owner petition. On October 29, 2008, patent owner filed a petition in opposition to the requester's opposition.

However, patent owner recognized that a decision on the October 16, 2008 petition to strike or seal requester's Cross Appeal Brief might not be granted, and that a decision refusing to strike or seal requester's Cross Appeal Brief might not be mailed early enough to provide patent owner sufficient time to file a respondent's brief addressing requester's Cross Appeal Brief on its merits. Accordingly, on November 7, 2008, patent owner filed the present petition for extension of time. In that petition, patent owner requests an extension of time that would provide patent owner with a one month period of time running from the date of entry into the record of requester's Cross Appeal Brief in which to file a respondent's brief directed to requester's October 10, 2008 Cross Appeal Brief as provided for by 37 CFR 41.68. Patent owner also recognized that 37 CFR 41.66(b) precludes granting an extension of time in which to file a respondent's brief. Therefore, patent owner also filed a petition on November 7, 2008 requesting waiver of the provisions of 37 CFR 41.66(b).

DECISION

On November 18, 2008, the Office mailed a paper entitled "Decision Granting Petition" in which patent owner's October 16, 2008 petition to strike or seal requester's Cross Appeal Brief was granted. In light of the fact that the requester's Cross Appeal Brief has not been entered into the record, the present patent owner petition to extend the time for filing a respondent's brief directed to the Cross Appeal Brief, and the present patent owner petition to waive the rules so as to permit such an extension of time, are moot.

FURTHER DISCUSSION

Patent owner should note that the November 18, 2008 "Decision on Petition" has not been designated as a final agency action under 5 U.S.C. § 704. Accordingly third party requester has a right to file a renewed petition. In the event that the October 24, 2008 third party requester Cross Appeal Brief is subsequently entered into the record, patent owner would be entitled to file a renewed petition under 37 CFR 1.183, together with the fee therefor, seeking waiver of the provisions of 37 CFR 41.66(b) so as to provide patent owner with a period of one month from the date of any decision directing entry of requester's October 10, 2008 Cross Appeal Brief into the record in which patent owner may file a respondent's directed to that Cross Appeal Brief. Patent owner need not file a separate petition for an extension of time.

CONCLUSION

1. The November 7, 2008 patent owner petition for an extension of time under 37 CFR 1.956 is dismissed as moot.

2. The November 7, 2008 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.956 is dismissed as moot.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Senior Legal Advisor, at (571) 272-7743, or 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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MAILED (For patent owner)
DEC 08 2008
CENTRAL REEXAMINATION UNIT

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Washington, DC 20005

(For Requester)

In re Andrew E. Meyer et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

: DECISION GRANTING PETITION
: TO WAIVE PAGE LIMITS FOR
: PATENT OWNER APPELLANT BRIEF
: AND
: DECISION DISMISSING REQUESTER
: PETITION TO STRIKE PATENT
: OWNER APPELLANT BRIEF

This is a decision addressing the November 26, 2008 patent owner petition entitled "Petition Under 37 C.F.R. §1.183 to Waive the Page and Word Limits of 37 CFR 1.943(c) with Respect to the Appeal Brief of Patent Owner Cooper Technology Company Filed October 1, 2008" ("the patent owner petition"). This decision also addresses the November 26, 2008 third party requester petition entitled "Requester's Petition Under 37 C.F.R. § 1.182 to Find Patent Owner's Appeal Brief an Unauthorized Paper Under 37 C.F.R. § 1.943(c)" ("the requester petition").

The November 26, 2008 patent owner petition, the requester petition, and *inter partes* reexamination control number 95/000,209, are before the Office of Patent Legal Administration for decision.

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FEES

Patent owner has authorized a charge against a Deposit Account No. 06-2380 for the $400.00 petition fee (37 CFR 1.17(f) for its 37 CFR 1.183 petition. Requester has remitted a check for the $400.00 petition fee (37 CFR 1.17(f) for its 37 CFR 1.182 petition.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,984,791 ("the '791 patent") issued on January 10, 2006.

2. The papers requesting *inter partes* reexamination of the '791 patent were deposited by a third party requester on December 21, 2006, and were assigned control No. 95/000,209.

3. The request papers were deemed to be informal, and a substitute request for *inter partes* reexamination of the '791 patent was filed by the third party requester on January 17, 2007, accepted as proper, and accorded a filing date of January 17, 2008 as the date of filing of the request.

4. Reexamination was ordered in *inter partes* reexamination control No. 95/000,209 ("the '209 reexamination proceeding") on April 13, 2007.

5. Prosecution progressed to the point when on November 1, 2007, the Office issued an Action Closing Prosecution.

6. On June 25, 2008, the Office mailed a Right of Appeal Notice ("RAN") whereby the patent owner and the third party requester were notified of their entitlement to each file a notice of appeal to the Board of Patent Appeals and Interferences within one month or thirty days from the date of the RAN. The RAN also notified the parties that if one party filed a notice of appeal within the one month or thirty day period, the other party was entitled to file a notice of cross appeal within fourteen days of service of the opposing party's filing of its notice of appeal.

7. On July 25, 2008, patent owner filed a Notice of Appeal from the rejection of patent claims 1-30, together with the appeal fee.

8. It then appeared that the Office had not properly received, or had received but then mishandled, patent owner's notice of appeal. Accordingly, patent owner filed a petition on August 11, 2008, supported by copies of the July 25, 2008 papers requesting acceptance of the July 25, 2008 notice of appeal, and acknowledgement of that acceptance by the Office. The papers attached to the petition included a Certificate of Service stating that patent owner had served a copy of the notice of appeal on third party requester on July 25, 2008.[1]

9. On August 1, 2008, third party requester filed a Notice of Cross Appeal from the examiner's decision to not adopt certain claim rejections that had been proposed by third party requester.

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[1] See: Exhibit A, attached to the patent owner petition filed on August 11, 2008.

10. On August 20, 2008, the Office mailed a decision granting the July 25, 2008 patent owner petition. The decision accepted July 25, 2008 as the filing date of patent owner's Notice of Appeal. [2]

11. On October 1, 2008, patent owner filed its "Appeal Brief of Patent Owner Cooper Technology Company" ("Appellant Brief").

12. On October 10, 2008, third party requester filed its "Cross Appeal Brief of Requester Thomas & Betts Corporation" ("Cross Appellant Brief").

13. On October 16, 2008, patent owner filed a petition to seal or strike requester's Cross Appellant Brief, alleging that the Cross Appellant Brief had not been timely filed.

14. On October 24, 2008, requester filed a paper opposing the October 16, 2008 patent owner petition.

15. On November 18, 2008, the Office mailed a decision granting the October 16, 2008 patent owner petition and dismissing the October 24, 2008 requester opposition petition.

16. On November 26, 2008, patent owner filed the present petition to waive the page and word limits of 37 CFR 1.943(c) with respect to its October 1, 2008 Appellant Brief.

17. Also on November 26, 2008, requester filed the present petition to have the Office treat the October 1, 2008 patent owner Appellant Brief as an unauthorized paper.

RELEVANT AUTHORITY

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.943(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

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[2] See: "Petition Decision to Accept Papers as Timely Filed ... ," page 1 and page 4, second paragraph.

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.

37 CFR 1.953(a) provides:

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.

37 CFR 1.957(d) provides:

When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

37 CFR 1.959 provides:

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

DECISION

I. Preliminary Discussion

Following acceptance of a corrected request for *inter partes* reexamination on January 25, 2007, reexamination was ordered for claims 1-30, (*i.e.*, all of the claims), of the '791 patent. Prosecution progressed to the point where a RAN (37 CFR 1.953(a)) was mailed by the Office on June 25, 2008. The RAN triggered the right of the patent owner to appeal from the rejection of claims pending in the '209 reexamination proceeding by filing a notice of appeal. [3] Similarly, the RAN triggered the right of the requester to appeal from the examiner's holding favorable to claim patentability, including a refusal to adopt any claim rejection that had been proposed by the third party requester, by filing a notice of appeal. [4] Pursuant to 37 CFR 41.61(b)(1) and (2), where either party was the first to timely file a notice of appeal as provided in either of 37 CFR 41.61(a) or (b), the other party had a period of fourteen days running from the date of service of the first filing party's notice of appeal in which to file its notice of appeal. [5]

On July 25, 2008, patent owner filed its Notice of Appeal, together with a Certificate of Service dated July 25, 2008 that evidenced service of patent owner's Notice of Appeal on requester. The patent owner's July 25, 2008 filing was received in the Office, but was misplaced. These facts were set forth in the patent owner petition filed on August 11, 2008, which includes evidence showing that the patent owner had deposited such papers (the notice of appeal, a check for the appeal fee, a certificate of service, a transmittal form and a return receipt post card) with the United States Postal Service as Express Mail Post Office to Addressee ("Express Mail") on July 25, 2008, and that the

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[3] See: 37 CFR 41.61(a)(1)

[4] See: 37 CFR 41.61(a)(2)

[5] The party filing the first notice of appeal is deemed be the appellant and is said to have filed a notice of appeal, while the party filing second is deemed to have filed a notice of cross appeal. See: 37 CFR 41.60 & 41.61(b)(1) and (2). For purposes of filing an appellant brief and the present petition, the order of filing of the appeals and the terminology attaching to a party by reason of the order of filing are not relevant.

papers had arrived at the Office on July 28, 2008. [6] In a Decision on Petition dated August 20, 2008, the Director of the Central Reexamination Unit (the "CRU") accepted patent owner's showing. [7] On October 1, 2008, patent owner filed its Appellant Brief. On October 10, 2008, requester filed its Cross Appellant Brief.

Patent owner filed a petition on October 16, 2008 requesting that the Office strike or seal the October 10, 2008 requester Cross Appellant Brief as having been untimely filed. On October 24, 2008, requester filed a paper opposing that petition. In the course of considering those papers and formulating a decision thereon, it was noted that the October 1, 2008 patent owner Appellant Brief appeared to exceed the word and page limitations of 37 CFR 1.943(c). Therefore, in the decision treating the October 16, 2008 and October 24, 2008 petition papers, the Office informed the parties that it would "close" the October 1, 2008 patent owner Appellant Brief to public view, pending a formalities review of that paper by the Central Reexamination Unit. [8] As a result of the comment in the November 18, 2008 "Decision Granting Petition" regarding the October 1, 2008 patent owner Appellant Brief, the patent owner and requester have each filed a petition on November 26, 2008 directed to the October 1, 2008 patent owner Appellant Brief.

II. Patent Owner's Position

Patent owner argues in its petition that the provisions of 37 CFR 1.943(c) "may not" apply to the filing of an appellant brief in an *inter partes* reexamination proceeding, because the filing of an appellant brief is governed by 37 CFR 41.67. 37 CFR 41.67 was promulgated on August 12, 2004, subsequent to 37 CFR 1.943(c) having been promulgated on December 7, 2000. 37 CFR 41.67 does not contain a limit for the number of pages or words in an appellant brief. Accordingly, patent owner believes that it is not clear that the page limitations of 37 CFR 1.943(c) apply to its October 1, 2008 Appellant Brief. Alternatively, in the event that page limits imposed by 37 CFR 1.943(c) are deemed by the Office to apply to the filing of a 37 CFR 41.67 appellant brief, patent owner requests that 37 CFR 1.943(c) be waived to the extent that the Office accept the sixty-seven (67) page Appellant Brief filed by patent owner on October 1, 2008. Patent owner bases the request for this relief on the fact that the examiner's RAN is in excess of sixty (60) pages and in excess of nineteen-thousand (19,000) words. [9]

III. Requester's Position

Requester's petition attempts to explain to the Office why it should treat the October 1, 2008 patent owner Appellant Brief as an unauthorized paper. Filed before requester had seen the concurrently filed patent owner petition, requester predicts, in its petition,

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[6] A printout of a Track & Confirm page for the Express Mail filing was submitted as part of the August 11, 2008 petition. The petition also included a Certificate of Service on the requester, which was dated August 11, 2008.

[7] The August 20, 2008 Decision on Petition was signed by a supervisor in the CRU as delegated by the CRU Director.

[8] See: "Decision Granting Petition," November 18, 2008, at footnote 10.

[9] The June 25, 2008 RAN contains sixty-seven (67) pages.

that patent owner would seek to have the an opportunity to redraft its October 1, 2007 Appellant Brief pursuant to the provisions of 37 CFR 1.957(d) and MPEP § 2667(I)(A)(2). Requester opines that the Office should not treat the patent owner Appellant Brief under the provisions of these authorities because "37 CFR 1.957(d) does not provide any remedy for non-compliance with the rules when a patent owner files an Appeal Brief that violates 37 CFR 1.943(c)." [10]

Requester also asks in its petition that, in the event the Office permits entry of a patent owner Appellant Brief that exceeds the page/word limits imposed by 37 CFR 1.943(c), that the Office accord the same treatment to requester. Requester offers to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c).

IV. Analysis and Findings

Patent owner's argument that the provisions of 37 CFR 1.943(c) may not apply to an appellant brief filed under 37 CFR 41.67 is not persuasive. Although the regulations in Part 41, Subpart C of Title 37 of the Code of Federal Regulations were promulgated subsequent to 37 CFR 1.943(c) having been promulgated, it is noted that when the regulations in Part 41, Subpart C of Title 37 of the Code of Federal Regulations were promulgated, 37 CFR 1.959 was amended "to direct inter partes reexamination participants to Part 41 for information in appeals in such proceedings." [11] In addition, 37 CFR 1.961 - 1.977 were removed in the same rule-making "to consolidate inter partes reexamination appeal information in part 41." [12] If it had been intended that the provisions of 37 CFR 1.943(c) would not apply to an appellant brief filed in accordance with 37 CFR 41.67, then it follows that 37 CFR 1.943(c) would have been removed in that rule-making. Instead, 37 CFR 1.943(c) was not removed, and 37 CFR 1.959 was provided to direct parties in an *inter partes* reexamination proceeding to Part 41, Subpart C with respect to the bulk of the rules governing appeals in *inter partes* reexamination proceedings. Further, the provisions of 37 CFR 1.943(c) and 37 CFR 41.67 are not inconsistent, and the provisions of both rules can certainly be complied with in the same appellant brief.

In addition, patent owner argues in favor of waiver of the provisions of 37 CFR 1.943(c) because circumstances require that its Appellant Brief include more than thirty (30) pages. This is persuasive. Patent owner has pointed out that the RAN exceeds sixty (60) pages. Based on that point and the individual facts and circumstances of this case, the provisions of 37 CFR 1.943(c) are waived to the extent that the sixty-seven (67) page Appellant Brief filed by patent owner on October 1, 2008 is deemed acceptable and will be entered into the IFW record.

Requester's argument regarding the inapplicability of the provisions of 37 CFR 1.957(d) and MPEP § 2667(I)(A)(2) is not persuasive. 37 CFR 1.957(d) provides an opportunity for a party responding to an Office action in an *inter partes* reexamination proceeding to

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[10] "Requester's Petition Under 37 CFR § 1.182 ... ," November 26, 2008, at pages 3-4.
[11] 69 FR 49960, August 12, 2004.
[12] Id.

correct an inadvertent failure to comply with a requirement. MPEP § 2667(I)(A)(2) explains the examining practice to be undertaken by a CRU patent examiner when papers filed by a party in a reexamination are reviewed for compliance with the rules and are found to be too long. Requester provides no cogent explanation why these provisions would not apply here, since an appellant brief coupled with the notice of appeal is in fact a substantive response to a RAN.

More importantly, patent owner has not waited for the CRU examiner to act pursuant to 37 CFR 1.957(d), but has, instead, proactively filed a petition to waive the provisions of 37 CFR 1.943(c). Requester's petition paper provides no argument why the patent owner's petition should not be considered, and if found to be persuasive, granted.

Note is been taken of requester's offer to file a petition under 37 CFR 1.183 requesting waiver of the provisions of 37 CFR 1.943(c) so that it may file a respondent brief pursuant to 37 CFR 41.68 containing more than the number of pages permitted by 37 CFR 1.943(c). In view of that request, requester is being provided with a period of fifteen (15) days from the mailing date of this decision in which to file such a 37 CFR 1.183 petition requesting waiver of the provisions of 37 CFR 1.943(c), together with the required petition fee. The period for filing that petition may not be extended. A grantable 37 CFR 1.183 petition must set forth the need for requested relief. In that regard, it is to be noted that an appellant brief often address both the position of the examiner and the position of the other party. However, the respondent brief must be limited to issues raised in the appellant brief to which the respondent brief is directed. [13] Therefore, 37 CFR 1.943(c) provides half the number of pages for a respondent brief that are provided for an appellant brief. Requester should consider that its November 3, 2008 respondent brief contains more than three times the number of pages provided for by the rule, and is not to be responsive to the RAN. The requester should also consider that its respondent brief is also not to be a substitute for its untimely filed October 10, 2008 Cross Appellant Brief, but is, instead, to be solely responsive to the issues raised in the patent owner Appellant Brief. 37 CFR 41.68(a)(3).

[13] See: 37 CFR 41.68(a)(3)

CONCLUSION

1. The patent owner petition to waive the provisions of 37 CFR 1.943(c) is granted to the extent that the sixty-seven (67) page appellant brief filed on October 1, 2008 will be entered into the record.

2. The third party petition is dismissed in view of the grant of the patent owner petition.

3. Third party requester may, within **fifteen (15) days** from the date of this decision, submit a petition under 37 CFR 1.183 requesting waiver of the fifteen (15) page limit established by 37 CFR 1.943(c).

4. The third party requester respondent brief filed on November 3, 2008 will remain provisionally sealed pending the filing by requester of a grantable petition to waive the provisions of 37 CFR 1.943(c). The November 3, 2008 respondent brief may be replaced by a corrected respondent brief filed within one month of this decision (which makes the appellant brief proper by waiver of 37 CFR 1.943(c) as described above). Such a corrected respondent brief could delete material from the November 3, 2008 respondent brief (to address the matters noted above in section IV of this decision).

5. The '209 reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for further action not inconsistent with this decision.

6. Telephone inquiries related 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

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.
95/000,209	01/25/2007	6984791	71518/P001RE/10706444	8587

29053 7590 01/06/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2009

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

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Date: MAILED
JAN 06 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000209
PATENT NO. : 6984791
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

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JAN 06 2009

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Andrew E. Meyer et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,209
Filed: January 25, 2007
For: U.S. Patent No. 6,984,791

DECISION GRANTING PETITION TO WAIVE PAGE LIMITS FOR REQUESTER RESPONDENT BRIEF

This is a decision addressing requester T&B's December 12, 2008 submission entitled "Requester's Petition Under 37 C.F.R. §1.183 to Waive the Provisions of 37 CFR 1.943(c)" ("the requester petition"). 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 requester petition, and *inter-partes* reexamination control number 95/000,209, are before the Office of Patent Legal Administration for decision.

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. 50-0988, as authorized by the requester T&B.

The requester's petition to waive the restrictions under 37 CFR 1.943(c) is granted to the extent that the page limit for requester T&B's respondent brief shall not exceed twenty-five (25) pages or 11,670 words. [1]

[1] The decision, in section II *infra*, provides guidance on which portions of the brief are counted towards the size limit.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,984,791 ("the '791 patent") issued on January 10, 2006.

2. The papers requesting *inte-partes* reexamination of the '791 patent were deposited by a third party requester on December 21, 2006, and were assigned control No. 95/000,209.

3. The request papers were deemed by the Office to be informal, and a substitute request for *inter-partes* reexamination of the '791 patent was filed by the third party requester on January 17, 2007. The substitute request was accepted as proper, and accorded a filing date of January 17, 2007.

4. Reexamination was ordered in *inter-partes* reexamination control No. 95/000,209 ("the '209 reexamination proceeding") on April 13, 2007.

5. Prosecution progressed to the point when, on November 1, 2007, the Office issued an Action Closing Prosecution.

6. On June 25, 2008, the Office mailed a Right of Appeal Notice ("RAN") whereby the patent owner and the third party requester were notified of their entitlement to each file a notice of appeal to the Board of Patent Appeals and Interferences within one month or thirty days from the date of the RAN. The RAN also notified the parties that if one party filed a notice of appeal within the one month or thirty day period, the other party was entitled to file a notice of cross appeal within fourteen days of service of the opposing party's filing of its notice of appeal.

7. On July 25, 2008, patent owner filed a Notice of Appeal from the rejection of patent claims 1-30, together with the appeal fee.

8. It then appeared that the Office had not properly received, or had received but then mishandled, patent owner's notice of appeal. Accordingly, patent owner filed a petition on August 11, 2008, supported by copies of the July 25, 2008 papers requesting acceptance of the July 25, 2008 notice of appeal, and acknowledgement of that acceptance by the Office. The papers attached to the petition included a Certificate of Service stating that patent owner had served a copy of the notice of appeal on third party requester on July 25, 2008. [2]

9. On August 1, 2008, third party requester filed a Notice of Cross Appeal from the examiner's decision to not adopt certain claim rejections that had been proposed by third party requester.

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[2] See: Exhibit A, attached to the patent owner petition filed on August 11, 2008.

10. On August 20, 2008, the Office mailed a decision granting the July 25, 2008 patent owner petition. The decision accepted July 25, 2008 as the filing date of patent owner's Notice of Appeal. [3]

11. On October 1, 2008, patent owner filed its "Appeal Brief of Patent Owner Cooper Technology Company" ("Appellant Brief").

12. On October 10, 2008, third party requester filed its "Cross Appeal Brief of Requester Thomas & Betts Corporation" ("Cross Appellant Brief").

13. On October 16, 2008, patent owner filed a petition to seal or strike requester's Cross Appellant Brief, alleging that the Cross Appellant Brief had not been timely filed.

14. On October 24, 2008, requester filed a paper opposing the October 16, 2008 patent owner petition.

15. On November 3, 2008, requester filed a Respondent Brief directed to the October 1, 2008 patent owner Appellant Brief.

16. On November 18, 2008, the Office mailed a decision granting the October 16, 2008 patent owner petition and dismissing the October 24, 2008 requester opposition petition.

17. On November 26, 2008, patent owner filed a petition to waive the page and word limits of 37 CFR 1.943(c) with respect to its October 1, 2008 Appellant Brief.

18. On December 8, 2008, a decision was mailed by the office granting the October 1, 2008 patent owner petition to waive the provisions of 37 CFR 1.943(c) with respect to its October 1, 2008 Appellant Brief, and provisionally closing the November 3, 2008 Respondent Brief.

19. On December 12, 2008, requester filed the present petition entitled "Requester's Petition Under 37 C.F.R. § 1.183 to Waive the Provisions of 37 CFR 1.943(c)."

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).

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[3] See: "Petition Decision to Accept Papers as Timely Filed ... ," page 1 and page 4, second paragraph.

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. [Emphasis added.]

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. Analysis and Findings

On October 1, 2008, patent owner filed an Appellant's Brief after the examiner had issued a RAN on June 25, 2008, and patent owner had filed its notice of appeal. On November 3, 2008, a Monday, requester timely filed a Respondent Brief directed to the patent owner Appellant's Brief. However, the Office noted that the Respondent Brief exceeded the number of pages permitted by 37 CFR 1.943(c), and provisionally closed the requester Respondent Brief pending the timely filing of a grantable petition to waive the provisions of 37 CFR 1.943(c). Requester has now timely filed such petition.

The December 12, 2008 requester petition to waive the provisions of 37 CFR 1.943(c) begins by noting that requester's previously filed November 3, 2008 Respondent Brief was thirty-five (35) pages long. Petitioner points out that the appellant's brief (which was entered in the record as per the decision rendered December 8, 2008), when properly counted, is 50 pages in length; petitioner requests that the respondent's be permitted to provide a brief of 25 pages - half the length of the appellant's brief. Petitioner further explains that the patent owner's brief on appeal "includes more than 25 separate arguments across four alternative prior art rejections" and thus requester cannot effectively respond to patent owner's arguments if limited to 15 pages.

The Office finds the requirements of 37 CFR 1.183 have been satisfied in this instance. The Office will consider a respondent brief 25 pages in length. In balancing the equities of the petition, the Office notes that there are a substantial number of arguments that must be addressed. Moreover, the Office has previously acknowledged the complex nature of this proceeding by waiving the thirty page limit under 37 CFR 1.943(c) for the patent owner's brief on appeal. Based on the above, and the facts and circumstances of this individual case, the Office finds that justice requires that requester be provided the additional pages to address the issues raised in the appellant brief by patent owner.

Accordingly, the requester's petition to waive the restrictions under 37 CFR 1.943(c) is granted to the extent that the page limit for requester T&B's respondent brief shall not exceed twenty-five (25) pages or 11,670 words.

II. What is included or excluded from the page limit.

A: "Reference Materials"

A comparison of 37 CFR 41.67(c) and 37 CFR 41.68(b), which set out the respective requirements for an appellant's brief and a respondent's brief, reveals that the claims appendix is the only item required in the appellant's brief that is not required in the respondent's brief.

By its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Section 1.943 does not, however, specify that reference materials are excluded from the page count of respondent's brief. To the extent that the rule can be read as giving unequal treatment to reference materials in determining the page count of appellant and respondent briefs, the rule is hereby waived. Specifically, "reference materials such as prior art references" that are properly part of an appendix to the respondent's brief are not being counted toward the page limit set in § 1.943(c). Furthermore, the sections of the appellant and respondent briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and 37 CFR 41.68(b)(1)(i)-(iv) respectively [4] are deemed to be included in "reference materials" that do not count toward the page limits. [5]

It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) and 37 CFR 41.67(b)(ix) are considered "reference materials," and are excluded from the page count only insofar as they are documents that are formally required in the appendix. Note that this requirement only covers copies of decisions rendered by a court of 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 size limit of the brief.

B: *Sua Sponte* Waiver of 37 CFR 1.943(c) as Recorded in MPEP § 2667

MPEP § 2667 I.A.2 provides that the table of contents pages, the table of case law and the pages of (the appealed) claims are excluded from the thirty (30) page limit. It is noted that the only brief that may be filed in an *inter partes* reexamination proceeding in which the party may include thirty (30) pages is an appellant brief. Therefore, the

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[4] i.e., (i) *Real Party in Interest;* (ii) *Related Appeals and Interferences;* (iii) *Status of Claims;* and (iv) *Status of Amendments.*

[5] The exclusion is only for compliant filings. If any portion of the relevant section includes material that goes beyond that which is required, the entire section will be counted toward the page total. Partial pages will be tallied as whole pages for this purpose.

waiver of 1.943(c) set forth in MPEP § 2667 I.A.2 applies, on its face, only to appellant's brief. Likewise, MPEP § 2667 I.B.2, in discussing the appropriate length of third party requester papers, which refers the reader to subsection I.A.2 would apply to a requester appellant brief. Although the MPEP does not specifically address respondent briefs, it is equitable to waive the provisions of 37 CFR 1.943(c) for the respondent's brief to the same extent as the provisions are waived for the appellant's brief (as the basis for waiver is equally applicable in each case).

III. Application of the above discussion to the November 3, 2008 Respondent's Brief.

A review of the November 3, 2008 document coded as XI.RSBR (Respondent Brief) in the electronic Image File Wrapper shows that the document contains forty-five (45) pages. These pages include one (1) title page, five (5) pages of table of contents and table of authorities, and one (1) page stating that an evidence appendix and a related proceedings appendix are attached to the Respondent Brief.

Section II "Related Appeals and Interferences" is not limited to merely "identifying" the related proceedings, but instead characterizes the proceedings and comments on the parties actions. As this goes beyond that which is required by the rule, pages 7-10 are included in the page count for this brief. Similarly, the corresponding related proceedings appendix contains documents that are not required as part of the brief - for example - Appendix C7 is a copy of an Office action in U.S. application 11/888,333, and Appendix B6 is a 266 page deposition and supporting exhibits.

Thus, it is clear that the November 3, 2008 submission is far in excess of the requested 25 page limit granted by this decision. Accordingly, petitioner T&B is given a period of 15 days from the date of this decision to provide a brief which complies with the page limit established herein.

IV. Different Matters Submitted In A Single Paper

The December 12, 2008 petition "[in] addition to its request to...the rules.. seeks further guidance .. with regard to any additional informalities" in the November 3, 2008 brief. [6]

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.

Review of the requester's filing for determination of whether it complies with the rules is within the purview of the Central Reexamination Unit. Accordingly, requester must file a separate paper directed to the CRU for resolution of this matter.

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[6] Petition at page 3

CONCLUSION

1. The third party requester's petition to waive the provisions of 37 CFR 1.943(c) is granted to the extent that the requester's respondent brief shall not exceed twenty-five (25) pages or 11,670 words. If the brief is in excess of 25 pages, a certificate is required stating the number of words contained in the brief.

2. The third party requester's is given a period of **fifteen (15) days** from the date of this decision to provide its respondent's brief in compliance with the guidance set out above with respect to content and size limitation.

3. The '209 reexamination proceeding is being returned to the jurisdiction of 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, including a review of the briefs of record as to propriety.

4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

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

1-6-09
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Law Office of David H. Judson
15950 Dallas Parkway
Suite 225
Dallas Texas, 75248

(For Patent Owner)

MAILED

SEP 20 2007

CENTRAL REEXAMINATION UNIT

Joseph T. Jakubek, Esq.
Klarquist Sparkman, LLP
121 SW Salmon Street, Suite 1600
Portland, Oregon 97204

(For *Inter* Partes
Reexamination Requester)

In re Brad A. Armstrong
Inter Partes Reexamination Proceeding
Control No.: 95/000,214
Filed: April 24, 2007
For: U.S. Patent No. 6,347,997

: **DECISION**
: **REFUSING**
: **ENTRY OF**
: **PAPERS**

This is a decision on the September 18, 2007 third party requester papers styled "Petition under 37 CFR § 1.183 to Suspend the Rules for Consideration of Microsoft's Opposition To Anascape's Emergency Request for Extension of Time" and "Corrected Petition under 37 CFR § 1.183 to Suspend the Rules for Consideration of Microsoft's Opposition To Anascape's Emergency Request for Extension of Time."

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. U.S Patent number 6,347,997 (hereafter the '997 patent) issued to Brad A. Armstrong on February 19, 2002 from an application filed on May 10, 2000.

2. On April 24, 2007, a request for *inter partes* reexamination of the '997 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,214 (hereinafter the '214 reexamination proceeding).

3. On July 17, 2007, the Office issued an order, in the '214 reexamination proceeding, granting *inter partes* reexamination of the '997 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 September 17, 2007, the patent owner filed a request for a one-month extension of the time for filing a response to the Office action mailed July 17, 2007.

5. On September 18, 2007, the third party requester filed the instant papers opposing the patent owner's September 17, 2007 request for the one -month extension of time.

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 1.947 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 1.937 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 1.111(a)(1) states in pertinent part:

> (a)(1) If the Office action after the first examination is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment.

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 1.956 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.

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.

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 September 18, 2007 requester oppositions to the patent owner's September 17, 2007 request for an extension of time 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, 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 requester to file an opposition or comment on a patent owner's request for an extension of time under 37 CFR 1.956. This is an issue that goes to timeliness, rather than to the merits. 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. 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 is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was 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 is, therefore, not enterable into the record, because it is not provided for by the reexamination statute or regulations.

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[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 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.

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 discussed above. Therefore, the requester's opposition to patent owner's request for extension of time is not enterable into the record as addressing the jurisdiction of the Office to act on the 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 oppositions filed on September 18, 2007 to the patent owner's request for an extension of time filed on September 17, 2007 do not have a right of entry into the record of the present reexamination proceeding, and, as such, are not authorized papers. Because the present petition papers were filed using the EFS-Web system and have already been incorporated into the electronic Image File Wrapper (IFW), the original petition papers cannot be physically returned to the third party requester. Thus, the present petition papers opposing the patent owner's request for an extension of time will 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 September 18, 2007 oppositions to the patent owner's September 17, 2007 request for an extension of time are refused entry as they are improper papers. The oppositions 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 opposition petition papers were previously incorporated into the IFW, the opposition petition papers will be marked as "closed" and "non-public" in the IFW record of the present reexamination proceeding. No copy of the opposition petition paper 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.

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[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.

4. Telephone inquiries with regard to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or to the undersigned at (571) 272-7710.

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

September 20, 2007

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JUN 04 2007

CENTRAL REEXAMINATION UNIT

George R. Corrigan
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Appleton, WI 54915

For Patent Owner

Paul J. Wilson
Paul Hasting Janofsky & Walker LLP
875 15th Street N.W.
Washington DC 20005

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,216
Filed: January 31, 2007
For: US Patent No. 6,849,827

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.956]

This is a decision on the petition filed May 14, 2007 to request a sixty (60) day extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed April 10, 2007.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated April 10, 2007, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(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 to date, Patent Owner and counsel have been coordinating and reviewing the materials at issue. The present reexamination is one of five (5) requests for reexamination on five separate patents for which reexamination was ordered on April 10, 2007. This has resulted in a large volume of materials to review. Additional time is necessary in order to undertake the required analysis of the cited art references and formulate and draft responses for each of the patents at issue. It is anticipated that Patent Owner will be unable to fully and completely respond to the instant Office action by the current due date. An extension of time for sixty (60) days is requested to provide Patent Owner with a fair opportunity to respond to the outstanding Office action.

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 two-month extension of time in which to file a response to the Office action. Accordingly, the response is due August 9, 2007. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of April 10, 2007 is **granted**.

2. The Patent Owner's response is due August 9, 2007.

3. Response may be submitted as follows:

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

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

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

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

for Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,216	01/31/2007	6849827	ITW 7188.62R	1214

23721 7590 06/30/2010

CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LINCOLN ELECTRIC COMPANY
PERKINS COIE LLP
607 FOURTHEENTH STREET, NW
WASHINGTON, DC 20005-2003

Date:
MAILED

JUN 30 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000216
PATENT NO. : 6849827
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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JUN 30 2010

CENTRAL REEXAMINATION UNIT

CORRIGAN LAW OFFICE
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(For Patent Owner)

LINCOLN ELECTRIC COMPANY/
PERKINS COIE LLP
607 FOURTEENTH STREET , NW
WASHINGTON, DC 20005-20

(For Third Party Requester)

In re: James M Thommes
Ex Parte Reexamination Proceeding
Control No. 95/000,216
Deposited: 31 January 2007
For: US Patent No. 6,849,827 B2

DECISION
DISMISSING
PETITION
37 CFR §§ 1.181, 1.182 & 1.183

This is a decision on the petition dated 14 April 2010, which is entitled "Requestor's Petition for Suspension of Rules Pursuant to 37 CFR §§ 1.181, 1.182, 1.983" requesting that the Office withdraw its decision dated 03 March 2010.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,849,827 B2 issued on 01 February 2005.
- A request for *inter partes* reexamination was filed concerning the '8270 patent and assigned control no. 95/000,216 on 31 January 2007.
- *Inter partes* reexamination was ordered in the above named proceeding.
- On 27 July 2009 the third party requester timely filed a paper in response to the patent owner's amendment and remarks dated 30 June 2009.
- The third party requester was notified that the response dated 27 July 2009 was improper with a Notice of Defective Paper in Inter Partes Reexamination dated 09 November 2009 explaining that the response did not fully comply with MPEP §§ 2617 & 2666.05. The third party requester was given fifteen (15) days to rectify and refile their response.
- On 24 November 2009 the third party requester submitted a replacement response.
- On 03 March 2010 a Decision *Sua Sponte* returning the non-compliant third party response dated 24 November 2009 was mailed.
- On 14 April 2010 the instant petition submitted by the third party requester was filed pursuant to 37 CFR §§ 1.181, 1.182 & 1.183

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.4(c) Nature of Correspondence 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) 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;

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

DECISION

The petition raises multiple issues which are distinct inquiries which may be addressed by different branches of the Office, as such, this is an improper paper not in compliance with 37 CFR § 1.4(c). In view of the fact that the petition improperly combines multiple, distinct subjects of inquiry in a single paper, the petition is dismissed under 37 CFR § 1.4(c). For example, petitions filed under 37

CFR 1.181 are handled by the Central Reexamination Unit whereas, petitions filed under 37 CFR § 1.182 are handled by the Office of Patent Legal Administration.

CONCLUSION

1. The petition dated 30 March 2010 is hereby dismissed.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

JAN 30 2008

CENTRAL REEXAMINATION UNIT

Brad A. Armstrong (For Patent Owner)
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Carson City, Nevada 89702

Michael J. Keenan (For 95/000,217 Requester)
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Arlington, Virginia 22203

Stephen Joncus, Esq. (For 95/000,222 Requester)
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121 SW Salmon Street
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In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,217
Filed: May 7, 2007
For: U.S. Patent No. 6,344,791

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,222
Filed: May 10, 2007
For: U.S. Patent No. 6,344,791

: 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 6,344,791 (the '791 patent) issued to Brad A. Armstrong on February 2, 2002, with 66 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,217 ('217), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 7, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,222 ('222), was initially deposited by third party requester Microsoft Corporation on February 2, 2007 and received a filing date of May 10, 2007.

4. An order granting reexamination of claims 1-66 of the '791 patent was mailed for the '217 reexamination proceeding on August 1, 2007.

5. An order granting reexamination of claims 1-66 of the '791 patent was mailed for the '222 reexamination proceeding on August 2, 2007.

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 '217 and the '222 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,217 and 95/000,222 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,217 and 95/000,222 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,217 and *inter partes* Reexamination Control No. 95/000,222 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer in the Office of Patent Legal Administration, at (571)272-7726.

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

January 29, 2008
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,218	01/23/2007	RE39465	A42P992US1 REEXAM	8099

3017 7590 03/24/2010

BARLOW, JOSEPHS & HOLMES, LTD.
101 DYER STREET
5TH FLOOR
PROVIDENCE, RI 02903

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROBERT A. PARSONS
4000 N CENTRAL AVE.
SUITE 1220
PHOENIX, AZ 85012

MAILED

MAR 24 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,218*.

PATENT NUMBER *RE 39,465*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BARLOW, JOSEPHS & HOLMES, LTD.
101 DYER STREET
5TH FLOOR
PROVIDENCE, RI 02903

(For Patent Owner)

MAILED

MAR 24 2010

CENTRAL REEXAMINATION UNIT

PARSONS & GOLTRY
4000 NORTH CENTRAL AVENUE
SUITE 1220
PHOENIX, AZ 85012

(For Requester)

In re Swan	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,218	:	UNDER 37 CFR 1.181
Filed: January 23, 2007	:	
For: U.S. Patent No.: RE 39,465	:	

This is a decision on a petition filed by the third party requester on March 11, 2010. The petition is entitled "PETITION TO DIRECTOR UNDER 37 C.F.R. 1.181" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and review the examiner's dismissal of the third party requester's appeal issued on February 17, 2010.

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 March 11, 2010 is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. RE 39,465 (hereinafter, the RE '465 patent) issued on January 16, 2007.

2. A request for *inter partes* reexamination, assigned control No. 95/000,218, was filed by a third party requester on January 23, 2007. The request for reexamination included an explanation for how (a) U.S. Patent No. 5,343,650 to Swan ("Swan '650") anticipated claims 11-16, 20-25, and 29-36 of the RE '465 patent; (b) U.S. Patent No. 5,533,292 to Swan ("Swan '292") anticipated claims 11-16, 20-25, and 29-36 of the 'RE '465 patent via incorporation by reference of the detailed explanation for Swan '650; (c) U.S. Patent No. 5,198,600 to E'Nama ("E'Nama '600") anticipated claims 31-36 of the 'RE '465 patent; (d) E'Nama '600 in view of U.S. Patent No. 5,590,484 to Mooney ("Mooney '484") rendered obvious claim 32; and (e) Mooney '484 anticipated or rendered obvious claims 34-36.

3. *Inter partes* reexamination was ordered for the '218 reexamination proceeding on April 12, 2007. The order determined that Swan '650, Swan '292, E'Nama '600 and Mooney '484 raised a SNQ for certain claims of the RE '465 patent. See pages 4-7 of the order. On the same day, a non-final Office action was mailed in the '218 reexamination proceeding. This Office action set forth four issues that included the proposed rejections raised by the request. See page 3 of the Office action. None of these issues included a proposed obviousness rejection based upon Swan '650 or Swan '292. The examiner did not adopt the proposed anticipation rejection based on Swan '650 for claims 13, 32, 33, 35, and 36, but did adopt the proposed rejection for claims 11, 12, 14-16, 20-25, 29-31, and 34. The examiner did not adopt the proposed anticipation rejection based on Swan '292 for claims 13, 14, 16, 22, 23, 25, 32, 33, 35, and 36, but did adopt the proposed rejection for claims 11, 12, 14, 15, 20, 21, 24, 29-31, and 34. The examiner did not adopt the proposed anticipation rejection based on E'Nama '600 for claims 31-36. The examiner did not adopt the proposed obviousness rejection based on E'Nama '600 in view of Mooney '484 for claim 32. The examiner did not adopt the proposed anticipation and obviousness rejections based on Mooney '484 for claims 33-36.

4. The patent owner filed a response to the non-final Office action on June 11, 2007. The response did not include any proposed claim amendments or new claims, but included a declaration under 37 CFR 1.132.

5. The third party filed comments on July 9, 2007 to the patent owner's response, which only included comments regarding the examiner's decision to not adopt the proposed anticipation rejections based on Swan '650 or Swan '292 for certain claims of the RE '465 patent. See, e.g., pages 14-15 and 27-31 of the comments. The comments did not

make remarks in regards to the proposed obviousness rejections based on E'Nama '600 and Mooney '484.

6. On February 29, 2008, 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 rejections based on Swan '650 or Swan '292 for claims 11, 12, 14, 15, 29, and 30, as set forth in the previous Office action. The ACP also withdrew the adopted anticipation rejections for claims 16 (based on Swan '650), claims 20-25 (based on Swan '650 or Swan '292), and claims 31 & 34 (based on Swan '650 or Swan '292). See pages 20-22 of the Office action. The ACP did not make any new rejections.

7. On March 31, 2008, patent owner filed remarks in response to the ACP. The remarks included two declarations under 37 CFR 1.132.

8. On April 28, 2008, the third party requester filed comments, which addressed the patent owner's two declarations and the anticipation rejections based on Swan '650 or Swan '292 that were either maintained or withdrawn.

9. On July 17, 2008, the Office issued a Right of Appeal Notice (RAN), which addressed the patent owner's response and the third party comments. The RAN maintained the anticipation rejections based on Swan '650 or Swan '292 for claims 29 and 30, as set forth in the previous two Office actions. The RAN also withdrew the adopted anticipation rejections for claims 11, 12, 14, and 15 (based on Swan '650 or Swan '292). See pages 18-19 of the Office action. The RAN did not make any new rejections.

10. On August 13, 2008, the third party requester filed a notice of appeal.

11. On August 15, 2008, the patent owner filed a notice of appeal.

12. On October 8, 2008, the third party requester filed their appeal brief.

13. On October 9, 2008, the patent owner filed their appeal brief.

14. On November 5, 2008, the third party requester filed their respondent brief.

15. On November 10, 2008, the patent owner filed their respondent brief.

16. On April 14, 2009, the Office sent a notice of defective appeal brief and respondent brief to the third party requester and a notice of defective respondent brief to the patent owner.

The notice of the defective appeal brief to the requester explicitly stated that the appeal brief dated October 8, 2008 was noncompliant because (1) it exceeded the page limit; (2) the summary of the claimed invention was incomplete; and (3) the issues to be reviewed were lumped and included new grounds of rejections (e.g., obviousness rejections based on Swan '650 and Swan '292) that were not raised by the request or the prior prosecution in this reexamination proceeding. See page 3 of the notice.

17. On May 7, 2009, the third party requester timely submitted a replacement appeal brief.

18. On February 17, 2010, the Office issued an Examiner's Answer that addressed patent owner's appeal brief, and a notice dismissing the appeal by the third party requester because the replacement appeal brief dated May 7, 2009 was still noncompliant for substantially two of the same reasons pointed out in the April 14, 2009 notice (e.g., the summary of the claimed invention was incomplete, and the issues to be reviewed were lumped and included new grounds of rejections).

19. On March 3, 2010, the patent owner filed a proposed amendment to cancel claims 29 and 30.

20. On March 11, 2010, the third party requester filed 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 withdraw the requester's appeal based upon the determination that the replacement appeal brief, dated May 7, 2009, was noncompliant with Office regulations and policies. The petitioner request reconsideration of the following two issues:

"1) Does the Corrected Appeal Brief comply with 37 CFR 41.67(v) [sic] Summary of Claimed Subject Matter?

2) Does the Corrected Appeal Brief comply with 37 CFR 41.67(vi) [sic] Issues to be Review on Appeal?"

See page 13 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 1.915(b) states that any request for *inter partes* reexamination must include:

> "(1) An identification of the patent by patent number and every claim for which reexamination is requested.
> "(2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.
> "(3) 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.
> "(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.
> "(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.
> "(6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.
> "(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.
> "(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an inter partes reexamination request to determine whether that person is a privy."

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 2617, subsection I. (rev. 5, Aug 2006) states, in part:

"For proposed obviousness rejections, requester **must provide** at least one motivation to combine the cited references, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination. ... The explanation **must not** lump together the proposed rejections or proposed combination of references.

Examples of inappropriate language:
- Claim 1 is unpatentable under 35 U.S.C. 102(b) as being anticipated by, **or in the alternative,** under 35 U.S.C. 103 as being obvious over the Smith reference.
- Claim 1 is unpatentable under 35 U.S.C. 103 as being obvious over Smith and/or Charles."

Analysis:

The CRU Director's review of the request on petition is limited to whether the examiner did not properly follow reexamination laws, regulations and policies in his decision to withdraw the third party requester's appeal. Therefore, the review will determine whether the examiner's decision to consider the replacement appeal brief, dated May 7, 2009, as noncompliant was in accordance with the reexamination laws and policies.

Issue 1: Compliance with 37 CFR 41.67(c)(1)(v)

In the petition, the petitioner states that summary of claims 16 and 25 is consistent with the specification and drawings of the RE '465 patent, and therefore, meets the requirements of 37 CFR 41.67(c)(1)(v). See, e.g., pages 6-7, 9, and 14 of the petition. Specifically, the requester disagrees with the examiner's determination that the summary of invention for claims 16 and 25 is incomplete because of the explanation regarding the element 90. See page 2 of the April 14, 2009 notice of noncompliant appeal brief by the third party requester.

Upon review of the appeal brief dated May 7, 2009, it is found that the summary of invention for claims 16 and 25 is compliant with the requirements of 37 CFR 41.67(c)(1)(v). See MPEP 2675. The record shows that the appeal brief did supply a concise explanation of the subject matter for which the third party requester deems to be the subject matter defined by claims 16 and 25. The fact that the examiner may disagree with the third party requester's summary is not grounds for holding the appeal brief dated May 7, 2009 noncompliant with the requirements of 37 CFR 41.67(c)(1)(v). The examiner may state the reasons for his disagreement with the summary of the claimed invention in the examiner's answer. See MPEP 2677. Therefore, upon further review, noncompliance with the requirements of 37 CFR 41.67(c)(1)(v) is not deemed a ground for holding the appeal brief dated May 7, 2009 noncompliant.

However, agreement with the petitioner on this issue does not mean that the examiner's decision to hold the appeal brief dated May 7, 2009 noncompliant and dismiss the appeal was incorrect. As discussed below, the examiner's dismissal of the appeal was proper because the appeal brief dated May 7, 2009 was noncompliant with the requirements of 37 CFR 41.67(c)(1)(vi).

Issue 2: Compliance with 37 CFR 41.67(c)(1)(vi)

In the petition, the petitioner states that the request for reexamination did include the proposed obviousness rejections based on Swan '650 and Swan '292. See page 4 of the petition. For support for their statement that the issue of obviousness based on Swan '650 and Swan '292 was raised in the request for reexamination, the petitioner is relying on the statement in the request that:

> "[s]ubstantial new questions of patentability under 35 U.S.C. §102 and/or §103 exist with respect to claims 11-16, 20-25 and 29-36 of Swan, U.S. Reissue Patent RE 39,465 (the Swan '465 Patent), in view of at least:
> 1) Swan, U.S. Patent No. 5,343,650 (Swan '650);
> 2) Swan, U.S. Patent No. 5,533,292 (Swan '292);
> 3) E'Nama, U.S. Patent No. 5,198,600 (E'Nama '600); and
> 4) Mooney et al., U.S. Patent No. 5,590,484 (Mooney '600)."

See page 4 of the request for reexamination under the subheading "Citation of Prior Art Patents" and page 4 of the petition.

Turning to the facts in this proceeding, the proposed obviousness rejections based on Swan '650 and Swan '292 were not included in the request for reexamination in a manner that is compliant with 37 CFR 1.915(b) and the policies set forth in MPEP 2617. The quoted statement above is not sufficient to clearly and explicitly identify the proposed obviousness rejections based on Swan '650 and Swan '292 because it is subject to different interpretations. For example, as supported by the Office actions, the examiner thought the citation to 35 U.S.C. 103 only referred to the E'Nama '600 and the Mooney '600 references, for which an explanation under 35 U.S.C. 103 was provided in the request. Therefore, the Office did not send out a notice of noncompliance with the reexamination filing date requirements, as stated in MPEP 2627. In other words, the Office believed the request to be compliant with the filing date requirements under its interpretation of the scope of the reexamination request. Additionally, the request does not provide the detailed explanation for how Swan '650 and Swan '292 renders claims 11-16, 20-25, and 29-36 obvious. See, e.g., pages 2-38 of the "Detailed Explanation of the Pertinency of the Prior Art" section of the request, which only provides the detailed explanation for how Swan '650 and Swan '292 (via incorporation by reference of Swan '650) anticipates claim 11-16, 20-25, and 29-36. Therefore, the record is clear that the request for reexamination, at best, provides the pertinency and manner of applying Swan '650 and Swan '292 in a proposed anticipation rejection, and not the pertinency and manner of applying Swan '650 and Swan '292 in proposed obviousness rejections in the request for reexamination. In other words, the request for reexamination did not establish the proposed obviousness rejections based on Swan '650 and Swan '292 in accordance with the requirements of 35 U.S.C. 311(b)(2), and its implementing regulation of 37 CFR 1.915(b)(3). Therefore, the content of the request does not provide clear support for petitioner's statement that the proposed obviousness rejection based on Swan '650 and Swan '292 was raised in the request.

In the order granting reexamination, the examiner set forth a summary of the proposed rejections, which he understood were raised from the request for reexamination. This summary did not include any obviousness rejections based on Swan '650 and Swan '292. See page 3 of the order. The first Office action, mailed with the order, also set forth the proposed rejections raised by the request, which did not include any obviousness rejections based on Swan '650 and Swan '292.

The third party requester's comments, dated July 9, 2007, did not state that the examiner failed to address the proposed obviousness rejections based on Swan '650 and Swan '292 in the order and/or first Office action. Instead, the comments only presented remarks concerning the anticipation rejections based on Swan '650 and Swan '292. In the petition, the requester states that "[n]o argument as to the omission of a 35 U.S.C. §103 rejection was required or appropriate" in this response because the examiner adopted most of the anticipation proposed rejections. See page 5 of the petition. This statement is not understood as 37 CFR 1.947 provides for the requester to file comments on issues raised by not only the patent owner, but also by the Office action. See 37 CFR 1.947. Clearly, this issue was raised by the Office action because it failed to address proposed rejections that the requester felt that they included in their request for reexamination. Alternatively, the requester could have filed a petition under 37 CFR 1.181 requesting withdrawal of the order and Office action because the actions failed to address all the proposed rejections that the requester believed they raised in the request for reexamination. As reexamination proceedings must be conducted with special dispatch, the requester could have and should have pointed out any alleged deficiencies with the Office actions early in the prosecution.

As stated above in the relevant facts section, the ACP also did not address any proposed obviousness rejections based on Swan '650 and Swan '292. Again, the third party requester's response remained silent as any obviousness rejections based on Swan '650 and Swan '292. See the comments filed April 28, 2008. In the petition, the requester states that "[r]equester could not respond to the allowance or object to the omission of a 35 U.S.C. §103 rejection" in this response because of 37 CFR 1.951. See page 5 of the petition. This statement is not understood as 37 CFR 1.951 provides for the requester to file comments on issues raised by not only the patent owner, but also by the ACP. See 37 CFR 1.951(a). Clearly, this issue was raised again by the ACP because it failed to address proposed rejections that the requester felt that they included in their request for reexamination.

Therefore, the record is clear that the entire pre-appeal prosecution of the reexamination proceeding did not include any proposed obviousness rejections based on Swan '650 and Swan '292. It is not until the prosecution reached the point of appeal that the requester now asserts that proposed obviousness rejections based on Swan '650 and Swan '292 were raised in the request, but not addressed. As explained in the paragraphs above, the record does not support the alleged fact that the requester set forth a proposed obviousness rejection based on Swan '650 and Swan '292 in the request for reexamination. Therefore, to allow a requester to set forth additional proposed rejections during appeal only after the examiner determines that they did not meet their burden in establishing a *prima facie* case of unpatentability for certain proposed anticipation

rejections would lengthen reexamination proceedings, which is clearly against the statutory mandate of "special dispatch."

Given that the request for reexamination did not clearly established any proposed obviousness rejections based on Swan '650 and Swan '292 in compliance with reexamination rules and policies, and that requester repetitively chose to remain silent as to the issue of obviousness based on Swan '650 and Swan '292 in their responses to Office actions prior to appeal, the examiner's determination that the proposed obviousness rejections based on Swan '650 and Swan '292 in the appeal brief are new grounds of rejection is in accordance with Office regulations and policies. See 37 CFR 41.67(c)(1)(vi), which states that "[n]o new ground of rejection can be proposed by a third party request appellant, unless such ground was withdrawn by the examiner..." In the petition, requester alleges that the proposed obviousness rejections based on Swan '650 and Swan '292 were withdrawn by the examiner in the ACP (see page 12 of the petition). As discussed in detailed above, the record is clear that the examiner did not appreciate that the request even raised any proposed obviousness rejections based on Swan '650 and Swan '292, as alleged by the requester, and never made any proposed obviousness rejections based on Swan '650 and Swan '292. Therefore, the record does not support petitioner's statement that the proposed obviousness rejections based on Swan '650 and Swan '292 were withdrawn in the ACP, because such rejections were never made.

Therefore, the examiner correctly determined that the requester's initial appeal brief, dated October 8, 2008, was not compliant because it introduced new grounds of rejection, which is not permitted by 37 CFR 41.67(c)(1)(vi). In accordance with Office policies set forth in MPEP 2675.02, the examiner notified the requester of the noncompliance of the appeal brief, gave explicit reasons for the noncompliance, and gave a one month time period to provide a replacement appeal brief. The requester filed a replacement appeal brief on May 7, 2009, but kept the new grounds of rejection in the replacement brief, despite the explicit notification that the proposed obviousness rejections based on Swan '650 and Swan '292 are new grounds of rejections. See page 3 of the notice concerning the defective appeal brief, dated April 14, 2009. In accordance with Office policies set forth in MPEP 2675.02, the examiner dismissed the requester's appeal as a result of the noncompliant replacement appeal brief.

Accordingly, for all these reasons, the petition is not persuasive that the examiner erred in his decision to hold the replacement appeal brief, dated April 14, 2009, noncompliant and dismissed the appeal as to the third party requester.

In conclusion, the examiner appropriately dismissed the appeal for the third party requester in the interest of "special dispatch." Accordingly, the examiner correctly applied Office policies and procedures in determining that the proposed obviousness rejections based on Swan '650 and Swan '292 are new grounds of rejection and are not appropriately raised under 37 CFR 41.67(c)(1)(vi). For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to dismiss third party requester's appeal. Accordingly, the third party requester's petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the examiner's decision to dismiss the appeal based on noncompliance of the replacement appeal brief by the requester is dismissed.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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MAILED

DEC 18 2007

CENTRAL REEXAMINATION UNIT

In re The Procter & Gamble Company :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,219 : **DISMISSING**
Filed: March 8, 2007 : **PETITION**
For: U.S. Patent No. 7,169,418 B2 :

This is a decision on the October 31, 2007 third party requester petition requesting entry of a concurrently filed declaration of Mr. Samuel Belcher and associated exhibits (hereinafter "the Belcher declaration") following an Action Closing Prosecution. The petition requests entry under 37 CFR 1.116(e) or under 37 CFR 1.182 or 37 CFR 1.182 for purposes of the record to be considered on appeal.

The petition and the 95/000,219 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The patent owner's petition is dismissed for the reasons set forth below.

FEES

A single $400.00 petition fee (37 CFR 1.17(f) as required for a petition filed under 37 CFR 1.182 or 37 CFR 1.183 will be charged to Deposit Account No 12-0555 as authorized by third party requester.

REVIEW OF SALIENT FACTS

1. U.S Patent number 7,169,418 ("the '418 patent") issued to David Andrew Dalton *et al* on January 30, 2007, and is assigned The Procter and Gamble Company.

2. On January 31, 2007, a request for *inter partes* reexamination of the '863 patent was deposited by a third party requester, Marvin Petry, in which the third party requester identified Kraft Foods Global, Inc. as being "the real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b).

3. The papers deposited on January 31, 2007 were assigned *inter partes* reexamination control number 95/000,219 ("the '219 *inter partes* reexamination proceeding") but were not accorded a filing date, and notification to that effect was mailed to both the patent owner and the third party requester on March 5, 2007.

4. On March 8, 2007, the third party requester filed a corrected request for the '219 inter partes reexamination proceeding, which was accepted by the Office.

5. On March 22, 2007, the patent owner and the third party requester were notified that the corrected request for the '219 *inter partes* reexamination proceeding had been accorded a filing date of March 8, 2007.

6. On June 7, 2007, the Office mailed an Order granting *inter partes* reexamination for claims 1-55 (*i.e., all claims*) of the '418 patent.

7. Also on June 7, 2007, the Office mailed an Action Closing Prosecution (ACP) in which all of the claims for which *inter partes* reexamination was ordered were confirmed as being patentable. The ACP set a one month period for the patent owner to file a submission under 37 CFR 1.951(a) in response to the to the ACP and a non-extendable thirty day period from the date of service of the patent owner's submission on the third party requester in which the third party requester could submit responsive comments thereto under 37 CFR 1.951(b), provided that the patent owner had filed a response.

8. The patent owner did not timely file a response to the ACP.

9. On October 31, 2007, the third party requester filed the present petition and the Belcher declaration.

DISCUSSION

I. Relevant Authority and Examining Procedure

35 U.S.C. § 314(b) & (c) provide:

> "(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.

35 U.S.C. § 317 provides:

> (a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination

of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings."

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

"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."

37 CFR 1.181 provides, in pertinent part:

"(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in ... *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; ...
(3) To invoke the supervisory authority of the Director in appropriate circumstances.

...

(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." [Emphasis added.]

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.937(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 1.947 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 1.951 provides:

"(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 § 2617 - Statement in the Request Applying Prior Art - provides in pertinent part:

"Subsection I. EXPLANATION MUST BE COMPLETE

The mere citation of new patents or printed publications without an explanation does not comply with 37 CFR 1.915(b)(3). Requester should present an explanation of how the cited patents or printed publications are applied to all claims which the requester considers to merit reexamination based on patents or printed publications. This not only sets forth the requester's position to the Office, but also to the patent owner."

...

Subsection II. AFFIDAVITS/DECLARATIONS/OTHER WRITTEN EVIDENCE

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in any reexamination. See MPEP § 2258."

MPEP § 2642 - Criteria for Deciding Request - provides in pertinent part:

"Subsection II. POLICY IN SPECIFIC SITUATIONS

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."

II. Third Party Requester's Position

The relevant section of the *inter partes* reexamination statute (35 U.S.C. § 314 (b)) and the corresponding implementing regulation (37 CFR 1.951) do not provide an opportunity for the third party requester to file a response to an ACP unless the patent owner first files comments to the ACP. In the '219 *inter partes* reexamination proceeding, the ACP accompanied the Order granting *inter partes* reexamination. The patent owner exercised the option provided by 37 CFR 1.951(a) and filed no comments to the ACP.

The third party requester argues that requester had no opportunity to respond to any of the examiner's arguments that are set forth in the ACP, and no opportunity to provide the examiner with additional information in light of the Supreme Court's decision in *KSR International Co. v Teleflex*, 127 S. Ct. 1727, 167 L. Ed. 2d 705, 82 USPQ2D 1385 (2007). The third party requester indicates that a declaration after an ACP is permitted to be entered pursuant to 37 CFR 1.116(e) upon a showing of good and sufficient reasons, and that such reasons exist because:

(1) The Belcher declaration could not have been submitted before the ACP; and

(2) There was no procedural mechanism by which the third party requester could explain to the examiner that according to one of ordinary skill in the art, the alleged improvements in the '418 was no more than the predictable use of the prior art elements according to their established functions. The third party requester argues that under the Guidelines issued by the Office on October 10, 2007 in light of the *KSR* decision, the examiner is required to articulate certain grounds when making a 35 U.S.C. § 103 rejection, and the Guidelines require a Section 103 rejection for obviousness when a combination of known elements does no more than yield predictable results.

III. Analysis and Findings

A. Entry of the Belcher Declaration as a Matter of Right Pursuant to 37 CFR 1.116(e)

Although 37 CFR 1.116(e) provides for the entry of declaration evidence after an ACP in the appropriate circumstances, the regulation must be read in a manner consistent with the requirements and limitations on the filing of party papers after an ACP that are imposed 37 CFR 1.951. 37 CFR 1.951(b) places a limitation on the filing of papers after an ACP that precludes the filing of such papers by a third party requester unless the patent owner has first filed a response to the ACP. Thus, while 37 CFR 1.116(e) *per se* establishes that the parties in an *inter partes* reexamination proceeding may file declaration evidence after an ACP, and that declaration evidence may admitted into the record upon the proper showing of cause, the rule does not override the requirement that a third party requester is permitted to file any response to an ACP, including declaration evidence, only in response to a patent owner paper filed after an ACP. Stated differently, 37 CFR 1.116(e) cannot be invoked to

admit declaration evidence after an ACP where 37 CFR 1.951(b) precludes a third party requester from even filing such evidence.

B. Consideration under 37 CFR 1.182 - No Regulation Will Afford Relief

As discussed in Section III(C) below, the relief requested by the third party requester would be available upon a showing that the circumstances presented by the third party requester establish an extraordinary situation such that waiver of certain of the regulations of this part pursuant to 37 CFR 1.183 should be granted in the interest of justice. Hence, granting relief under 37 CFR 1.183 would not require the USPTO Director, or his delegate, to decide the present petition pursuant to 37 CFR 1.182. However, for the reasons discussed in Section III(C), it does not appear that the third party requester has demonstrated that the present circumstances establish the requisite extraordinary situation. Accordingly, a discussion of relief under 37 CFR 1.182 is warranted.

It appears that if relief pursuant to the present petition is not granted, the third party requester has alternative means whereby the Belcher declaration could be presented to the Office in the context of a reexamination proceeding.

First, it appears that the third party requester may make the appropriate arguments on appeal to the Board of Patent Appeals and Interferences. That the Belcher declaration is not entered into the record would not appear to preclude the presentation of arguments by the third party requester explaining why the claimed invention would have been obvious to one of ordinary skill in the art under 35 U.S.C. § 103, as the third party requester believes that the statute should be construed in light of the *KSR* decisions.

Second, to the extent that the information contained in the Belcher declaration was unavailable to the third party requester as of the filing date of the '219 *inter partes* reexamination proceeding, the third party requester (and the real party in interest) may have the ability to file a grantable request for *inter partes* reexamination that includes the Belcher declaration since doing so might not be precluded by 35 U.S.C. § 317(b). Note should be taken of the discussion in MPEP § 2641 of the availability of *inter partes* reexamination based on prior patents and printed publications that have previously been considered by the Office in a proceeding involving the patent, if the request for reexamination presents such documents "in a new light." Thus, the third party requester may have an avenue to file a request for *inter partes* reexamination in which the Belcher declaration evidence casts the documents considered in the '219 *inter partes* reexamination proceeding in a new light.

Third, the 35 U.S.C. § 317 estoppel provisions do not preclude the filing of a request for *ex parte* reexamination of a patent by a third party requester (or real party in interest) who has previously filed a request for *inter partes* reexamination of the same patent. It is to be noted that MPEP § 2241 contains the same language as MPEP § 2641 with respect to a party's ability to obtain reexamination of a patent based upon prior patents and printed publications if such are presented "in a new light." Thus, the third party requester may have the ability to obtain *ex parte* reexamination of the '418 patent.

Fourth, it is to be noted that 37 CFR 1.181(f) provides that any petition for relief "under this part," (*i.e.*, Part 1 of Chapter I of Title 37 of the Code of Federal Regulations) 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. In the '219 *inter partes* reexamination proceeding, a timely filed patent owner response to the ACP would have due on or before July 7, 2007. Therefore, had the patent owner filed a response to the ACP, any responsive comments by the third party requester would have been timely filed only if filed not later than 30 days after the date of service of patent owner's response on the third party requester. Therefore, the due date for the third party requester's comments would ordinarily not have been later than August 7, 2007. Even allowing for the failure of the patent owner to properly serve post-ACP comments on the third party requester, the third party requester could have diligently inquired of the patent owner, or the Office, or both, whether the patent owner had filed a response to the ACP, or intended not to do so. Thus, even assuming that the third party requester would have made a diligent inquiry no later than August 15, 2007, the present third party petition was filed more than two months after the third party requester should have known that the patent owner had elected not to file a response to the ACP. The petition is therefore considered to have been untimely filed. Granting relief on the untimely filed petition resulting in admission of the Belcher declaration at this point in the proceeding would run counter to the statutory mandate that *inter partes* reexamination proceedings are to be handled with special dispatch within the Office

Finally, assuming, *arguendo*, that the present petition is timely filed, or that the Office would grant relief thereon in its discretion, it remains the case that *inter partes* reexamination proceedings are required to be addressed with special dispatch in the Office. The relief requested in the present third party requester petition would operate against the special dispatch requirement. The present petition does not establish any basis for concluding that the third party requester could not have made seasonable inquiry into the matter of the patent owner's filing of a response to the ACP, and therefore would have been well placed to timely file the present petition in accordance with 37 CFR 1.181(f). Further, entry of the Belcher declaration into the record at this juncture has the potential to significantly increase the pendency of the '219 *inter partes* reexamination proceeding by returning the proceeding to a pre-ACP status, and/or creating the potential for the patent owner to file an additional paper directed to the Belcher declaration, (since the patent owner might have elected to comment thereon had the paper been submitted with the request for reexamination as discussed in Section III(C) below).

For each of the above reasons, petitioner third party requester has not established a basis for granting the requested relief pursuant to 37 CFR 1.182.

C. Consideration under 37 CFR 1.183 - Waiver of 37 CFR 1.951(b) and 37 CFR 1.116(e)

As set forth in MPEP § 2141 (EXAMINATION GUIDELINES FOR DETERMINING OBVIOUSNESS UNDER 35 U.S.C. 103):

> "These guidelines do not constitute substantive rule making and hence do not have the force and effect of law. They have been developed as a matter of internal Office management and are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the Office." [Emphasis added.]

As further noted in subsection I of MPEP § 2141:

> "The Supreme Court in KSR reaffirmed the familiar framework for determining obviousness as set forth in Graham v. John Deere Co. (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. KSR, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (Id. at ___, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (Id.); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try'" (*Id.*); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (*Id.*).
>
> "In KSR, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles **based on its precedent** that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at ___, 82 USPQ2d at 1395. The Supreme Court stated that there are "[t]hree cases decided after *Graham* [that] illustrate this doctrine." *Id.* at __, 82 USPQ2d at 1395. (1) "In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *Id.* at ___, 82 USPQ2d at 1395. (2) "In Anderson's-*Black Rock, Inc. v. Pavement Salvage Co.*, . . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation." *Id.* at ___, 82 USPQ2d at 1395. (3) "[I]n *Sakraida v. AG Pro*, Inc., the Court derived . . . the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *Id.* at ___, 82 USPQ2d at 1395-96 (Internal quotations omitted.). The principles underlining these cases are instructive when the question is whether a patent application claiming the combination of elements of prior art would have been obvious."

Thus, the *KSR* Guidelines are viewed by the Office as re-affirming certain principles of law that apply to obviousness determinations under 35 U.S.C. 103. One such principle is that which provides guidance to all patent practitioners, including patent examiners and other Office personnel, with respect to combination inventions involving arrangements of old elements wherein each element performs the same function that it had been known to perform and which combination yields no more than one would expect from such an arrangement. Therefore, to the extent that the third party requester's arguments state or imply that there exists an extraordinary situation that would justify waiving the provisions of 37 CFR 1.951(b) to permit the filing and entry into the record of the Belcher declaration because the *KSR* decision issued in April, 2007, (*i.e.*, after the filing of the '219 *inter partes* reexamination request), such position is not persuasive because the third party requester

has not explained why the Belcher declaration evidence was not filed with the request for *inter partes* reexamination. To the extent that the third party requester indicates that the Belcher declaration addresses the general state of the relevant art with respect to known elements and the manner in which they would be expected to perform in combinations of such elements, it is clear that the Belcher declaration could have been filed with the request for *inter partes* reexamination as an aid to an understanding of the proposed Section 103 obviousness rejections advanced in the request.

The absence of an opportunity to submit such evidence in the '219 *inter partes* reexamination proceeding due to the early confirmation of the patent claims having resulted in the issuance of the ACP, coupled with the fact that patent owner did not respond to the ACP, does not excuse the failure of the third party requester to file the Belcher declaration as part of the request for *inter partes* reexamination. Indeed, the question of establishing the level of skill in the art, which includes the manner in which "conventional components" would be expected to function when combined in a certain way, has been a long standing necessary part of the analysis required to resolve patentability under 35 U.S.C. 103. Moreover, it is to be noted that pursuant to MPEP § 2617, a request for filing an *inter partes* reexamination should be complete when filed. It is further to be noted that MPEP § 2617 specifically states that affidavit (*i.e.*, declaration) evidence that explains the content of prior patents and printed publications can, and will, be considered in *inter partes* reexamination. It is additionally to be noted that the originally filed request for *inter partes* reexamination was accepted after receipt of the corrected request for *inter partes* reexamination. The originally filed request for *inter partes* reexamination contains a number of proposed obviousness rejections, and also contains a section entitled "Knowledge of those of Ordinary Skill" (at pages 1-3 of the 102-page paper dated January 31, 2007) in which the third party requester endeavored to explain the state of the prior art, including an explanation of the existence of certain old elements in the art and their functionality.

Accordingly, it appears that to the extent that the third party requester considers the information in the Belcher declaration to be important information to place before an examiner, when considering and evaluating evidence that would bear on resolution of the question of the obviousness of the '418 patent claims, the request for *inter partes* reexamination as filed could have included the Belcher declaration for the purposes of explaining the state of the art, and the implications thereof on patentability under 35 U.S.C. 103. The absence of the Belcher declaration in the record of the '219 *inter partes* reexamination results from third party requester's failure to provide it when filing the original request for *inter partes* reexamination. Moreover, the regulations regarding a third party requester's ability to introduce additional evidence regarding the prior art during the patentability determination phase of an *inter partes* reexamination proceeding (37 CFR 1.947 with respect to the filing of a third party requester response to Office actions prior to an ACP and 37 CFR 1.951(b) with respect to the filing of a third party requester response to Office actions after an ACP) were available to the third party requester, and are quite clear. Petitioner third party requester has not established that the absence of the Belcher declaration in the record is the result of an extraordinary circumstance that warrants waiver of the provisions of 37 CFR 1.951(b) so as to permit the filing of the Belcher declaration after an ACP and the waiver of the "good and sufficient reasons" provision of 37 CFR 1.116(e) so as to mandate entry of the Belcher declaration into the record.

Further, as discussed in Section III(B) above with respect to the filing and entry of the Belcher declaration pursuant to 37 CFR 1.182, the fact that the declaration is now being offered by the third party requester beyond the period set in 37 CFR 1.181(f), when it could have been seasonably filed had the third party requester made diligent inquiry in the issue of the filing of a patent owner response to the ACP, also weighs against exercising discretion to accept the untimely filed petition and then to grant the requested relief of waiving the regulations to permit filing and entry into the record. To enter the Belcher declaration at this stage of the prosecution would, in essence, require reopening of the prosecution to an earlier stage of prosecution, and operate against the special dispatch requirements of the *inter partes* reexamination statute and the implementing regulations. The patent owner might well assert a right to comment on the Belcher declaration, since, had it been filed with the request for *inter partes* reexamination, the patent owner could have elected to do so. Not only has the third party requester failed to establish that waiver of the rules is not necessary in the interest of justice from the third party requester's perspective, (inasmuch as the third party requester may well have other options to bring the information in the Belcher declaration before the Office in a reexamination proceeding), granting of the requested relief would also adversely effect that segment of the public that has an interest in the speedy resolution of the '219 *inter partes* reexamination proceeding. For all of the foregoing reasons, the third party requester is not deemed to have established a basis for waiving the provisions of 37 CFR 1.951(b) regarding the filing of a post-ACP comment paper and the provisions of 37 CFR 1.116(e) that would govern the entry of such paper into the record.

CONCLUSION

1. The petition to enter the Belcher declaration in the '219 *inter partes* reexamination proceeding pursuant to 37 CFR 1.116(e), or in the alternative to enter the Belcher declaration under 37 CFR 1.182 and/or 37 CFR 1.183, is dismissed.

2. The Belcher declaration is not entered into the active Image File Wrapper record, and will therefore be sealed by being marked "closed" and non-public" because it cannot by physically expunged.

3. The proceeding is being forwarded to the Central Reexamination Unit for appropriate action.

4. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

Kenneth M. Schor

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

sm
December 18, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,221	05/04/2007	6906700		9799

50086 7590 10/08/2008

LAW OFFICE OF DAVID H. JUDSON
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DALLAS, TX 75248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/08/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph T. Jakubek, Esq.
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121 SW Salmon Street Suite 1600
Portland, OR 97204

Date:

MAILED

OCT 08 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000221
PATENT NO. : 6906700
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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Law Office of David H. Judson
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(For Patent Owner)

MAILED

OCT 08 2008

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Anascape, Ltd.
Inter Partes Reexamination Proceeding
Control No. 95/000,221
Filed: May 4, 2007
For: U.S. Patent No. 6,906,700 B1

: **DECISION DISMISSING**
: **PETITION TO SUSPEND**
: ***INTER PARTES* REEXAMINATION**
: **PROCEEDING AND ORDER TO**
: **SHOW CAUSE WHY THE**
: **PROCEEDING SHOULD NOT**
: **BE VACATED**

The above-captioned *inter partes* reexamination proceeding is the subject of a petition filed by patent owner entitled "PETITION UNDER 37 CFR § 1.987 TO SUSPEND REEXAMINATION PROCEEDING" (hereinafter, "the petition"). The petition was filed on August 2, 2008.

The 95/000,221 *inter partes* reexamination proceeding and the present patent owner petition are before the Office of Patent Legal Administration.

FEES

Petitioner patent owner has remitted a petition fee under 37 CFR 1.17(f) of $400.00. The present petition is therefore being taken as a petition under 37 CFR 1.182 for relief not otherwise provided for by the rules.

BACKGROUND

1. U.S. Patent number 6,906,700 B1 ("the '700 patent") issued to Brad A. Armstrong on June 14, 2005, and is assigned to Anascape, Ltd.

2. On February 2, 2007, a request for *inter partes* reexamination of the '700 patent was deposited in the Office by a third party requester, Microsoft Corporation, was assigned control No. 90/000,221 ("the '221 *inter partes* reexamination proceeding"), and was accorded a filing date of February 2, 2007.

3. On April 4, 2007, the Office issued a decision, *sua sponte* vacating the February 2, 2007 filing date for the '221 *inter partes* reexamination proceeding for failure to comply with the provisions of 37 CFR 1.915(b)(3) and 37 CFR 1.915(b)(4).

4. On May 4, 2007, requester filed a response to the April 4, 2007 decision in the form of a corrected request for *inter partes* reexamination of the '700 patent, which request was accepted by the Office and assigned a filing date of May 4, 2007.

5. An Order granting reexamination in the '221 *inter partes* reexamination proceeding for claims 1-33, (*i.e.*, all of the claims), of the '700 patent was mailed on July 12, 2007. An initial Office action has not been mailed in this proceeding.

6. On August 2, 2008, patent owner simultaneously filed (a) the present petition, and (b) a notification that final judgment was rendered on July 23, 2008 in litigation styled as *Anascape, Ltd. v. Nintendo of America, Inc.*, Civil Action No. 9:06-CV-158 (D. E.D. Tex.) ("the *Anascape* litigation"). The final judgment held no claims of the '700 patent invalid, and found that certain claims were valid. It does not appear that all of the claims of the '700 patent were subject to the litigation.

7. Although Microsoft Corporation ("Microsoft") was also a defendant in the *Anascape* litigation, patent owner has informed the Office by a paper filed on May 1, 2008, that Microsoft, a co-defendant in the litigation, settled in the litigation and has taken a license under the '700 patent.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. §§ 311(a) and (b) provide:

> (a) IN GENERAL.– Any **third-party requester** at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
>
> (b) REQUIREMENTS.– The request shall–
>
> (1) be in writing, **include the identity of the real party in interest**, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
>
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. [Emphasis in bold added.]

35 U.S.C. § 315(c) provides:

> (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. [Emphasis in bold added.]

35 U.S.C. § 317 provides:

> (a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, **neither the third-party requester nor its privies** may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
>
> (b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that **the party** has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding **instituted by a third-party requester** is favorable to the patentability of any original or proposed amended or new claim of the patent, then **neither that party nor its privies** may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which **that party or its privies**

raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings. [Emphasis in bold added.]

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. [Emphasis in bold added.]

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. [Emphasis in bold added.]

37 CFR 1.915 provides, in pertinent part:

(b) A request for *inter partes* reexamination must include the following parts:

...

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

37 CFR 1.919(a) provides:

The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

DECISION

I. Relief Requested by Patent Owner

The present patent owner petition seeks to suspend the '221 *inter partes* reexamination proceeding because "[N]o claims of the '700 patent were held to be invalid" in concurrent for infringement of the '700 patent, (the subject of the '221 *inter partes* reexamination proceeding), in litigation styled as styled as *Anascape, Ltd. v. Nintendo of America, Inc.*, Civil Action No. 9:06-CV-158 (D. E.D. Tex.). A final judgment was entered in the district court on July 23, 2008. That decision is now been appealed to the Court of Appeals for the Federal Circuit ("Federal Circuit"). Patent owner relies on the decision in *Sony Computer Entertainment America Inc., et al v. Jon W. Dudas*, No. 1:05cv1447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006) ("*Sony* "), as authority for the requested suspension of the present '221 *inter partes* reexamination proceeding until the appeal in the Federal Circuit has been

concluded. Petitioner patent owner asserts that suspension of the '221 *inter partes* reexamination proceeding would be appropriate, as Office resources and the resources of patent owner will be conserved by suspension (assuming that the Federal Circuit sustains the holding of the district court). Patent owner opines that, although a final, non-appealable holding of claim validity will not strictly apply to Microsoft because Microsoft settled the litigation, the rationale of 35 U.S.C. § 317(b) should apply even if the literal language of the statute does not. Therefore, patent owner believes that the estoppel provisions of Section 317(b) would apply against Nintendo of America ("Nintendo"), the remaining defendant in the litigation, once the district court decision becomes final and non-appealable. Patent owner sees this line of argument as also supporting suspension of the '221 *inter partes* reexamination proceeding.

II. Disposition of Petition

Consideration of providing the relief requested in the petition is premature, as there is a threshold issue to resolve first.

A review of the record shows that nowhere in the request papers originally deposited on February 2, 2007, or in the corrected request papers filed on May 4, 2007, is the "real party in interest" in the present '221 *inter partes* reexamination proceeding unambiguously identified. The "transmittal letter" for the request papers is not the pre-printed Office form (PTO/SB/58), but is, instead, a typewritten document. The "transmittal letter" merely names Microsoft as the reexamination requester. Although 35 U.S.C. § 311(a) states that "[A]ny third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent ..., " 35 U.S.C. § 311(b) requires, *inter alia*, that the request shall ... include the identity of the real party in interest... ." [1] A request for *inter partes* reexamination that merely identifies the "requester" may, or may not, also identify the "real party in interest." The named requester may, or may not, be an entity that filed the request on behalf of other unnamed entities that contributed to the information contained in the request, financed preparation and filing of the request, and would subsequently contribute input during the prosecution of the request. For example, if Nintendo, and perhaps other entities not named in the district court litigation, contributed to the filing of the request for *inter partes* reexamination, it would appear that the statutory estoppels prohibiting the filing another request for *inter partes* reexamination by Nintendo or such other entities not named would attach. The status of Nintendo as a co-defendant does not establish whether Nintendo, (and/or other, unnamed entities), had any sort of input into the filing of the request for *inter partes* reexamination that resulted in the present '221 *inter partes* reexamination proceeding, so as to subject Nintendo, (and other, unnamed entities), to the statutory estoppels.

For the foregoing reasons, 37 CFR 1.915(b)(8) specifically requires that a request for *inter partes* reexamination identify the "real party in interest." As it appears that no request papers submitted in the '221 *inter partes* reexamination proceeding unambiguously identify

[1] Based on Section 311(b), the Office has interpreted the terminology "third party requester" (and its privies) that appears in subsequent sections of the reexamination statute to mean "real party in interest" (and entities in privity therewith) for consistency with 35 U.S.C. § 311(b), notwithstanding that those subsequent sections of the reexamination statute (*e.g.*, 35 U.S.C. §§ 315(c) and 317(b)) employ the terminology "third-party requester," as do implementing regulations 37 CFR 1.907 and 1.913,. Otherwise, 35 U.S.C. § 111(b) would have no meaning at all, because any entity such as a law firm could file a request for *inter partes* reexamination, and only that law firm and "its privies" would be subject to the statutory estoppels established by 35 U.S.C. §§ 315(b) and 317(c).

the real party in interest, as opposed to simply naming the reexamination requester, it appears that the '221 *inter partes* reexamination request should not have been granted a filing date. [2] Therefore, the present petition is not ripe for decision. Accordingly, the petition is dismissed.

III. Order to Show Cause

Patent owner and requester are provided with a non-extendable period of **ONE MONTH** from the date of this decision to show cause why the failure of the request papers in the '221 *inter partes* reexamination proceeding to name the real party in interest as required by 35 U.S.C. § 311(b) and 37 CFR 1.915(b)(8) should not result in vacatur of the filing date of that proceeding pursuant to 37 CFR 1.919(a).

Although the '221 *inter partes* reexamination request was filed by requester Microsoft, petitioner patent owner has been provided the non-extendable period of **ONE MONTH** from the date of this decision to provide a response to this Order to Show Cause because requester Microsoft has signed a settlement agreement in the *Anascape* litigation, and may no longer be interested (or able) to participate in the '221 *inter partes* reexamination proceeding. An adequate response by patent owner would be to provide the identity of the "real party in interest" that caused the present '221 *inter partes* reexamination to be filed, based on information obtained from third party requester Microsoft, and to also provide a certification that the information being provided was obtained from Microsoft. It is sufficient that either patent owner or requester provide a response to the Order to show cause.

Failure to timely and adequately respond to this Order to Show Cause will result in vacatur of the filing date of the '221 *inter partes* reexamination proceeding and conclusion of the proceeding without publication of a reexamination certificate (see: MPEP § 2694).

ADDITIONAL DISCUSSION

Patent owner should also note that the action of the Office in suspending the *inter partes* reexamination proceedings that resulted in the *Sony* decision was predicated, in part, on the fact that the claims in the *inter partes* reexamination proceedings and the claims of the involved patent that had been subject to the copending litigation were identical. Therefore, a final, non-appealable holding of claim invalidity would have resulted in termination of two *inter partes* reexamination proceedings with respect to all of the claims subject to *inter partes* reexamination in those proceedings. Had the claims not been identical in each litigation and the corresponding *inter partes* reexamination proceeding, the 35 U.S.C. § 317(c) estoppel would not have applied and, in furtherance of the public interest, the Office would have continued to reexamination of the patent claims that were not the subject of the litigation.

It presently appears, that the '221 *inter partes* reexamination proceeding involves patent claims 1-33. [3] The *Anascape* litigation appears to have determined only the validity of patent claims 14, 16, 19, 22 and 23. [4] Therefore, based on present information, a petition to suspend the '221 *inter partes* reexamination proceeding would not be grantable. If patent owner

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[2] See: 37 CFR 1.919(a)

[3] See: "*Order Granting Inter Partes Reexamination*," July 12, 2007

[4] See: "Verdict Form" filed May 14, 2008 in the *Anascape* litigation, as filed by patent owner on June 27, 2008 in the '221 *inter partes* reexamination proceeding.

intends to pursue a suspension of the present '221 *inter partes* proceeding by responding to the Order to Show Cause, patent owner should, in that response, address the issue of congruence of claims in the *Anascape* litigation and the '221 *inter partes* reexamination. If the claims in the reexamination proceeding and the litigation are not identical, patent owner should explain why suspension should, nevertheless, be granted, inasmuch as it would appear that the Office will have to continue the '221 *inter partes* reexamination proceeding even if the litigation results in a final, non-appealable holding of claim validity.

CONCLUSION

1. The patent owner petition to suspend the '221 *inter partes* reexamination proceeding is dismissed.

2. The parties are hereby given a period of **Thirty (30) Days** from the date of this decision for at least one of the parties to Show Cause why the filing date of the '221 *inter partes* reexamination proceeding should not be vacated and concluded without publication of a reexamination certificate.

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

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

sm
October 6, 2008

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JAN 30 2008

CENTRAL REEXAMINATION UNIT

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In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,217
Filed: May 7, 2007
For: U.S. Patent No. 6,344,791

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,222
Filed: May 10, 2007
For: U.S. Patent No. 6,344,791

: 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 6,344,791 (the '791 patent) issued to Brad A. Armstrong on February 2, 2002, with 66 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,217 ('217), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 7, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,222 ('222), was initially deposited by third party requester Microsoft Corporation on February 2, 2007 and received a filing date of May 10, 2007.

4. An order granting reexamination of claims 1-66 of the '791 patent was mailed for the '217 reexamination proceeding on August 1, 2007.

5. An order granting reexamination of claims 1-66 of the '791 patent was mailed for the '222 reexamination proceeding on August 2, 2007.

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 '217 and the '222 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,217 and 95/000,222 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,217 and 95/000,222 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,217 and *inter partes* Reexamination Control No. 95/000,222 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer in the Office of Patent Legal Administration, at (571)272-7726.

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

January 29, 2008
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United States Patent and Trademark Office
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JAN 30 2008

CENTRAL REEXAMINATION UNIT

Brad A. Armstrong (For Patent Owner)
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Carson City, Nevada 89702

Michael J. Keenan (For 95/000,224 Requester)
Nixon & Vanderhye, P.C.
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11th Floor
Arlington, Virginia 22203

Jared S. Goff (For 95/000,230 Requester)
Klarquist Sparkman, LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,224
Filed: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,230
Filed: April 19, 2007
For: U.S. Patent No. 6,563,415

: 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 6,563,415 (the '415 patent) issued to Brad A. Armstrong on May 13, 2003, with 24 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,224 ('224), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 10, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,230 ('230), was filed April 19, 2007, by third party requester Microsoft Corporation.

4. An order granting reexamination of claims 1-24 of the '415 patent was mailed for the '230 reexamination proceeding on June 4, 2007.

5. An order granting reexamination of claims 1-2, 7-10 and 18-19 of the '415 patent was mailed for the '224 reexamination proceeding on June 15, 2007.

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 '224 and the '230 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,224 and 95/000,230 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,224 and 95/000,230 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-990100
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,224 and *inter partes* Reexamination Control No. 95/000,230 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer in the Office of Patent Legal Administration, at (571)272-7726.

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

January 29, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,224	05/10/2007	6563415	723-2110	2632

7590 06/18/2008

EXAMINER	

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

ART UNIT	PAPER NUMBER

DATE MAILED: 06/18/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAEL J. KEENAN
NIXON & VANDERHYE P.C.
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

Date:
MAILED

JUN 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000224
PATENT NO. : 6563415
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JARED S. GOFF, ESQ.,KLARQUIST SPARKMAN, LLP
One Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

Date:
MAILED

JUN 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000230
PATENT NO. : 6563415
ART UNIT : 3992

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

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

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JUN 18 2008

CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15950 Dallas Parkway
Suite 225
Dallas, TX 75248

(For Patent Owner)

Michael J. Keenan
Nixon & Vanderhye, P. C.
901 North Glebe Road
11th Floor
Arlington, VA 22203

(For 95/000,224 Requester)

Jared S. Goff, Esq.
Klarquist Sparkman, LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

(For 95/000,230 Requester)

In re Armstrong
Reexamination Proceeding
Control No. 95/000,224
Filing Date: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Armstrong
Reexamination Proceeding
Control No. 95/000,230
Filing Date: April 19, 2007
For: U.S. Patent No. 6,563,415

: DECISION DISMISSING
: PETITION
: FOR EXTENSTION OF TIME
: 37 CFR 1.956

This is a decision on the February 29, 2008, patent owner Petition for Extension of Time requesting that the time to submit a response to the office action mailed January 31, 2008 be extended an additional month.

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

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

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,563,415 (the '415 patent) issued to Brad A. Armstrong on May 13, 2003, with 24 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,224 ('224), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 10, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,230 ('230), was filed April 19, 2007, by third party requester Microsoft Corporation.

4. An order granting reexamination of claims 1-24 of the '415 patent was mailed for the '230 reexamination proceeding on June 4, 2007.

5. An order granting reexamination of claims 1-2, 7-10, and 18-19 of the '415 patent was mailed for the '224 reexamination proceeding on June 15, 2007.

6. The '224 and '230 proceedings were merged on January 30, 2008.

7. A non-final office action was mailed on January 31,2008 setting a one-month period for response because litigation has been stayed for the purpose of conducting this merged proceeding.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed January 31, 2008. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on February 29, 2008, together with authorization to charge 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...

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Analysis and Findings

Patent Owner notes that "[o]ne of the undersigned's other clients is currently involved in an ongoing patent infringement trial that is taking place in Boston, Massachusetts...While not counsel of record, the undersigned was actively involved in the trial, including performing extensive witness preparation, briefing, and trial management...The undersigned has been working full time in Boston on the above trial since February 7th. As a result of being away from Texas, the undersigned has not had an opportunity to meet with Mr. Armstrong (who lives in Texas), the inventor, to discuss the details of the lengthy first Office action, or to prepare a formal response to the pending action. While the undersigned has been working effectively full time on the trial identified above, he has carefully reviewed the Office action. Over the last several weeks, the undersigned has also reviewed the cited prior art. In addition, the undersigned has had two (2) telephone conferences with Mr. Armstrong to discuss the rejection at a high level. These efforts notwithstanding, the undersigned now needs to meet with Mr. Armstrong face-to-face so that a more thorough and comprehensive analysis of the rejections and the cited prior art can be made." Reference is made to the petition for details of this and other issues.

On balance it is considered that the petition fails to explain the "sufficient cause" for an extension of time. Patent Owner's representative requests a one-month extension of time based on the fact that most of the time during the previous period for response was spent working on matters for other clients. The requirement for conducting the present proceedings with special dispatch overrides any desire to provide Patent Owner additional time to make up for the time not spent working on the present merged proceeding. Therefore, petitioner's request for additional time is dismissed.

It is noted that a response was untimely filed in the present proceeding. Patent Owner may wish to consider filing a petition under 37 CFR 1.137 to accept the untimely filed paper (see also MPEP 2668).

Service of Papers

It is also noted that the certificate of service does not indicate the manner of service (see 37 CFR 1.248(b)). It is also unclear if the papers were served on both requesters as the certificate of service states "that a copy of this paper was served on Requester's counsel on this 26th day of February, 2008." Patent Owner is reminded of the requirement set forth in the merger decision of January 30, 2008, which states, in part, "The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission."

CONCLUSION

1. Petitioner's request is dismissed.

2. Any response to this decision 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 hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

Eric Keasel For

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,224	05/10/2007	6563415	723-2110	2632

7590 11/10/2008

EXAMINER

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

ART UNIT	PAPER NUMBER

DATE MAILED: 11/10/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,230	04/19/2007	6563415	6620-76454-12	7142

50086 7590 11/10/2008

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/10/2008

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

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MICHAEL J. KEENAN
NIXON & VANDERHYE P.C.
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

Date:
MAILED

NOV 10 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000224
PATENT NO. : 6563415
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JARED S. GOFF, ESQ.,KLARQUIST SPARKMAN, LLP
One Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

Date:

MAILED

NOV 10 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000230
PATENT NO. : 6563415
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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NOV 10 2008

CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15950 Dallas Parkway
Suite 225
Dallas, Texas 75248

(For Patent Owner)

Michael J. Keenan
Nixon & Vanderhye, P.C.
901 North Glebe Road
11th Floor
Arlington, VA 22203

(For 95/000,224 Third Party Requester)

Jared S. Goff, Esq.
Klarquist Sparkman, LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

(For 95/000,230 Third Party Requester)

In re Armstrong
Reexamination Proceeding
Control No. 95/000,224
Filed: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Armstrong
Reexamination Proceeding
Control No. 95/000,230
Filed: April 19, 2007
For: U.S. Patent No. 6,563,415

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the October 21, 2008 patent owner petition entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED[1] UNINTENTIONALLY 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 March 27, 2008 response to the January 31, 2008 Office Action as having been unintentionally delayed.

The petition and the merged reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620.00 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. 50-4001, in accordance with

[1] Reexamination proceedings are not abandoned; they are "terminated" for failure to timely respond.

petitioner's authorization in the "Electronic Acknowledgement Receipt" 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 1.956; 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

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 Monday March 3, 2008, for failure of petitioner to timely file a proper response within the meaning of 37 CFR 1.111 to the non-final Office action of January 31, 2008. [2]

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 response by patent owner.

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.

Where there is a question whether the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See 37 CFR 1.137(b)(3), last sentence, and see MPEP 711.03(c)(III)(C) and (D).

Petitioner has supplied items required by items (1) and (2). Petitioner has **not**, however, satisfied item (3), because the showing of record raises questions as to whether the abandonment of this application was unintentional within the meaning of 37 CFR 1.137(b), as will now be discussed.

There are three periods which must be considered during the evaluation of a petition under 37 CFR 1.137(b) as outlined in MPEP 711.03(c)(III)(D):

(1) the delay in response that originally resulted in the abandonment;
(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding; and
(3) the delay in filing an otherwise **grantable** petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding.

---

[2] 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).

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for Period (2).

As to Period (1):

Petitioner filed a patent owner request under 37 CFR 1.956 on February 29, 2008 to extend the time to respond to the first office action mailed on January 31, 2008 until March 31, 2008. Petitioner filed a response to the first office action on March 27, 2008. The Office decision dismissing the petition for extension of time under 37 CFR 1.956, informed patent owner that the response remained due on the original date, because the extension of time was not granted; this Office decision was not mailed until June 18, 2008. It is to be noted that extensions of time are not granted as a matter of right in reexamination proceedings. 37 CFR 1.956, the provision under which patent owner requested an extension, specifically states that "the mere filing of a request" will not result in the granting of an extension. However, given the particular facts and circumstances, patent owner's intention to file a timely response is evident from the record, and the statement that the entire delay until the filing of a response on March 27, 2008, was unintentional is accepted. Therefore, the petitioner's delay, in the filing of a response that originally resulted in the termination, was unintentional.

As to Period (2):

The Office decision dismissing the petition for the extension of time under 37 CFR 1.956 was mailed on June 18, 2008. Petitioner first filed a petition for revival of the reexamination proceeding on October 21, 2008. Thus, there was a delay of 4 months from the mailing of the decision dismissing the request for an extension of time until the filing of the petition for revival pursuant to 37 CFR 1.137(b) on October 21, 2008.

Petitioner only provided the statement that the entire delay in filing the required response from the due date for the required response until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Petitioner also filed a communication accompanying the present petition under 37 CFR 1.137(b) acknowledging therein the decision mailed on June 18, 2008. That decision informed patent owner that the response to the Office action was untimely and suggested the filing of a petition under 37 CFR 1.137.

Petitioner provides no explanation as to how the delay of 4 months from the mailing of the decision dismissing the request for an extension of time and the instant initial petition under 37 CFR 1.137(b) filed on October 21, 2008 was "unintentional."

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive a reexamination proceeding which has been terminated due to "an unintentionally delayed response by the patent owner in any reexamination proceeding." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition...would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982),

reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and implementing regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for an unintentionally delayed response by the patent owner in any reexamination proceeding." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional. Where there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application* of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) is clear, unambiguous, and without qualification. That is, the delay in filing the petition seeking revival, must have been, without qualification, "unintentional" in order for the response to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application or a terminated reexamination prosecution, to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly **after becoming aware of the abandonment**" [emphasis added]). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application or a terminated reexamination prosecution. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that ***any protracted delay (here, 4 months) could trigger, as here, a request for additional information***. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay, as opposed to Office acceptance of a general allegation of unintentional delay. See *Lawman Armor v. Simon*, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); *Field Hybrids, LLC v. Toyota Motor Corp.*, 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

In view of the above, statements are required from the responsible person(s) having firsthand knowledge of the circumstances surrounding the delay, after the termination date, in seeking revival. Furthermore, as the record shows that petitioner was aware that the decision dismissing the petition for the extension of time under 37 CFR 1.956 was mailed on June 18, 2008, an explanation from petitioner as to why the 4-month delay in seeking revival should be excused must be provided, independently of delay in responding which caused termination in the first instance.

SERVICE OF COPIES

37 CFR 1.248(a) states:

"(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*."

The proffered proofs of service on the third party requester filed on March 27, 2008 and on October 21, 2008 state that the third party requester was provided with a copy of the papers filed on March 27, 2008 and on October 21, 2008 by electronic mail (per agreement of the parties). However, service by electronic mail does not comply with the requirements set forth in 37 CFR 1.248(a).

Any response by patent owner to this decision must include a Certificate that the present petition papers and the March 27, 2008 and October 21, 2008 papers have been served on the third party requester in the manner provided by 37 CFR 1.248.[3]

In addition, any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.248(a).

CONCLUSION

1. The present petition under 37 CFR 1.137(b) is **dismissed.**

2. **For granting of the present petition, it is required that patent owner provide:**

(A) A Certificate that the petition papers and the March 27, 2008 and October 21, 2008 papers have been served on the third party requester in accordance with 37 CFR 1.248(a); **and**

(B) A detailed explanation or showing by the petitioner that the delay for period (2) under 37 CFR 1.137(b) as discussed above was unintentional.

Note that any papers filed in these proceedings must be served in compliance with 37 CFR 1.248.

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)."**

---

[3] Obviously, if the papers have not yet been served, patent owner must first do so, before providing the Certificate to the Office.

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 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.

6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or in her absence to Pinchus M. Laufer, Legal Advisor at (571) 272-7726.

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

10-6-08
C:\Kiva|Kpetabe\95_0224+95230-dismiss_uninten

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.
95/000,224	05/10/2007	6563415	723-2110	2632

7590 02/18/2009

EXAMINER	
ART UNIT	PAPER NUMBER

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

DATE MAILED: 02/18/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,230	04/19/2007	6563415	6620-76454-12	7142

50086 7590 02/18/2009

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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
MICHAEL J. KEENAN
NIXON & VANDERHYE P.C.
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

Date:
MAILED
FEB 1 82009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000224
PATENT NO. : 6563415
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JARED S. GOFF, ESQ.,KLARQUIST SPARKMAN, LLP
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121 S.W. Salmon Street
Portland, OR 97204

Date:

MAILED

FEB 18 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000230
PATENT NO. : 6563415
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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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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FEB 18 2009

CENTRAL REEXAMINATION UNIT

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Michael J. Keenan (For 95/000,224 Third Party Requester)
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Jared S. Goff, Esq. (For 95/000,230 Third Party Requester)
Klarquist Sparkman, LLP
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Suite 1600
Portland, Oregon 97204

In re Armstrong : **DECISION**
Reexamination Proceeding : **GRANTING**
Control No. 95/000,224 : **PETITION**
Filed: May 10, 2007 :
For: U.S. Patent No. 6,563,415 :

In re Armstrong :
Reexamination Proceeding :
Control No. 95/000,230 :
Filed: April 19, 2007 :
For: U.S. Patent No. 6,563,415 :

This is a decision on the December 10, 2008 patent owner renewed petition entitled "RENEWED PETITION UNDER 37 CFR 1.137(b)" filed in response to the Decision mailed on November 10, 2008 in the above identified proceeding.

The petition and the merged reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The renewed petition is granted for the reasons set forth below.

DECISION

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding 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 previously supplied item (1). In addition, the required petition fee was submitted with the original petition filed on October 21, 2008; thus, item (2) has been satisfied, because no additional petition fee is required for a renewed petition under 37 CFR 1.137(b).

Petitioner did not previously satisfy item (3), for the reasons set forth at pages 2-4 of the November 10, 2008 Decision.

For the granting of the patent owner petition under 37 CFR 1.137(b), the following submissions were required in the November 10, 2008 Decision:

(A) A Certificate that the petition papers and the March 27, 2008 and October 21, 2008 papers have been served on the third party requester in accordance with 37 CFR 1.248(a); **and**

(B) A detailed explanation or showing by the petitioner that the delay for period (2) [1] under 37 CFR 1.137(b) as discussed in the November 10, 2008 Office decision was unintentional.

With respect to required item (A) above, petitioner certifies in the present renewed petition that the petition papers and the March 27, 2008 and October 21, 2008 papers have been re-served on third party requesters in accordance with 37 CFR 1.248(a). Petitioner also certifies that the present renewed petition has been served on third party requesters in accordance with 37 CFR 1.248(a).

However, patent owner does not explicitly indicate the date or the manner in which the petition papers and the March 27, 2008 and October 21, 2008 papers were re-served. Since the present renewed petition was served via first class mail on December 10, 2008, the Office construes the phrase "have been re-served on third party requesters in accordance with 37 CFR 1.248(a)" as "have been re-served on third party requesters via first class mail on December 10, 2008." Patent owner is required to inform the Office if these papers were not re-served by first class mail on December 10, 2008 and to designate the mode of service and date of service as required

[1] Period (2) is directed to the timing in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding.

by 37 CFR 1.248(b). If the mode of service is not sanctioned according to 1.248(a), then patent owner is required to re-serve the papers and notify the Office of the proper service.

With respect to required item (B) above, petitioner provides, in the present renewed petition, a detailed explanation that the delay for period (2) under 37 CFR 1.137(b) was unintentional. Therefore, the four month delay in seeking revival is excused.

As to the delay for period (3) [2] under 37 CFR 1.137(b) discussed on page 2 of the November 10, 2008 Decision, since petitioner promptly filed the present renewed petition under 37 CFR 1.137(b), there is no delay in filing an otherwise grantable petition pursuant to 37 CFR 1.137(b) to revive the present proceeding.

Accordingly, the March 27, 2008 patent owner response to the January 31, 2008 Office action is accepted as having been unintentionally delayed.

CONCLUSION

1. The present renewed petition under 37 CFR 1.137(b) is **granted.**

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for further examination and consideration of the patent owner amendment and response filed on March 27, 2008 and the third party requester comments filed on April 28, 2008.

3. **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

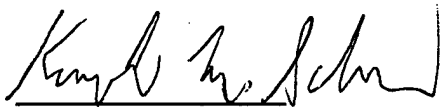
   By FAX to: (571) 273-9900
   Central Reexamination Unit

[2] Period (3) is directed to the timing in filing an otherwise **grantable** petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding.

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

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

4. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



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

JAN 30 2008

CENTRAL REEXAMINATION UNIT

Brad A. Armstrong (For Patent Owner)
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Jared S. Goff, Esq. (For 95/000,226 Requester)
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In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,225
Filed: May 10, 2007
For: U.S. Patent No. 6,351,205

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,226
Filed: April 19, 2007
For: U.S. Patent No. 6,351,205

: 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 6,351,205 (the '205 patent) issued to Brad A. Armstrong on February 26, 2002, with 9 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,225 ('225), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 10, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,226 ('226), was filed April 19, 2007, by third party requester Microsoft Corporation.

4. An order granting reexamination of claims 1-9 of the '205 patent was mailed for the '226 reexamination proceeding on June 15, 2007.

5. An order granting reexamination of claims 5-9 of the '205 patent was mailed for the '225 reexamination proceeding on June 25, 2007.

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 '225 and the '226 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,225 and 95/000,226 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,225 and 95/000,226 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,225 and *inter partes* Reexamination Control No. 95/000,226 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer in the Office of Patent Legal Administration, at (571)272-7726.

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

January 29, 2008
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APR 03 2009

CENTRAL REEXAMINATION UNIT

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Michael J. Keenan (For Third Party Requester)
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Portland, OR 97204

In re Brad A. Armstrong :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,225 : **GRANTING**
Filed: May 10, 2007 : **PETITION UNDER**
For: U.S. Patent No. 6,351,205 : **37 CFR 1.137(b)**

In re Brad A. Armstrong
Inter Partes Reexamination Proceeding
Control No. 95/000,226
Filed: April 19, 2007
For: U.S. Patent No. 6,351,205

This is a decision on the March 17, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated merged reexamination ("the March 17, 2009 patent owner petition to revive").[1]

[1] Although a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged prosecution was "terminated" within the meaning of 37 CFR 1.957(b) for failure of the patent owner to timely file a response under 37 CFR 1.945(a) to the February 12, 2008 Office action.

The March 17, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

The March 17, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

35 U.S.C. 314(a) provides, in pertinent part:

> 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 of this title.

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.945(a) provides, in pertinent part:

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 1.957(b) provides, in pertinent part:

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the March 17, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this merged reexamination proceeding prosecution was terminated due to the failure to timely submit a response to the February 12, 2008 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that 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. The February 12, 2008 Office action set a one-month period for response. A response to the February 12, 2008 Office action was not filed until April 12, 2008, which was untimely. For the purpose of evaluating whether the March 17, 2009 patent owner petition to revive is a grantable petition, the submission of the April 12, 2008 response satisfies item (1).[2]

Accordingly, the March 17, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 17, 2009 patent owner petition under 37 CFR 1.137(b) to revive is **granted**.

2. Patent owner's response to the February 12, 2008 Office action is hereby entered into the record of the present proceeding, thus triggering a comment right for each of the third party requesters under 37 CFR 1.947. Accordingly, each third party requester may file comments to patent owner's response as per 37 CFR 1.947, if such comments are filed within 30 days of the mailing date of this decision.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, to await requesters' comments under

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the April 12, 2008 response as to each of the rejections set forth in the February 12, 2008 Office action; such is the examiner's province.

37 CFR 1.947, or the expiration of the time to file such comments, after which the examiner will issue an Office action.

4. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JAN 30 2008

CENTRAL REEXAMINATION UNIT

Brad A. Armstrong (For Patent Owner)
P.O. Box 2048
Carson City, Nevada 89702

Michael J. Keenan (For 95/000,225 Requester)
Nixon & Vanderhye, P.C.
901 North Glebe Road
11th Floor
Arlington, Virginia 22203

Jared S. Goff, Esq. (For 95/000,226 Requester)
Klarquist Sparkman, LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,225
Filed: May 10, 2007
For: U.S. Patent No. 6,351,205

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,226
Filed: April 19, 2007
For: U.S. Patent No. 6,351,205

: 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 6,351,205 (the '205 patent) issued to Brad A. Armstrong on February 26, 2002, with 9 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,225 ('225), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 10, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,226 ('226), was filed April 19, 2007, by third party requester Microsoft Corporation.

4. An order granting reexamination of claims 1-9 of the '205 patent was mailed for the '226 reexamination proceeding on June 15, 2007.

5. An order granting reexamination of claims 5-9 of the '205 patent was mailed for the '225 reexamination proceeding on June 25, 2007.

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 '225 and the '226 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,225 and 95/000,226 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,225 and 95/000,226 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,225 and *inter partes* Reexamination Control No. 95/000,226 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer in the Office of Patent Legal Administration, at (571)272-7726.

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

January 29, 2008
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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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APR 03 2009

CENTRAL REEXAMINATION UNIT

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Portland, OR 97204

(For Third Party Requester)

In re Brad A. Armstrong
Inter Partes Reexamination Proceeding
Control No. 95/000,225
Filed: May 10, 2007
For: U.S. Patent No. 6,351,205

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

In re Brad A. Armstrong
Inter Partes Reexamination Proceeding
Control No. 95/000,226
Filed: April 19, 2007
For: U.S. Patent No. 6,351,205

This is a decision on the March 17, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated merged reexamination ("the March 17, 2009 patent owner petition to revive").[1]

[1] Although a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged prosecution was "terminated" within the meaning of 37 CFR 1.957(b) for failure of the patent owner to timely file a response under 37 CFR 1.945(a) to the February 12, 2008 Office action.

The March 17, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

The March 17, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

35 U.S.C. 314(a) provides, in pertinent part:

> 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 of this title.

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.945(a) provides, in pertinent part:

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 1.957(b) provides, in pertinent part:

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the March 17, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this merged reexamination proceeding prosecution was terminated due to the failure to timely submit a response to the February 12, 2008 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that 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. The February 12, 2008 Office action set a one-month period for response. A response to the February 12, 2008 Office action was not filed until April 12, 2008, which was untimely. For the purpose of evaluating whether the March 17, 2009 patent owner petition to revive is a grantable petition, the submission of the April 12, 2008 response satisfies item (1).[2]

Accordingly, the March 17, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 17, 2009 patent owner petition under 37 CFR 1.137(b) to revive is **granted**.

2. Patent owner's response to the February 12, 2008 Office action is hereby entered into the record of the present proceeding, thus triggering a comment right for each of the third party requesters under 37 CFR 1.947. Accordingly, each third party requester may file comments to patent owner's response as per 37 CFR 1.947, if such comments are filed within 30 days of the mailing date of this decision.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, to await requesters' comments under

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the April 12, 2008 response as to each of the rejections set forth in the February 12, 2008 Office action; such is the examiner's province.

37 CFR 1.947, or the expiration of the time to file such comments, after which the examiner will issue an Office action.

4. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. __

Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

(For Patent Owner)

MAILED

APR 16 2007

CENTRAL REEXAMINATION UNIT

Tracy Druce
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Street
Houston, Texas 77002

(For Requester)

In re Khandors
Reexamination Proceeding
Control No.: 95/000,227
Filed: February 9, 2007
For: U.S. Patent No.: 6,433,419

: NOTICE OF TIME PERIOD TO
: OPPOSE PETITION TO
VACATE FILING DATE IN
: REEXAMINATION PROCEEDING

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration after receipt of the patent owner's March 26, 2007 petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the instant *inter partes* reexamination proceeding, or alternatively to suspend action in the proceeding.

BACKGROUND

U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) issued on August 13, 2002.

Patents 6,465,893 and the '419 patent, along with other related patents, are currently the subject of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California.

A request for reexamination of the '419 patent, assigned control No. 90/000,227 (the '0227 proceeding), was filed by a third party requester, Silicon Precision Industries Co., Ltd, on February 9, 2007. Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b).

The present 37 CFR 1.182 and 1.183 petition to vacate the filing date in the instant *inter partes* reexamination proceeding, or alternatively to suspend action in the proceeding, was received from the patent owner on March 26, 2007.

The Office has not yet issued a decision on the request for reexamination in the '0227 reexamination proceeding.

REQUIREMENT

The petition received from the patent owner requests that the Office vacate the filing date of, or suspend, the present *inter partes* reexamination proceeding. The patent owner's request is based upon the assertion, in the petition, that the requestor has not correctly identified the "real party of interest" as mandated by 35 U.S.C. 311(b)(1) and 37 CFR 1.915(b)(8) and 1.919(a).

Consistent with 35 U.S.C. 311(b)(1), the rules require that a request must include "a statement identifying the real party in interest to the extent necessary for a subsequent person filing an inter partes reexamination request to determine whether that person is a privy." 37 CFR 1.915 (b)(8) (emphasis added). Further, 37 CFR 1.919 (a) provides that if the request fails to identify the real party so that privies can be identified, then the requirements for a filing date have not been met.

The third party requester is hereby being provided with an opportunity to address the patent owner's March 26, 2007 petition under 37 CFR 1.182 and 1.183, as follows.

Pursuant to this Notice, the third party requester is hereby given a period of **FIFTEEN DAYS** to respond to the March 26, 2007 patent owner petition by **showing cause** why the petition should not be granted based upon the allegations set forth therein. The showing of cause must include the following:

1. An identification of all the parties that participated/consulted in the preparation of the request, including reviewing it and providing comments, including any or all of the other *Tessera,* litigation defendants. This will include an identification of the parties amongst whom the *inter partes* reexamination request was circulated during its preparation andwho was involved in the consultation and preparation of the request for inter *partes* reexamination

2. An identification of who will be involved in the prosecution of *inter partes* reexamination proceeding in the future. Identify which parties will review draft papers before they are filed in the Office..

3. In "DEFENDANTS' JOINT MOTION TO STAY PROCEEDINGS PENDING REEXAMINATION OF THE PATENTS-IN-SUIT" filed March 22, 2002, in the *Tessera* litigation the following is stated at page 1:

PLEASE TAKE NOTICE that on April 26, 2007, at 2:00 p.m., or as soon thereafter as the parties may be heard, in the courtroom of the Honorable Claudia Wilken, Courtroom 2, 4th Floor, located at 1301 Clay Street, Oakland, California 94612, Defendants Advanced Micro Devices, Inc., Spansion Inc., Spansion Technology Inc., Spansion LLC, Advanced Semiconductor Engineering, Inc., ASE (U.S.) Inc., ChipMOS Technologies Inc., ChipMOS U.S.A., Inc., Siliconware Precision Industries Co., Ltd., Siliconware USA Inc., STMicroelectronics N.V., STMicroelectronics, Inc., Stats ChipPAC Ltd., Stats ChipPAC, Inc., and Stats ChipPAC (BVI) Limited (collectively "Defendants") will, and hereby do, move the Court for an order staying all proceedings pending reexamination by the United States Patent & Trademark Office ("PTO") of each of the patents-in-suit Since the parties (defendants) all appear to rely on the request for reexamination as a basis for their joint motion to stay the litigation, why does requester not consider all of them "real parties in interest"? Why should the remainder of the defendants also relying on the present reexamination be permitted to avoid the estoppel provisions of 35 U.S.C. 317(b), 35 U.S.C. 315(c)?

The requester must clarify which parties are a "real party in interest," as set forth in 35 U.S.C. 311(b)(1) and 37 CFR 1.915 (b)(8). In other words, did Silicon Precision handle the reexamination request alone, or did some or all of the other *Tessera* litigation defendants also, in some way, participate in preparing/revising the pending reexamination request? It is to be noted that the requester must sufficiently identify the "real party in interest" to the extent necessary to determine if a subsequent requester is a "privy" pursuant to 35 U.S.C. 317(b) and 37 CFR 1.915 (b)(8).

CONCLUSION

1. The third party requester is hereby given a period of **Fifteen days from the date of this Notice** to respond to the March 26, 2007patent owner petition. This period of time is **not** subject to extension.

2. A response to the patent owner's March 26, 2007 petition may be treated as a petition and opposition under 37 CFR 1.182, in response to patent owner's petition and submitted by:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit
Attention: Maria Nuzzolillo and Pinchus Laufer

By hand (or delivery service):

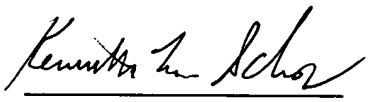
Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 223

To avoid a delay in matching papers and to ensure timely consideration, **it is strongly advised that a copy of the requester's response also be submitted by facsimile** and directed to:

Maria Nuzzolillo
571-273-8150 AND

Pinchus Laufer
571-273-7726

3. Telephone inquiries related to this decision should be directed to Nuzzolillo, Maria, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.



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

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4-16-07

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419		6504

530 7590 05/22/2007

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/22/2007

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

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Paper No. __

Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

(For Patent Owner)

MAILED

MAY 22 2007

CENTRAL REEXAMINATION UNIT

Tracy Druce
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Street
Houston, Texas 77002

(For Requester)

In re Khandors
Reexamination Proceeding
Control No.: 95/000,227
Filed: February 9, 2007

For: U.S. Patent No.: 6,433,419

: DISMISSAL OF
: PETITION
: FOR LEAVE TO REBUT
: IMPROPERLY ADMITTED
: ARGUMENT
:

This is a decision on the May 8, 2007 patent owner petition entitled "Petition for Leave to Rebut Improperly Admitted Argument" to permit remarks rebutting the Litigation Activity Update under 1.985 (b) filed by the third party requestor.

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

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

BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent

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BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent

was filed by a third party requester, Silicon Precision Industries Co., Ltd. Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 90/000,227 (the '0227 proceeding).

3. Also on February 9, 2007, a request for *inter partes* reexamination of companion patent 6,465,893 (the '893 patent) was filed by a third party requester, Silicon Precision Industries Co., Ltd.. Again, Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). This companion request was assigned control No. 90/000,229 (the '0229 proceeding).

4. On March 26, 2007, the patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like petition was filed in the companion '0229 proceeding.

5. Patent owner's petition stated that the '419 and '893 patents, along with other related patents, are currently the subjects of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California. Silicon Precision is one of the co-defendants in the *Tessera* litigation.

6. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

7. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," in which the April 16, 2007 notice was vacated.

8. On May 8, 2007 the requester submitted, in response to the Modified Notice, a paper titled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

9. The Office issued a decision granting the request for reexamination in the '0227 reexamination proceeding on May 04, 2007.

10. On April 17, 2007 the third party requestor, Siliconware, submitted a paper titled "Litigation Activity Update under 37 C.F.R. 1.985." On May 7, 2007 the patent Owner, Tessera, Inc., submitted a paper titled "Notice of Prior and Concurrent Proceedings Pursuant 37 C.F.R. 1.985."

11. On May 7, 2007, the patent owner filed a "Petition Under 37 C.F.R. 1.183 to Admit exhibits on CD-Rom" to permit filing of the exhibits accompanying the Notice of Prior and Concurrent Proceedings Pursuant to 37 C.F.R. 1.985 in the form of CD-ROM.

12. On May 8, 2007 the Patent Owner filed "Petition for Leave to Rebut Improperly Admitted Argument" to suspend 37 C.F.R. 1.939 and enter remarks.This petition is being addressed by a decision mailed on even date with the present decision.

13. On May 18, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision expunging from the record both the third party requestor and patent owner submissions under 37 CFR 1.985.

DECISION

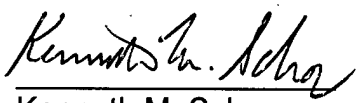
As pointed out above, the Notice of April of 17, 2007 by the Third Party Requestor, Siliconware, "Litigation Activity Update under 37 C.F.R. 1.985" has been expunged, and is thus not available for rebuttal or comment by patent owner. Accordingly the petition is moot and is being dismissed.

This decision is not addressed to the merits of the petition, and has not considered it to any extent.

CONCLUSION

1. The Petition filed on May 8, 2007 to Suspend 37 C.F.R. 1.939 requesting For Leave to Rebut Improperly Admitted Argument is **DISMISSED.**

2. Telephone inquiries related to this decision should be directed to Nuzzolillo, Maria, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.



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

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(For Patent Owner)

MAILED

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CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Khandors	:	DISMISSAL OF
Reexamination Proceeding	:	PETITION
Control No.: 95/000,227	:	OPPOSE PETITION TO
Filed: February 9, 2007	:	UNDER 37 C.F.R. 1.183
	:	TO ADMIT EXHIBITS
For: U.S. Patent No.: 6,433,419	:	ON CD-ROM

This is a decision on the May 7, 2007 patent owner petition titled "Petition Under 37 C.F.R. 1.183 to Admit exhibits on CD-Rom" to permit the filing, in the form of CD-ROM, of the exhibits to the Notice of Prior and Concurrent Proceedings Pursuant to 37 C.F.R. 1.985 that accompanied the petition.

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

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

BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent was filed by a third party requester, Silicon Precision Industries Co., Ltd. Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 90/000,227 (the '0227 proceeding).

3. Also on February 9, 2007, a request for *inter partes* reexamination of companion patent 6,465,893 (the '893 patent) was filed by a third party requester, Silicon Precision Industries Co., Ltd.. Again, Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). This companion request was assigned control No. 90/000,229 (the '0229 proceeding).

4. On March 26, 2007, the patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like petition was filed in the companion '0229 proceeding.

5. Patent owner's petition stated that the '419 and '893 patents, along with other related patents, are currently the subjects of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California. Silicon Precision is one of the co-defendants in the *Tessera* litigation.

6. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

7. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," in which the April 16, 2007 notice was vacated.

8. On May 8, 2007, the requester submitted, in response to the Modified Notice, a paper titled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

9. The Office issued a decision granting the request for reexamination in the '0227 reexamination proceeding on May 04, 2007.

10. On April 17, 2007 the third party requestor, Siliconware, submitted a paper titled "Litigation Activity Update under 37 C.F.R. 1.985." On May 7, 2007 the patent Owner, Tessera, Inc., submitted a paper titled "Notice of Prior and Concurrent Proceedings Pursuant 37 C.F.R. 1.985."

11. On May 7, 2007, the patent owner filed a "Petition Under 37 C.F.R. 1.183 to Admit exhibits on CD-Rom" to permit filing of the exhibits accompanying the Notice of Prior and Concurrent Proceedings Pursuant to 37 C.F.R. 1.985 in the form of CD-ROM.

12. On May 8, 2007 the Patent Owner filed "Petition for Leave to Rebut Improperly Admitted Argument" to suspend 37 C.F.R. 1.939 and enter remarks. This petition is being addressed by a decision mailed on even date with the present decision.

13. On May 18, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision expunging from the record both the third party requestor and patent owner submissions under 37 CFR 1.985.

DECISION

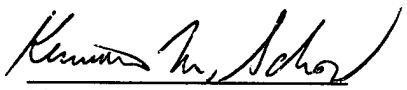
As pointed out above, the Notice of Prior and Concurrent Proceedings Pursuant to 37 C.F.R. 1.985 filed on May 7, 2007 by the Patent Owner, Tessera, Inc. has been expunged, and is thus not available for a submission of a CD-ROM with respect to that paper. Accordingly the petition is moot and is being dismissed.

This decision is not addressed to the merits of the petition, and has not considered it to any extent. Any petition directed to the matter of submitting documents on CD-ROM can only be considered once it is known what will be submitted.[1] Since it is not known what any replacement 37 CFR 1.985 might or might not contain, any consideration prior to that time is premature.

CONCLUSION

1. The Petition filed on May 7, 2007 under 37 CFR. 1.183 to admit exhibits on CD-ROM is **DISMISSED.**

2. Telephone inquiries related to this decision should be directed to Nuzzolillo, Maria, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.



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

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[1] See 37 CFR 1.52 and MPEP 609.04(a) with respect to CD submission of sequence listings, large tables and computer program listings.

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MAILED

JUN 08 2007

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Khandors	:	
Reexamination Proceeding	:	DECISION DENYING
Control No.: 95/000,227	:	PETITION TO
Filed: February 9, 2007	:	VACATE FILING DATE
	:	
For: U.S. Patent No.: 6,433,419	:	

This is a decision on the March 26, 2007, patent owner's "Petition to Vacate Filing Date in *Inter Partes* Reexamination or, alternatively, to Suspend *Inter Partes* Reexamination Proceedings" under 37 CFR 1.182 and 1.183. A May 8, 2007 "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination" has also been filed.

The petition and opposition are before the Office of Patent Legal Administration for consideration.

The petition is denied for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent was filed by a third party requester, Silicon Precision Industries Co., Ltd. (hereinafter "Silicon Precision"). Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 90/000,227 (the '0227 proceeding).

3. On February 15, 2007, a request for *inter partes* reexamination of companion patent 6,465,893 (the '893 patent) was filed by Silicon Precision. Again, Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). This companion request was assigned control No. 90/000,229 (the '0229 proceeding).

4. On March 26, 2007, the patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like petition was filed in the companion '0229 proceeding.

5. Patent owner's petition provides that the '419 and '893 patents, along with other related patents, are currently the subjects of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California. Silicon Precision is one of the co-defendants in the *Tessera* litigation.

6. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

7. On April 17, 2007 the third party requestor, Siliconware, submitted a paper titled "Litigation Activity Update under 37 C.F.R. 1.985." On May 7, 2007 the patent Owner, Tessera, Inc., submitted a paper titled "Notice of Prior and Concurrent Proceedings Pursuant 37 C.F.R. 1.985."

8. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," in which the April 16, 2007 notice was vacated.

9. The Office issued a decision granting the request for reexamination in both the '0227 and '0229 reexamination proceedings on May 04, 2007. The decision granting the '0227 request was accompanied by the first Office action on the merits.

10. On May 7, 2007, the patent owner filed a "Petition Under 37 C.F.R. 1.183 to Admit exhibits on CD-Rom" to permit filing of the exhibits accompanying the Notice of Prior and Concurrent Proceedings Pursuant to 37 C.F.R. 1.985 in the form of CD-ROM.

11. On May 8, 2007, the requester submitted, in response to the Modified Notice, a paper titled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

12. Also on May 8, 2007 the Patent Owner filed a "Petition for Leave to Rebut Improperly Admitted Argument" to suspend 37 C.F.R. 1.939 and enter remarks.

13. On May 21, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision expunging from the record both the third party requestor and patent owner submissions under 37 CFR 1.985.

14. Also on May 21, 2007, the Senior Legal Advisor of Office of Patent Legal Administration issued concurrent decisions dismissing the "Petition Under 37 C.F.R. 1.183 to Admit exhibits on CD-Rom" and the "Petition for Leave to Rebut Improperly Admitted Argument," respectively.

DECISION

1. In the February 9, 2007 request for *inter partes* reexamination, the third party requestor identified Silicon Precision as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). In requester's May 8, 2007 response to the "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," requester has now verified, that Silicon Precision is the real party in interest. Nothing further is required by statute, as 35 U.S.C. 311(b)(1) requires that the request for *Inter Partes* Reexamination "include the identity of the real party in interest". Likewise, 37 C.F.R. 1.915(b)(8) requires "[a] statement identifying the real party in interest". Nothing more is required by the statutes or rules, for compliance with the "real party in interest" filing date requirement. It would thus be inappropriate to vacate or terminate the present proceeding, based on the issue raised as to the identity of the "real party in interest."

2. Even if the "real party in interest" is shown to be misstated, the statute and rules do not provide a remedy for such misstatement to be addressed in the Office. Rather, relief from such a misstatement can only be addressed via the courts. It is to be observed that the courts, in which discovery, testimony and other tools (such as subpoena power) are available, provide the forums best equipped to determine who is, and who is not, the real party in interest. Further, the courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if such a request is already filed, the court can enjoin participation by the requester in the proceeding, where appropriate, thereby essentially turning the proceeding into an *ex parte* reexamination proceeding, the filing of which is not prohibited by statute and rule, even after an *inter partes* reexamination was filed by the

same real party in interest. [1] Also, if (1) a decision in the present *inter partes* proceeding is ultimately made which is adverse to the requestor, and (2) the issue is presented before a court by way of a civil action, the courts (at that point in time) can address any estoppel considerations which may or not apply, depending on the court's resolution (at that time) of the "real party in interest" issue.

As a final point, the patent owner's petition does not allege that the identity of the real party in interest will change the manner in which the present proceeding is handled, and no change can be found by the Office. It is only the *potential* resulting statutory estoppels/prohibitions against the real party in interest (which the petition urges to be more parties than Silicon Precision), which is the concern of petitioner. To that extent, the determination of any potential relief to patent owner is premature, and, as pointed out above, is a decision for the courts to determine. If patent owner can provide basis for immediate relief being needed (e.g., to enjoin future party filings of reexamination and/or civil litigation activity), the patent owner has recourse to the United States District Court for the Northern District of California, before which court the *Tessera* litigation is now pending. A motion to that court could be filed to address the relief that patent owner feels is warranted.

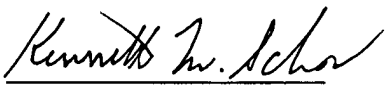
CONCLUSION

1. The patent owner petition filed on March 26, 2007 under 37 CFR. 1.182 and 1.183 is **DENIED**.

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 (CRU).

4. Telephone inquiries related to this decision should be directed to Nuzzolillo, Maria, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.



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

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[1] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

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(For Requester)

In re Khandors	:
Reexamination Proceeding	: DECISION ON
Control No.: 95/000,227	: PETITION FOR
Filed: February 9, 2007	: RECONSIDERATION
For: U.S. Patent No.: 6,433,419	:

This is a decision on the July 02, 2007 patent owner REQUEST FOR RECONSIDERATION OF DECISION DENYING PETITION TO VACATE FILING DATE" filed under 37 CFR 1.182 and 1.183.

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

The petition is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested. The instant decision is designated as a final agency decision.

BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent was filed by a third party requester, Silicon Precision Industries Co., Ltd. (hereinafter "Silicon Precision"). Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 90/000,227 (the '0227 proceeding).

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4. On March 26, 2007, the patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like petition was filed in the companion '0229 proceeding.

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6. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

7. On April 17, 2007 the third party requester, Siliconware, submitted a paper titled "Litigation Activity Update under 37 C.F.R. 1.985." On May 7, 2007 the patent Owner, Tessera, Inc., submitted a paper titled "Notice of Prior and Concurrent Proceedings Pursuant 37 C.F.R. 1.985."

8. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," in which the April 16, 2007 notice was vacated.

9. The Office issued a decision granting the request for reexamination in both the '0227 and '0229 reexamination proceedings on May 04, 2007. The decision granting the '0227 request was accompanied by the first Office action on the merits.

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11. On May 8, 2007, the requester submitted, in response to the Modified Notice, a paper titled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

12. Also on May 8, 2007 the Patent Owner filed a "Petition for Leave to Rebut Improperly Admitted Argument" to suspend 37 C.F.R. 1.939 and enter remarks.

13. On May 21, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision expunging from the record both the third party requester and patent owner submissions under 37 CFR 1.985 as improper papers.

14. Also on May 21, 2007, the Office of Patent Legal Administration (OPLA) issued concurrent decisions dismissing the "Petition Under 37 C.F.R. 1.183 to Admit exhibits on CD-Rom" and the "Petition for Leave to Rebut Improperly Admitted Argument," respectively.

15. On June 8, 2007, OPLA issued a decision denying the Patent Owner request of March 26, 2007, under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like decision was issued for the companion '0229 proceeding.

16. On July 2, 2007 the Patent Owner filed a "Request for Reconsideration of [the June 8, 2007] Decision Denying Petition to Vacate Filing Date."

DECISION

In the February 9, 2007 request for *inter partes* reexamination, the third party requester identified Silicon Precision as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). In requester's May 8, 2007 response to the "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," requester verified that Silicon Precision is the "real party in interest." Absent clear evidence that the identified "real party in interest" is erroneously identified, nothing further is required by the statute. Specifically, 35 U.S.C. 311(b)(1) simply requires that the request for *Inter Partes* Reexamination "include the identity of the real party in interest," and in this instance the requester has done so.

At pages 5 and 6 of the present petition, petitioner argues that "the statute's text does not require that the request include a 'statement ' identifying the real party in interest; it requires that the request '*include the identity* of the real party in interest.' § 311(b) (i) (emphasis added). Further, petitioner asserts that no 'statement' can satisfy the statute unless it actually 'includes the identity' of that person or persons." Id. In the present instance, requester has identified "Silicon Precision Industries Co., Ltd." as the "real party in interest." Thus, requester has provided the identity to the extent required by the statute, and nothing in the statute requires the Office to investigate the accuracy of that identification, absent clear evidence that the identification is inaccurate. In this instance, petitioner relies on "DEFENDANTS' JOINT MOTION TO STAY PROCEEDINGS PENDING REEXAMINATION OF THE PATENTS-IN-SUIT" filed March 22, 2002 ("the joint motion"), in the *Tessera*

district court litigation to assert that the correct real party in interest is not identified in this proceeding. Page 1 of the joint motion states:

> PLEASE TAKE NOTICE that on April 26, 2007, at 2:00 p.m., or as soon thereafter as the parties may be heard, in the courtroom of the Honorable Claudia Wilken, Courtroom 2, 4th Floor, located at 1301 Clay Street, Oakland, California 94612, Defendants Advanced Micro Devices, Inc., Spansion Inc., Spansion Technology Inc., Spansion LLC, Advanced Semiconductor Engineering, Inc., ASE (U.S.) Inc., ChipMOS Technologies Inc., ChipMOS U.S.A., Inc., Siliconware Precision Industries Co., Ltd., Siliconware USA Inc., STMicroelectronics N.V., STMicroelectronics, Inc., Stats ChipPAC Ltd., Stats ChipPAC, Inc., and Stats ChipPAC (BVI) Limited (collectively "Defendants") will, and hereby do, move the Court for an order staying all proceedings pending reexamination by the United States Patent & Trademark Office ("PTO") of each of the patents-in-suit.

Further, footnote 10 at page 18 of the petition details petitioner's basis for its allegation that the correct real party in interest is not identified in this proceeding, as follows:

> Specifically: Tessera's evidence showing that SPIL is not the real party in interest included, among other things, the following: (i) SPIL and the other defendants in litigation with Tessera have claimed that their communications relating to the reexamination are protected by a joint defense privilege pursuant to a "Defendants' Common Interest Agreement"; (2) SPIL and the other defendants collectively drafted Preliminary Invalidity Contentions incorporating all of the prior art cited in the reexamination proceedings; (3) SPIL and the other defendants jointly filed an unsuccessful motion to stay the litigation based on their reexamination requests; and (4) SPIL filed a "Litigation Activity Update" on May 22, 2007, in the Office for the express purpose of asking the Office to expedite its issuance of a first Office Action in view of an investigation by the International Trade Commission in which only other defendants (and not SPIL) are respondents.

Petitioner relies upon the above as argument that the *Tessera* co-defendants should all be named in the present reexamination as real parties in interest. However, petitioners argument that the co-defendants all appear to rely on the request for reexamination as a basis for their joint motion to stay the litigation, and have collectively participated in other matters, does not establish that the co-defendants are real parties in interest in this reexamination proceeding. The fact that Silicon Precision's co-defendants may benefit from this reexamination request, or that Silicon Precision may be collaborating with others in a concurrent litigation and other matters, does not, by itself, evidence those co-defendants to be real parties in interest in this reexamination.

With respect to the Office conducting an investigation to ferret out whether a particular party is a "real party in interest" - - the statute does not require, nor does it provide the tools, for the Office to investigate the matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination - - nor did not authorize the Office to impose punitive sanctions for non-compliance. Such evidentiary tools are,

however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest." [1]

To expand, courts have discovery, testimony and other evidentiary tools (e.g., subpoena power and sanctions) available, and are the forums best equipped to determine who is, and who is not, the "real party in interest." Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if such an *inter partes* reexamination request was filed by one of the other parties in the civil action, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 USC 301-302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[2] In addition, if (1) a decision in the present *inter partes* proceeding is ultimately made which is adverse to the requester, and (2) the issue is presented before a court, any estoppel considerations which may or may not apply from the *inter partes* reexamination statute, depending on the court's resolution of the "real party in interest" issue can be addressed by the court at that time.

The petitioner also argues (at p. 9) that "outside the Office 'real party in interest' precedent universally requires a party whose disclosure has been challenged to provide support for the disclosure, citing federal district court cases as examples, and referring to areas such as jurisdiction (e.g., presence of diversity or amount of suit) and representative suits such as bankruptcies and probate. Petitioner further asserts (at page 9) that "[o]ther tribunals routinely look behind self-certifications of the real party in interest if a challenge has been made, sometimes aggressively." However, petitioner's reliance on examples of court proceedings resolving "real party in interest" issues is precisely the reason why the Office

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[1] Note *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), where the court took note of parties' availability of the court's investigative powers, to address the absence of same to the Office.

> "During ex parte PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under 37 C.F.R. Section 1.132 (1993). Moreover, if applicants wish to cross-examine the authors of written hearsay assertions, under 35 U.S.C. Section 145 (1988) they may bring a civil action in the United States District Court for the District of Columbia seeking adjudication that they are entitled to receive a patent. In such an action, testimony could be compelled by subpoena under Federal Civil Procedure Rule 45. See Gould v. Quigg , 822 F.2d 1074, 1076, 3 USPQ2d 1302, 1303 (Fed.Cir. 1987) ("While the evidentiary record before the Board serves as the 'evidentiary nucleus' of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence."). [32 F.3d at 1565, 31 USPQ2d at 1821]

Note further MPEP 2010 which states:

> "The Office is not the best forum in which to determine whether there was an 'intent to mislead'; such intent is best determined when the trier of facts can observe demeanor of witnesses subjected to cross-examination. A court, with subpoena power, is presently the best forum to consider duty of disclosure issues under the present evidentiary standard for finding an 'intent to mislead'."

See also MPEP 2686.04(III) which points to this difference between the Office and the courts stating:

> "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)."

[2] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

cannot perform such a function here. That is - - the Office does not possess subpoena, discovery, hearing and sanction tools that a court and certain other tribunals possess. As pointed out in our June 8, 2007 decision, [3] petitioner may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present reconsideration petition is *silent* as to why petitioner did not approach the *Tessera* District Court for relief (e.g., an investigation into the matter and an appropriate order), despite the invitation to do so in the last 2 sentences of the June 8, 2007 decision. The petition is also silent as to why petitioner has re-approached the Office for relief, despite the fact that the Office is not equipped with the necessary discovery or evidentiary tools to ferret out the relevant information, while petitioner would not immediately approach the court, which *is* so-equipped.

In addition, petitioner (pet. at 6) emphasizes the importance of "real party in interest" disclosure requirement:

> The real party in interest disclosure requirement is at the core of the *inter partes* reexamination statute, *cf. Reyna*, 218 F.3d at 1111, for it determines the scope of the unique statutory estoppel associated with the proceeding. See 35 U.S.C. § 315 and P.L. 106-113 § 4607 (subjecting requestors to estoppel as to issues they raised or could have raised). Thus, the statute is written so that "anyone who requests *inter partes* reexamination must identify the real party in interest[,] and third-party requesters who participate in an *inter partes* reexamination proceedin[g] are estopped from raising in a subsequent court action or *inter partes* reexamination any issue of patent validity that they raised or could have raised during such *inter partes* reexamination." G. Mossinghoff, "Post-Grant Review Of Patents," 43 IDEA 83, 91 (2002). The real party in interest requirement is thus critical "[t]o prevent harassment" of patent owners under the statute, id., for otherwise third parties could hide behind others serving the same interest, in an attempt to escape estoppel in subsequent litigations. Indeed, this "important distinction" between *ex parte* and *inter partes* reexamination is regarded as *the "price for th[e] right....*

Given petitioner's allegation of the importance of the matter, petitioner could have immediately requested investigation by the *Tessera* court into the issue of "real party in interest." Petitioner voluntarily chose not to.

With respect to 37 CFR 1.915(b) regarding the issue of "real party in interest," the following discussion is provided. 37 CFR 1.915(b)(8) requires "[a] statement identifying the real party in interest to the extent necessary for a subsequent person filing an inter partes reexamination request to determine whether that person is a privy." Silicon Precision is identified as the "real party in interest," and further has been identified sufficiently for a

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[3] The last 2 sentences of the DECISION section of the June 8, 2007 decision state:

"If patent owner can provide basis for immediate relief being needed (e.g., to enjoin future party filings of reexamination and/or civil litigation activity), the patent owner has recourse to the United States District Court for the Northern District of California, before which court the Tessera litigation is now pending. A motion to that court could be filed to address the relief that patent owner feels is warranted."

party to know where it is located, and which business it operates under. To the extent that petitioner construes 37 CFR 1.915(b)(8) to require inclusion of the identity of all parties who would be related or co-defendants of Silicon Precision, such a construction would be unreasonable. Simply because a party may be related to or a co-defendant of Silicon Precision does not necessarily make that party a "real party in interest."

In the last complete paragraph of page 7 of the petition, petitioner has characterized requester's identification of the "real party of interest" as "patently false statements." As pointed out above, petitioner has not shown that any of the *Tessera* co-defendants qualify as "real party in interest" but has simply shown that the co-defendants are simply that -- co-defendants in a civil suit. Further, we unaware of - - and petitioner has not pointed to - - any authority that equates co-defendants in a civil suit with "real parties in interest" in an inter partes reexamination proceeding.

Petitioner's position appears to be that because the *Tessera* co-defendants' may benefit from this reexamination proceeding along with collaborating with Silicon Precision in concurrent litigation they should automatically qualify as a "real party interest" in this reexamination. As pointed out above, it is the Office's position that such is not the case. The difference in petitioner's interpretation of a "real party in interest," and that of the requester does not make the requester's statements of identification, on their face, "patently false statements." Further, the Office relies on factual assertions made before it as true. See 37 CFR 10.18(b) ("By presenting to the Office . . . any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that . . . statements made therein of the party's own knowledge are true . . ."). And, as explained earlier, the Office is not equipped with the proper evidentiary tools to scrutinize the veracity of such asserted facts. While petitioner's allegation that requester has made "patently false statements," if proven in the proper forum, could bear on the issue of conduct,[4] in this proceeding, it simply rises to the level of a difference in interpretation of the term "real party in interest" - - and to the extent that the statute requires the "real party in interest" be identified for purposes of this proceeding, Requester has done so.

CONCLUSION

1. The patent owner petition for reconsideration is granted to the extent that the prior decision has been fully reconsidered, and 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.

---

[4] 37 CFR 1.3 ("Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy.").

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit (CRU).

4. Telephone inquiries related to this decision should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.

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

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(For Patent Owner)

MAILED

DEC 19 2007

CENTRAL REEXAMINATION U.

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(For Third Party Requester)

In re Tessera, Inc.
Inter Partes Reexamination Proceeding
Control No.: 95/000,227
Filed: February 9, 2007
For: U.S. Patent No.: 6,433,419 B2

: **DECISION GRANTING**
: **REQUESTER PETITION AND**
: **SEALING PAPERS**

This is a decision on the November 27, 2007 third party requester petition entitled "PETITION TO NOT ENTER PATENT OWNER'S SUPPLEMENTAL RESPONSE 37 CFR § 1.182".

The petition and the 95/000,227 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the above petition.

The petition is granted for the reasons set forth below. In addition, the supplemental response in question is sealed so that it will not form a part of the active Image File Wrapper (IFW) record.

FEES

The petition fee of $ 400.00 (37 CFR 1.17(f)) has been charged to Deposit Account No. 18-1579 as authorized in the requester's petition.

REVIEW OF SALIENT FACTS

1. Patent number 6,433,419 ("the '419 patent") issued on August 13, 2002.

2. A request for *inter partes* reexamination of the '419 patent was filed on February 9, 2007, and was assigned control No. 95/000,227 (the '227 *inter partes* reexamination proceeding).

3. An Order Granting *Inter Partes* Reexamination in the '227 *inter partes* reexamination proceeding was mailed on May 4, 2007.

4. On June 5, 2007, a non-final Office action on the patentability of the claims for which reexamination was ordered was mailed in the '227 *inter partes* reexamination proceeding.

5. On August 10, 2007, patent owner filed a response to the June 5, 2007 Office action as provided for by 37 CFR 1.945. The response was timely filed because it included a 37 CFR 1.8 certificate of mailing dated August 6, 2007, which was a Monday.

6. On September 5, 2007, third party requester timely filed written comments directed to the August 6, 2007 patent owner response. Such comments are provided for by 37 CFR 1.947.

7. On October 26, 2007, patent owner filed a petition to strike the August 6, 2007 third party requester comments. That petition will be treated in a separate decision

8. On November 9, 2007, patent owner filed papers styled as a "Supplemental Response" that are directed to the June 5, 2007 non-final Office action.

9. On November 27, 2007, third party requester filed the present petition directed to the patent owner paper.

DECISION

I. Relevant Authority

35 U.S.C. § 314(b)(2) provides:

> "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 1.111(a)(2) reads as follows:

> (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.
> (ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

37 CFR 1.181(a) provides:

> 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 1.182 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 1.937(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:

(a)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.

(b)Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.

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."

II. Background and Relief Requested

A review of the record shows that the patent owner paper filed on August 10, 2007, as a response to the June 5, 2007 non-final Office action, relies in part on a written verified statement executed by Dr. Ephraim Suhir. It also appears from the record that the September 5, 2007 third party requester written comments directed to the August 10, 2007 patent owner response contains comments, (beginning at page 16), that are directed to whether Dr. Suhir is "an independent expert." The third party requester's written comments also rely on a written verified statement executed by Dr. Richard Ulrich that is offered to provide a technical analysis of the patent owner's assertions and Dr. Suhir's conclusions.

Thereafter, on November 9, 2007, patent owner filed papers styled as a supplemental response directed to the June 5, 2007 non-final Office action. The present third party requester petition seeks to have the supplemental response stricken in its entirety (*i.e.*, with all declarations and exhibits attached thereto), for failure to comply with 37 CFR 1.111.

III. Analysis and Findings

The third party requester petition is styled as a petition under 37 CFR 1.182. The rule provides that a petitioner may request relief in "[A]ll situations not specifically provided for in the regulations of this part," and that a petition requesting such relief "will be decided in accordance with the merits of each situation by or under the authority of the Director."

Petitioner third party requester asserts that the entry of a supplemental response is addressed by 37 CFR 1.111, and that 37 CFR 1.111 is applicable to the present *inter partes* reexamination proceeding pursuant to 37 CFR 1.937(b). However, it is to be noted that 37 CFR 1.945 was amended on May 16, 2007 to specifically address the treatment of a patent owner supplemental response to an Office action. As amended, 37 CFR 1.945(b) states that a supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
(3) A compelling reason to enter the supplemental response.

In turn, the requirements of 37 CFR 1.111(a)(2)(i) are that unless the supplemental response is entitled to entry as a matter of right because it was filed while the proceeding was suspended, the supplemental response may not be entered a proceeding unless the supplemental response 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.

If an attempt to satisfy the requirements of 37 CFR 1.945(b) accompanies the filing of a supplemental response in an *inter partes* reexamination, the examiner is required to evaluate the supplemental response for compliance with the regulation. When the examiner takes action to enter or not enter the supplemental response after that evaluation, and a party is dissatisfied with the examiner's decision, the dissatisfied party could obtain review of the examiner's decision to enter or not enter the supplemental response by filing of a petition under 37 CFR 1.181 for the exercise of supervisory authority to modify or reverse the examiner's treatment of the supplemental response.

However, in this instance, a review of the November 9, 2007 supplemental response filed by patent owner shows that the supplemental response was not accompanied by any showing that facially attempts to comply with the requirements of 37 CFR 1.945(b). Accordingly, there is

nothing for the examiner to evaluate with respect for determining whether the supplemental response is, or is not, entitled to entry. Pursuant to the regulation, the supplemental response is clearly not entitled to entry because:

1) The supplemental response was not entitled to entry as a matter of right pursuant to 37 CFR 1.111(a)(2)(ii), and

2) The supplemental response is clearly not 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.

For the foregoing reasons, the third party requester is entitled to the relief requested in the present 37 CFR 1.182 petition. The supplemental response will not be entered into the active IFW record. Instead, the supplemental response and all papers filed therewith will be sealed by being marked "closed" and "non-public," because they cannot be physically expunged from the IFW record.

CONCLUSION

1. The third party requester petition requesting that the patent owner November 9, 2007 supplemental response, (and accompanying all accompanying papers filed therewith) not be entered is granted.

2. The supplemental response filed on November 9, 2007, and all papers filed therewith, are sealed.

3. A decision on the October 26, 2007 patent owner petition is being mailed on even date.

4. Jurisdiction of the '227 *inter partes* reexamination proceeding will be returned to the Central Reexamination Unit for appropriate action on the patent owner response filed on August 10, 2007, and the third party requester written comments filed on September 5, 2007.

5. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

sm
December 18, 2007

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CENTRAL REEXAMINATION UNIT

Tracy Druce
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(For Third Party Requester)

In re Tessera, Inc.
Inter Partes Reexamination Proceeding
Control No.: 95/000,227
Filed: February 9, 2007
For: U.S. Patent No.: 6,433,419 B2

: **DECISION**
: **DISMISSING**
: **PATENT OWNER**
: **PETITION**

This is a decision on the October 26, 2007 patent owner petition entitled "PETITION TO STRIKE REQUESTOR'S COMMENTS." The petition is filed pursuant to 37 CFR 1.182.

The petition and the 95/000,227 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the above petition.

The petition is dismissed for the reasons set forth below.

FEES

The petition fee of $ 400.00 (37 CFR 1.17(f)) has been charged to Deposit Account No. 18-1579 as authorized in the patent owner petition.

REVIEW OF SALIENT FACTS

1. Patent number 6,433,419 ("the '419 patent") issued on August 13, 2002.

2. A request for *inter partes* reexamination of the '419 patent was filed on February 9, 2007, and was assigned control No. 95/000,227 (the '227 *inter partes* reexamination proceeding).

3. An Order Granting *Inter Partes* Reexamination in the '227 *inter partes* reexamination proceeding was mailed on May 4, 2007.

4. On June 5, 2007, a non-final Office action on the patentability of the claims for which reexamination was ordered was mailed in the '227 *inter partes* reexamination proceeding.

5. On August 10, 2007, patent owner filed a response to the June 5, 2007 Office action as provided for by 37 CFR 1.945. The response was timely filed because it included a 37 CFR 1.8 certificate of mailing dated August 6, 2007, which was a Monday.

6. On September 5, 2007, third party requester timely filed written comments directed to the August 6, 2007 patent owner response. Such comments are provided for by 37 CFR 1.947.

7. On October 26, 2007, patent owner filed the present petition to strike the August 6, 2007 third party requester comments.

8. On November 9, 2007, patent owner filed papers styled as a "Supplemental Response" that are directed to the June 5, 2007 non-final Office action.

9. On November 27, 2007, third party requester has filed a petition directed to the patent owner paper. That petition will be treated in a separate decision.

DECISION

I. Relevant Authority

35 U.S.C. § 314(b)(2) provides:

> "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:

> "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 § 2658(IV) provides in pertinent part:

> "*G. Affidavits in Reexamination*
>
> Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding. Note, however, that an affidavit under 37 CFR 1.131 may not be used to "swear back" of a reference patent if the reference patent is claiming the same invention as the patent undergoing reexamination. In such a situation, the patent owner may, if appropriate, seek to raise this issue via an affidavit under 37 CFR

1.130 (see MPEP § 718) or in an interference proceeding via an appropriate reissue application if such a reissue application may be filed (see MPEP § 1449.02).

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."

II. Background and Relief Requested

A review of the record shows that the patent owner paper filed on August 10, 2007, as a response to the June 5, 2007 non-final Office action, relies in part on a written verified statement executed by Dr. Ephraim Suhir. It also appears from the record that the September 5, 2007 third party requester written comments directed to the August 10, 2007 patent owner response contains comments, (beginning at page 16), that are directed to whether Dr. Suhir is "an independent expert." The third party requester's written comments also rely on a written verified statement executed by Dr. Richard Ulrich that is offered to provide a technical analysis of the patent owner's assertions and Dr. Suhir's conclusions.

Patent owner alleges in the present petition that the allegations in the third party requester's written comments are misleading. The basis for patent owner's allegation is that, while the requester argues that Dr. Suhir is not an independent expert because he has been employed by patent owner to provide expert opinions for the present '227 *inter partes* reexamination proceeding and for litigation, the requester comments omit facts that would cast doubt on whether Dr. Ulrich is an independent expert, and that these facts would go the credibility of Dr. Ulrich. Thus, patent owner requests that the third party requester's comments be stricken.

III. Analysis and Findings

Initially, it is noted that evidence going to the credibility of expert testimony (whether in the form of oral or written depositions, verified statements of any kind including those executed pursuant to 37 CFR 1.132, or oral testimony offered in litigation) does not go beyond the scope of information that may be properly considered in an *inter partes* reexamination proceeding. See subsections IV(G) and IV(H) of MPEP § 2658.

Further, it appears that in *Ferring B.V. et al v. Barr Laboratories, Inc.*, 437 F.3d 1181; 2006 U.S. App. LEXIS 3554; 78 USPQ2d 1161 (Fed. Cir. 2006) and in *Ole K. Nilssen et al v. Osram Sylvania Products,* 2007 U.S. App. LEXIS 23733 (Fed. Cir. 2007), the Federal Circuit discussed the importance of information bearing on the credibility of an affiant/declarant in matters pending before the Office, as, for example, bias on the part of affiant/declarant. Failure to disclose, in a proceeding before the Office, information regarding the relationship of an affiant/declarant to the party who proffered a verified statement of that affiant/declarant as evidence was deemed to raise issues of inequitable conduct. *Nilssen*, Slip opinion at 11-12; *Ferring B.V.*, 437 F.3d at 1187-1188.

Therefore, the written comments filed by the third party requester on August 10, 2007, are not deemed to contain material that should be stricken. Rather, the information in the third party written comments would appear to be information that can be material to patentability in that it bears on the impartiality of the patent owner's affiant/declarant, and hence on credibility.

This conclusion is especially warranted in light of the additional information bearing on credibility that is present in the present patent owner petition. Stated differently, if the information appearing in the third party requester comments that is alleged to bear on the impartiality (and therefore the credibility) of Dr. Suhir is deemed to be improper such that the third party requester's written comments should be stricken, then it would logically follow that the material that is directed to the impartiality (and therefore the credibility) of Dr. Ulrich contained in the present patent owner petition would warrant striking of this petition.

In light of the discussions in the *Nilssen* and *Ferring B.V.* cases regarding the importance of information that would bear on the credibility of an affiant/declarant when a verified statement is filed in proceedings before the Office, it is considered that petitioner patent owner has not demonstrated that the third party requester written comments filed on August 10, 2007 should be stricken.

ADDITIONAL DISCUSSION

To date, the Office regards the issues raised by each party regarding the other party's declarant as having been properly presented as appropriate material information that an examiner may consider. These issues have not been presented as issues of improper conduct on the part of the party relying upon the declarant. However, each party in this proceeding must not make comments regarding the propriety of the conduct of the opposing party. Fraud, "improper conduct" by an opposing party, and the like are not relevant considerations in an *inter partes* reexamination proceeding. The reexamination statute authorizes the Office to consider only prior patents/printed publications, and evidence bearing on the content thereof, as the basis for conferring jurisdiction to reexamine an issued patent, and as the basis for determining the patentability of issued patent claims in an *inter partes* reexamination proceeding. Qualifications and credibility of a declarant are material to such patentability determination. Alleged "misconduct" is not.

The present '227 *inter partes* reexamination proceeding is a proceeding before an administrative agency. It is not litigation. Thus, tactics and comments that may be appropriate in the context of litigation must be carefully considered with respect to the requirements of 37 CFR 1.3 and 37 CFR 10.18(b) before such are incorporated in a paper filed before the Office. The parties are advised that a paper that contains inappropriate comments or otherwise does not comply with 37 CFR 10.18(b) will, at a minimum, result in return of the paper.

CONCLUSION

1. The patent owner petition requesting that the third party requester written comments filed on August 10, 2007 be stricken is dismissed.

2. A decision on the November 27, 2007 requester petition is being mailed on even date.

3. Jurisdiction of the '227 *inter partes* reexamination proceeding will be returned to the Central Reexamination Unit for appropriate action on the patent owner response filed on August 10, 2007, and the third party requester written comments filed on September 5, 2007, as well as for appropriate treatment of the supplemental response filed by patent owner on November 9, 2007.

4. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

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December 4, 2007

December 18, 2007
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ART UNIT	PAPER NUMBER

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

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In re Tessera, Inc.
Inter Partes Reexamination Proceeding
Control No.: 95/000,227
Filed: February 9, 2007
For: U.S. Patent No.: 6,433,419 B2

: **DECISION DISMISSING**
: **PATENT OWNER PETITION,**
: **GRANTING REQUESTER**
: **PETITION, AND SEALING PAPERS**

This is a decision on the January 9, 2008 patent owner petition entitled "RESUBMISSION OF SUPLEMENTAL RESPONSE TO OFFICIAL ACTION, SHOWING PURSUANT TO 37 CFR § 1.945(b) AND PETITION FOR ENTRY." This decision also treats the January 17, 2008 third party requester petition entitled "REQUESTER'S COMMENTS SUBMITTED UNDER 37 CFR § 1.947 AND PETITION TO NOT ENTER PATENT OWNER'S SUPPLEMENTAL RESPONSE OF JANUARY 4, 2008 UNDER 37 CFR §1.182." [1]

The petition papers and the 95/000,227 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the above petitions.

The patent owner petition is granted to the extent that it has been considered. However, for the reasons set forth below, the patent owner petition is dismissed with respect to granting the substantive relief requested therein.

The third party requester petition is granted.

[1] The patent owner petition includes a 37 CFR 1.181 certificate of mailing dated January 4, 2008, the date referred to in requester's petition, but it was received in the Office on January 9, 2008. In accordance with 37 CFR 1.6 and 1.8, the patent owner petition is considered to have been filed on January 9, 2008, the actual date of receipt in the Office.

FEES

A petition fee of $ 400.00 (37 CFR 1.17(f)) will be charged to Deposit Account No. 12-1095 and a petition fee of $ 400.00 will be charged to Deposit Account No. 14-1437 as authorized in the petition papers filed by the patent owner and the third party requester.

REVIEW OF SALIENT FACTS

1. Patent number 6,433,419 ("the '419 patent") issued on August 13, 2002.

2. A request for *inter partes* reexamination of the '419 patent was filed on February 9, 2007, and was assigned control No. 95/000,227 (the '227 *inter partes* reexamination proceeding).

3. An Order Granting *Inter Partes* Reexamination in the '227 *inter partes* reexamination proceeding was mailed on May 4, 2007.

4. On June 5, 2007, a non-final Office action on the patentability of the claims for which reexamination was ordered was mailed in the '227 *inter partes* reexamination proceeding.

5. On August 10, 2007, patent owner filed a response to the June 5, 2007 Office action as provided for by 37 CFR 1.945. The response was timely filed because it included a 37 CFR 1.8 certificate of mailing dated August 6, 2007, which was a Monday.

6. On September 5, 2007, third party requester timely filed written comments directed to the August 6, 2007 patent owner response. Such comments are provided for by 37 CFR 1.947.

7. On October 26, 2007, patent owner filed a petition to strike the August 6, 2007 third party requester comments.

8. On November 9, 2007, patent owner filed papers styled as a "Supplemental Response" that are directed to the June 5, 2007 non-final Office action.

9. On November 27, 2007, third party requester filed a petition directed to the patent owner "Supplemental Response" paper.

10. On December 19, 2007, a decision was mailed dismissing the patent owner's October 26, 2007 petition.

11. Also on December 19, 2007, a separate decision granting the third party requester's November 27, 2007 petition and sealing the papers that accompanied the patent owner's November 9, 2007 supplemental response papers.

12. On January 9, 2008, patent owner filed the papers resubmitting the supplemental response that had been filed on November 9, 2007 that is currently sealed, together with the present petition, by which petition patent owner requests entry of the resubmitted supplemental response.

13. On January 17, 2008, third party requester filed the present petition opposing the patent owner's January 9, 2008 petition requesting that patent owner petition not be granted and

that the resubmitted supplemental response papers filed with the patent owner petition be sealed. [2]

DECISION

I. Relevant Authority

35 U.S.C. § 314(b)(2) provides:

> 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.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317(b) provides:

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

37 CFR 1.111(a)(2) provides:

> *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.

---

[2] Although the third party requester's January 17, 2008 petition is entitled, "Requester's Comments Submitted Under 37 CFR § 1.947 ... ", it does not appear that the petition includes comments on the merits of the patent owner's supplemental response. Rather, it appears that requester's "comments" are directed to the patent owner's supplemental response only insofar as arguing that the patent owner petition should not be granted and explaining why the supplemental response is not proper for entry.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

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 1.945 provides:

(a)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.

(b)Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1)An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2)An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3)A compelling reason to enter the supplemental response.

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 § 2666(I) provides, in pertinent part:

> Pursuant to 37 CFR 1.937(b):
>
> The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process...
>
> Accordingly, the provisions of 37 CFR 1.111 apply to the response by a patent owner in a reexamination proceeding.
>
> The patent owner may request reconsideration of the position stated in the Office action, with or without amendment to the claims and/or specification. As to amendments in reexamination proceedings, see MPEP § 2666.01.

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. ...
>
> 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. If the next

Office action is an Action Closing Prosecution under 37 CFR 1.949, or an action that otherwise closes prosecution, the entry of the response is governed by 37 CFR 1.116 (see 37 CFR 1.951(a)).

II. Background

A review of the record shows that on August 10, 2007, the patent owner paper filed a response to the June 5, 2007 non-final Office action. That response relied in part on a written verified statement executed by Dr. Ephraim Suhir. It also appears from the record that the September 5, 2007 third party requester filed written comments directed to the August 10, 2007 patent owner response, containing comments (beginning at page 16) that were directed to whether Dr. Suhir is "an independent expert." The third party requester's written comments also relied on a written verified statement executed by Dr. Richard Ulrich that is offered to provide a technical analysis of the patent owner's assertions and Dr. Suhir's conclusions.

Patent owner filed a petition on October 26, 2007, requesting that the third party requester's comments be stricken because the comments were misleading. On November 9, 2007, patent owner then filed a supplemental response directed to the June 5, 2007 non-final Office action. The patent owner's supplemental response addressed the third party requester's written comments in the event that the third party requester's written comments were not stricken as requested in the October 26, 2007 patent owner petition. On November 27, 2007 third party requester filed a petition requesting that the November 9, 2007 patent owner supplemental response be stricken. The patent owner petition was dismissed in a decision mailed on December 19, 2007. The third party requester petition was granted in a separate decision that was also mailed on December 19, 2007. The November 9, 2007 papers comprising the patent owner's supplemental response were sealed.

On January 9, 2008, patent owner has resubmitted the supplemental response to the June 5, 2007 non-final Office action, together with a petition requesting entry of the supplemental response under the provisions of 37 CFR 1.945(b). Patent owner also requested that, in the alternative, the provisions of 37 CFR 1.945(b) be waived pursuant to 37 CFR 1.183 in order to permit entry of the supplemental response. On January 17, 2008, third party requester filed an opposition petition, requesting that patent owner petition not be granted and that the resubmitted supplemental response papers filed with the patent owner petition be sealed.

III. Analysis and Findings

a. Patent Owner's Position -The Provisions Of 37 CFR 1.945(b) Are Satisfied [3]

Patent owner argues that the January 9, 2007 supplemental response will, in patent owner's opinion, render the claims pending in the '227 *inter partes* reexamination proceeding in condition for "allowance." Therefore, patent owner regards the supplemental response as satisfying the condition set forth in 37 CFR 1.111(a)(2)(i)(C) that provides for entry of a supplemental response. Patent alleges, therefore, that the requirements of 37 CFR 1.945(b)(1) are satisfied because the supplemental response satisfies the requirements of 37 CFR 1.111(a)(2)(i)(C).

Patent owner next argues that the provisions of 37 CFR 1.945(b)(2) are satisfied because the material contained in the supplemental response could not have been presented with the

[3] Patent owner's position as presented in the present petition has been carefully and fully considered. The failure to expressly list or discuss each and every point raised by patent owner does not reflect that such was not considered.

originally filed response to the June 5, 2007 Office action, since such material is directed to new proposed grounds of rejection and alleged new evidence contained in the third party requester response to the patent owner's August 10, 2007 response.

Patent owner also argues that there is a compelling reason for entry of the supplemental response under 37 CFR 1.945(b), because entry will eliminate needless work on the part of the examiners.

b. Patent Owner's Position - If Not Satisfied, The Provisions of 37 CFR 1.945 Should Be Waived

Patent owner argues that, in the response to the patent owner's August 10, 2007 response to the June 5, 2007 Office action, third party requester has effectively withdrawn its prior assertions and bases for rejection, and instead posed new purported bases for rejection based on newly submitted evidence and references. Patent owner regards this as effectively constituting a new request for *inter partes* reexamination. Patent owner opines that an Office action based solely upon patent owner's August 10, 2007 response and third party requester's written comments directed to that response might prejudice patent owner at a trial, which is scheduled to begin on February 25, 2008.

c. Patent Owner's Position is Not Persuasive

1. Patent Owner Has Not Established That The Conditions of 37 CFR 1.945(b) Have Been Satisfied

Patent owner has not established that the conditions of 37 CFR 1.111(a)(2)(i) are satisfied, as is required by 37 CFR 1.945(b)(1). Patent owner relies upon the condition set forth in 37 CFR 1.111(a)(2)(i)(C) that provides for entry of a supplemental response when the supplemental response places the proceeding in condition for "allowance." However, in the rulemaking that promulgated 37 CFR 1.111(a)(2)(i), it is noted that "the standard for entry under § 1.116 [of a response after final action] is similar to the standard for entry under § 1.111(a)(2)(i)." [4] That is, with respect to entry of a supplemental response pursuant to 37 CFR 1.111(a)(2)(C), the standard of whether the response has placed "the application in condition for allowance" (or, in a reexamination proceeding, whether the claims are placed in a condition to be held patentable or confirmed) is not a subjective standard based upon an applicant's or patent owner's belief that the supplemental response places the *inter partes* reexamination proceeding in condition for termination favorable to the applicant or patent owner. Rather, the standard under 37 CFR 1.111(a)(2)(C) is an objective standard, *i.e.*, whether the supplemental response adopts examiner's suggestions made on the record of the proceeding, such that the proceeding would be ready for issuance of a Notice of Intent to Issue a Reexamination Certificate. In this regard, note should be taken that in accordance with 37 CFR 1.937(b) and MPEP § 2666(I), the provisions of 37 CFR 1.104 - 1.116 are to be applied in an *inter partes* reexamination proceeding. Thus, it is clear that when construing 37 CFR 1.111(a)(2)(i)(C), it is necessary that the provisions of 37 CFR 1.104 - 1.116 be applied consistently. Therefore when construing 37 CFR 1.111(a)(2)(i)(C), it is appropriate that the language "in condition for allowance" be given the same construction as is mandated by 37 CFR 1.113 and 1.116(b)(1); *i.e.*, that the result of entry of the response would be to cancel all rejected claims and to leave only those claims in the record

[4] 69 FR 56517, 56481

that are patentable. To construe the requirement of 37 CFR 1.111(a)(2)(i)(C) otherwise would have the effect of converting any supplemental response in a reexamination proceeding into a response that would be enterable as a matter of right, simply because the patent owner takes the entirely subjective position that the supplemental response would place the reexamination proceeding in condition for termination with the claims being confirmed or patentable.

Patent owner has not established that the condition of 37 CFR 1.945(b)(2) that patent owner must explain why the supplemental response was not earlier presented has been satisfied. The present proceeding is an *inter partes* reexamination proceeding. In accordance with 37 CFR 1.947, a third party requester has the right to file a single set of written comments directed to a response filed by the patent owner after an Office action. That is where 35 U.S.C. § 314(b)(2) ends the iteration of patent owner and requester addressing the Office action issued. It is clear that the rules do not provided for any entry of a supplemental response filed by patent owner after such third party requester written comments, during that iteration. (Of course, patent owner has the ability to respond to such of those written comments that are adopted by the examiner and are incorporated into the next Office action.) Indeed, patent owner has no way of knowing prior to the next Office action whether a supplemental response after the third party requester files written comments is even necessary, since the examiner may not be persuaded of the merits of the third party requester's comments in the first place. The interpretation that patent owner is placing on 37 CFR 1.945(b)(2) would mean that if a third party requester exercised the right to file written comments pursuant to 37 CFR 1.947, (a regulation that implements a right established by 35 U.S.C. § 314(b)(2)), a patent owner could always file a supplemental response that would be enterable as a matter of right, since such could not have been filed before seeing the third party requester's written comments. The provisions of 37 CFR 1.945(b)(2) and 35 U.S.C. § 314(b)(2) would thus be rendered meaningless. It is to be noted that such an interpretation was expressly rejected in the rulemaking for 37 CFR 1.945(b)(2), [5] wherein it was stated that "[A] showing of sufficient cause will not be established by an explanation that the supplemental response is needed to address the requester's comments (on a patent owner's response), and could not have been presented together with the original response because it was not known that requester would raise a particular point." Therefore, patent owner's position clearly does not accurately reflect the practice mandated by 37 CFR 1.945(b)(2).

Patent owner has not established that the condition of 37 CFR 1.945(b)(3) has been satisfied. *Inter partes* reexamination practice is constructed to permit a patent owner to file a response, and to permit a third party requester to thereafter file written comments thereon. Patent owner's "compelling reason" why the present supplemental response should be entered is simply that it will satisfy patent owner's desire that it be entered because patent owner believes that third party requester's written comments are (1) erroneous and (2) introduce new bases for rejections. The patent owner is once again premature in substituting patent owner's own judgment for what the examiner may or may not decide to do in light of the third party requester's written comments, in the next Office action. Further, 37 CFR 1.947 and the examining practice implemented based on the regulation do not place any restrictions on the comments that a third party requester may file under 37 CFR 1.947 beyond that they address the Office action or the patent owner's response. Indeed, 37 CFR 1.947 is broadly worded, using the language of the statute. Nothing in the reexamination statute or the regulation precludes a third party requester from introducing a new basis for rejection of claims in an *inter partes* reexamination proceeding in rebuttal of a patent owner's response to an Office action. If, as

[5] 72 FR 18892, at 18902.

argued by patent owner, that is the situation arising from the third party requester's response, then patent owner will have to be satisfied with continuation of prosecution in accordance with the *inter partes* regulations. It may be that the examiner will not find third party requester's comments persuasive. If, however, the examiner does adopt some or all of third party requester's comments, and/or finds other bases to reject one or more pending claims, patent owner will have ample opportunity to overcome such rejections as prosecution of the present *inter partes* proceeding continues.

2. Patent Owner Has Not Demonstrated That An Extraordinary Situation Exists Such That Justice Demands Waiver Of The Provisions Of CFR 1.945(b)

Patent owner's alternative argument that due to the fact that the '419 patent is involved in litigation and that trial is scheduled for February 25, 2008, an extraordinary situation exists that would justify waiver of the provisions of 37 CFR 1.945(b) to admit patent owner's supplemental response into the record. Patent owner's theory is that because any action that the examiner takes based upon third party requester's written comments that is adverse to patent owner might be prejudicial to patent owner's position, patent owner is entitled to rebut third party requester's written comments.

However, the situation presented by the circumstance that the '227 *inter partes* reexamination proceeding and litigation on the '419 patent may be copending is not an extraordinary situation. Indeed, Congress recognized that copending litigation and *inter partes* reexamination may exist, and Congress has enacted such provisions as it deemed to be necessary and appropriate with respect to such circumstance. [6] It appears that the intent of Congress was to permit concurrent *inter partes* reexamination and litigation until a point in time in which one proceeding or the other was finally concluded with no further appeal possible, thereby raising certain estoppels at that point in time as to the other proceeding. Apparently, Congress believed that concurrent litigation and *inter partes* reexamination involving the patent in litigation could be trusted to continue without prejudice to a patent owner or to a third party in one proceeding based upon circumstances in the other proceeding. The reexamination regulations and practice reflect these legislative provisions. Indeed, with respect to copending litigation in the courts and reexamination proceedings in the Office on the same patent, in *Ethicon v. Quigg*, 878 F.2d 1422, 1427; 7 USPQ2d 1152, 1155 (Fed. Cir. 1988), the court stated that "T]he district court [from which an appeal had been taken] thought that one of the purposes of the [reexamination] 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, and the courts, unlike the PTO during a reexamination of patent claims, are not limited to review of prior art patents or printed publications, 37 C.F.R. § 1.552(a); *In re Etter*, 756 F.2d 852, 856, 225 USPQ 1, 4 (Fed. Cir. 1985) (*in banc*), but may also consider challenges to validity on other grounds." The *Ethicon* court further noted that "[T]he thought that a PTO decision may unnecessarily complicate the litigation and could create an awkward situation if different conclusions are reached overlooks that challenging validity in a court and requesting PTO reexamination "are concepts not in conflict." *Id.*, at 1428, at 1157. It appears, therefore, that the existence of concurrent litigation and *inter partes* reexamination for the same patent is regarded as being rather normal and not undesirable, and so would not constitute an extraordinary circumstance that would justify

[6] See, for example, 35 U.S.C. §§ 315(c) and 317(b)

waiver of the regulations on the grounds of potential prejudice to patent owner in the litigation based upon an inability to immediately address an argument presented by third party requester in the '227 *inter partes* reexamination proceeding.

d. Third Party Requester's Position

Third party requester's position, as expressed in the opposition petition filed on January 17, 2008, has been fully and carefully considered. A detailed discussion of such position is not, however, deemed to be necessary. To the extent that third party requester requests that the January 9, 2008 patent owner supplemental response not be entered into the record, such is inherent in that patent owner has not demonstrated any basis for entering the supplemental response.

CONCLUSION

1. The patent owner petition requesting entry of the supplemental response filed on January 9, 2008 is dismissed.

2. The third party requester opposition petition is granted to the extent that the January 9, 2008 supplemental patent owner response will be sealed by being marked "closed" and "non-public." The supplemental response will not form part of the official record of the '227 *inter partes* reexamination proceeding.

3. Jurisdiction of the '227 *inter partes* reexamination proceeding will be returned to the Central Reexamination Unit for appropriate action on the patent owner response filed on August 10, 2007, and the third party requester written comments filed on September 5, 2007.

4. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

sm
February 11, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419		6504

530 7590 03/18/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2008

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

Commissioner for Patents
United States Patent and Trademark Office
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Marcus J. Millet
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

(For Patent Owner

MAILED

MAR 18 2008

CENTRAL REEXAMINATION UNIT

Tracy W. Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Ave.
53rd Floor
Houston, Texas 77002

(For Requester)

: DECISION DISMISSING
: PETITION FOR EXTENSION
: OF TIME
: [37 CFR 1.956)]

In re Khandros *et alia* :
Inter partes Reexamination Proceeding :
Control No. 95/000,227 :
Deposited: 9 February 2007 :
For: U.S. Patent No. 6,433,419 :

This is a decision on the March 10 and 14, 2007 patent owner "Request for Extension of Time Pursuant to 37 CFR 1.956." requesting that the time for responding to the Action Closing Prosecution, Office action dated 19 February 2008, be extended by one additional month or 20 days after final disposition of the petition to invoke the supervisory authority of the Director filed 10 March 2008.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated 19 February 2008, which set a one month date for filing a response thereto. The Office action is a Action Closing Prosecution, and the request for extension is the first request for an extension of time with respect to the outstanding Office action. Further in the request for extension of time dated 10 March 2008 the patent owner requests an extension of time of 20 days following a derision of a petition to invoke the supervisory authority of the Director which is also filed 10 March 2008. The present petitions for extension of time were timely filed on 10 March 2008 and 14 March 2008 respectively with an electronic fee transmittal for the $200.00 petition fee as set forth in 37 CFR 1.956 filed on 14 March 2008. The patent owner further submitted a communication dated 17 march 2008 in which the patent owner noted that issues related to confidentiality in which a one-month extension of time being sought was now resolved, however, the patent owner still seeks the 20 days extension of time.

37 CFR 1.956. Patent owner extensions of time in inter partes reexamination.

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

Addressing the requirement of 37 CFR 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed.

The patent owner has noted in the communication of 17 March 2008 that the confidentiality issues for which the one-month extension of time was sought was now resolved. In light of the communication of 17 March 2008 from the patent owner, the request for one-month extension of time is now moot.

The patent owner additionally seeks 20 days extension of time following the final disposition of a petition filed 10 March 2008. The petition seeks to invoke the supervisory authority of the Director as to why the Action Closing Prosecution should be vacated.

Evaluation as to whether "sufficient cause" has been shown for an extension of time must be made by balancing the desire to provide the patent owner with a fair opportunity to respond against the requirement of the statute. On balance, the time extension to await the decision of another concurrently filed petition is not deemed to be "sufficient cause" to delay the prosecution of a case in which the time to respond is statutorily shortened to expedite prosecution.

If the patent owner seeks an extension of time following this decision in order to complete the present petition for extension, the patent owner must renew the petition and provide the above-identified requisite information to enable the Director of the Central Reexamination Unit to determine whether there is "sufficient cause" to grant the patent owner's request for an extension.

Conclusion

1. The patent owner's petitions for extensions of time filed on March 10 and 14, 2008 are dismissed as incomplete.

2. The patent owner is invited to file a renewed petition for extension of time, without additional fee, addressing the matters raised above. The renewed petition would be directed 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

3. 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
CRU SPE-AU 3992

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Marcus J. Millet (For Patent Owner)
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

MAILED

JUL 16 2008

CENTRAL REEXAMINATION UNIT

Tracy Druce (For Requester)
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, Texas 77002

In re Khandors :
Reexamination Proceeding : DECISION
Control No.: 95/000,227 : DISMISSING
Filed: February 9, 2007 : PETITION
For: U.S. Patent No.: 6,433,419 :

This is a decision on the July 7, 2008 patent owner petition paper entitled "PATENT OWNER'S REQUEST FOR RECONSIDERATION OF "DECISION RETURNING PAPER NOT ENTITLED TO ENTRY RIGHT."

The petition paper and the record of the present proceeding are before the Office of Patent Legal Administration for consideration.

Summary: The petition paper, taken as petition under 37 CFR 1.182, is granted to the extent that the Office has reconsidered its prior decision, but is dismissed with respect to the relief requested therein.

FEES

A petition fee of $400.00 pursuant to 37 CFR 1.17(f), as required by 37 CFR 1.182, will be charged to Deposit Account No. 12-1095

BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent was filed by a third party requester, Silicon Precision Industries Co., Ltd. (hereinafter "Silicon Precision"). Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 95/000,227 ("the '227 *inter partes* reexamination proceeding").

3. On May 4, 2007, an *Order Granting Request for Inter Partes Reexamination* for some of the claims of the '419 patent was mailed.

4. Prosecution on the patentability of the claims for which reexamination had been ordered commenced with a first (non-final) Office action mailed on June 5, 2007.

5. On February 19, 2008, an action closing prosecution was mailed.

6. On June 3, 2008 (and again on June 6, 2008), patent owner filed a petition to vacate the filing date of the '227 *inter partes* reexamination proceeding.

7. On June 11, 2008, third party requester filed a paper opposing the June 3, 2008 patent owner petition. The paper included an opposition petition having attached exhibits, and a petition to expunge the opposition petition and the attached exhibits.

8. On June 13, 2008, prosecution was re-opened by the mailing of a new action closing prosecution.

9. On June 23, 2008, patent owner filed petition paper opposing the June 11, 2008 third party requester paper.

10. On June 25, 2008, the Office mailed a decision "returning" * the June 23, 2008 patent owner petition paper as be a paper that was not entitled to an entry right.

11. On July 7, 2008, patent owner filed the present request for reconsideration of the June 25, 2008 Office decision together with a copy of the June 23, 2008 patent owner petition paper.

12. On July 8, 2008, an Order to Show Cause was mailed in which third party requester was required to explain why its June 11, 2008 petition to expunge should and concurrently filed opposition petition should no each be summarily dismissed.

---

* The return of the June 23, 2008 patent owner petition paper was accomplished by marking the paper as "closed" and "non-public" in the electronic Image File Wrapper (IFW) of the '227 *inter partes* reexamination proceeding. As such, the paper forms no part of the official record in the '227 *inter partes* reexamination proceeding.

DECISION

To accomplish reconsideration of the June 25, 2008 Office decision, the June 23, 2008 petition paper has been reviewed, together with the present petition paper by which patent owner requests relief in the form of entry of the June 23, 2008 petition papers (a copy of which was filed by patent owner concurrently with the present petition paper.

Initially, it is to be noted that patent owner argues that the June 23, 2008 petition paper filed by patent owner, (styled as a "Request to Strike and Opposition to Requestor's Petition to Expunge"), merely questioned the propriety of serving a paper on a party wherein the party served is unable to view the content of the paper because the paper is labeled as being subject to a Protective Order promulgated by a court having jurisdiction of a matter involving the serving and the served parties.

However, the Office did not, and cannot, agree that the June 25, 2008 patent owner paper did not oppose the June 11, 2008 third party requester opposition petition. The June 11, 2008 third party requester opposition petition was itself labeled as being subject to the Protective Order in question, and the exhibits mentioned in the June 23, 2008 patent owner opposition paper were attachments to the opposition petition, not to the petition to expunge. An Office decision that merely held the June 11, 2008 third party requester petition to expunge to be improper would have had no effect on the merits of the of the position taken by patent owner in the June 23, 2008 opposition paper regarding the propriety of third party requester's service of its June 11, 2008 opposition paper and attached exhibits on patent owner. The third party requester opposition petition and the third party requester petition to strike, filed concurrently, were properly viewed by the Office as part of the same submission, and as such, it is clear that June 23, 2008 patent owner opposition paper opposed the propriety of the manner in which the third party requester opposition paper was served on patent owner. For example, patent owner's June 23, 2008 opposition paper stated, at page 5, that "the Office should strike the papers as not served in the manner required" by the rules. Nothing in the June 23, 2008 opposition paper stated the "the papers" in question consisted only of the June 11, 2008 third party requester petition to expunge, and not the third party opposition paper and attached exhibits filed concurrently with the petition to expunge.

Having taken that view, the Office then explained that it considered that the June 3, 2008 patent owner petition to vacate was tantamount to a petition of the type provided for in MPEP § 2646, which provides that a patent owner may file a single petition pursuant to 37 CFR 1.181 requesting vacatur of an Order granting *inter partes* reexamination on the grounds that the Order was an *ultra vires* act. (An Order granting reexamination in a reexamination proceeding that was not properly entitled to a filing date is such an *ultra vires* act.) MPEP § 2646 further provides for a single third party requester opposition paper. There is no provision in MPEP § 2646 for either the patent owner or the third party requester to file multiple petition/opposition papers on the matter. As the June 23, 2008 patent owner paper constituted an opposition to the third party requester opposition to patent owner's June 3, 2008 petition paper, the Office properly held that the June 23, 2008 patent owner paper was a paper not provided for in either the practice discussed in the MPEP, or otherwise. Accordingly, the June 23, 2008 patent owner paper was deemed to not be entitled to an entry right in the '227 *inter partes* reexamination proceeding. Therefore, it is considered that the June 23, 2008 paper was properly "returned" to patent owner in accordance MPEP § 2667. The "return" of the paper was accomplished by marking the

paper as "closed" and "non-public" in the electronic Image File Wrapper (IFW) because papers scanned into the IFW cannot be physically "removed," and so cannot be physically "returned" to a party.

Note is taken of patent owner's argument that the June 25, 2008 Office decision "holds that there is no mechanism by which Patent Owner can advise the Office of defects in service, and of the fact that the Patent Owner has been deprived of the right to review materials filed by the third-party Requestor, and that there is no mechanism by which Patent Owner can include such facts in the record for judicial review." Patent owner's argument is incorrect; the Decision dated June 25, 2008 does not so hold. Rather, the decision holds that papers filed by patent owner on June 23, 2008 constituted an opposition to an opposition paper, and that such was not a proper paper for entry into the IFW of the present reexamination proceeding. To advise the Office of service considered to be defective, and to preserve the right to judicial review, patent owner could simply have filed a paper that brought the issue of the propriety of service to the attention of the Office without including nine pages of argument that could be construed as argument opposing the June 11, 2008 patent owner opposition paper, and without also including forty-eight other pages of material. Patent owner should take note that the record now reflects that on July 8, 2008, the Office, acting *sua sponte*, issued a paper that reflects recognition of the potentially problematic nature of both the manner in which the June 11, 2008 third party requester papers were filed and served.

CONCLUSION

1. The July 7, 2008 patent owner request for reconsideration is granted to the extent that the Office decision dated June 25, 2008 has been reviewed, but is dismissed as to granting substantive relief.

2. The copy of the previously "returned" June 23, 2008 patent owner opposition petition and the exhibits attached thereto will again be "returned" to patent owner by being marked as "closed" and "non-public." Such papers will not form part of the electronic IFW record in the '227 *inter partes* reexamination proceeding.

3. Jurisdiction over this proceeding is being retained in the Office of Patent Legal Administration for consideration of the June 3, 2008 patent owner petition and the June 9, 2008 third party requester opposition thereto, and of party responses to the July 8, 2008 Order to Show Cause, should such response(s) be filed.

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

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

sm
July 15, 2008

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.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 09/10/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/10/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED
SEP 10 2008
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000227
PATENT NO. : 6433419
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
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600 South Avenue West
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(For Patent Owner)

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

Tracy Druce
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, Texas 77002

(For Requester)

In re Khandors :
Reexamination Proceeding : DECISION
Control No.: 95/000,227 : DENYING
Filed: February 9, 2007 : PETITION
For: U.S. Patent No.: 6,433,419 :

This is a decision on the June 6, 2008 patent owner petition paper entitled "RENEWED PETITION TO VACATE FILING DATE FOR FAILURE TO INCLUDE INDENTITY OF REAL PARTY IN INTEREST" ("the renewed petition"). This decision also has considered the third party requester ("requester") opposition petition paper originally filed on June 11, 2008 and subsequently re-submitted on July 21, 2008 entitled "THIRD PARTY REQUESTOR'S PETITION AND OPPOSITION TO PATENT OWNER'S RENEWED PETITION TO VACATE FILING DATE FOR FAILURE TO INCLUDE INDENTITY OF REAL PARTY IN INTEREST" ("the opposition paper").

The renewed petition and the opposition paper are before the Office of Patent Legal Administration for consideration.

Summary:

The patent owner petition paper has been considered as petition under 37 CFR 1.182 and 1.183. The petition is denied with respect to the relief requested therein.

This decision is designated as a final agency action pursuant to 5 U.S.C. § 704.

FEES

A single petition fee of $400.00 pursuant to 37 CFR 1.17(f) will be charged to Deposit Account No. 12-1095 as invited on page 1 of the patent owner petition. Similarly, the

opposition paper will also be treated under 37 CFR 1.182 and 1.183. Accordingly, a single $400.00 petition fee has been remitted by credit card authorization form attached to the present opposition paper.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.

2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent was filed by requester, Silicon Precision Industries Co., Ltd. (hereinafter "Siliconware"[1]) and was assigned control No. 95/000,227 ("the '227 reexamination proceeding").

3. On March 26, 2007, patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively, to suspend action in the proceeding.

4. Patent owner's March 26, 2007 petition provided that the '419 patent, (along with other related patents), was currently the subject of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al* (No. 4:05CV04063) in the United States District Court for the Northern District of California. Petitioner patent owner asserted that Siliconware was one of multiple co-defendants in the *Tessera* litigation. [2]

5. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

6. On April 17, 2007, requester submitted a paper entitled "Litigation Activity Update under 37 C.F.R. 1.985." On May 7, 2007, patent owner (Tessera, Inc.), submitted a paper entitled "Notice of Prior and Concurrent Proceedings Pursuant to 37 CFR 1.985."

7. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding ... " in which the April 16, 2007 Notice was vacated.

8. On May 4, 2007, the Office issued a decision granting the request for reexamination in the '227 reexamination proceeding. The decision granting the '227 request was not accompanied by the first Office action on the merits, which action was, instead, mailed on June 5, 2007.

9. On May 8, 2007, requester submitted, in response to the Modified Notice, a paper entitled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

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[1] At page 1 of the "Request for *Inter Partes* Reexamination Transmittal Form," Silicon Precision Industries Co., Ltd. was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). At page 1, paragraph 1 of the request papers, Siliconware Precision Industries Co., Ltd. and Siliconware USA, Inc., (collectively "Siliconware"), were identified as the parties requesting reexamination. In the present requester opposition paper, third party requester unambiguously identifies Siliconware Precision Industries Co., Ltd. and Silconware USA, Inc., (collectively "Siliconware"), as the real party in interest in the present '227 *inter partes* reexamination proceeding. These parties are named defendants in the litigation mention in Fact # 4. The real party in interest is deemed to be as identified in the present opposition paper, and will hereinafter be referred to as "Siliconware."

[2] "Petition to Vacate Filing Date ... or, Alternatively, to Suspend ... Proceeding," March 26, 2007, page 3, footnote 3.

10. On June 8, 2007, the Office issued a decision denying the patent owner petition to vacate the filing date or, in the alternative, to suspend the '227 *inter partes* reexamination proceeding. The decision was designated as a final agency action under 5 U.S.C. § 704.

11. On July 5, 2007, patent owner filed a paper entitled "Request for Reconsideration of Decision Denying Petition to Vacate Filing Date," addressed to the June 8, 2007 Office decision.

12. On September 7, 2007, the Office mailed a decision that granted the July 5, 2007 request for reconsideration only to the extent that the June 8, 2007 decision was reconsidered, but which denied the underlying relief requested in July 5, 2007 request for reconsideration. The September 7, 2007 decision was also designated as a final agency action under 5 U.S.C. § 704. [3]

13. On June 6, 2008, patent owner filed the present renewed petition.

14. On June 11, 2008, requester filed opposition papers opposing the renewed petition, which opposition papers were re-submitted on July 21, 2008. [4]

RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

> (a) IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
> (b) REQUIREMENTS.– The request shall–
> (1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

[3] It is noted that this decision refers to the patent owner's request for reconsideration as having been filed on July 2, 2007. However, that date is the date appearing in the 37 CFR 1.8 certificate of mailing. The actual filing date of the request for reconsideration was July 5, 2007.

[4] The June 11, 2008 opposition paper and the exhibits attached thereto were labeled as being subject to a Protective Order. Further, the copies of these papers that were served on patent owner arrived in an envelope that labeled the content of the envelope as being subject to a Protective Order, and each paper in the envelope was so labeled. In response to an Order to Show Cause promulgated by the Office on July 8, 2008, third party requester filed papers on July 21, 2008 that "de-designated" the documents so that they were no longer submitted as being subject to a Protective Order. The "de-designated" documents were then served on patent owner.

requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 provides:

(a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.
...
(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2612 provides, in part:

> 37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

> The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

DECISION

I. Timeliness of the Renewed Petition

Note is taken that there is an issue of whether the present renewed petition to vacate has been timely filed because 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."

The present renewed petition was filed on June 11, 2008, eleven months after the Office mailed a decision denying patent owner's July 5, 2007 request for reconsideration of the Office decision dated June 8, 2007. The Office's decision was designated as final agency action.

In the July 5, 2007 request for reconsideration and in the March 26, 2007 original petition, patent owner argued that the request for *inter partes* reexamination in the '227 proceeding,

as filed, admitted that defendants in the litigation identified in Fact # 4, *supra*, other than Siliconware, had filed reexamination requests. [5] Patent owner also argued that the existence of multiple co-defendants in the litigation, in which the defendants have a common interest and are collaborating to attack the validity of the '419 patent, indicated that the other defendants, should also be named as the real party in interest in the '227 proceeding. Patent owner drew certain inferences based on the timing of the filing of papers in the litigation and the filing of the '227 request for reexamination that patent owner asserted "proved" that the other co-defendants are unnamed real parties in interest in the '227 proceeding, and that the Office had a duty to investigate the matter. [6]

A comparison of the arguments advanced by patent owner in the present renewed petition with the arguments relied upon by prior patent owner in the prior petitions to vacate or suspend the '227 reexamination proceeding shows that patent owner is now relying on information (to establish that the real party in interest was not properly identified in the request for reexamination of that proceeding) that may not have been available for inclusion in the prior petitions to vacate or suspend. Accordingly, the Office deems that the present renewed petition is not untimely filed. [7]

II. Patent Owner's Case for Vacatur

In the present petition, patent owner asserts that there is now firm evidence that the real party in interest was not properly identified in the '227 request for reexamination. The asserted evidence is:

a. A declaration of Brian Marucci, Vice President of Business Development and Licensing for patent owner, that discusses a meeting with Juliette Chan, Corporate Counsel for Siliconware Precision and C.B. Chang, Vice President for Sales for Siliconware USA. In this declaration, Mr. Marucci avers that, in conversation, Ms. Chan stated that respondents in Investigation No. 337-TA-605 before the U.S. International Trade Commission [8] would be unhappy with Siliconware if Siliconware stopped participating in the '227 reexamination proceeding because "they would lose control of the reexaminations." Mr. Marucci further avers that Ms. Chan subsequently refused to disclose Siliconware's conversations with third parties regarding the '227 reexamination proceeding. [9]

b. STMicroelectronics, N.V. ("ST-NV"), co-defendant in the '419 patent litigation, filed an Annual Report with the U.S. Securities and Exchange Commission ("SEC") "at approximately the same time" that the original March 26, 2007 patent owner petition was filed. In that report, ST-NV stated that:

> Tessera is claiming [10] that our BGA packages practice certain technology and patents owned by Tessera, and that we are liable for royalties. Trial is currently scheduled for the first quarter of 2008. **We recently filed, together with our co-**

[5] "Petition to Vacate Filing Date ... or, Alternatively, to Suspend ... Proceeding," March 26, 2007, page 3.
[6] Id., at pages 3-11. See also "Request for Reconsideration ... ," July 5, 2007.
[7] The Office takes note that patent owner has not timely contested the determination by the Office that neither the March 26, 2007 petition nor the July 5, 2007 request for reconsideration established that the real party in interest had not been properly identified in the '227 request for reexamination, but rather is acting on apparently newly available information.
[8] Patent Owner Complainant in that ITC Investigation which also involves the '419 patent.
[9] Mr. Marucci's declaration is attached to the present renewed petition.
[10] In the '419 patent litigation.

defendants, a request for reexamination by the United States Patent and Trademark Office of all patents being asserted by Tessera in the lawsuit. [Emphasis supplied by patent owner.] [11]

Patent owner notes that subsequent to the March 26, 2007 petition to vacate the filing date, later ST-NV SEC filings omitted mention of ST-NV's participation. [12]

c. Patent owner refers to an annual report by ChipMOS Technologies Bermuda Ltd., that was filed with the SEC, in which it is stated that ChipMOS Taiwan and ChipMOS USA requested reexamination of all Tessera patents being asserted in the '419 patent litigation. [13]

d. Patent owner also alleges that when it attempted to examine Dr. Richard K. Ulrich, a technical expert hired by Siliconware as to the involvement of unidentified parties in the reexamination proceedings and his communications with such entities, Dr. Ulrich refused to answer on the advice of counsel (who is also counsel in the '227 reexamination proceeding). Patent owner opines that this evidences a joint-defense privilege (joint participation) in the reexamination proceedings.

Patent owner then asserts that there is undisputed evidence of participation and control of the '227 reexamination proceeding by unidentified real parties in interest other that Siliconware, and that requester argues that it need not state the real party in interest accurately. [14] Patent owner concludes that the '227 reexamination proceeding should be dismissed, or in the alternative, that requester should be required to show cause why the petition should not be granted.

III. Requester's Case Against Vacatur

In the opposition paper, requester argues that the Marucci declaration contains language that is subject to interpretation. Requester also argues that, in the conversation referred to in the Marucci declaration, Ms. Chan told Mr. Marucci that Siliconware solely prepared, filed, paid for and controls the reexamination request for the '419 patent, (*i.e.*, the '227 reexamination proceeding). [15]

Requester asserts that the ST-NV SEC filing was subsequently corrected to point out that ST-NV's co-defendants in the '419 patent litigation, and not ST-NV, had filed reexamination requests for the involved Tessera patents. This argument is supported by a verified statement of Mr. Steven K. Rose, Vice President, Secretary and General Counsel of ST-NV and a copy of page 21 of Form 6-F filed on May 7, 2007, with the SEC. [16]

Requester argues that the 2007 20-F SEC filing by ChipMOS Technologies Bermuda, Ltd. (that states that a co-defendant filed a reexamination request against the '419 patent with the concurrence of ChipMOS Taiwan and ChipMOS USA) does not indicate that ChipMOS filed

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[11] The ST-NV SEC filing is attached to the renewed petition as Exhibit 1.
[12] "Renewed Petition to Vacate ... ,"June 6, 2008, page 11, footnote 5; See also: Exhibit 4 attached to the renewed petition.
[13] Id., at page 12.
[14] Id., at pages 16-21.
[15] "Third Party Requestor's Petition and Opposition to Patent Owner's Renewed Petition to Vacate ... ," Exhibit D.
[16] Id., Exhibit E and Exhibit A attached thereto.

the reexamination request or is in any way a real party in interest. Further, the 2008 20-F SEC filing by ChipMOS Technologies Bermuda, Ltd., states that:

> [A] co-defendant in the Tessera lawsuit requested the United States Patent and Trademark Office to reexamine the patentability of each of Tessera's patents that are at issue in the case in the California court. [17]

It is requester's position that the statement means that another co-defendant, not ChipMOS, requested reexamination of the '419 patent, and that even if other co-defendants concurred with or consulted with Siliconware in the filing of the reexamination request, such would not "automatically" make such co-defendants real parties in interest. This follows, according to requester, from the fact there are sixteen co-defendants accused of infringing the same patents, that each defendant would necessarily "have an interest" in the claims of the '419 patent being invalidated, but that such an interest does not make any of such co-defendants a real party in interest or mean that Siliconware was falsely identified as being the (*i.e.*, only) real party in interest. [18]

Requester concludes by noting that with respect to Dr. Ulrich having invoked joint defense privilege, that does constitute a showing that co-defendants in the '419 patent litigation are real parties in interest in the '227 reexamination proceeding. To the extent that Dr. Ulrich is an expert for a defendant in the '419 patent litigation, and that some or all of the other co-defendants have formed a joint defense effort with Siliconware, patent owner has not established that mere status as part of that joint defense effort necessarily means that unidentified co-defendants are directing, controlling or paying for the '227 reexamination proceeding.

IV. Patent Owner Has Failed to Establish That Siliconware is Not the Real Party in Interest or That There is Reason to Believe that Unidentified Parties are Also Real Parties in Interest

After consideration of the arguments presented by patent owner and by requester, together with the supporting evidence submitted by these parties and the record as a whole, it is found that patent owner has failed to establish that there is another real party in interest, in addition to Siliconware, for the present reexamination proceeding. Rather, it appears that, as stated in the request papers and as confirmed in the present opposition paper, Siliconware is in fact the real party in interest in the '227 reexamination proceeding.

With respect to the SEC filings of ST-NV and ChipMOS which stated that they and their co-defendants filed reexamination proceedings against the Tessera patents: In view of the clarifications made by ST-NV and ChipMOS in subsequent SEC filings, it is quite reasonable to conclude that their earlier statements in the SEC filings were made in error, and that their later statements represent a correction of the earlier statements. There is no basis for determining that the earlier SEC filings by those entities were accurate, and it is not expected that any additional statements by those entities that would differ from those made in the subsequent SEC filings would be forthcoming.

With respect to the Marucci declaration: Even without consideration of the issue of whether the Marucci declaration constitutes hearsay, (as alleged by requester), it is clear that the Marucci declaration is not dispositive evidence that unidentified co-defendants in the '419

[17] Id., Exhibit F (pages 90-91 of Form 20-F filed June 9, 2008).
[18] Id., at page 6.

patent litigation are real parties in interest. The statement of Ms. Chan relied upon by patent owner may reasonably be interpreted as meaning that requester's co-defendants in the '419 patent litigation would be unhappy if Siliconware ceased to participate as the third party requester in the '227 proceeding, because then "**they**" (*i.e.*, Siliconware) would be no longer control (*i.e.*, "have input into") that reexamination proceeding, so that there would no longer be a party in the '227 proceeding that was interested in establishing claim unpatentability. Such an interpretation is no less reasonable than that urged by patent owner, in which the word "they" is interpreted to refer to respondents in the ITC proceeding in order to indicate that such respondents would no longer control the reexamination proceeding. Further, in light of the April 7, 2008 declaration filed and the attached e-mail that together constitute Exhibit D of requester's opposition paper, it is clear that Ms. Chan disagrees that such statement was made to be subject to the interpretation urged by patent owner in the present renewed petition; she recalls telling Mr. Marucci that other co-defendants or respondents "might be" worried if Siliconware "abandoned" the *inter partes* reexaminations, because no party would oppose patent owner in that proceeding. [19] Further, Ms. Chan's declaration affirmatively states that she told Mr. Marucci that Siliconware alone prepared, and paid for the preparation and filing of the '227 reexamination proceeding. [20]

With respect to the issues raised by patent owner regarding Dr. Ulrich being advised to claim privilege when patent owner attempted to examine him as to the involvement of "unidentified parties" in the reexamination proceedings: Patent owner has not cited any legal basis for drawing an inference/conclusion based on a claim of privilege. The basis for (considerations behind) a party claiming privilege is protected by law. In addition, it is hardly surprising that counsel would advise Dr. Ulrich to claim "joint-defense" privilege, where such privilege was properly available. Patent owner's "belief" as to the impact of advice to claim such privilege is no more cognizable on the issue of whether there are in fact "unidentified parties" who are actually real parties in interest in the '227 reexamination proceeding than such advice in a criminal matter would equate to an admission of guilt.

A. When The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous, The Office Lacks The Authority And The Tools To Question That Identification

Patent owner believes that because there are a number of co-defendants in the '419 patent litigation, it is possible or likely that at least some of those co-defendants are actively participating in the '227 reexamination proceeding to the extent that they are real parties in interest. Patent owner thus urges that the Office should investigate the issue of whether the real party in interest has been properly identified in the '227 reexamination proceeding or at least require requester to establish why the patent owner petition should not be granted. It is, however, found that there is insufficient evidence presented by patent owner to establish that the '227 reexamination proceeding should be vacated. It is clear that the patent owner is in reality both requesting a remedy without having shown any damage, and requesting the Office to investigate a matter that patent owner bears the burden of establishing, and has not so established. The basis for this will now be discussed.

The arguments presented in the petition for reconsideration fail to establish that the Office has either the authority to question the accuracy of a third party requester's facially accurate

[19] Id., at Exhibit D.
[20] Id.

and unambiguous identification of the real party in interest in an *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, or as subsequently corrected by the requester, contains an unambiguous identification of the identity of the real party in interest.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> "It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the inter partes reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed."

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rulemaking does not discuss the type or depth of investigation that can and will be undertaken, and does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination. Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed; thus the issue is not ripe for consideration (see discussion in part B. below).

If the issue whether a second reexamination does become ripe for consideration via a second proceeding, the Office would certainly query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. A third party making such statement is a party appearing before the Office. Therefore, a third party requester is available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, the third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the third party requester, and would have no need to obtain information from parties not before the Office by reason of the filing of the request for *inter partes* reexamination. Similarly, where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, a third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (i.e., the ambiguity causes an issue that is ripe for consideration). Such occurred in the present proceeding, and was addressed by the Office and then

requester. [21] The record in the present '227 *inter partes* reexamination proceeding reveals that third party requester clarified the record in the '227 reexamination proceeding with respect to its identification of the real party in interest, after being put on notice that the identification was facially ambiguous. Since the present record in the '227 reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office (which the Office did in this proceeding), patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability. [22] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding). [23] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent, how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, it appears that where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is facially inaccurate, even though it is unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) [24] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees. [25] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one

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[21] Attention is invited to the "Order to Show Cause" dated February 22, 2008 and to "Decision Denying Petition" dated June 17, 2008 both of record in *inter partes* reexamination proceeding 95/000,166. Attention is also invited to the footnote 1, *supra*.

[22] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[23] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability, (or any duty of disclosure), that attaches to a reexamination third party requester.

[24] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[25] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest. [26]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order); even though this is the third petition on the matter and patent owner has been asked twice to address it, patent owner has remained silent on the matter. Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so. Patent owner's argument that it is the Office, not a district court, "that administers the patent statute," is wholly unpersuasive. The Office may consider that it is "the sole agency that administers the patent statute," [27] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rulemaking) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the provenance of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate:

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ." [28] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy." [29] Requester has made it clear that Siliconware is the real party in interest , and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified Siliconware to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

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[26] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.
[27] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[28] 35 U.S.C. § 311(b)(1).
[29] 37 CFR 1.915(b)(8).

In the present '227 *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. [30] The identification of the real party in interest does not appear to facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the '227 reexamination proceeding, because there is no legal reason to do so, even if the office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The '227 *Inter Partes* Reexamination Proceeding

It is also to be noted that, in the present '227 reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the '227 reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the '419 patent by a party that should have been identified as a real party in interest in the '227 reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the '227 reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the '227 reexamination proceeding if such a party "loses" as a defendant in any '419 patent litigation. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the '419 patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the '227 reexamination proceeding. No additional requests for *inter partes* reexamination of the '419 patent have been filed by any of Siliconware's co-defendants (or anyone else), so clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the '419 patent. Accordingly, granting need to consider addressing the relief requested by patent owner in the present '227 *inter partes* reexamination proceeding has not arrived, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the '419 patent that would be barred by statutory estoppel.

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[30] It is to be noted that although the identification of the real party in interest was ambiguous in the various papers comprising the request for reexamination filed by the third party requester in the '227 *inter partes* reexamination proceeding, such ambiguity has been resolved. The identification of the real party in interest in the present opposition paper would applies to this proceeding *nunc pro tunc*, and will allow any subsequent party to draw the necessary conclusions for purposes of 37 CFR 1.907 and statutory estoppel in *inter partes* reexamination.

V. Synopsis

Rather than having presented clear and undisputed evidence establishing that Siliconware is not the only real party in interest in the '227 reexamination proceeding, the present renewed petition is based on (a) equal measures of evidence that are directly contradicted by evidence of at least equal caliber and weight, and (b) argument supported only by supposition and conjecture on patent owner's part. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the '227 reexamination proceeding. Therefore, such relief is denied, and this decision is being designated as a within the meaning of 5 U.S.C. § 704.

ADDITIONAL DISCUSSION

As this decision is designated as a final agency action under 5 U.S.C. § 704, and as two previous decisions on this issue have also been so designated, patent owner is advised that to the extent that patent owner disagrees with the disposition of the issues in this decision, those issues are now at the stage of judicial review - should patent owner desire any further review of those issues. Any further patent owner petition paper directed to the issues decided herein will not be considered unless accompanied by a strong showing of additional facts warranting further review by the Office, together with a certification by patent owner that these additional facts were not known, and could not have been known, at the time that the present patent owner petition was filed. The filing by patent owner of a petition paper directed the issues decided herein that does not include such showing and certification may be construed as being a paper interposed for purposes of delay.

CONCLUSION

1. The June 6, 2008 patent owner renewed petition is denied.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for such action as may be appropriate.

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

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

sm

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 10/09/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2008

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

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Tracy Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

MAILED

OCT 09 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,227*.

PATENT NUMBER *6,433,419*.

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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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
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(For Patent Owner)

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

(For Requester)

MAILED

OCT 09 2008

CENTRAL REEXAMINATION UNIT

In re Khandros *et alia*
Reexamination Proceeding
Control No. 95/000,227
Request Deposited: February 9, 2007
For: U.S. Patent No. 6,433,419

: DECISION DISMISSING
: PETITION PURSUANT
: TO 37 CFR 1.181

This is a decision on the July 18, 2008, "RENEWED PETITION PURSUANT TO 37 C.F.R. §1.181 AND MPEP § 2672(VI)" and the March 24, 2008, "PETITION PURSUANT TO 37 C.F.R. §1.181 AND MPEP § 2672(VI)" requesting "to withdraw the designation of the Official Action mailed June 13, 2008 (the "Second ACP") as an action closing prosecution if the same is not vacated or otherwise withdrawn."

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

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

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,433,419 (the '419 patent) issued to Khandros *et alia* on August 13, 2002.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,227 ('227), was deposited by a third party requester on February 9, 2007.

3. An order granting reexamination of the '419 patent was mailed May 4, 2007.

4. A non-final office action was mailed on June 5, 2007.

5. An Action Closing Prosecution (ACP) was mailed February 19, 2008.

6. A "PETITION PURSUANT TO 37 C.F.R. §1.181 AND MPEP § 2672(VI)" was filed on March 24, 2008.

7. A second ACP was mailed June 13, 2008.

8. A "RENEWED PETITION PURSUANT TO 37 C.F.R. §1.181 AND MPEP § 2672(VI)" was filed on July 18, 2008.

9. A Right of Appeal Notice (RAN) was mailed on September 17, 2008.

DECISION

Petitioner argues that the "ACP imposed improper new rejections which were expressly based on teachings taken from the *Sinnadurai* Handbook [i.e. the *Handbook of Microelectronics*]... [and the] *Lea* Handbook". However, a review of the record clearly indicates that these references were not used in any ground of rejection, but were cited in the arguments section to rebut statements.

Petitioner then argues that "[i]t makes no difference what portion of the action cites the *Lea* Handbook. The fact that an Examiner cites a reference in a "rebuttal" section of an Official Action simply means that, after evaluating the remarks of the Patent Owner, the Examiner deemed some additional teaching necessary to meet a flaw pointed out by the Patent Owner in the original references." The office disagrees with this argument. The Handbooks are not relied upon because of any "flaw" in the original references. The rejections stand on their own. The Handbooks are mentioned in the argument section to rebut particular arguments made by Patent Owner or to rebut opinions set forth in declarations. For example, in the passage cited by petitioner at the ACP, page 256, the *Handbook of Microelectronics* is referenced to rebut a statement made in the Suhir declaration. The Handbooks are only mentioned in the arguments section and are not relied upon for any new grounds of rejection.

Petitioner quotes MPEP 706.07, which is referenced in MPEP 2671.02 regarding the criteria for issuing an ACP being analogous to making a rejection final in an application

"The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

Petitioner's reliance on this passage of the MPEP appears to be misplaced as Patent Owner has not amended the claims.

Petitioner states that the ACP of June 13, 2008 contained two new grounds of rejection based on references that Patent Owner made of record in the '227 proceeding after the non-final office action. Petitioner states that one of the references (*Yamada*) had been of record in the underlying patent. Petitioner argues that "Yamada was among the references which the Examiner was bound to consider from the inception of this proceeding" and that a new grounds of rejection based on this reference would be improper in an ACP. However, the RAN mailed September 17, 2008 withdraws the rejection based on the Yamada reference. Therefore, the argument is moot.

CONCLUSION

1. The request to redesignate the ACP as a non-final office action 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. 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 10/30/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
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WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2008

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,227	02/09/2007	6433419	

EXAMINER
TIBBITS,PIA

TRACY DRUCE
NOVAK, DRUCE & QUIGG, LLP
1000 LOUISIANA STREET, 53th FLOOR
HOUSTON, TX 77002

ART UNIT	PAPER
3992	

DATE MAILED:

10/30/08

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

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(For Patent Owner)

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1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

MAILED

OCT 3 0 2008

CENTRAL REEXAMINATION UNIT

In re Khandros *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,227
Request Deposited: February 9, 2007
For: U.S. Patent No.: 6,433,419

DECISION ON PETITION

This is a decision on the October 21, 2008 patent owner petition entitled REQUEST FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.183, filed concurrently with a petition pursuant to 37 CFR 1.181 for ENTRY OF COMMENTS AFTER ACP and a NOTICE OF APPEAL

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition for extension of time filed October 21, 2008, is dismissed as premature.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 12-1095 as authorized in the October 21, 2008 petition.

DECISION

37 CFR 1.183 states:

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

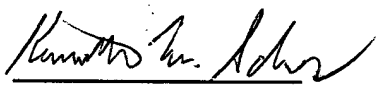
The present petition for an extension of time was filed concurrently with a Notice of Appeal. Upon filing a Notice of Appeal, by operation of rule 37 CFR 41.66 (a), an appellant has a two month time period within which to file an Appellant Brief. In the present proceeding, patent owner petitioner has until December 21, 2008 to file an Appellant Brief. Therefore, as of the date of this decision, patent owner has approximately six to seven weeks remaining before reaching the December 21, 2008 deadline for filing an Appellant Brief. Under the current facts and circumstances of the proceeding, petitioner's time period to submit an Appellant Brief has not been reduced to a point where an extraordinary circumstance requiring suspension of a rule would exist. However, if the concurrently filed petition under 37 CFR 1.181 has not yet been decided at the point where the time for patent owner to file an Appellant Brief becomes less than one month prior to the December 21, 2008 deadline, then petitioner may renew its petition for an extension of time. In that event, petitioner is advised to contact either Joseph F. Weiss, Jr., at the phone number given below in the contact information, or the undersigned, to inform the Office that the petition is being renewed - in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed October 21, 2008 for filing an Appellant Brief is **dismissed as premature.**

2. Petitioner has until December 21, 2008 to file an Appellant Brief and may submit a renewed petitioner for an extension of time if the concurrently filed petition under 37 CFR 1.181 is not decided at the point in time stated above.

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



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

Oct. 30, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 11/03/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

NOV 13 2008

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000227
PATENT NO. : 6433419
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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LERNER, DAVID, LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

(For Patent Owner)

Tracy Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

In re Khandros *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,227
Request Deposited: February 9, 2007
For: U.S. Patent No.: 6,433,419

DECISION ON PETITION

This is a decision on the October 21, 2008 patent owner petition entitled PETITION PURSUANT TO 37 C.F.R. § 1.181 AND M.P.E.P. § 2673.02 FOR ENTRY OF COMMENTS TO ACP in which "Patent Owner seeks entry and consideration of Patent Owner's Comments filed July 14, 2008, and the documentary evidence filed therewith in response to the Official Office Action mailed June 13, 2008". This decision is also on the pending March 10, 2008 patent owner petition entitled PETITION PURSUANT TO 37 C.F.R. § 1.181 (A)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR.

The petitions are before the Director of the Central Reexamination Unit for consideration under 37 CFR. § 1.181 and no fee is required.

The petitions are **granted** for the requested relief as set forth below.

DECISION

After reconsideration and based on the facts set forth in the petitions, the requested relief is granted. The Right of Appeal Notice mailed September 17, 2008 is withdrawn. Patent Owner's comments filed July 14, 2008 and the documentary evidence filed therewith are entered. The proceeding is being forwarded to the examiner for a new office action in due course. If such new action includes any objection to the specification regarding definitions for various claim terms as being new matter, a rejection of the affected claims should be made under 35 USC §112.

CONCLUSION

1. The patent owner petitions under 37 CFR § 1.181 filed March 10, 2008 and October 21, 2008 are **granted**.

2. Patent Owner's Comments filed July 14, 2008, and the documentary evidence filed therewith are **entered**.

3. The Right of Appeal Notice mailed September 17, 2008 is **withdrawn**.

4 The proceeding is returned to the examiner for a new office action to issue in due course.

5. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 07/30/2009

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/30/2009

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HOUSTON, TX 77002

Date:
MAILED
JUL 30 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000227
PATENT NO. : 6433419
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

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Marcus J. Millet.
LERNER DAVID LITTENBERG
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(For Patent Owner)

MAILED

JUL 30 2009

CENTRAL REEXAMINATION UNIT

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FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 95/000,227
Deposited: 09 February 2007
For: US Patent No. 6,433,419

DECISION
DISMISSING
PETITION
PURSUANT TO
37 CFR §§ 1.181

This is a decision on the 01 July 2009, "Petition to Withdraw Right of Appeal Notice" requesting that the Right of Appeal Notice Office action dated 19 June 2009 be withdrawn and the prosecution reopened.

The patent owner has petitioned under 37 CFR §§ 1.181, 1.182, 1.183.

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

The petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 13 August 2002 US Patent No. 6,433,419 was granted to Khandros *et alia.*

2. On 09 February 2007 a request for *inter partes* reexamination was submitted by a third party requester identified by control number 95/000,227.

3. On 04 May 2007 the Order was granted for *inter partes* reexamination in control number 95/000,227.

4. On 05 June 2007 a non-final Office action was mailed.

5. On 10 August 2007 a response from the patent owner was received.

6. On 05 September 2007 a response from the third party requester was received.

7. On 19 February 2008 an action closing prosecution was mailed.

8. On 24 March 2008 the patent owner's comments to the action closing prosecution was received.

9. On 02 April 2008 the third party requester's comments to the action closing prosecution was received.

10. On 13 June 2008 a second action closing prosecution was mailed.

11. On 18 July 2008 the patent owner's comments to the second action closing prosecution was received.

12. On 08 August 2008 the third party requester's comments to the second action closing prosecution was received.

13. On 17 September 2008 the Right of Appeal Notice was mailed.

14. On 21 October 2008 the patent owner submitted a Notice of Appeal.

15. On 03 November 2008 a petition decision withdrew the Right of Appeal Notice.

16. On 09 January 2009 a third Action Closing Prosecution was mailed.

17. On 28 January 2009 the patent owner's comments to the third Action Closing Prosecution was received.

18 On 23 February 2009 the third party requester's comments to the third Action closing Prosecution was received.

19. On 19 June 2009 the second Right of Appeal Notice was mailed.

20. On 01 July 2009 the instant petition to withdraw the Right of Appeal Notice was submitted under 37 CFR §§ 1.181, 1.182, & 1.183.

DISCUSSION

The Patent Owner requests that the Right of Appeal Notice dated 19 June 2009 be withdrawn. The patent owner has provided the petition fee and certificate of service.

The petition is dismissed.

STATEMENT 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. 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.

37 CFR § 1.182 Questions not specifically provided for.
All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

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).

37 CFR § 1.4(c) Nature of Correspondence
(c) Since different matters may be considered by different branches or sections

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

2673.02 Examiner Issues Right of Appeal Notice (RAN)

A Right of Appeal Notice (RAN) is a final Office action which presents a final decision to reject the claims (i.e., a final decision that the claims are rejected) and/or a final decision favorable to patentability as to the claims (i.e., a final decision not to make a proposed rejection).
The RAN will identify the status of each claim. It will set forth:
(A) the grounds of rejection for all claims rejected in the RAN;
(B) the reasons why a proposed rejection is not made for all decisions favorable to patentability as to claims that were contested by the third party requester; and
(C) the reasons for patentability for all claims "allowed " and not contested by the third party requester. The RAN will also advise parties of their rights of appeal at this stage in the reexamination proceeding, and the consequences of failure to appeal.

See MPEP § 2673 as to matters that should be taken into account by the examiner before deciding to issue a RAN. Before the examiner actually issues a RAN, all outstanding grounds of rejection of record and findings of patentability that are of record should be carefully reviewed, after consideration of all submissions of record by the parties. Where it is appropriate to retain the grounds of rejection and findings of patentability, and the examiner's position will not be changed, the examiner is permitted to issue a RAN. Any grounds of rejection and findings of patentability relied upon should be restated in the RAN. The reasons for each rejection and finding should be set forth in detail. The grounds of rejection and findings of patentability should, at this point, be clearly developed to such an extent that the patent owner and the third party requester may readily judge the advisability of filing an appeal. The examiner's position as to any arguments and comments raised by the patent owner and the third party requester should be clearly set forth, so that any appeal taken can address the examiner's position as to the arguments and comments.

MPEP § 1207.03 New Ground of Rejection in Examiner's Answer (in-part)
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). In addition, former 37 CFR § 1.193(a)(2) also provided that if:
(A) an amendment under 37 CFR § 1.116 [or 41.33] proposes to add or amend

one or more claims;
(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and
(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then
(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and
(2) the examiner's answer may include the rejection(s) of the added or amended claims. Such rejection(s) made in the examiner's answer would not be considered as a new ground of rejection.

...

A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *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). See also MPEP § 2144.03.

...

ANALYSIS AND FINDINGS

The petition before the Office is considered pursuant to 37 CFR § 1.181. The petitions under 37 CFR §§ 1.182 and 1.183 are hereby dismissed pursuant to 37 CFR §1.4(c) which states that different matters may be considered by different branches or sections of the Office, each distinct subject or inquiry must be contained in separate papers.

The petitioner notes that the third party requester first cited Bauer as a footnote responding to the third Action Closing Prosecution in their facts item 6. The petitioner further notes in facts item 8 that the examiner discusses Bauer in the Right of Appeal Notice page 67 in the remarks. It is not agreed that the examiner "modifies" the rejection of claims under 35 USC 102(b) as anticipated by White in the Right of Appeal Notice.

The examiner is discussing remarks made by the third party requester with regard to Bauer. Bauer is not part of the rejection using White, and neither patent owner nor third party requester has a right of appeal with regard to a (fictional) rejection that includes Bauer. White is considered to anticipate all of the relevant claims as identified at page 33 of the Right of Appeal Notice (and pages 85-126 of the Action Closing referred to in the RAN).

It should be noted that the patent owner incorrectly relies on a passage from MPEP § 1208.01 (sic). That section of the MPEP was removed in revision 3 of the Eighth Edition of the MPEP, which was published in August 2005. The current edition of the MPEP does not contain a section 1208.01 as the policy on new grounds of rejection itself has been changed since that time.

Citing from MPEP § 1207.03 "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." In this instance the Bauer reference is not a part of any rejection.

As to the alternative relief requested under 37 CFR §§ 1.182 & 1.183, only the petition filed under 37 CFR § 1.181 is before the Central Reexamination Unit of the United States Patent and Trademark Office, and is addressed by this decision. The petition under 37 CFR §§ 1.182 or 1.183 must be filed as a separate paper for proper consideration by the Office, and is not addressed in this decision.

> 37 CFR 1.4(c) states:
> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Because petitions filed under 37 CFR §§ 1.182 & 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 third party must submit the petition under 37 CFR §§ 1.182 or 1.183 in a separate paper to avoid confusion and delay.

The petition to withdraw Right of Appeal Notice filed on 01 July 2009 under 37 CFR § 1.181 is hereby dismissed.

The petition as filed under 37 CFR §§ 1.182 & 1.183 are dismissed pursuant to 37 CFR § 1.4(c).

CONCLUSION

1. The patent owner's petition for withdrawal of the June 19, 2009 Right of Appeal Notice under 37 CFR § 1.181 proceeding is hereby dismissed.

2. The petition as filed under 37 CFR §§ 1.182 & 1.183 are dismissed pursuant to 37 CFR § 1.4(c).

3. This dismissal is without prejudice to a request for reconsideration or higher-level review. See MPEP 1002.

4. The proceeding is hereby forwarded to the examiner in charge of the proceeding for further handling.

5. Response should be addressed as follows:

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

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

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

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

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

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 09/21/2009

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/21/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,227	02/09/2007	6433419	

NOVAK, DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
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HOUSTON, TX 77002

EXAMINER	
TIBBITS, PIA	
ART UNIT	**PAPER**
3992	

DATE MAILED:

09/21/09

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
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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Lerner, David, Littenberg
Krumholz and Mentik
600 South Avenue West
Westfield, N. J. 07090

(For Patent Owner)

RECEIVED

SEP 21 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re Khandors, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,227
Filed: February 9, 2007
For: U.S. Patent No. 6,433,419

: **DECISION GRANTING**
: **IN-PART PETITION**
: **TO WAIVE PAGE**
: **LIMITS FOR**
: **APPELLANT'S BRIEF**

This is a decision on the September 1, 2009 patent owner petition entitled "PETITION TO WAIVE PAGE LIMIT". 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 patent owner petition paper is before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to patent owner's Deposit Account No. 12-1095 pursuant to the authorization on page 4 of the petition.

The patent owner request to waive the restrictions under 37 CFR 1.943(c) is granted to the extent that the page limit for patent owner's brief shall not exceed 50 pages (fifty) pages.[1] This waiver is conditional on the submission being in at least 12 point font, having at least one-and-a-half spacing, and having appropriate margins.

[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 13 August 2002, U.S. Patent No. 6,433,419 was granted to Khandros *et alia*.

2. On 09 February 2007, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,227 ("the '227 proceeding").

3. On 04 May 2007, a Order was granted for *inter partes* reexamination in the '227 proceeding.

4. Prosecution in the '227 proceeding progressed to the point where, on 19 June 2009, a Right of Appeal Notice (RAN) was mailed in the '227 proceeding.

8. On 01 July 2009, a petition under 37 CFR 1.181, 1.182, & 1.183 to withdraw the 19 June 2009 Right of Appeal Notice was submitted by patent owner.

9. On 24 July 2009, patent owner filed a Notice of Appeal.

10. On 30 July 2009, a decision dismissing patent owner's 01 July 2009 petition was mailed.

11. On 07 August 2009, patent owner filed a request for reconsideration of the decision dismissing the petition of 01 July 2009.

12. On 01 September 2009 patent owner filed the instant petition under 37 CFR 1.183 entitled "PETITION TO WAIVE PAGE LIMIT," 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 September 1, 2009

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 seventy pages (70) pages and 32,667 words in length[2] In support of waiver of the rule, patent owner submits that "enforcement of the 30-page limit on the substance of Patent Owner's brief would deprive Patent Owner of the ability to put forth all of the points necessary for fair consideration of the issues."[3] Patent owner states that "[t]he complexity of the issues in this case is demonstrated by the length of the Official Actions in the case, including the length of the present RAN, and the length of the supposed rebuttal in the third ACP."[4] Moreover, patent owner states that "the issues to be addressed include complex issues underlying a rejection on § 112, first paragraph (written description grounds)" and that the "the Examiner's treatment of these issues alone occupy some 51 pages."[5] Finally, patent owner identifies two other reexamination proceedings where "the Office has granted similar relief to other parties similarly situated."[6]

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 discussing the length and complexity of the issues presented in the June 19, 2009 RAN.

---

[2] Petition under 37 CFR 1.183 at page 1.

[3] Petition under 37 CFR 1.183 at page 3.

[4] On pages 2 and 3 of the petition under 37 CFR 1.183, patent owner states that "five separate Official Actions have been issued," that the third ACP comprises 353 pages in length, and that the June 19, 2009 RAN comprises 71 pages of largely single-spaced text and "incorporates pages 79-204 of the Third ACP (some 125 pages of text), such that the Present RAN actually constitutes 196 pages in all."

[5] Petition under 37 CFR 1.183 at page 2.

[6] Petition under 37 CFR 1.183 at page 3 (citing *inter partes* reexamination proceeding control nos. 95/000,160 and 95/000,020).

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 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 brief.

Thus, 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 that is approximately the same number of pages in length as the June 19, 2009 RAN,[7] which argument fails for the reason stated in the previous paragraph. A review of the record in the '227 proceeding, including the prior patent owner responses, indicates that patent owner's previous responses in the '227 proceeding appear to be presentable within a 50-page limit. In the instant case, patent owner's responses met the 50-page limit of 37 CFR 1.943(b) in the earlier stages of the proceeding. And, the issues to be addressed in patent owner's appeal brief should be addressable by a brief of no more than 50 pages.

Based on the specific facts set forth in the petition under 1.183 and the particular circumstances of the '277 proceeding, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. In particular, patent owner's petition under 37 CFR 1.183 is **granted** to the extent that patent owner's appeal brief shall not exceed **fifty (50) pages** in length. **This waiver is conditional on the submission being in at least 12 point font, having at least one-and-a-half spacing, and having appropriate margins.**

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 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

[7] *See* petition under 37 CFR 1.183 at page 2, paragraph 4 (asserting that the June 19, 2009 RAN "runs 71 pages").

37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[8] 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" appendices required by 37 CFR 41.67(c)(x) are considered "reference materials," and are excluded from the page count only insofar as they are 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.

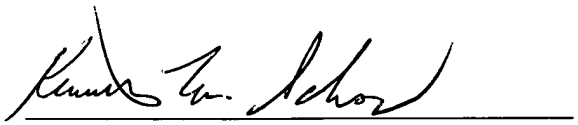
CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is granted to the extent that the patent owner's appeal brief shall not exceed fifty (50) pages. **This waiver is conditional on the submission being in at least 12 point font, having at least one-and-a-half spacing, and having appropriate margins.**

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. The time for filing a respondent's brief may not be extended.

3. Jurisdiction over the '227 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

9-21-09

[8] *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.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 03/05/2010

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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NOVAK, DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

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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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Lerner, David, Littenberg,
Krumholz and Mentik
600 South Avenue West
Westfield, NJ 07090

(For Patent Owner)

MAILED

MAR 05 2010

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re Khandors et al.
Inter Partes Reexamination Proceeding
Control No..95/000,227
Filed: February 9, 2007
For: U.S. Patent No. 6,433,419

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION AND**
: **EXPUNGING**
: **IMPROPER PAPER**

This is a decision on the November 5, 2009 third party requester petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 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 fifteen (15) pages in length. Third party requester timely filed a respondent brief, that is accompanied by 30 exhibits, concurrently with the present petition. Third party requester also concurrently filed a declaration with the present petition.

The present petition and the above-captioned reexamination proceeding are before the Office of Patent Legal Administration.

Third party requester's petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c) is granted to the extent that the page limit for third party requester's respondent brief shall not exceed twenty-five (25) pages or 11,670 words in length. This waiver is conditional on the submission being in at least 12 point font, having at least one-and-a-half spacing, and having appropriate margins.

For the reasons set forth below, third party requester's respondent brief is an improper paper and is being expunged without consideration. Since the third party requester paper has been scanned

into the record, Image File Wrapper (IFW) of the 95/000,227 *inter partes* reexamination proceeding, the November 5, 2009 third party requester respondent brief is being expunged from the record by closing it and marking it "not public" in the IFW of the 95/000,227 *inter partes* reexamination proceeding.

FEE

Third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 from Deposit Account No. 15-0665.

REVIEW OF THE RELEVANT FACTS

1. On August 13, 2002, U.S. Patent No. 6,433,419 ("the '419 patent") was granted to Khandros et al.

2. On February 9, 2007, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,227 ("the '227 proceeding").

3. On May 4, 2007, an Order was granted for *inter partes* reexamination in the '227 proceeding.

4. Prosecution in the '227 proceeding progressed to the point where, on June 19, 2009, a Right of Appeal Notice (RAN) was mailed in the '227 proceeding.

5. On July 1, 2009, a petition under 37 CFR 1.181, 1.182, & 1.183 to withdraw the June 19, 2009 Right of Appeal Notice was submitted by patent owner.

6. On July 24, 2009, patent owner filed a Notice of Appeal.

7. On July 30, 2009, a decision dismissing patent owner's July 1, 2009 petition was mailed.

8. On August 7, 2009, patent owner filed a request for reconsideration of the decision dismissing the petition of July 1, 2009.

9. On September 1, 2009, patent owner filed a petition under 37 CFR 1.183 entitled "PETITION TO WAIVE PAGE LIMIT," requesting waiver of the page limit requirements of 37 CFR 1.943(c) for patent owner's appeal brief.

10. On September 21, 2009, a decision granting-in-part patent owner's September 1, 2009 petition was mailed. The decision granted the patent owner's petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) to the extent that the patent owner's appeal brief was not to exceed fifty (50) pages. The waiver was conditional on the submission being in at least 12 point font, having at least one-and-a-half spacing, and having appropriate margins.

11. On October 7, 2009, patent owner timely filed an appeal brief.

12. On November 5, 2009, third party requester filed the present petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183." Third party requester timely filed the respondent brief concurrently with the present petition. Third party requester also filed a declaration by Michael Heafey concurrently with the present petition.

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. [Emphasis added.]

MPEP § 2667 I.A.2 provides (in-part):

> 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 (in-part):

> For additional information with respect to the length of papers, see Subsection I.A.2 above.

I. Third Party Requester Petition under 37 CFR 1.183

In the instant petition, petitioner requests waiver of 37 CFR 1.943(c), which limits respondent briefs to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit third party requester to file a respondent brief of 32 pages and four claim charts (Exhibits CC-1 to CC-4 attached to the present petition) reformatted from the Examiner's claim charts in the Third Action Closing Prosecution that was mailed on December 23, 2008. Pet. at 3. In support of waiver of the rule, third party requester asserts that significant amount of argument and documentation in the Third ACP, Examiner's RAN, and Patent Owner's Appeal brief combined, totaling over 500 pages, creates an extraordinary situation that renders the exclusion of claim charts from the 15-page limit imposed by 37 CFR 1.943(c) impractical. Pet. at 3. Third party

requester further asserts that in order to provide an adequate response to patent owner's appeal brief, requester's respondent brief must address and incorporate elements of these various documents, including the several hundred pages of claim charts contained in the ACP. Pet. at 3.

Third party requester states that "[i]n an effort to provide the Examiner and the Board with claim charts that are clearer and easier to read, the Requester has reformatted and revised the claim charts provided by the Examiner in the Third ACP." Pet. at 3. Petitioner also states that the Declaration of Michael F. Heafey (who is an attorney of record for third party requester) attached to the present petition states that "[r]equester has copied the substance of the claim charts in the Third ACP and provided revised claim charts with uniform and consistent formatting." Pet. at 3. Declarant Heafey alleges at page 1 of the declaration attached to the present petition that "[t]he claim charts in the Third ACP contained sections with inconsistent formatting and graphic insertions between limitations of the claims within the charts." Petitioner states that "[r]equester has not modified the substance of the charts in the Third ACP" and that "[t]he compiled charts do not introduce any new arguments or materials into the record and are provided solely for the convenience of the Examiner and the Board." Pet. at 3.

In addition, third party requester notes that "[t]he Office recently granted Patent owner's petition to waive the page requirement, permitting Patent owner to file an Appeal Brief 50 pages long, *excluding* supporting documents." Pet. at 3. Third party requester further argues that patent owner's appeal brief contains complex arguments that necessitate requester's in-depth analysis and rebuttal. Pet. at 4. Requester states that its respondent brief addresses and rebuts issues raised in patent owner's appeal brief and involves detailed discussion of new matter rejections under §§ 112 and 132. Pet. at 3. Finally, petitioner states that it would be "inequitable and impractical to require Requestor to respond to Patent Owner's 50 pages of analysis with only 15 pages alone." Pet. at 4.

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.

A review of the October 7, 2009 patent owner's appeal brief shows that the document is fifty-pages (50) of text that is one-and-a half spaced and is accompanied by forty-three (43) exhibits. The forty-three (43) exhibits and where they have been entered of record are cited in patent owner's appeal brief. Therefore, patent owner's appeal brief is effectively substantively fifty (50) pages and is page length complaint in view of the waiver of 37 CFR 1.943(c) set forth in the September 21, 2009 Office decision.

A review of the November 5, 2009 third party requester respondent brief[1] submitted concurrently with the present petition shows that the document contains thirty-two (32) pages of text that is

[1] This decision is directed merely at the page-limit issue, and does not review the propriety of the respondent brief. The Central Reexamination Unit (CRU) will review that matter, when jurisdiction over the proceeding is returned to the CRU.

single spaced and is accompanied by thirty (30) exhibits. Twenty-six (26) of the thirty (30) exhibits are specifically cited in the respondent brief and the remaining four (4) exhibits are the claim charts (Exhibits CC-1 to CC-4) cited and attached to the present petition. The twenty-six (26) exhibits cited in the requester's respondent brief are a subset of the forty-three (43) exhibits cited in patent owner's appeal brief that have been entered of record. Thus, the twenty-six (26) exhibits accompanying the respondent brief have been entered into the record and do not count toward the page limit. The four (4) claim charts (Exhibits CC-1 to CC-4) attached to the present petition total 178 pages. If requester's respondent brief were to contain one-and-a half spaced text instead single spaced text, it would be 45 pages. Therefore, the requester's respondent brief is effectively substantively 223 pages.

In response to petitioner's arguments in support of waiver of the requirement of 37 CFR 1.943(c) that the patent owner's appeal brief contains complex arguments that necessitate requestor's in-depth analysis and rebuttal, patent owner was granted 50 pages for its appeal brief to address approximately 200 pages of claim charts and new matter rejections under § 112 and 132 in the Examiner's Third ACP (mailed December 23, 2008, hereinafter "ACP"). Furthermore, third party requester's February 23, 2009 comments after ACP was only 13 pages while patent owner's January 28, 2009 comments after ACP was 40 pages. It is unclear why the attached claim charts to the present petition are necessary if requester has copied the substance of the claim charts in the ACP other than requester's opinion that the attached claim charts are clearer and easier to read. A cursory review of the 4 attached claim charts (Exhibits CC-1 to CC-4) shows that the attached claim charts cover only 3 of the 5 separate grounds of rejection set forth in the claim charts in the ACP.[2] The title of the claim chart for Exhibit CC-3 is drawn to a claim invalidity chart to the '891 patent instead of to the '419 patent that is under reexamination in the present proceeding. A comparison of the claim chart for claim 1 in Exhibit CC-1 with the corresponding claim chart for claim 1 in the ACP reveals that additional statements that appear to be reproductions of the claim limitations of claim 1 have been inserted into the body of the rejection for claim 1 in the attached claim chart. Thus, the content of the attached claim charts do not appear to be identical to the content of the Examiner's claim charts in the ACP. The attached claim charts could also create confusion as to which claim charts the Board should rely on. The Heafey declaration attached to the present petition states at page 1 that "[w]e attempted not to alter or modify the substance of the claim charts from the Third ACP" and does not positively state that the substance of the claim charts from the ACP was not altered or modified.

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[2] The attached claim charts (Exhibits CC-1 to CC-4) have the following titles, respectively: 1) INVALIDITY CLAIM CHART FOR CLAIMS 1-15, AND 19 OF THE '419 PATENT- US PATENT NO. 4,700,473 ("FREYMAN"), 2) INVALIDITY CLAIM CHART FOR CLAIMS 16-18, 24, and 27 OF THE '419 PATENT- U.S. PATENT NO. 4,700,473 ("FREYMAN") IN VIEW OF OTSUKA ET AL., "HIGH RELIABILITY MECHANISM OF NEW SILICONE GEL SEALING IN ACCELERATED ENVIRONMENT TEST" ("OTSUKA"), 3) INVALIDITY CLAIM CHART FOR CLAIMS 1-8, 10-14, 16-19, 22-24 AND 27 OF THE '891 PATENT- JAPANESE PATENT PUBLICATION NO. S61-177759 (OKINAGA), and 4) INVALIDITY CLAIM CHART FOR CLAIMS 1-8, 10, 11, 14, 15 AND 19 OF THE '419 PATENT - U.S. PATENT NO. 4,601,526 ("WHITE"). However, the June 19, 2009 RAN sets forth the following five grounds of rejection based on prior art that incorporated the claim charts in the December 23, 2008 ACP: 1) Claims 1-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Freyman, 2) Claims 16-18, 24, 27 are rejected under 35 U.S.C. 103(a) as beinq unpatentable over Freyman in view of Otsuka, 3) Claims 1-8, 10, 11, 14, 15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by White, 4) Claims 1-8, 10-14, 16-19, 22-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Okinaga, and 5) Claims 1-14, 16-19, 22-24 and 27 are rejected under 35 U.S.C. 102(e) as beinq anticipated by Mullen.

Furthermore, the requester's respondent brief refers only the ACP and makes no mention of the claim charts attached to the present petition. Therefore, the attached claim charts are redundant, unnecessary, and would create confusion in the record if entered, and will not be waived from the page limit.

Based on the particular circumstances of the '227 proceeding, and in light of the September 21, 2009 decision,[3] it is deemed equitable to waive the 15-page limit of 37 CFR 1.943(c) for requester's respondent brief in this instance by an amount proportional to the amount granted for patent owner's appellant brief. Therefore, third party requester's petition under 37 CFR 1.183 is granted to the extent that third party requester's respondent brief shall not exceed twenty-five (25) pages or 11,670 words in length.[4] **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.**

Accordingly, third party requester's respondent brief that is effectively substantively 223 pages in length does not comply with the page limit of twenty-five (25) pages or 11,670 words in length granted in this decision. The third party requester respondent brief lacks an entry right in the present '227 proceeding. The respondent brief paper was entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the respondent brief paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present reexamination proceeding.

III. What is Included or Excluded from the Page Limit Count

A: "Reference Materials"

A comparison of 37 CFR 41.67(c) and 37 CFR 41.68(b), which set out the respective requirements for an appellant's brief and a respondent's brief, reveals that the claims appendix is the only item required in the appellant's brief that is not required in the respondent's brief.

By its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Section 1.943 does not, however, specify that reference materials are excluded from the page count of respondent's brief. To the extent that the rule can be read as giving unequal treatment to reference materials in determining the page count of appellant and respondent briefs, the rule is hereby waived. Specifically, "reference materials such as prior art references" that are properly part of an appendix to the respondent's brief are not being counted toward the page limit set in § 1.943(c). Furthermore, the sections of the appellant and respondent briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and 37 CFR 41.68(b)(1)(i)-(iv) respectively are deemed to be included in "reference materials" that do not count toward the page limits.

It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) and 37 CFR 41.67(b)(ix) are considered "reference materials," and are excluded from the page count

[3] The September 21, 2009 Office decision on patent owner's petition under 37 CFR 1.183 was granted for 20 pages over the 30 page limit allowed by 37 CFR 1.943(c) for appellant's brief.

[4] Section III *infra*, provides guidance on which portions of the brief are counted towards the size limit.

only insofar as they are documents that are formally required in the appendix. Note that this requirement only covers copies of decisions rendered by a court of 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 size limit of the brief.

B: *Sua Sponte* Waiver of 37 CFR 1.943(c) as Recorded in MPEP § 2667

MPEP § 2667 I.A.2 provides that the table of contents pages, the table of case law and the pages of (the appealed) claims are excluded from the thirty (30) page limit. It is noted that the only brief that may be filed in an *inter partes* reexamination proceeding in which the party may include thirty (30) pages is an appellant brief. Therefore, the waiver of 1.943(c) set forth in MPEP § 2667 I.A.2 applies, on its face, only to appellant's brief. Likewise, MPEP § 2667 I.B.2, in discussing the appropriate length of third party requester papers, which refers the reader to subsection I.A.2 would apply to a requester appellant brief. Although the MPEP does not specifically address respondent briefs, it is equitable to waive the provisions of 37 CFR 1.943(c) for the respondent's brief to the same extent as the provisions are waived by the MPEP for the appellant's brief (as the basis for waiver is equally applicable in each case).

CONCLUSION

1. Third party requester's November 5, 2009 petition under 37 CFR 1.183 is granted to the extent that third party requester's respondent brief shall not exceed twenty-five (25) pages or 11,670 words in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.** Third party requester's respondent brief is an improper paper, and therefore will NOT be made a part of the record of the '227 proceeding.

2. Since third party requester's respondent brief and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the '227 proceeding, these papers are expunged by closing them in the '227 reexamination proceeding's IFW file and marking them as "non-public."

3. Third party requester has fifteen (15) days from the mailing date of this decision to file a redacted respondent brief that meets the page limit granted in the present decision. The third party requester's responsive submission must be clearly labeled as either a redacted or re-drafted respondent brief.

4, No copy of the respondent brief filed on November 5, 2009 will be maintained in the record, or elsewhere in the Office.

5. Jurisdiction for the '227 reexamination proceeding is returned to the Central Reexamination Unit.

6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Third Party Requester)

In re Thomas D. Dickson, Jr.
Reexamination Proceeding
Control No. 95/000,228
Filed: February 12, 2007
For: U.S. Patent No. 6,979,117

: DECISION
: DISMISSING
: PETITION

This is a decision on the May 14, 2007 patent owner paper entitled "PETITION UNDER 35 U.S.C. § 314(c) and 37 C.F.R. § 1.978 [sic-1.987] TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING (RENEWED)." On May 29, 2007, the third party requester filed an opposition to the patent owner's petition.

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

The petition is dismissed for the reasons set forth below.

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) is now being charged to the patent owner's Deposit Account No. 08-2623 as authorized in the May 14, 2007 patent owner renewed petition.

REVIEW OF FACTS

1. U.S. Patent No. 6,979,117 (the '117 patent), issued to Thomas D. Dickson, Jr., on December 27, 2005.

2. A request for *inter partes* reexamination of the '117 patent was filed by a third party requester (requester), Vita-Mix Corp., on February 12, 2007. The request was assigned Control No. 95/000,228 (the '228 proceeding).

3. The patent owner then filed a petition, on March 30, 2007, citing 35 U.S.C. § 314(c) and 37 CFR 1.978 [sic-1.987], to suspend *inter partes* reexamination.

4. The third party requester then filed, on April 3, 2007, an opposition to patent owner's petition to suspend *inter partes* reexamination.

5. The '117 patent is subject to litigation in the United States District Court for the District of Utah, K-TEC, INC. v. VITA-MIX CORP., {Case No. 2:06-cv-00108-TC-PMW. On April 6, 2007, the patent owner submitted a copy of an ORDER from the District Court denying defendant's motion to stay litigation and affirming an Order to proceed with discovery.

6. On April 20, 2007 the Office issued a decision returning, as improper papers, the patent owner's March 30, 2007 petition to suspend reexamination and the requester's April 3, 2007 opposition to the patent owner's petition.

7. On April 27, 2007, the patent owner filed a reply (the reply paper) to the requester's opposition to the patent owner petition to suspend reexamination.

8. On May 7, 2007, the Office granted the '228 request for reexamination, and concurrently, issued a first action on the merits.

9. On May 14, 2007 patent owner filed a renewed petition under 35 U.S.C. § 314(c) and 37 CFR 1.978 [sic-1.987] to suspend *inter partes* reexamination.

10. On May 15, 2007 the United States District Court for the District of Utah granted a motion to stay the K-TEC litigation pending reexamination of US Patent 6,979,117.

11. On May 25, 2007 the office issued a decision returning, as an improper paper, the patent owner's April 27, 2007 reply to requester opposition to patent owner's March 30, 2007 petition to suspend *inter partes* reexamination.

12. On May 29, 2007, requester filed an opposition to patent owner's renewed petition to

suspend *inter partes* reexamination.

13. On June 8, 2007, patent owner filed a reply to the May 29, 2007 requester opposition to the petition. This paper is being returned by separate decision, mailed concurrently with this decision.

14. Patent owner, as of the date of this decision, has not yet responded to the outstanding Office action of May 7, 2007.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. § 314(c) states:

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

35 U.S.C. § 317(b) states:

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

35 U.S.C. 318 states:

> Once an order for inter partes reexamination of a patent has been issued under section, the patent owner may 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, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

37 CFR 1.182 states:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as

> may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.907 states:

> (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.

37 C.F.R. § 1.987 states:

> 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.

MPEP 2686.04 III states (in part with respect to suspension of *inter partes* reexamination):

> "... '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)."

PRELIMINARY MATTER:
Proper Legal Authority for the Petition

As noted in previous decisions in regard to patent owner's attempts to stay the '228 reexamination proceeding, 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." However, 37 CFR 1.987, does not authorize the filing of a petition to suspend an *inter partes* reexamination proceeding. No regulation authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. Therefore, the patent owner's renewed petition will be considered pursuant to 37 CFR 1.182 (questions not specifically provided for), as petitioner's proposed suspension of an *inter partes* reexamination proceeding is a situation not specifically provided for in the regulations. The fee set forth in 37 CFR 1.17(f) for a § 1.182 petition is $400, and it has been charged to petitioner's deposit account as pointed out above in the fee section.

DECISION

Patent owner urges 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 '228 *inter partes* reexamination proceeding. Patent owner asserts the existence of matters to be raised in concurrent litigation that are argued to affect the proper resolution of the '228 *inter partes* reexamination proceeding, or to 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. The patent owner's position is that a suspension of the '228 *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.

Patent owner asserts that the existance of a protective order issued by the District Court presiding over the concurrently pending patent litigation involving the '117 patent will prevent the full and proper submission of all documentary evidence that will be needed during the '228 reexamination proceeding. Patent owner also argues that the use of the District Court's discovery and subpoena power is required to permit full, proper and fair factual and legal evaluation of the invaldity arguments based upon obviousness issues under 35 U.S.C. § 103 raised by the third party requester. Patent owner's position is based on its point that (a) issues requiring evaluation of the Graham factors include objective evidence of secondary considerations, e.g. commercial success, and (b) objective evidence that is confidential in nature is relevant, yet its use in reexamination comes into conflict with the public nature of reexamination proceedings, while it can best be preserved in confidence by the District Court protective order. Patent owner argues that access to confidential evidence that would establish commercial success of the third party requester's accused products could be best obtained and preserved utilizing the District Court's discovery and subpoena powers.

Third party requester asserted several arguments in an opposition to the patent owner's petition to stay reexamination, arguements which were taken in to consideration in the making of this decision.

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. The Court of Appeals for the Federal Circuit has 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 being reexamined. *Ethicon, Inc., v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). *Ethicon* discusses certain fundamental concepts regarding concurrent *ex parte* reexamination and litigation proceedings for a patent. The *Ethicon* court quoted extensively from the decision of the Federal Circuit 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." 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) authorizes a narrow exception to the mandate for special dispatch in an *inter partes* reexamination proceeding, within the discretion of Director "for good cause." Thus, the question of suspending an *inter partes* reexamination proceeding being conducted concurrently with litigation may be considered where there is a clear showing of "good cause" for the suspension. Pursuant to 35 U.S.C. § 314(c), and 37 CFR 1.987 that implements the statutory provision, the USPTO Director has, within his discretion, authority to evaluate whether facts and circumstances amount to "good cause" for suspension of an *inter partes* reexamination proceeding, 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 '093 and '094 reexamination proceedings), the Office issued a decision granting a patent owner petition to stay the *inter partes* reexamination proceedings due to the existence of concurrent litigation of the patents that were

being reexamined. [1] The decision pointed out that MPEP § 2684.04 set forth certain criteria as indicia of "good cause" for suspension of an *inter partes* reexamination proceeding, and that these criteria were merely exemplary. [2] The decision then proceeded to grant a stay based upon a set of facts and circumstances as to the reexamination and litigation proceedings enunciated in the decision in detail. 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 U.S. Dist. LEXIS 36856. This criteria establishes a benchmark and standard which the Office is using to test the facts and circumstances of record in any given *inter partes* reexamination proceeding, in order to determine whether there is "good cause" to suspend that *inter partes* reexamination proceeding based on the existence of concurrent litigation of the patent being reexamined.

In the *Sony* scenario:

In the Immersion-Sony '093 and '094 reexamination proceedings, 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 accordingly 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. The Office pointed out that the requested suspension would lead to a piecemeal reexamination, and a delay in reexamination of the non-litigated claims. [3] The patent owner then disclaimed claim 1 of each patent, leaving only identical patent claims to be 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 '093 and '094 *inter partes* reexamination proceedings.

At the point in time that the Immersion-Sony *inter partes* reexamination proceedings were suspended, the reexamination proceedings were at an early stage; the Office's work had been limited solely to a finding that the two requests for reexamination had raised a substantial new question of 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

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[1] See the '093 and '094 proceedings, Decision Granting Petitions To Suspend, November 17, 2005
[2] *Id.*, Decision Granting Petitions To Suspend, November 17, 2005, footnote 6.
[3] *Id.*, Decision Denying Petitions, August 23, 2005, at page 6.

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 resources, since a final holding of claim validity would statutorily require termination of the Immersion-Sony *inter partes* reexamination proceedings with respect to all of the claims subject to the litigation, which were also all the claims subject to reexamination in the two proceedings. It was not in the Office's and the parties' interests to engage resources in administrative proceedings, where there was a substantial likelihood that the reexamination proceedings would be mooted by the concurrent litigation which was *soon* to be finally resolved. The substantial likelihood that prosecution of the reexamination proceedings would soon terminate and the proceedings then 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 pointed out 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 requester 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. As pointed out, the Office's position was ratified by the District Court for the Eastern District of Virginia.

In the present instance:

The facts and circumstances in the '228 *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 '117 patent is at an early stage. For example, the issue of claim construction is still pending. Furthermore, the Utah District court has **stayed litigation** pending the '228 *inter partes* reexamination for the Office to proceed. Thus, unlike the Immersion-Sony *inter partes* proceedings, in which the litigation had already resulted in an appealable holding of claim validity, with the appeal having been filed and briefed to the appellate court, in this instance, the Utah District Court has stayed litigation at a very early stage to prevent such a scenario from arising. No final holding of claim validity in the litigation is forthcoming, in the near future, to justify the Director to exercise his narrow "good cause" discretion exception to the statutory special dispatch reexamination mandate to suspend the '228 *inter partes* proceeding. In this instance, not even a District Court finding is forthcoming in the near future! Accordingly, good cause to suspend the '228 *inter partes* proceeding clearly has not been shown.

Futher, as to the difference:

In the Immersion-Sony *inter partes* proceedings, third party requester Sony, chose to permit the District Court litigation to proceed for three years before filing its two requests for reexamination only after District Court 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, at in the instant case, might have stayed the litigation to await the Office's decisions in the reexamination proceedings. In the present instance, the requester has filed the '228 *inter partes* reexamination well before the District Court litigation has advanced to conclusion, and the Office proceedings can thus be seasonably made available to the District Court.

As to petitioner's secondary considerations argument:

The Utah District Court has manifested, in the May 15, 2007 order, a willingness to timely address any needs or concerns that either party may have in regard to confidentiality, as defined by the court's previously granted protective order, that may conflict with the '228 reexamination proceeding. This addresses petitioner's above argument as to the presentation of the evidence of secondary considerations, e.g. commercial success. On this matter, see MPEP 724 *et seq* which sets forth the guidelines for submitting and treatment of proprietary, confidential, and protected information. After a careful review of that area to ensure proper submission of information, MPEP 724.04(c) may be focused on as to "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)."

In addition, it is to be noted that, if information is relevant to commercial success to the extent that it is "important" to the patentability determination, it is in the public interest to make that information public, such that the information can be evaluated by the public. Opening such information will permit the public, whose knowledge is collective, to bring any contrary or otherwise relevant information to the attention of the appropriate deciding official, who cannot be charged with (cannot possess) the collective knowledge of the public. Asserting that a claim is patentable based on information not to be disclosed to the public cuts against the principles of fairness in disclosing why the claims are patentable.

As a final point, if the commercial success evidence contains a customer's name, or the like information that is protected, the patent owner could simply redact any evidence submitted to delete that name or like information, and the evidence submitted could still be available for evaluation as to its probative weight.

CONCLUSION

1. The May 14, 2007 patent owner petition is dismissed.

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

3. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

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6-29-07

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Thomas D. Dickson, Jr.
Reexamination Proceeding
Control No. 95/000,228
Filed: February 12, 2007
For: U.S. Patent No. 6,979,117

: DECISION
: DISMISSING
: PETITION

This is a decision on the August 9, 2007 third party paper entitled "PETITION TO EXPUNGE UNDER 37 C.F.R. § 1.59 AND MPEP § 724.05." On August 17, 2007, the patent owner filed a paper in opposition to the third party's petition.

Inasmuch as the regulations do not expressly provide for relief other than expungement, the petition is taken as a petition pursuant to 37 CFR 1.182, requesting that papers already made of record in the proceeding be provisionally sealed pending a subsequent determination of their relevance by the Office. See the discussion below.

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

The petition is granted to the extent that the materials requested will be provisionally sealed, and dismissed as to the expungement requested, for the reasons set forth below.

FEES

The 400 USD petition fee under 37 CFR 1.17(f) required by 37 CFR 1.182 will be charged to Deposit Account No. 13-0265, as authorized by the patent owner in footnote 1 of the August 9, 2007 petition.

REVIEW OF FACTS

1. U.S. Patent No. 6,979,117 (the '117 patent), issued to Thomas D. Dickson, Jr., on December 27, 2005.

2. The '117 patent is subject to litigation in the United States District Court for the District of Utah, Central Division, *K-TEC, INC. v. VITA-MIX CORP.*, (Case No. 2:06-cv-00108-TC-PMW).

2. A request for *inter partes* reexamination of the '117 patent was filed by a third party requester (requester), Vita-Mix Corp., on February 12, 2007. The request was assigned Control No. 95/000,228 (the '228 proceeding).

3. On March 30, 2007, citing 35 U.S.C. § 314(c) and 37 CFR 1.987, patent owner filed a petition to suspend *inter partes* reexamination.

4. On April 20, 2007 the Office issued a decision returning, as an improper paper, the patent owner's March 30, 2007 petition to suspend *inter partes* reexamination.

5. On May 7, 2007, the Office granted the '228 request for reexamination, and concurrently, issued a first action on the merits.

6. On May 14, 2007, patent owner filed a renewed petition under 35 U.S.C. § 314(c) and 37 CFR 1.987 to suspend *inter partes* reexamination.

7. On May 15, 2007, the District Court granted a motion to stay the *K-TEC* litigation, pending reexamination of the '117 patent.

8. On July 5, 2007, the Office dismissed patent owner's May 14, 2007 renewed petition to suspend *inter partes* reexamination.

9. On July 6, 2007, patent owner filed a timely response to the May 7, 2007 first action on the merits, including a paper entitled "Declaration of Clarke B. Nelson" (the Nelson Declaration) which includes as attachments schedules 2, 2A and 2B.

10. On August 9, 2007, third party requester filed a petition to expunge schedules 2, 2A and 2B attached to the Nelson Declaration that are included in patent owner's July 6, 2007 response.

11. On August 17, 2007, patent owner filed an opposition to third party's August 9, 2007 petition to expunge.

APPLICABLE REGULATIONS AND PRACTICE

37 CFR 1.59 states (in part):

> (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 1.182 states:

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

37 CFR 1.945 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 1.933(a) states (in part):

(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).

37 CFR 1.555(a) states (in part):

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.

MPEP § 724.04(c) states (in part):

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

(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR1.11 (d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

In response to the Office action dated May 7, 2007, patent owner filed papers on July 6, 2007, which contain the Nelson declaration, including schedules 2, 2A and 2B as attachments to the Nelson declaration. Pursuant to 37 CFR 1.941-1.945, patent owner's response was both timely and proper in order to avoid termination of the reexamination prosecution.

In its petition, third party requester alleges that schedules 2, 2A and 2B attached the Nelson declaration in the July 6, 2007 patent owner response are subject to a Protective Order issued by the District Court in the stayed *K-TEC* litigation. Specifically, third party requester alleges that schedules 2, 2A and 2B consist entirely of requester's confidential, proprietary and trade secret financial information, which is subject to the June 22, 2007 protective order issued by the District Court of Utah, Central Division.

37 CFR 1.933(a) requires, *inter alia*, that a patent owner submit all information known to patent owner, and all information known to any individual associated with the patent owner, that is material to the patentability of any claim pending in the '228 *inter partes* reexamination proceeding. Patent owner alleges that (a) schedules 2, 2A and 2B attached the Nelson declaration *inter alia* are important to a reasonable examiner in determining the patentability of patent owner's claims, (b) the schedules are not subject to the protective order issued by the District Court on June 22, 2007, and (c) the schedules for various reasons are not eligible for expungement in accordance with MPEP 724.02.

37 CFR 1.59 relates to expunging information from an "application," and MPEP § 724.04(c) addresses expunging information from the record of a reexamination proceeding, thereby applying 37 CFR 1.59 to reexamination proceedings. MPEP § 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." As pointed out in MPEP § 724.04(c), information that is determined by the examiner to be material to patentability **will not be expunged**. When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office

official responsible for considering the information) will review any information sealed under MPEP § 724.04(c), and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable," i.e., whether it is material. The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but in no event, later than the close of prosecution.

To date, there has been no determination by the examiner as to the materiality the Nelson declaration and, more importantly to the issue at hand, schedules 2, 2A and 2B attached thereto. It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is, "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is the responsibility of, and is issued by, the examiner in charge of the proceeding. Thus, even if it were established that any part of the Nelson declaration (and its attachment) is protected, any decision as to expunging information subject to the District Court's Protective Order would be premature, and such would be required to be held in abeyance at this time. It is only after the examiner has issued a determination on the issue of importance of provisionally sealed information in an Office action on the merits, that a petition to expunge protected information can be timely.

With regard to the dispute between parties as to whether information of the Nelson declaration, including its attachments, (hereinafter "the Nelson declaration paper") is protected or not, the Office will does not determine, *sua sponte*, whether any part of the Nelson declaration paper is subject to a District Court's Protective order. Rather, the petitioner must make access to the District Court to resolve any issue as to what is protected (or not) by the court's order. Clearly, the District Court's is the appropriate tribunal to make that determination.

The requester petition does however provide a reasonable basis upon which to provisionally seal the Nelson declaration paper at this point in time. Such will protect the documents, while providing petitioner an opportunity to approach the District Court to resolve any issue as to what is protected. The '228 *inter partes* reexamination proceeding is contained in an electronic Image File Wrapper (IFW). The Nelson declaration inclusive of its attachments, which includes schedules 2, 2A and 2B, are contained in a single IFW document, the Nelson declaration paper. This document is being provisionally sealed in order to make the schedules unavailable for public viewing in the otherwise publicly accessible IFW.

The provisionally sealed papers will remain sealed on a provisional basis for a period of two months from the date of the present petition decision. During that period, petitioner may file the appropriate papers with the District Court to resolve the issue in question. Examination can proceed during this period. If any of the information in question is determined to be material during that period, the examiner may employ that material in any Office action that is issued. [1]Otherwise, such information is not to be employed by the examiner.

[1] As pointed out in MPEP § 724.04(c), information that is determined by the examiner to be material to patentability will not be expunged. Such information is made use of in an Office action to the extent of its materiality.

After approaching the District Court, the requester may, within the two month time limit, file a renewed petition without additional fee, requesting:

(A) That the provisionally sealed information remain provisionally sealed, pending a determination by the District Court on a motion (etc.) already filed by requester for a determination as to what information is protected. Any such petition must set forth the date the motion (etc.), as well as the expected date for the court to take action on it.

(B) That information determined to be protected by the District Court remain sealed, pending a determination of whether the papers are deemed by the examiner to contain information that is determined to be "important to a reasonable examiner in deciding whether or not a claim is patentable" as to any claim pending in this proceeding.

With respect to filing a renewed petition pursuant to option (B): For **each document** that third party wishes to have sealed, third party must submit a statement certifying either (1) that the entire document contains material subject to the District Court's Protective Order and requesting that the entire document remain sealed, or (2) that only a portion of the substance of a given document contains material subject to the District Court's Protective Order and requesting that such document remained sealed and that a replacement redacted version of the document be submitted with any such renewed petition. A copy of the Court's order, or other determination on the matter, must be attached to any such renewed petition In the case of option (2), for any document not consisting entirely of information that is subject to the District Court's Protective Order, patent owner will be required to provide, a version of the document having the protected material redacted. [2]

As a final point: It is to be noted that the information which petitioner has requested to be expunged/sealed has already been made available to the general public and was subject to copying (of the file by the public) since a reexamination proceeding is open to the public. See 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the public did not previously access the materials, which are now being sealed as a result of this decision.

CONCLUSION

1. The August 9, 2007 third party petition to seal schedules 2, 2A and 2B of the Nelson declaration filed on July 6, 2007 is granted to the extent that the Nelson declaration, and its attachments, will be provisionally sealed, and is dismissed as to the expungement requested

2. The Nelson declaration, including schedules 2, 2A and 2B, submitted with the July 6, 2007 patent owner response, are provisionally sealed on an interim basis for a period not to exceed **TWO MONTHS** from the mailing date of the present decision.

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[2] If any part of the July 6, 2007 patent owner response recites protected material that cannot be separated out electronically, e.g. citations to and disclosure of the content of the schedules in the text of the Nelson declaration, patent owner will be required to provide a redacted copy of the response to substitute in the IFW public file for the copy of the response which is requested to be sealed. This is so, because it is not possible to seal passages on individually specified pages entered into the IFWs without sealing the rest of that page.

3. If a renewed petition under 37 CFR 1.182 to seal, or to provisionally seal, is not filed pursuant to options (A) or (B) above, within TWO MONTHS from the date of the present decision, then the provisionally sealed materials will be unsealed.

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.

5. 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. **If any of the information in question is determined to be material during that period, the examiner may employ that material in any Office action that is issued. Otherwise, such information is not to be employed by the examiner.**

6. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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CENTRAL REEXAMINATION UNIT

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In re Dickson	:	
Ex parte Reexamination Proceeding	:	
Control No. 90/008,814	:	
Filed: August 13, 2007	:	
For: U.S. Patent No. 6,979,117	:	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
In re Dickson	:	
Inter partes Reexamination Proceeding	:	
Control No. 95/000,228	:	
Filed: February 12, 2007	:	
For: U.S. Patent No. 6,979,117	:	

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

REVIEW OF FACTS

1. On December 27, 2005, United States Patent Number 6,979,117 (the '117 patent) issued.

2. On February 12, 2007, a request for *inter parte* reexamination of the '117 patent, assigned Reexamination Control No. 95/000,228 (the '228 proceeding), was filed by David Cupar on behalf of third party requester, Vita-Mix Corp.

3. On May 7, 2007, an order granting *inter partes* reexamination issued, accompanied by an action on the merits for the '228 proceeding

4. On July 6, 2007, patent owner responded to the May 7, 2007 Office Action. No amendments were submitted by patent owner.

5. On August 6, 2007, third party requester submitted comments after patent owner's July 6, 2007 response.

6. On August 13, 2007 a request for *ex parte* reexamination of the '117 patent, assigned Reexamination Control No. 90/008,814 (the '8814 proceeding), was filed by David Cupar on behalf of Vita-Mix Corp.

7. An order granting *ex parte* reexamination was mailed for the '8814 proceeding on November 9, 2007.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '228 proceeding) is an *inter partes* proceeding. The *inter partes* proceeding is still pending, and has not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/000,228 and 90/008,814 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, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

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
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

by hand to:

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim

should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* requester) which may be filed, even though the brief relates to merged multiple proceedings and copies usually must be filed (as pointed out above) for each file in the 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. 95/000,228 and *ex parte* Reexamination Control No. 90/008,814 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759, or, in her absence, to the undersigned, at 571-272-7710.

Kenneth M. Schor

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

December 12, 2007
C:\kiva\petmerger\Reexreex\95_0228+8814_EP-IP-Merge_cls-same EP-3PR-is-IP-3PR.doc_

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.
95/000,228	02/12/2007	6979117	46264.0037	6286

57600 7590 03/23/2009

HOLLAND & HART LLP
60 E. South Temple, Suite 2000
P.O. Box 11583
Salt Lake City, UT 84110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,228	02/12/07	6979117	46264.0037

EXAMINER
STEIN, STEPHEN

MCDONALD HOPKINS LLC
600 SUPERIOR AVENUE, EAST
SUITE 2100
CLEVELAND, OH 44114-2653

ART UNIT	PAPER
3991	

DATE MAILED:

03/23/09

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
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L. Grant Foster (For Patent Owner)
HOLLAND & HART LLP
60 East South Temple
Suite 2000
Salt Lake City, UT 84111-1031

David B. Cupar (For Third Party Requester)
600 Superior Avenue, E.
Suite 2100
Cleveland, OH 44114-2653

MAILED

MAR 23 2009

CENTRAL REEXAMINATION UNIT

In re Dickson :
Ex parte Reexamination Proceeding :
Control No. 90/009,113 :
Filed: April 17, 2005 :
For: U.S. Patent No. 6,979,117 :
:
In re Dickson : **DECISION, *SUA SPONTE*,**
Ex parte Reexamination Proceeding : **TO MERGE**
Control No. 90/008,814 : **REEXAMINATION**
Filed: August 13, 2007 : **PROCEEDINGS**
For: U.S. Patent No. 6,979,117 :
:
In re Dickson :
Inter partes Reexamination Proceeding :
Control No. 95/000,228 :
Filed: February 12, 2007 :
For: U.S. Patent No. 6,979,117 :

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

REVIEW OF FACTS

1. On December 27, 2005, United States Patent Number 6,979,117 (the '117 patent) issued.

2. On February 12, 2007, a request for *inter partes* reexamination of the '117 patent, assigned Reexamination Control No. 95/000,228 (the '228 proceeding), was filed by David Cupar on behalf of third party requester, Vita-Mix Corp.

3. On May 7, 2007, an order granting *inter partes* reexamination issued, accompanied by an action on the merits for the '228 proceeding

4. On July 6, 2007, patent owner responded to the May 7, 2007 Office Action. No amendments were submitted by patent owner.

5. On August 6, 2007, third party requester submitted comments after patent owner's July 6, 2007 response.

6. On August 13, 2007, a first request for *ex parte* reexamination of the '117 patent, assigned Reexamination Control No. 90/008,814 (the '8814 proceeding), was filed by David Cupar on behalf of Vita-Mix Corp.

7. On November 9, 2007, the Office issued an order granting *ex parte* reexamination for the '8814 proceeding.

8. On December 13, 2007, the Office issued a decision *sua sponte* merging the '228 and the '8814 proceedings.

9. On April 17, 2008 a second request for *ex parte* reexamination of the '117 patent, assigned Reexamination Control No. 90/009,113 (the '9113 proceeding), was filed by David Cupar on behalf of Vita-Mix Corp.

10. On May 23, 2008, the Office issued an order granting *ex parte* reexamination for the '9113 proceeding.

11. A patent owner's statement under 37 CFR 1.530 has not been received in the '9113 reexamination proceeding, and the time for same has expired.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. One of the proceedings (the '228 proceeding) is an *inter partes* proceeding. The *inter partes* proceeding is currently part of a merged proceeding with an *ex parte* reexamination proceeding, the '8814 proceeding (the previously merged proceeding). The previously merged proceeding is still pending, and has not been terminated. Further, a patent owner's statement under 37 CFR 1.530 has not been received in the '9113 reexamination proceeding, and the time for same has expired. Therefore, consideration of further merger with the '9113 proceeding pursuant to 37 CFR 1.989 is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the previously merged proceeding, consisting of the 95/000,228 and 90/008,814 proceedings, and the 90/009,113 reexamination proceedings, are now merged. The new tri-merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files *throughout the tri-merged proceeding*. As the claims are the same in all files, a "housekeeping amendment" is NOT needed.

III. CONDUCT OF TRI-MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with merged proceeding that includes an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the tri-merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the 90/009,113 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the two *ex parte* reexaminations were requested by the same third party that requested the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

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

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

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

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

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

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Patent owner and requester are reminded that every paper filed in the tri-merged proceeding subsequent to this decision must be served on the other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as set forth above.

C. Amendments:

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* reexamination Control No. 95/000,228 and *ex parte* reexamination Control Nos. 90/008,814 and 90/009,113 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the tri-merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. __

Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

(For Patent Owner)

MAILED

APR 16 2007

CENTRAL REEXAMINATION UNIT

Tracy Druce
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Street
Houston, Texas 77002

(For Requester)

In re Khandors
Reexamination Proceeding
Control No.: 95/000,229
Filed: February 15, 2007
For: U.S. Patent No.: 6,465,893

: NOTICE OF TIME PERIOD TO
: OPPOSE PETITION TO
VACATE FILING DATE IN
: REEXAMINATION PROCEEDING

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration after receipt of the patent owner's March 26, 2007 petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the instant *inter partes* reexamination proceeding, or alternatively to suspend action in the proceeding.

BACKGROUND

U.S. Patent No. 6,465,893 (hereinafter, the '893 patent) issued on October 15, 2002.

Patents 6,433,419 and the '893 patent, along with other related patents, are currently the subject of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California.

A request for reexamination of the '893 patent, assigned control No. 90/000,229 (the '0229 proceeding), was filed by a third party requester, Silicon Precision Industries Co., Ltd, on February 15, 2007. Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b).

The present 37 CFR 1.182 and 1.183 petition to vacate the filing date in the instant *inter partes* reexamination proceeding, or alternatively to suspend action in the proceeding, was received from the patent owner on March 26, 2007.

The Office has not yet issued a decision on the request for reexamination in the '0229 reexamination proceeding.

REQUIREMENT

The petition received from the patent owner requests that the Office vacate the filing date of, or suspend, the present *inter partes* reexamination proceeding. The patent owner's request is based upon the assertion, in the petition, that the requestor has not correctly identified the "real party of interest" as mandated by 35 U.S.C. 311(b)(1) and 37 CFR 1.915(b)(8) and 1.919(a).

Consistent with 35 U.S.C. 311(b)(1), the rules require that a request must include "a statement identifying the real party in interest to the extent necessary for a subsequent person filing an inter partes reexamination request to determine whether that person is a privy." 37 CFR 1.915 (b)(8) (emphasis added). Further, 37 CFR 1.919 (a) provides that if the request fails to identify the real party so that privies can be identified, then the requirements for a filing date have not been met.

The third party requester is hereby being provided with an opportunity to address the patent owner's March 26, 2007 petition under 37 CFR 1.182 and 1.183, as follows.

Pursuant to this Notice, the third party requester is hereby given a period of **FIFTEEN DAYS** to respond to the March 26, 2007 patent owner petition by **showing cause** why the petition should not be granted based upon the allegations set forth therein. The showing of cause must include the following:

1. An identification of all the parties that participated/consulted in the preparation of the request, including reviewing it and providing comments, including any or all of the other *Tessera,* litigation defendants. This will include an identification of the parties amongst whom the *inter partes* reexamination request was circulated during its preparation and who was involved in the consultation and preparation of the request for inter *partes* reexamination

2. An identification of who will be involved in the prosecution of *inter partes* reexamination proceeding in the future. Identify which parties will review draft papers before they are filed in the Office.

3. In "DEFENDANTS' JOINT MOTION TO STAY PROCEEDINGS PENDING REEXAMINATION OF THE PATENTS-IN-SUIT" filed March 22, 2002, in the *Tessera* litigation the following is stated at page 1:

PLEASE TAKE NOTICE that on April 26, 2007, at 2:00 p.m., or as soon thereafter as the parties may be heard, in the courtroom of the Honorable Claudia Wilken, Courtroom 2, 4th Floor, located at 1301 Clay Street, Oakland, California 94612, Defendants Advanced Micro Devices, Inc., Spansion Inc., Spansion Technology Inc., Spansion LLC, Advanced Semiconductor Engineering, Inc., ASE (U.S.) Inc., ChipMOS Technologies Inc., ChipMOS U.S.A., Inc., Siliconware Precision Industries Co., Ltd., Siliconware USA Inc., STMicroelectronics N.V., STMicroelectronics, Inc., Stats ChipPAC Ltd., Stats ChipPAC, Inc., and Stats ChipPAC (BVI) Limited (collectively "Defendants") will, and hereby do, move the Court for an order staying all proceedings pending reexamination by the United States Patent & Trademark Office ("PTO") of each of the patents-in-suit Since the parties (defendants) all appear to rely on the request for reexamination as a basis for their joint motion to stay the litigation, why does requester not consider all of them "real parties in interest"? Why should the remainder of the defendants also relying on the present reexamination be permitted to avoid the estoppel provisions of 35 U.S.C. 317(b), 35 U.S.C. 315(c)?

The requester must clarify which parties are a "real party in interest," as set forth in 35 U.S.C. 311(b)(1) and 37 CFR 1.915 (b)(8). In other words, did Silicon Precision handle the reexamination request alone, or did some or all of the other *Tessera* litigation defendants also, in some way, participate in preparing/revising the pending reexamination request? It is to be noted that the requester must sufficiently identify the "real party in interest" to the extent necessary to determine if a subsequent requester is a "privy" pursuant to 35 U.S.C. 317(b) and 37 CFR 1.915 (b)(8).

CONCLUSION

1. The third party requester is hereby given a period of **Fifteen days from the date of this Notice** to respond to the March 26, 2007patent owner petition. This period of time is **not** subject to extension.

2. A response to the patent owner's March 26, 2007 petition may be treated as a petition and opposition under 37 CFR 1.182, in response to patent owner's petition and submitted by:

By U.S. Postal Service Mail:	Mail Stop *Inter Partes* Reexam Central Reexamination Unit P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-9900 Central Reexamination Unit Attention: Maria Nuzzolillo and Pinchus Laufer
By hand (or delivery service):	Customer Service Window

Randolph Building
401 Dulany St.
Alexandria, VA 223

To avoid a delay in matching papers and to ensure timely consideration, **it is strongly advised that a copy of the requester's response also be submitted by facsimile** and directed to:

Maria Nuzzolillo
571-273-8150 AND

Pinchus Laufer
571-273-7726

3. Telephone inquiries related to this decision should be directed to Nuzzolillo, Maria, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.

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

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4-16-07

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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Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

(For Patent Owner)

MAILED

JUN 08 2007

CENTRAL REEXAMINATION UNIT

Tracy Druce
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Street
Houston, Texas 77002

(For Requester)

In re Khandors	:	
Reexamination Proceeding	:	DECISION DENYING
Control No.: 95/000,229	:	PETITION TO
Filed: February 15, 2007	:	VACATE FILING DATE
	:	
For: U.S. Patent No.: 6,465,893	:	

This is a decision on the March 26, 2007, patent owner's "Petition to Vacate Filing Date in *Inter Partes* Reexamination or, alternatively, to Suspend *Inter Partes* Reexamination Proceedings" under 37 CFR 1.182 and 1.183. A May 8, 2007 "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination" has also been filed.

The petition and opposition are before the Office of Patent Legal Administration for consideration.

The petition is denied for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 6,465,893 (hereinafter, the '893 patent) was issued on October 15, 2002.

2. On February 15, 2007, a request for *inter partes* reexamination of the '893 patent was filed by a third party requester, Silicon Precision Industries Co., Ltd. (hereinafter "Silicon Precision"). Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 90/000,229 (the '0229 proceeding).

3. On February 9, 2007, a request for *inter partes* reexamination of companion patent 6,433,419 (the '419 patent) was filed by Silicon Precision. Again, Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). This companion request was assigned control No. 90/000,227 (the '0227 proceeding).

4. On March 26, 2007, the patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like petition was filed in the companion '0227 proceeding.

5. Patent owner's petition provides that the '419 and '893 patents, along with other related patents, are currently the subjects of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California. Silicon Precision is one of the co-defendants in the *Tessera* litigation.

6. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

7. On April 17, 2007 the third party requestor, Siliconware, submitted a paper titled "Litigation Activity Update under 37 C.F.R. 1.985."

8. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," in which the April 16, 2007 notice was vacated.

9. The Office issued a decision granting the request for reexamination in the '0227 and '0229 reexamination proceedings on May 04, 2007. The decision granting the '0227 request was accompanied by the first Office action on the merits.

10. On May 8, 2007, the requester submitted, in response to the Modified Notice, a paper titled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

11. On May 23, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision expunging from the record both the April 17, 2007 Litigation Activity Update under 37 C.F.R. 1.985.

DECISION

1. In the February 15, 2007 request for *inter partes* reexamination, the third party requestor identified Silicon Precision as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). In requester's May 8, 2007 response to the "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," requester has now verified, that Silicon Precision is the real party in interest. Nothing further is required by statute, as 35 U.S.C. 311(b)(1) requires that the request for *Inter Partes* Reexamination "include the identity of the real party in interest". Likewise, 37 C.F.R. 1.915(b)(8) requires "[a] statement identifying the real party in interest". Nothing more is required by the statutes or rules, for compliance with the "real party in interest" filing date requirement. It would thus be inappropriate to vacate or terminate the present proceeding, based on the issue raised as to the identity of the "real party in interest."

2. Even if the "real party in interest" is shown to be misstated, the statute and rules do not provide a remedy for such misstatement to be addressed in the Office. Rather, relief from such a misstatement can only be addressed via the courts. It is to be observed that the courts, in which discovery, testimony and other tools (such as subpoena power) are available, provide the forums best equipped to determine who is, and who is not, the real party in interest. Further, the courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if such a request is already filed, the court can enjoin participation by the requester in the proceeding, where appropriate, thereby essentially turning the proceeding into an *ex parte* reexamination proceeding, the filing of which is not prohibited by statute and rule, even after an *inter partes* reexamination was filed by the same real party in interest. [1] Also, if (1) a decision in the present *inter partes* proceeding is ultimately made which is adverse to the requestor, and (2) the issue is presented before a court by way of a civil action, the courts (at that point in time) can address any estoppel considerations which may or not apply, depending on the court's resolution (at that time) of the "real party in interest" issue.

As a final point, the patent owner's petition does not allege that the identity of the real party in interest will change the manner in which the present proceeding is handled, and no change can be found by the Office. It is only the *potential* resulting statutory estoppels/prohibitions against the real party in interest (which the petition urges to be more parties than Silicon Precision), which is the concern of petitioner. To that extent, the determination of any potential relief to patent owner is premature, and, as pointed out above, is a decision for the courts to determine. If patent owner can provide basis for immediate relief being needed (e.g., to enjoin future party filings of reexamination and/or civil litigation activity), the patent owner has recourse to the United States District Court for the Northern District of California, before which court the *Tessera* litigation is

[1] If the court makes a finding that the "real party in interest "was misstated, the Office can then take action, if appropriate, based upon the court's findings.

now pending. A motion to that court could be filed to address the relief that patent owner feels is warranted.

CONCLUSION

1. The patent owner petition filed on March 26, 2007 under 37 CFR. 1.182 and 1.183 is **DENIED**.

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 (CRU).

4. Telephone inquiries related to this decision should be directed to Nuzzolillo, Maria, Legal Advisor, at (571) 272-8150, or in her absence, the undersigned at (571) 272-7710.

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

6-8-07

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Marcus J. Millet (For Patent Owner)
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

Tracy Druce (For Requester)
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Street
Houston, Texas 77002

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SEP 13 2007

CENTRAL REEXAMINATION UNIT

In re Khandors	:
Reexamination Proceeding	: DECISION ON
Control No.: 95/000,229	: PETITION FOR
Filed: February 15, 2007	: RECONSIDERATION
For: U.S. Patent No.: 6,433,419	:

This is a decision on the July 05, 2007 patent owner REQUEST FOR RECONSIDERATION OF DECISION DENYING PETITION TO VACATE FILING DATE" filed under 37 CFR 1.182 and 1.183.

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

The petition is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested. The instant decision is designated as a final agency decision.

BACKGROUND

1. U.S. Patent No. 6,465,893 (hereinafter, the '893 patent) was issued on October 15, 2002.

2. On February 15, 2007, a request for *inter partes* reexamination of the '893 patent was filed by a third party requester, Silicon Precision Industries Co., Ltd. (hereinafter "Silicon Precision"). Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). The present request was assigned control No. 90/000,229 (the '0229 proceeding).

3. On February 9, 2007, a request for *inter partes* reexamination of companion patent 6,433,419 (the '419 patent) was filed by Silicon Precision. Again, Silicon Precision was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). This companion request was assigned control No. 90/000,227 (the '0227 proceeding).

4. On March 26, 2007, the patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively to suspend action in the proceeding. A like petition was filed in the companion '0227 proceeding.

5. Patent owner's March 26, 2007 petition provided that the '419 and '893 patents, along with other related patents, are currently the subjects of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al.* (No. 05-04063 CW) in the United States District Court for the Northern District of California. Silicon Precision is one of the co-defendants in the *Tessera* litigation.

6. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

7. On April 17, 2007 the third party requestor, Siliconware, submitted a paper titled "Litigation Activity Update under 37 C.F.R. 1.985."

8. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," in which the April 16, 2007 notice was vacated.

9. The Office issued a decision granting the request for reexamination in the '0227 and '0229 reexamination proceedings on May 04, 2007. The decision granting the '0229 request was accompanied by the first Office action on the merits.

10. On May 8, 2007, the requester submitted, in response to the Modified Notice, a paper titled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

11. On May 23, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision expunging from the record the April 17, 2007 Litigation Activity Update under 37 CFR 1.985, as an improper paper.

12. On June 8, 2007, OPLA issued a decision denying the Patent Owner request of March 26, 2007, under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination

proceeding, or alternatively to suspend action in the proceeding. A like decision was issued for the companion '0227 proceeding.

13. On July 5, 2007 the Patent Owner filed a "Request for Reconsideration of [the June 8, 2007] Decision Denying Petition to Vacate Filing Date" in conjunction with an amendment in response to the Official Action dated May 4, 2007.

14. On August 8, 2007, the requester submitted a response entitled "Third Party's Comments to Patent Owner's Response of July 5, 2007 under 37 CFR 1.947, in response to patent owner's July 5, 2007 submissions.

DECISION

In the February 15, 2007 request for *inter partes* reexamination, the third party requester identified Silicon Precision as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). In Requestor's May 8, 2007 response to the "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding," Requester verified that Silicon Precision is the "real party in interest." Absent clear evidence that the identified "real party in interest" is erroneously identified, nothing further is required by the statute. Specifically, 35 U.S.C. 311(b)(1) requires that the request for *Inter Partes* Reexamination "include the identity of the real party in interest," and in this instance the Requester has done so.

At pages 5 and 6 of the present petition, it is argued that "the statute's text does not require that the request include a 'statement ' identifying the real party in interest; it requires that the request '*include the identity* of the real party in interest.' § 311(b) (i) (emphasis added). And, further, that no 'statement' can satisfy the statute unless it actually 'includes the identity' of that person or persons." In the present instance, "Silicon Precision Industries Co., Ltd." has been identified as the real party in interest by requester. Requester has provided the identity required by the statute, and nothing in the statute requires the Office to investigate the accuracy of that identification, absent clear evidence that the identification is inaccurate. Only if such evidence is present is it reasonable for the Office to take action. In this instance, Petitioner relies on "DEFENDANTS' JOINT MOTION TO STAY PROCEEDINGS PENDING REEXAMINATION OF THE PATENTS-IN-SUIT" filed March 22, 2002 ("the joint motion"), in the *Tessera* district court litigation to assert that the correct real party in interest is not identified in this proceeding. Page 1 of the joint motion states:

> PLEASE TAKE NOTICE that on April 26, 2007, at 2:00 p.m., or as soon thereafter as the parties may be heard, in the courtroom of the Honorable Claudia Wilken, Courtroom 2, 4th Floor, located at 1301 Clay Street, Oakland, California 94612, Defendants Advanced Micro Devices, Inc., Spansion Inc., Spansion Technology Inc., Spansion LLC, Advanced Semiconductor Engineering, Inc., ASE (U.S.) Inc., ChipMOS Technologies Inc., ChipMOS U.S.A., Inc., Siliconware Precision Industries Co., Ltd., Siliconware USA Inc., STMicroelectronics N.V., STMicroelectronics, Inc., Stats ChipPAC Ltd., Stats ChipPAC, Inc., and Stats ChipPAC (BVI) Limited (collectively "Defendants") will, and hereby do, move the Court for an order staying all proceedings pending reexamination by the United States Patent & Trademark Office ("PTO") of each of the patents-in-suit.

Further, footnote 10 at page 18 of the petition details Petitioner's basis for the its allegation that the correct real party in interest is not identified in this proceeding, as follows:

> Specifically: Tessera's evidence showing that SPIL is not the real party in interest included, among other things, the following: (i) SPIL and the other defendants in litigation with Tessera have claimed that their communications relating to the reexamination are protected by a joint defense privilege pursuant to a "Defendants' Common Interest Agreement"; (2) SPIL and the other defendants collectively drafted Preliminary Invalidity Contentions incorporating all of the prior art cited in the reexamination proceedings; (3) SPIL and the other defendants jointly filed an unsuccessful motion to stay the litigation based on their reexamination requests; and (4) SPIL filed a "Litigation Activity Update" on May 22, 2007, in the Office for the express purpose of asking the Office to expedite its issuance of a first Office Action in view of an investigation by the International Trade Commission in which only other defendants (and not SPIL) are respondents.

Petitioner relies upon the above as argument that the *Tessera* co-defendants should all be named in the present reexamination as real parties in interest. However, Petitioners argument that the co-defendants all appear to rely on the request for reexamination as a basis for their joint motion to stay the litigation, and have collectively participated in other matters, does not establish that the co-defendants are real parties in interest in this reexamination proceeding. The fact that Silicon Precision's co-defendants may benefit from this reexamination request, or that Silicon Precision may be collaborating with others in a concurrent litigation and other matters, does not evidence those co-defendants to be real parties in interest in this reexamination,

With respect to the Office conducting an investigation to ferret out whether a particular party is a real party in interest the statute does not require, nor did it provide the tools for, the Office to investigate the matter. Congress did not vest the Office conducting a reexamination proceeding with subpoena power, did not provide for discovery and hearings with testimony and cross-examination, and did not authorize the Office to impose punitive sanctions for non-compliance, which tools would have enabled the Office to investigate the accuracy of the identification of the real party in interest. Those tools are, however, available to the courts, which are the appropriate vehicle to make an investigation as to the accuracy of the identification. [1]

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[1] Note *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), where the court took note of parties' availability of the court's investigative powers, to address the absence of same to the Office.

> "During ex parte PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under 37 C.F.R. Section 1.132 (1993). Moreover, if applicants wish to cross-examine the authors of written hearsay assertions, under 35 U.S.C. Section 145 (1988) they may bring a civil action in the United States District Court for the District of Columbia seeking adjudication that they are entitled to receive a patent. In such an action, testimony could be compelled by subpoena under Federal Civil Procedure Rule 45. See Gould v. Quigg , 822 F.2d 1074, 1076, 3 USPQ2d 1302, 1303 (Fed.Cir. 1987) ("While the evidentiary record before the Board serves as the 'evidentiary nucleus' of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence."). [32 F.3d at 1565, 31 USPQ2d at 1821]

Note further MPEP 2010 which states:

> "The Office is not the best forum in which to determine whether there was an 'intent to mislead'; such intent is best determined when the trier of facts can observe demeanor of witnesses subjected to cross-examination. A court, with subpoena power, is presently the best forum to consider duty of disclosure issues under the present evidentiary standard for finding an 'intent to mislead'."

See also MPEP 2686.04(III) which points to this difference between the Office and the courts stating:

> "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)."

To expand, courts have discovery, testimony and other evidentiary tools (e.g., subpoena power and sanctions) available, and are the forums best equipped to determine who is, and who is not, the "real party in interest." Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if such a request has already been filed, a court can enjoin participation by the requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which is not prohibited by statute and rule, even after an *inter partes* reexamination was filed by the same real party in interest.[2] Also, if (1) a decision in the present *inter partes* proceeding is ultimately made which is adverse to the requestor, and (2) the issue is presented before a court, any estoppel considerations which may or may not apply, depending on the court's resolution of the "real party in interest" issue can be addressed at that time.

The present petition argues (at p. 9) that "outside the Office 'real party in interest' precedent universally requires a party whose disclosure has been challenged to provide support for the disclosure, citing federal district court cases as examples, and referring to areas such as jurisdiction (e.g., presence of diversity or amount of suit) and representative suits such as bankruptcies and probate. Petitioner adds at page 9 of the petition that "[o]ther tribunals routinely look behind self-certifications of the real party in interest if a challenge has been made, sometimes aggressively." However, that is precisely the point. The Office does not possess subpoena, sanction, discovery and hearing tools that a court and certain other tribunals possess. As pointed out in our June 8, 2007 decision,[3] patent owner may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the "real party in interest.". It is also noted that the present petition for reconsideration is *silent* as to why patent owner did not approach the *Tessera* District Court for relief (an investigation into the matter and an appropriate order), despite the invitation to do so in the last 2 sentences of the DECISION section of the June 8, 2007 decision. The petition is also silent as to why patent owner has re-approached the Office for relief, despite the fact that the Office is not equipped with the necessary discovery tools to ferret out the relevant information, while patent owner would not immediately approach the court, which *is* so-equipped.

In addition, at pages 6 and 7 of the petition, the patent owner emphasizes the importance of real party in interest disclosure requirement:

> The real party in interest disclosure requirement is at the core of the *inter partes* reexamination statute, *cf. Reyna*, 218 F.3d at 1111, for it determines the scope of the unique statutory estoppel associated with the proceeding. See 35 U.S.C. § 315 and P.L. 106-113 § 4607 (subjecting requestors to estoppel as to issues they raised or could have raised). Thus, the statute is written so that "anyone

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[2] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

[3] The last 2 sentences of the DECISION section of the June 8, 2007 decision state:

"If patent owner can provide basis for immediate relief being needed (e.g., to enjoin future party filings of reexamination and/or civil litigation activity), the patent owner has recourse to the United States District Court for the Northern District of California, before which court the Tessera litigation is now pending. A motion to that court could be filed to address the relief that patent owner feels is warranted."

> who requests *inter partes* reexamination must identify the real party in interest[,] and third-party requesters who participate in an *inter partes* reexamination proceedin[g] are estopped from raising in a subsequent court action or *inter partes* reexamination any issue of patent validity that they raised or could have raised during such *inter partes* reexamination." G. Mossinghoff, "Post-Grant Review Of Patents," 43 IDEA 83, 91 (2002). The real party in interest requirement is thus critical "[t]o prevent harassment" of patent owners under the statute, id., for otherwise third parties could hide behind others serving the same interest, in an attempt to escape estoppel in subsequent litigations. Indeed, this "important distinction" between *ex parte* and *inter partes* reexamination is regarded as *the "price for th[e] right....*

Given patent owner's allegation of the importance of the matter, patent owner could have immediately requested the *Tessera* court's investigation into the issue of "real party in interest." Patent owner voluntarily chose not to.

With respect to 37 CFR 1.915(b) provision regarding the issue of "real party in interest," the following discussion is provided.

37 CFR 1.915(b)(8) requires "[a] statement identifying the real party in interest to the extent necessary for a subsequent person filing an inter partes reexamination request to determine whether that person is a privy." Silicon Precision is identified as the "real party in interest." "Silicon Precision Industries Co., Ltd." has been identified sufficiently for a party to know where it is located, and which business it operates under. A party would look for other entities and persons having sufficient connection to be classified as a privy. To the extent that petitioner construes 37 CFR 1.915(b)(8) to require inclusion of the identity of all parties who would be related or co-defendants of Silicon Precision Industries Co., Ltd.and thus be subject to the relevant estoppels would be unreasonable. Simply because a party may be related to or a co-defendant of Silicon Precision does not necessarily make that party a "real party in interest."

In the last complete paragraph of page 7 of the petition, requester's identification of the real party of interest is characterized as "patently false statements by requestors." As pointed out above, Patent owner has not shown that any of the *Tessera* co-defendants qualify as a "real party in interest" but has simply shown that the co-defendants are simply that -- co-defendants.

Patent owner's position appears to be that the other *Tessera* co-defendants' benefit from this reexamination request, together with their collaboration with Silicon Precision in a concurrent litigation and other matters, should automatically make those others a real party interest in this reexamination. As pointed out above, it is the Office's position that such is not the case. The difference in patent owner's interpretation of what is a "real party of interest," and that of the Office or requester does not make the requester's statements of identification "patently false statements." The statement in the petition that requester has made "patently false statements" bears on the issue of conduct. Note the statement of 37 CFR 1.3 that "[a]pplicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy."

CONCLUSION

1. The patent owner petition for reconsideration is granted to the extent that the prior decision has been fully reconsidered, and 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 this proceeding is being returned to the Central Reexamination Unit (CRU).

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or the undersigned at (571) 272-7710.

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

9-11-07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,229	02/15/2007	6465893		7288

530 7590 09/10/2008

LERNER, DAVID, LITTENBERG,
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/10/2008

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

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HOUSTON, TX 77002

Date:
MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000229
PATENT NO. : 6624263
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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

Tracy Druce
Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
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(For Requester)

In re Khandors :
Reexamination Proceeding : DECISION
Control No.: 95/000,229 : DENYING
Filed: February 15, 2007 : PETITION
For: U.S. Patent No.: 6,465,893 :

This is a decision on the June 9, 2008 patent owner petition paper entitled "RENEWED PETITION TO VACATE FILING DATE FOR FAILURE TO INCLUDE INDENTITY OF REAL PARTY IN INTEREST" ("the renewed petition"). This decision also has considered the third party requester ("requester") opposition petition paper originally filed on June 12, 2008 and subsequently re-submitted on July 21, 2008 entitled "THIRD PARTY REQUESTOR'S PETITION AND OPPOSITION TO PATENT OWNER'S RENEWED PETITION TO VACATE FILING DATE FOR FAILURE TO INCLUDE INDENTITY OF REAL PARTY IN INTEREST" ("the opposition paper").

The renewed petition and the opposition paper are before the Office of Patent Legal Administration for consideration.

Summary:

The patent owner petition paper has been considered as petition under 37 CFR 1.182 and 1.183. The petition is denied with respect to the relief requested therein.

This decision is designated as a final agency action pursuant to 5 U.S.C. § 704.

FEES

A single petition fee of $400.00 pursuant to 37 CFR 1.17(f) will be charged to Deposit Account No. 12-1095 as invited on page 1 of the patent owner petition. Similarly, the

opposition paper will also be treated under 37 CFR 1.182 and 1.183. Accordingly, a single $400.00 petition fee has been remitted by credit card authorization form attached to the present opposition paper.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,465,893 (hereinafter, the '893 patent) was issued on October 15, 2002.

2. On February 15, 2007, a request for *inter partes* reexamination of the '893 patent was filed by requester, Silicon Precision Industries Co., Ltd. (hereinafter "Siliconware"[1]) and was assigned control No. 95/000,229 ("the '229 reexamination proceeding").

3. On March 26, 2007, patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively, to suspend action in the proceeding.

4. Patent owner's March 26, 2007 petition provided that the '893 patent, (along with other related patents), was currently the subject of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al* (No. 4:05CV04063) in the United States District Court for the Northern District of California. Petitioner patent owner asserted that Siliconware was one of multiple co-defendants in the *Tessera* litigation. [2]

5. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."

6. On April 17, 2007, requester submitted a paper entitled "Litigation Activity Update under 37 C.F.R. 1.985." On June 4, 2007, patent owner (Tessera, Inc.), submitted a paper entitled "Notice of Prior and Concurrent Proceedings Pursuant to 37 CFR 1.985."

7. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding ... " in which the April 16, 2007 Notice was vacated.

8. On May 4, 2007, the Office issued a decision granting the request for reexamination in the '229 reexamination proceeding. The decision granting the '229 request was accompanied by the first Office action on the merits, also mailed on May 4, 2007.

9. On May 8, 2007, requester submitted, in response to the Modified Notice, a paper entitled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

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[1] At page 1 of the "Request for *Inter Partes* Reexamination Transmittal Form," Silicon Precision Industries Co., Ltd. was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). At page 1, paragraph 1 of the request papers, Siliconware Precision Industries Co., Ltd. and Siliconware USA, Inc., (collectively "Siliconware"), were identified as the parties requesting reexamination. In the present requester opposition paper, third party requester unambiguously identifies Siliconware Precision Industries Co., Ltd. and Silconware USA, Inc., (collectively "Siliconware"), as the real party in interest in the present '229 *inter partes* reexamination proceeding. These parties are named defendants in the litigation mention in Fact # 4. The real party in interest is deemed to be as identified in the present opposition paper, and will hereinafter be referred to as "Siliconware."

[2] "Petition to Vacate Filing Date ... or, Alternatively, to Suspend ... Proceeding," March 26, 2007, page 3, footnote 3.

10. On June 8, 2007, the Office issued a decision denying the patent owner petition to vacate the filing date or, in the alternative, to suspend the '229 *inter partes* reexamination proceeding. The decision was designated as a final agency action under 5 U.S.C. § 704.

11. On July 5, 2007, patent owner filed a paper entitled "Request for Reconsideration of Decision Denying Petition to Vacate Filing Date," addressed to the June 8, 2007 Office decision.

12. On September 13, 2007, the Office mailed a decision that granted the July 5, 2007 request for reconsideration only to the extent that the June 8, 2007 decision was reconsidered, but which denied the underlying relief requested in July 5, 2007 request for reconsideration. The September 3, 2007 decision was also designated as a final agency action under 5 U.S.C. § 704.

13. On June 9, 2008, patent owner filed the present renewed petition.

14. On June 12, 2008, requester filed opposition papers opposing the renewed petition, which opposition papers were re-submitted on July 21, 2008. [3]

RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

> (a) IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
> (b) REQUIREMENTS.– The request shall–
> (1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

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[3] The June 12, 2008 opposition paper and the exhibits attached thereto were labeled as being subject to a Protective Order. Further, the copies of these papers that were served on patent owner arrived in an envelope that labeled the content of the envelope as being subject to a Protective Order, and each paper in the envelope was so labeled. In response to an Order to Show Cause promulgated by the Office on July 8, 2008, third party requester filed papers on July 21, 2008 that "de-designated" the documents so that they were no longer submitted as being subject to a Protective Order. The "de-designated" documents were then served on patent owner.

(a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.
...
(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2612 provides, in part:

> 37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

> The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

DECISION

I. Timeliness of the Renewed Petition

Note is taken that there is an issue of whether the present renewed petition to vacate has been timely filed because 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."

The present renewed petition was filed on June 12, 2008, eleven months after the Office mailed a decision denying patent owner's July 5, 2007 request for reconsideration of the Office decision dated June 8, 2007. The Office's decision was designated as final agency action.

In the July 5, 2007 request for reconsideration and in the March 26, 2007 original petition, patent owner argued that the request for *inter partes* reexamination in the '229 proceeding,

as filed, admitted that defendants in the litigation identified in Fact # 4, *supra*, other than Siliconware, had filed reexamination requests. [4] Patent owner also argued that the existence of multiple co-defendants in the litigation, in which the defendants have a common interest and are collaborating to attack the validity of the '893 patent, indicated that the other defendants, should also be named as the real party in interest in the '229 proceeding. Patent owner drew certain inferences based on the timing of the filing of papers in the litigation and the filing of the '229 request for reexamination that patent owner asserted "proved" that the other co-defendants are unnamed real parties in interest in the '229 proceeding, and that the Office had a duty to investigate the matter. [5]

A comparison of the arguments advanced by patent owner in the present renewed petition with the arguments relied upon by prior patent owner in the prior petitions to vacate or suspend the '229 reexamination proceeding shows that patent owner is now relying on information (to establish that the real party in interest was not properly identified in the request for reexamination of that proceeding) that may not have been available for inclusion in the prior petitions to vacate or suspend. Accordingly, the Office deems that the present renewed petition is not untimely filed. [6]

II. Patent Owner's Case for Vacatur

In the present petition, patent owner asserts that there is now firm evidence that the real party in interest was not properly identified in the '229 request for reexamination. The asserted evidence is:

a. A declaration of Brian Marucci, Vice President of Business Development and Licensing for patent owner, that discusses a meeting with Juliette Chan, Corporate Counsel for Siliconware Precision and C.B. Chang, Vice President for Sales for Siliconware USA. In this declaration, Mr. Marucci avers that, in conversation, Ms. Chan stated that respondents in Investigation No. 337-TA-605 before the U.S. International Trade Commission [7] would be unhappy with Siliconware if Siliconware stopped participating in the '229 reexamination proceeding because "they would lose control of the reexaminations." Mr. Marucci further avers that Ms. Chan subsequently refused to disclose Siliconware's conversations with third parties regarding the '229 reexamination proceeding. [8]

b. STMicroelectronics, N.V. ("ST-NV"), co-defendant in the '893 patent litigation, filed an Annual Report with the U.S. Securities and Exchange Commission ("SEC") "at approximately the same time" that the original March 26, 2007 patent owner petition was filed. In that report, ST-NV stated that:

> Tessera is claiming [9] that our BGA packages practice certain technology and patents owned by Tessera, and that we are liable for royalties. Trial is currently scheduled for the first quarter of 2008. **We recently filed, together with our co-**

[4] "Petition to Vacate Filing Date ... or, Alternatively, to Suspend ... Proceeding," March 26, 2007, page 3.
[5] Id., at pages 3-11. See also "Request for Reconsideration ... ," July 5, 2007.
[6] The Office takes note that patent owner has not timely contested the determination by the Office that neither the March 26, 2007 petition nor the July 5, 2007 request for reconsideration established that the real party in interest had not been properly identified in the '229 request for reexamination, but rather is acting on apparently newly available information.
[7] Patent Owner Complainant in that ITC Investigation which also involves the '893 patent.
[8] Mr. Marucci's declaration is attached to the present renewed petition.
[9] In the '893 patent litigation.

> **defendants, a request for reexamination by the United States Patent and Trademark Office of all patents being asserted by Tessera in the lawsuit.** [Emphasis supplied by patent owner.] [10]

Patent owner notes that subsequent to the March 26, 2007 petition to vacate the filing date, later ST-NV SEC filings omitted mention of ST-NV's participation. [11]

c. Patent owner refers to an annual report by ChipMOS Technologies Bermuda Ltd., that was filed with the SEC, in which it is stated that ChipMOS Taiwan and ChipMOS USA requested reexamination of all Tessera patents being asserted in the '893 patent litigation. [12]

d. Patent owner also alleges that when it attempted to examine Dr. Richard K. Ulrich, a technical expert hired by Siliconware as to the involvement of unidentified parties in the reexamination proceedings and his communications with such entities, Dr. Ulrich refused to answer on the advice of counsel (who is also counsel in the '229 reexamination proceeding). Patent owner opines that this evidences a joint-defense privilege (joint participation) in the reexamination proceedings.

Patent owner then asserts that there is undisputed evidence of participation and control of the '229 reexamination proceeding by unidentified real parties in interest other that Siliconware, and that requester argues that it need not state the real party in interest accurately. [13] Patent owner concludes that the '229 reexamination proceeding should be dismissed, or in the alternative, that requester should be required to show cause why the petition should not be granted.

III. Requester's Case Against Vacatur

In the opposition paper, requester argues that the Marucci declaration contains language that is subject to interpretation. Requester also argues that, in the conversation referred to in the Marucci declaration, Ms. Chan told Mr. Marucci that Siliconware solely prepared, filed, paid for and controls the reexamination request for the '893 patent, (*i.e.*, the '229 reexamination proceeding). [14]

Requester asserts that the ST-NV SEC filing was subsequently corrected to point out that ST-NV's co-defendants in the '893 patent litigation, and not ST-NV, had filed reexamination requests for the involved Tessera patents. This argument is supported by a verified statement of Mr. Steven K. Rose, Vice President, Secretary and General Counsel of ST-NV and a copy of page 21 of Form 6-F filed on May 7, 2007, with the SEC. [15]

Requester argues that the 2007 20-F SEC filing by ChipMOS Technologies Bermuda, Ltd. (that states that a co-defendant filed a reexamination request against the '893 patent with the concurrence of ChipMOS Taiwan and ChipMOS USA) does not indicate that ChipMOS filed

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[10] The ST-NV SEC filing is attached to the renewed petition as Exhibit 1.

[11] "Renewed Petition to Vacate ... ,"June 9, 2008, page 11, footnote 5; See also: Exhibit 4 attached to the renewed petition.

[12] Id., at page 12.

[13] Id., at pages 16-21.

[14] "Third Party Requestor's Petition and Opposition to Patent Owner's Renewed Petition to Vacate ... ," Exhibit D.

[15] Id., Exhibit E and Exhibit A attached thereto.

the reexamination request or is in any way a real party in interest. Further, the 2008 20-F SEC filing by ChipMOS Technologies Bermuda, Ltd., states that:

> [A] co-defendant in the Tessera lawsuit requested the United States Patent and Trademark Office to reexamine the patentability of each of Tessera's patents that are at issue in the case in the California court. [16]

It is requester's position that the statement means that another co-defendant, not ChipMOS, requested reexamination of the '893 patent, and that even if other co-defendants concurred with or consulted with Siliconware in the filing of the reexamination request, such would not "automatically" make such co-defendants real parties in interest. This follows, according to requester, from the fact there are sixteen co-defendants accused of infringing the same patents, that each defendant would necessarily "have an interest" in the claims of the '893 patent being invalidated, but that such an interest does not make any of such co-defendants a real party in interest or mean that Siliconware was falsely identified as being the (*i.e.*, only) real party in interest. [17]

Requester concludes by noting that with respect to Dr. Ulrich having invoked joint defense privilege, that does constitute a showing that co-defendants in the '893 patent litigation are real parties in interest in the '229 reexamination proceeding. To the extent that Dr. Ulrich is an expert for a defendant in the '893 patent litigation, and that some or all of the other co-defendants have formed a joint defense effort with Siliconware, patent owner has not established that mere status as part of that joint defense effort necessarily means that unidentified co-defendants are directing, controlling or paying for the '229 reexamination proceeding.

IV. Patent Owner Has Failed to Establish That Siliconware is Not the Real Party in Interest or That There is Reason to Believe that Unidentified Parties are Also Real Parties in Interest

After consideration of the arguments presented by patent owner and by requester, together with the supporting evidence submitted by these parties and the record as a whole, it is found that patent owner has failed to establish that there is another real party in interest, in addition to Siliconware, for the present reexamination proceeding. Rather, it appears that, as stated in the request papers and as confirmed in the present opposition paper, Siliconware is in fact the real party in interest in the '229 reexamination proceeding.

With respect to the SEC filings of ST-NV and ChipMOS which stated that they and their co-defendants filed reexamination proceedings against the Tessera patents: In view of the clarifications made by ST-NV and ChipMOS in subsequent SEC filings, it is quite reasonable to conclude that their earlier statements in the SEC filings were made in error, and that their later statements represent a correction of the earlier statements. There is no basis for determining that the earlier SEC filings by those entities were accurate, and it is not expected that any additional statements by those entities that would differ from those made in the subsequent SEC filings would be forthcoming.

With respect to the Marucci declaration: Even without consideration of the issue of whether the Marucci declaration constitutes hearsay, (as alleged by requester), it is clear that the Marucci declaration is not dispositive evidence that unidentified co-defendants in the '893

[16] Id., Exhibit F (pages 90-91 of Form 20-F filed June 6, 2008).
[17] Id., at page 6.

patent litigation are real parties in interest. The statement of Ms. Chan relied upon by patent owner may reasonably be interpreted as meaning that requester's co-defendants in the '893 patent litigation would be unhappy if Siliconware ceased to participate as the third party requester in the '229 proceeding, because then "**they**" (*i.e.*, Siliconware) would be no longer control (*i.e.*, "have input into") that reexamination proceeding, so that there would no longer be a party in the '229 proceeding that was interested in establishing claim unpatentability. Such an interpretation is no less reasonable than that urged by patent owner, in which the word "they" is interpreted to refer to respondents in the ITC proceeding in order to indicate that such respondents would no longer control the reexamination proceeding. Further, in light of the April 7, 2008 declaration filed and the attached e-mail that together constitute Exhibit D of requester's opposition paper, it is clear that Ms. Chan disagrees that such statement was made to be subject to the interpretation urged by patent owner in the present renewed petition; she recalls telling Mr. Marucci that other co-defendants or respondents "might be" worried if Siliconware "abandoned" the *inter partes* reexaminations, because no party would oppose patent owner in that proceeding. [18] Further, Ms. Chan's declaration affirmatively states that she told Mr. Marucci that Siliconware alone prepared, and paid for the preparation and filing of the '229 reexamination proceeding. [19]

With respect to the issues raised by patent owner regarding Dr. Ulrich being advised to claim privilege when patent owner attempted to examine him as to the involvement of "unidentified parties" in the reexamination proceedings: Patent owner has not cited any legal basis for drawing an inference/conclusion based on a claim of privilege. The basis for (considerations behind) a party claiming privilege is protected by law. In addition, it is hardly surprising that counsel would advise Dr. Ulrich to claim "joint-defense" privilege, where such privilege was properly available. Patent owner's "belief" as to the impact of advice to claim such privilege is no more cognizable on the issue of whether there are in fact "unidentified parties" who are actually real parties in interest in the '229 reexamination proceeding than such advice in a criminal matter would equate to an admission of guilt.

A. When The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous, The Office Lacks The Authority And The Tools To Question That Identification

Patent owner believes that because there are a number of co-defendants in the '893 patent litigation, it is possible or likely that at least some of those co-defendants are actively participating in the '229 reexamination proceeding to the extent that they are real parties in interest. Patent owner thus urges that the Office should investigate the issue of whether the real party in interest has been properly identified in the '229 reexamination proceeding or at least require requester to establish why the patent owner petition should not be granted. It is, however, found that there is insufficient evidence presented by patent owner to establish that the '229 reexamination proceeding should be vacated. It is clear that the patent owner is in reality both requesting a remedy without having shown any damage, and requesting the Office to investigate a matter that patent owner bears the burden of establishing, and has not so established. The basis for this will now be discussed.

The arguments presented in the petition for reconsideration fail to establish that the Office has either the authority to question the accuracy of a third party requester's facially accurate

[18] Id., at Exhibit D.
[19] Id.

and unambiguous identification of the real party in interest in an *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, or as subsequently corrected by the requester, contains an unambiguous identification of the identity of the real party in interest.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> "It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the inter partes reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed."

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rulemaking does not discuss the type or depth of investigation that can and will be undertaken, and does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination. Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed; thus the issue is not ripe for consideration (see discussion in part B. below).

If the issue whether a second reexamination does become ripe for consideration via a second proceeding, the Office would certainly query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. A third party making such statement is a party appearing before the Office. Therefore, a third party requester is available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, the third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the third party requester, and would have no need to obtain information from parties not before the Office by reason of the filing of the request for *inter partes* reexamination. Similarly, where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, a third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (i.e., the ambiguity causes an issue that is ripe for consideration). Such occurred in the present proceeding, and was addressed by the Office and then

requester. [20] The record in the present '229 *inter partes* reexamination proceeding reveals that third party requester clarified the record in the '229 reexamination proceeding with respect to its identification of the real party in interest, after being put on notice that the identification was facially ambiguous. Since the present record in the '229 reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office (which the Office did in this proceeding), patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability. [21] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding). [22] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent, how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, it appears that where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is facially inaccurate, even though it is unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) [23] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees. [24] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one

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[20] Attention is invited to the "Order to Show Cause" dated February 22, 2008 and to "Decision Denying Petition" dated June 17, 2008 both of record in *inter partes* reexamination proceeding 95/000,166. Attention is also invited to the footnote 1, *supra*.

[21] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[22] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability, (or any duty of disclosure), that attaches to a reexamination third party requester.

[23] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[24] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest. [25]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order); even though this is the third petition on the matter and patent owner has been asked twice to address it, patent owner has remained silent on the matter. Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so. Patent owner's argument that it is the Office, not a district court, "that administers the patent statute," is wholly unpersuasive. The Office may consider that it is "the sole agency that administers the patent statute," [26] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rulemaking) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the provenance of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate:

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ." [27] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy." [28] Requester has made it clear that Siliconware is the real party in interest , and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified Siliconware to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

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[25] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.
[26] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[27] 35 U.S.C. § 311(b)(1).
[28] 37 CFR 1.915(b)(8).

In the present '229 *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. [29] The identification of the real party in interest does not appear to facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the '229 reexamination proceeding, because there is no legal reason to do so, even if the office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The '229 *Inter Partes* Reexamination Proceeding

It is also to be noted that, in the present '229 reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the '229 reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the '893 patent by a party that should have been identified as a real party in interest in the '229 reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the '229 reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the '229 reexamination proceeding if such a party "loses" as a defendant in any '893 patent litigation. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the '893 patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the '229 reexamination proceeding. No additional requests for *inter partes* reexamination of the '893 patent have been filed by any of Siliconware's co-defendants (or anyone else), so clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the '893 patent. Accordingly, granting need to consider addressing the relief requested by patent owner in the present '229 *inter partes* reexamination proceeding has not arrived, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the '893 patent that would be barred by statutory estoppel.

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[29] It is to be noted that although the identification of the real party in interest was ambiguous in the various papers comprising the request for reexamination filed by the third party requester in the '229 *inter partes* reexamination proceeding, such ambiguity has been resolved. The identification of the real party in interest in the present opposition paper would applies to this proceeding *nunc pro tunc*, and will allow any subsequent party to draw the necessary conclusions for purposes of 37 CFR 1.907 and statutory estoppel in *inter partes* reexamination.

V. Synopsis

Rather than having presented clear and undisputed evidence establishing that Siliconware is not the only real party in interest in the '229 reexamination proceeding, the present renewed petition is based on (a) equal measures of evidence that are directly contradicted by evidence of at least equal caliber and weight, and (b) argument supported only by supposition and conjecture on patent owner's part. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the '229 reexamination proceeding. Therefore, such relief is denied, and this decision is being designated as a within the meaning of 5 U.S.C. § 704.

ADDITIONAL DISCUSSION

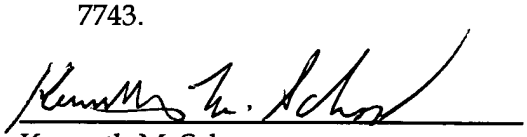
As this decision is designated as a final agency action under 5 U.S.C. § 704, and as two previous decisions on this issue have also been so designated, patent owner is advised that to the extent that patent owner disagrees with the disposition of the issues in this decision, those issues are now at the stage of judicial review - should patent owner desire any further review of those issues. Any further patent owner petition paper directed to the issues decided herein will not be considered unless accompanied by a strong showing of additional facts warranting further review by the Office, together with a certification by patent owner that these additional facts were not known, and could not have been known, at the time that the present patent owner petition was filed. The filing by patent owner of a petition paper directed the issues decided herein that does not include such showing and certification may be construed as being a paper interposed for purposes of delay.

CONCLUSION

1. The June 9, 2008 patent owner renewed petition is denied.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for such action as may be appropriate.

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



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.
95/000,229	02/15/2007	6465893		7288

530 7590 10/09/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2008

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KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

(For Patent Owner)

MAILED

OCT 0 9 2008

CENTRAL REEXAMINATION UNIT

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

(For Requester)

In re Khandros *et alia*
Reexamination Proceeding
Control No. 95/000,229
Request Deposited: February 15, 2007
For: U.S. Patent No. 6,465,893

: DECISION DISMISSING
: PETITION PURSUANT
: TO 37 CFR 1.181

This is a decision on the March 28, 2008, "PETITION PURSUANT TO 37 C.F.R. §1.181 AND MPEP § 2672(VI) TO REDESIGNATE ACTION CLOSING PROSECUTION".

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

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

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,465,893 (the '983 patent) issued to Khandros *et alia* on October 15, 2002.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,229 ('229), was deposited by a third party requester on February 15, 2007.

3. An order granting reexamination of the '983 patent was mailed May 4, 2007. A non-final office action was attached to the order.

4. An Action Closing Prosecution (ACP) was mailed February 15, 2008.

5. The present petition was filed on was filed on March 24, 2008.

6. A non-final office action was mailed August 21, 2008.

DECISION

In view of the fact that prosecution was re-opened in the non-final office action mailed August 21, 2008, the requested relief is **dismissed as moot**.

CONCLUSION

1. The request to redesignate the ACP as a non-final office action is **dismissed as moot.**

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,229	02/15/2007	6465893		7288

530 7590 09/25/2009

LERNER, DAVID, LITTENBERG,
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ART UNIT	PAPER NUMBER

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NDQ REEXAMINATION GROUP
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HOUSTON, TX 77002

Date:
MAILED
SEP 25 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000229
PATENT NO. : 6624263
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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Lerner, David, Littenberg,
Krumholz and Mentik
600 South Avenue West
Westfield, NJ 07090

(For Patent Owner)

MAILED

SEP 25 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re Khandors, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,229
Filed: February 15, 2007
For: U.S. Patent No. 6,465,893

: **DECISION DISMISSING**
: **PETITION**
: **TO WAIVE PAGE**
: **LIMITS FOR**
: **APPELLANT'S BRIEF**

This is a decision on the September 4, 2009 patent owner petition entitled "PETITION TO WAIVE PAGE LIMIT". 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 patent owner petition paper is before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to patent owner's Deposit Account No. 12-1095 pursuant to the authorization on page 4 of the petition.

The patent owner request to waive the restrictions under 37 CFR 1.943(c) is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On 15 October 2002, U.S. Patent No. 6,465,893 was granted to Khandros *et al.*

2. On 15 February 2007, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000, 229 ("229 proceeding").

3. On 04 May 2007, an Order was granted for *inter partes* reexamination in the '229 proceeding.

4. Prosecution in the '229 proceeding progressed to the point where, on 22 June 2009, a Right of Appeal Notice (RAN) was mailed in the '229 proceeding.

5. On 13 July 2009, a petition to withdraw the 22 June 2009 Right of Appeal Notice was submitted by patent owner.

6. On 27 July 2009, patent owner filed a Notice of Appeal.

7. On 04 September 2009 patent owner filed the instant petition under 37 CFR 1.183 entitled "PETITION TO WAIVE PAGE LIMIT," 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 September 04, 2009

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 seventy pages (70) pages and 32,667 words in length.[1] In support of waiver of the rule, patent owner submits that "enforcement of the 30-page limit on the substance of Patent Owner's brief would deprive Patent Owner of the ability to put forth all of the points necessary for fair consideration of the issues."[2] Patent owner states that "[t]he complexity of the issues in this case is demonstrated by the length of the Official Actions in the case, including the length of the Present RAN, and the length of the supposed rebuttal in the Second ACP."[3] Moreover, patent owner states that "the issues to be addressed include complex issues underlying a rejection on § 112, first paragraph (written description grounds)" and that the "the Examiner's treatment of these issues alone occupy 4 pages of the 15 page brief (Present RAN 5-8) and approximately 24 pages of the Second ACP."[4] Finally, patent owner identifies two other reexamination proceedings 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. The burden is on petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts to justify an increase in the number of pages available for patent owner's appeal brief, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(c). In this instance, petitioner has requested a waiver of the 30-page limit of 37 CFR 1.943(c) by discussing the length and complexity of the issues presented in the June 22, 2009 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

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[1] Petition under 37 CFR 1.183 at page 1.
[2] Petition under 37 CFR 1.183 at page 3.
[3] Petition under 37 CFR 1.183 at page 3. On page 2 of the petition under 37 CFR 1.183, patent owner states that "four separate Official Actions have been issued," that the second ACP comprises 121 pages in length and stated 6 separate rejections of the claims, and that the June 22, 2009 RAN comprises 15 pages of largely single-spaced text and "effectively incorporates pages 8-69 and 95-119 of the Second ACP (some 84 pages of text), such that the Present RAN actually constitutes 100 pages in all."
[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 and 95/000,020).

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 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 brief.

While in this instance, patent owner has provided arguments in support of why more pages are deemed necessary to complete the appeal brief, 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. Also, there is no indication in the petition under 37 CFR 1.183 how patent owner determined that 70 pages (*i.e.*, 40 additional pages) are needed to complete patent owner's appeal brief. A review of the record in the '229 proceeding, including the prior patent owner responses, indicates that patent owner's previous responses in the '229 proceeding appear to be presentable within approximately 30 pages.[6] Therefore, in the instant case, the issues to be addressed in patent owner's appeal brief should be addressable by a brief of no more than 30 pages.

Thus, the specific facts set forth in the petition under 37 CFR 1.183 and the particular circumstances of the '229 proceeding are not found to present an extraordinary situation requiring waiver of the 30-page limit requirement of 37 CFR 1.943(c) for patent owner's appeal brief. Accordingly, patent owner's petition under 37 CFR 1.183 is **dismissed**.

III. What is included or excluded from the page limit

The provisions of 37 CFR 1.943(c) have been waived by the Office 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 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/information that goes beyond that which is required by those sections,

[6] Patent owner's largest response appears to be 35 pages in length. For example, patent owner's March 10, 2009 submission under 37 CFR 1.951(a) to the February 5, 2009 ACP appears to be 22 pages in length; patent owner's October 24, 2008 response to the August 21, 2008 Office action appears to be 28 pages in length; patent owner's April 17, 2008 submission under 37 CFR 1.951(a) to the February 15, 2008 ACP appears to be 35 pages in length; and patent owner's July 5, 2007 response to the May 4, 2007 Office action appears to be 25 pages in length (note that any accompanying declarations were considered in the estimated page lengths, and that only those pages upon which arguments appear are included in the page-limit count of 37 CFR 1.943(b) pursuant to MPEP 2667(I)(A)(2)).

[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.

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" appendices required by 37 CFR 41.67(c)(x) are considered "reference materials," and are excluded from the page count only insofar as they are 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.

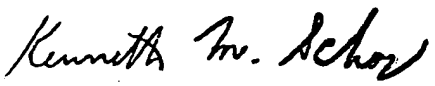
CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is **dismissed**.

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. The time for filing a respondent's brief may not be extended.

3. Jurisdiction over the '229 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,229	02/15/2007	6465893		7288

530 7590 03/04/2010

LERNER, DAVID, LITTENBERG,
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2010

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NDQ REEXAMINATION GROUP
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HOUSTON, TX 77002

Date: MAILED

MAR 0 4 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000229
PATENT NO. : 6624263
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 Patent Owner)

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CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Wells Fargo Plaza, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

In re Igor Y. Khandros et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,229
Filed: February 15, 2007
For: U.S. Patent No. 6,465,893

: **DECISION**
: **DISMISSING AS MOOT**
: **PETITION**

This is a decision on the November 17, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Patent Owner's Brief on Appeal and revive the present reexamination prosecution ("the November 17, 2009 patent owner petition to revive").

The November 17, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

Subsequent to the November 17, 2009 patent owner petition to revive, the Office issued a communication on November 19, 2009. The November 19, 2009 Office communication states that the November 12, 2009 Inter Partes Reexamination Notification re Brief "was mailed in error and is vacated." The November 19, 2009 communication further states that "[t]he Patent Owner appeal brief filed October 7, 2009 with a certificate of mailing of October 5, 2009 is timely." Therefore, the November 17, 2009 patent owner petition to revive is **dismissed** as moot.

Patent owner's petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the November 17, 2009 petition to revive is being refunded.

CONCLUSION

1. The November 17, 2009 patent owner petition to revive is **dismissed** as moot.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,229	02/15/2007	6465893		7288

530 7590 06/04/2010

LERNER, DAVID, LITTENBERG,
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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Date: MAILED
JUN 0 4 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000229
PATENT NO. : 6624263
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.

United States Patent and Trademark Office

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

Lerner, David, Littenberg,
Krumholz and Mentik
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Westfield, NJ 07090

(For Patent Owner)

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

(For Third Party Requester) JUN 0 4 2010

CENTRAL REEXAMINATION UNIT

In re Khandors, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,229
Filed: February 15, 2007
For: U.S. Patent No. 6,465,893

: **DECISION DISMISSING**
: **PETITION**
: **TO WAIVE PAGE**
: **LIMITS FOR**
: **RESPONDENT BRIEF**

This is a decision on the November 5, 2009 third party requester's petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183." The petition requests waiver of the 37 CFR 1.943(c) requirement that respondent's brief in an *inter partes* reexamination proceeding not exceed 15 pages or 7,000 words in length.

The proceeding and third party requester's petition paper are before the Office of Patent Legal Administration for consideration.

Requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) limit as to the number of pages permitted in a requester's respondent brief is dismissed. The requester's respondent's brief is not to exceed 15 pages in length or 7,000 words, excluding reference materials such as prior art references.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the November 5, 2009 petition under 37 CFR 1.183 was charged to requester's Deposit Account 15-0665 on November 10, 2009 pursuant to the authorization on page 2 of the petition.

REVIEW OF THE RELEVANT FACTS

1. On 15 October 2002, U.S. Patent No. 6,465,893 was granted to Khandros *et al.*

2. On 15 February 2007, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control number 95/000, 229 ("229 proceeding").

3. On 04 May 2007, an Order was granted for *inter partes* reexamination in the '229 proceeding.

4. Prosecution in the '229 proceeding progressed to the point where, on 22 June 2009, a Right of Appeal Notice (RAN) was mailed in the '229 proceeding.

5. On 27 July 2009, patent owner filed a Notice of Appeal.

6. On 04 September 2009, patent owner filed a petition under 37 CFR 1.183 entitled "PETITION TO WAIVE PAGE LIMIT," 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 25 September 2009, a decision on the petition of 04 September 2009 dismissed patent owner's request to waive the page limit for an appeal brief.

8. On 07 October 2009, an appellant's brief was filed by the patent owner.[1]

9. On 05 November 2009 third party requester filed the instant petition under 37 CFR 1.183 entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183" requesting waiver of the page limit requirements of 37 CFR 1.943(c) for requester's respondent brief ("the petition under 37 CFR 1.183"). A respondent's brief was filed concurrently with the petition.

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.

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[1] On 11 November 2009, the Office mailed a notice dismissing patent owner's appeal brief as untimely filed. On 17 November 2009 patent owner filed a petition pursuant to 37 CFR 1.137 to withdraws the 12 November 2009 Office notice and decision. On 19 November 2009, the office mailed a letter stating that the 12 November 2009 decision was mailed in error and it vacated the decision that the appeal brief was untimely filed, thus rendering the 07 October 2009 patent owner appeal brief timely. On 04 March 2010 an Office decision dismissing the 17 November 2009 patent owner petition pursuant 37 CFR 1.137 to withdraw the 12 November 2009 Office decision was dismissed as moot.

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. Third Party Requester's Petition of November 5, 2009

In the instant petition, petitioner requests waiver of 37 CFR 1.943(c), which limits third party requester's respondent brief to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit the requester to file a respondent brief not to exceed twenty-six pages (26) along with five (5) claim charts which have been reformatted from the examiner's claim charts relied upon in the Action Closing Prosecution (ACP).[2] In support of waiver of the rule, requester asserts that "It would therefore be inequitable and impractical to require Requestor to respond to Patent Owner's 30 pages of analysis with only 15 pages."[3] Requestor states that "[r]eexamination proceedings before the Office have been ongoing for over two years, resulting in a large amount of evidence and complex argument in the Second ACP, Examiner's RAN, and Patent Owner Appeal Brief. These documents combine to a total of over 150 pages. "[4] Moreover, requestor states that "[r]equestor brief, submitted with this petition, addresses and rebuts issues raised in Patent Owner's Appeal Brief, and involves detailed discussion of "new matter" rejections under § § 112 and 132. These discussions cite to and discuss the Second ACP and Examiner's RAN extensively. Requestor's brief refers to claim charts found throughout the Second ACP. The claims charts produced by the Examiner in the Second ACP total roughly 200 pages."[5]

Petitioner also requests waiver of the 15 page limit under 37 CFR 1.943 (c) for about 90 pages of reformatted claim charts. Petitioner states: "In an effort to provide the examiner and the Board with claim charts that are clearer and easier to read, the Requestor has reformatted and revised the claim charts provided by the examiner in the Second ACP". Pet. at 3. Accompanying the reformatted claim charts is a declaration by Attorney Michael Heafy declaring that "We have attempted not to alter or modify the substance of the claim Charts from the Second ACP." Pet. at 3.

---

[2] Petition under 37 CFR 1.183 at page 2.
[3] Petition under 37 CFR 1.183 at page 2.
[4] Petition under 37 CFR 1.183 at pages 3 and 4 On page 2 of the petition under 37 CFR 1.183, patent owner states that "four separate Official Actions have been issued," that the second ACP comprises 123 pages in length and included 58 pages of claim charts, and that the June 22, 2009 RAN comprises 15 pages of largely single-spaced text and it incorporates 61 pages of the second ACP.
[5] Petition under 37 CFR 1.183 at page 3.

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. The burden is on petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts to justify an increase in the number of pages available for a respondent brief, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(c). In this instance, petitioner has requested a waiver of the 15-page limit of 37 CFR 1.943(c) by discussing the length and complexity of the issues presented in the second ACP, the June 22, 2009 RAN as well as the length of the appellant brief submitted by the patent owner.

The reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of issues raised during prosecution. Yet, prior to appeal, the claims and rejections/issues were adequately addressed in responses that fell well within the regulatory page limits. Additionally, the patent owner's appellant brief complies with the page limit of 37 CFR 1.943(c). No reason why an increase in pages is now warranted has been provided, and certainly no extraordinary situation has been shown to exist that would require an increase in the limit for a respondent brief. Moreover, petitioner has not made of showing of any efforts made to reduce the number of pages or words, by for example referring back to prior arguments, consolidating issues or eliminating unnecessary portions of the argument. The page limits are intentionally designed to focus the issues and require a concise presentation of arguments. The respondent brief is purposely limited to half the length of the appellant brief. Based on the facts of this proceeding, it is apparent that measures that could have been taken to reduce the pages/words in order to comply with the limits were not taken to work within the limits set by the rules.

A persuasive showing has not been made that this situation is extraordinary such that significantly more pages be allotted compared to prior responses and especially compared to patent owner's appellant brief, which falls within the page limit and is formatted in a similar manner to third party requester's respondent brief. Therefore, the request for waiver of 37 CFR 1.943(c) to permit additional pages of respondent brief is dismissed.

As to the 90 pages of reformatted claim charts, petitioner asserts that the new charts are provided for the convenience of the examiner and the Board. MPEP § 2667 I.A.2 provides explicit guidance with respect to claim charts and states:

> 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). [Emphasis added.]

The claim charts in the instant reexamination have been part of the proceedings since at least the Second ACP, and both parties have relied on the claim charts of record throughout the

reexamination.[6] The resubmissions of the charts, albeit in a different format, are redundant and not necessary to the appeal process. The desire to resubmit them in a different format does not rise to an extraordinary situation in which justice would require waiver of the rule to permit their entry. Therefore, the request for waiver of 37 CFR 1.943 (c) to permit entry of the reformatted claim charts as part of respondent's brief is dismissed.

The respondent brief filed November 5, 2009, including all of the appendices, is improper and expunged by closing it in the Image File Wrapper (IFW) and marking it non-public. Third party requester may file a corrected or redacted respondent brief within 15 days of the mailing of this decision that does not exceed 15 pages or 7.000 words in compliance with 37 CFR 1.943(c). Extensions of time are not permitted.

III. What is included or excluded from the page limit

The provisions of 37 CFR 1.943(c) have been waived by the Office 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 15 page limit. *See* MPEP 2667(I)(A)(2). By its terms, 37 CFR 1.943(c) excludes 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/information 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" appendices required by 37 CFR 41.67(c)(x) are considered "reference materials," and are excluded from the page count only insofar as they are 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.

IV. Improper Content in the Appendices in the Briefs

The parties are reminded that the Evidence appendices required in 37 CFR 41.67(c)(1)(ix) and 37 CFR 41.68(b)(1)(viii) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection (appellant brief) or evidence entered by the examiner and relied upon by the respondent in the appeal (respondent brief). The appendix must include a statement where the evidence was entered into the record. The evidence appendix is not to include copies of the patent under reexamination, copies of Office actions in related cases or

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[6] ACP of Feb. 02, 2009 and RAN of June 22, 2009.

[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.

copies of prior art references. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

CONCLUSION

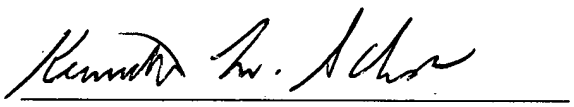
1. Requestor's petition under 37 CFR 1.183 is dismissed. The respondent brief must comply with the limit of 37 CFR 1.943(c) of 15 pages or 7,000 words.

2. The respondent brief filed November 5 is improper as it does not comply with 37 CFR 1.943(c), and it is expunged by closing it in IFW and marking it non-public.

3. The third party requester may file a corrected or redacted respondent brief that does not exceed 15 pages or 7,000 words within 15 days of this decision. The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

4. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole Dretar, Legal Advisor, at 571-272-7717.



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

June 2, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,229	02/15/2007	6465893		7288

530 7590 06/11/2010

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2010

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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NDQ REEXAMINATION GROUP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000229
PATENT NO. : 6624263
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.

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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LERNER DAVID LITTENBERG : (For Patent Owner)
KRUMHOLZ & MENTLIK :
600 SOUTH AVE. WEST :
WESTFIELD, NJ 07090 :

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
1000 LOUSIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

In re: Khandros *et al.* :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/000,229 : UNDER 37 CFR § 1.181
Deposited: 15 February 2007 :
For: U.S. Patent No.: 6,465,893 :

This is a decision on two petitions filed by the patent owner, the first on 13 July 2009, and the second on 17 November 2009. The petitions are entitled:

"PETITION TO WITHDRAW RIGHT OF APPEAL NOTICE" (hereinafter "first petition")

"PETITION PURSUANT TO 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF UNTIMELINESS OF APPEAL BRIEF" (hereinafter "second petition")

The petitions are a request to the Director to exercise his discretion pursuant to 37 CFR 1.181, first to withdraw an allegedly improper Right of Appeal Notice, and second to withdraw an allegedly improper finding that an appeal brief was untimely.

The petitions are before the Director of the Central Reexamination Unit. The petitions are dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,465,893 issued on 15 October 2002.
- A request for *inter partes* reexamination was filed on 15 February 2007 and assigned control no. 95/000,229.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice was mailed for the proceeding on 22 June 2009.
- On 13 July 2009, the first petition at issue herein was filed by the patent owner.
- On 27 July 2009, the Office received a notice of appeal by patent owner.
- On 07 October 2009, the Office received patent owner's appeal brief.
- On 12 November 2009, the Office mailed a communication stating the appeal is dismissed because patent owner's brief was not timely.
- On 17 November 2009, the second petition at issue herein was filed by the patent owner.
- On 19 November 2009, the Office mailed a letter vacating the 12 November 2009 paper and stating the patent owner's appeal brief is timely.

DECISION

As to the first petition, petitioner argues that discussion of a reference in a section entitled "response to arguments" that addresses the general state of the art constitutes a new ground of rejection. This section is not part of the grounds of rejection. Give the procedural posture of the case, it is for the Board of Appeals and Interferences to decide the sufficiency of the adopted (or non-adopted) rejections. The petition is dismissed as petitioner's argument and the examiner's response do not alter the previously stated rejection.

As to the second petition, the requested relief has already been granted. The Office has already vacated the paper dismissing the appeal and has stated that the Appeal Brief was timely filed. The second petition is therefore moot.

Accordingly, the petition of 13 July 13 2009 is dismissed. The petition of 17 November 2009 is dismissed as moot.

CONCLUSION

1. The petition of 13 July 13 2009 is dismissed. The petition of 17 November 2009 is dismissed as moot.

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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JAN 30 2008

CENTRAL REEXAMINATION UNIT

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Jared S. Goff (For 95/000,230 Requester)
Klarquist Sparkman, LLP
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Portland, Oregon 97204

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,224
Filed: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Brad A. Armstrong
Inter partes Reexamination Proceeding
Control No. 95/000,230
Filed: April 19, 2007
For: U.S. Patent No. 6,563,415

: 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 6,563,415 (the '415 patent) issued to Brad A. Armstrong on May 13, 2003, with 24 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,224 ('224), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 10, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,230 ('230), was filed April 19, 2007, by third party requester Microsoft Corporation.

4. An order granting reexamination of claims 1-24 of the '415 patent was mailed for the '230 reexamination proceeding on June 4, 2007.

5. An order granting reexamination of claims 1-2, 7-10 and 18-19 of the '415 patent was mailed for the '224 reexamination proceeding on June 15, 2007.

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 '224 and the '230 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,224 and 95/000,230 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,224 and 95/000,230 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-990100
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,224 and *inter partes* Reexamination Control No. 95/000,230 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer in the Office of Patent Legal Administration, at (571)272-7726.

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

January 29, 2008
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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.
95/000,230	04/19/2007	6563415	6620-76454-12	7142

50086 7590 06/18/2008

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15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/18/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JARED S. GOFF, ESQ.,KLARQUIST SPARKMAN, LLP
One Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

Date:
MAILED

JUN 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000230
PATENT NO. : 6563415
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,224	05/10/2007	6563415	723-2110	2632

7590 06/18/2008

EXAMINER	

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

ART UNIT	PAPER NUMBER

DATE MAILED: 06/18/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAEL J. KEENAN
NIXON & VANDERHYE P.C.
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

Date:
MAILED
JUN 18 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000224
PATENT NO. : 6563415
ART UNIT : 3992

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

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JUN 18 2008

CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15950 Dallas Parkway
Suite 225
Dallas, TX 75248

(For Patent Owner)

Michael J. Keenan
Nixon & Vanderhye, P. C.
901 North Glebe Road
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(For 95/000,224 Requester)

Jared S. Goff, Esq.
Klarquist Sparkman, LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

(For 95/000,230 Requester)

In re Armstrong
Reexamination Proceeding
Control No. 95/000,224
Filing Date: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Armstrong
Reexamination Proceeding
Control No. 95/000,230
Filing Date: April 19, 2007
For: U.S. Patent No. 6,563,415

: DECISION DISMISSING
: PETITION
: FOR EXTENSTION OF TIME
: 37 CFR 1.956

This is a decision on the February 29, 2008, patent owner Petition for Extension of Time requesting that the time to submit a response to the office action mailed January 31, 2008 be extended an additional month.

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

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

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,563,415 (the '415 patent) issued to Brad A. Armstrong on May 13, 2003, with 24 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,224 ('224), was initially deposited by third party requester Nintendo Corporation of America on January 31, 2007 and received a filing date of May 10, 2007.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,230 ('230), was filed April 19, 2007, by third party requester Microsoft Corporation.

4. An order granting reexamination of claims 1-24 of the '415 patent was mailed for the '230 reexamination proceeding on June 4, 2007.

5. An order granting reexamination of claims 1-2, 7-10, and 18-19 of the '415 patent was mailed for the '224 reexamination proceeding on June 15, 2007.

6. The '224 and '230 proceedings were merged on January 30, 2008.

7. A non-final office action was mailed on January 31,2008 setting a one-month period for response because litigation has been stayed for the purpose of conducting this merged proceeding.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed January 31, 2008. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on February 29, 2008, together with authorization to charge 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...

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Analysis and Findings

Patent Owner notes that "[o]ne of the undersigned's other clients is currently involved in an ongoing patent infringement trial that is taking place in Boston, Massachusetts...While not counsel of record, the undersigned was actively involved in the trial, including performing extensive witness preparation, briefing, and trial management...The undersigned has been working full time in Boston on the above trial since February 7th. As a result of being away from Texas, the undersigned has not had an opportunity to meet with Mr. Armstrong (who lives in Texas), the inventor, to discuss the details of the lengthy first Office action, or to prepare a formal response to the pending action. While the undersigned has been working effectively full time on the trial identified above, he has carefully reviewed the Office action. Over the last several weeks, the undersigned has also reviewed the cited prior art. In addition, the undersigned has had two (2) telephone conferences with Mr. Armstrong to discuss the rejection at a high level. These efforts notwithstanding, the undersigned now needs to meet with Mr. Armstrong face-to-face so that a more thorough and comprehensive analysis of the rejections and the cited prior art can be made." Reference is made to the petition for details of this and other issues.

On balance it is considered that the petition fails to explain the "sufficient cause" for an extension of time. Patent Owner's representative requests a one-month extension of time based on the fact that most of the time during the previous period for response was spent working on matters for other clients. The requirement for conducting the present proceedings with special dispatch overrides any desire to provide Patent Owner additional time to make up for the time not spent working on the present merged proceeding. Therefore, petitioner's request for additional time is dismissed.

It is noted that a response was untimely filed in the present proceeding. Patent Owner may wish to consider filing a petition under 37 CFR 1.137 to accept the untimely filed paper (see also MPEP 2668).

Service of Papers

It is also noted that the certificate of service does not indicate the manner of service (see 37 CFR 1.248(b)). It is also unclear if the papers were served on both requesters as the certificate of service states "that a copy of this paper was served on Requester's counsel on this 26th day of February, 2008." Patent Owner is reminded of the requirement set forth in the merger decision of January 30, 2008, which states, in part, "The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission."

CONCLUSION

1. Petitioner's request is dismissed.

2. Any response to this decision 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 hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

Eric Keasel For
Lissi M. Marquis
Director, Center Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,230	04/19/2007	6563415	6620-76454-12	7142

50086 7590 11/10/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/10/2008

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ARLINGTON, VA 22203

Date:

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NOV 10 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000224
PATENT NO. : 6563415
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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Date:
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NOV 10 2008
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000230
PATENT NO. : 6563415
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.

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(For 95/000,224 Third Party Requester)

Jared S. Goff, Esq.
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Portland, Oregon 97204

(For 95/000,230 Third Party Requester)

In re Armstrong
Reexamination Proceeding
Control No. 95/000,224
Filed: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Armstrong
Reexamination Proceeding
Control No. 95/000,230
Filed: April 19, 2007
For: U.S. Patent No. 6,563,415

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the October 21, 2008 patent owner petition entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED[1] UNINTENTIONALLY 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 March 27, 2008 response to the January 31, 2008 Office Action as having been unintentionally delayed.

The petition and the merged reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620.00 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. 50-4001, in accordance with

[1] Reexamination proceedings are not abandoned; they are "terminated" for failure to timely respond.

petitioner's authorization in the "Electronic Acknowledgement Receipt" 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 1.956; 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

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 Monday March 3, 2008, for failure of petitioner to timely file a proper response within the meaning of 37 CFR 1.111 to the non-final Office action of January 31, 2008. [2]

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 response by patent owner.

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.

Where there is a question whether the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See 37 CFR 1.137(b)(3), last sentence, and see MPEP 711.03(c)(III)(C) and (D).

Petitioner has supplied items required by items (1) and (2). Petitioner has **not**, however, satisfied item (3), because the showing of record raises questions as to whether the abandonment of this application was unintentional within the meaning of 37 CFR 1.137(b), as will now be discussed.

There are three periods which must be considered during the evaluation of a petition under 37 CFR 1.137(b) as outlined in MPEP 711.03(c)(III)(D):

(1) the delay in response that originally resulted in the abandonment;
(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding; and
(3) the delay in filing an otherwise **grantable** petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding.

---

[2] 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).

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for Period (2).

As to Period (1):

Petitioner filed a patent owner request under 37 CFR 1.956 on February 29, 2008 to extend the time to respond to the first office action mailed on January 31, 2008 until March 31, 2008. Petitioner filed a response to the first office action on March 27, 2008. The Office decision dismissing the petition for extension of time under 37 CFR 1.956, informed patent owner that the response remained due on the original date, because the extension of time was not granted; this Office decision was not mailed until June 18, 2008. It is to be noted that extensions of time are not granted as a matter of right in reexamination proceedings. 37 CFR 1.956, the provision under which patent owner requested an extension, specifically states that "the mere filing of a request" will not result in the granting of an extension. However, given the particular facts and circumstances, patent owner's intention to file a timely response is evident from the record, and the statement that the entire delay until the filing of a response on March 27, 2008, was unintentional is accepted. Therefore, the petitioner's delay, in the filing of a response that originally resulted in the termination, was unintentional.

As to Period (2):

The Office decision dismissing the petition for the extension of time under 37 CFR 1.956 was mailed on June 18, 2008. Petitioner first filed a petition for revival of the reexamination proceeding on October 21, 2008. Thus, there was a delay of 4 months from the mailing of the decision dismissing the request for an extension of time until the filing of the petition for revival pursuant to 37 CFR 1.137(b) on October 21, 2008.

Petitioner only provided the statement that the entire delay in filing the required response from the due date for the required response until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Petitioner also filed a communication accompanying the present petition under 37 CFR 1.137(b) acknowledging therein the decision mailed on June 18, 2008. That decision informed patent owner that the response to the Office action was untimely and suggested the filing of a petition under 37 CFR 1.137.

Petitioner provides no explanation as to how the delay of 4 months from the mailing of the decision dismissing the request for an extension of time and the instant initial petition under 37 CFR 1.137(b) filed on October 21, 2008 was "unintentional."

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive a reexamination proceeding which has been terminated due to "an unintentionally delayed response by the patent owner in any reexamination proceeding." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition...would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982),

reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and implementing regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for an unintentionally delayed response by the patent owner in any reexamination proceeding." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional. Where there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application* of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) is clear, unambiguous, and without qualification. That is, the delay in filing the petition seeking revival, must have been, without qualification, "unintentional" in order for the response to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application or a terminated reexamination prosecution, to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly **after becoming aware of the abandonment**" [emphasis added]). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application or a terminated reexamination prosecution. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that ***any protracted delay (here, 4 months) could trigger, as here, a request for additional information***. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay, as opposed to Office acceptance of a general allegation of unintentional delay. See *Lawman Armor v. Simon*, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); *Field Hybrids, LLC v. Toyota Motor Corp.*, 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

In view of the above, statements are required from the responsible person(s) having firsthand knowledge of the circumstances surrounding the delay, after the termination date, in seeking revival. Furthermore, as the record shows that petitioner was aware that the decision dismissing the petition for the extension of time under 37 CFR 1.956 was mailed on June 18, 2008, an explanation from petitioner as to why the 4-month delay in seeking revival should be excused must be provided, independently of delay in responding which caused termination in the first instance.

SERVICE OF COPIES

37 CFR 1.248(a) states:

"(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*."

The proffered proofs of service on the third party requester filed on March 27, 2008 and on October 21, 2008 state that the third party requester was provided with a copy of the papers filed on March 27, 2008 and on October 21, 2008 by electronic mail (per agreement of the parties). However, service by electronic mail does not comply with the requirements set forth in 37 CFR 1.248(a).

Any response by patent owner to this decision must include a Certificate that the present petition papers and the March 27, 2008 and October 21, 2008 papers have been served on the third party requester in the manner provided by 37 CFR 1.248.[3]

In addition, any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.248(a).

CONCLUSION

1. The present petition under 37 CFR 1.137(b) is **dismissed.**

2. **For granting of the present petition, it is required that patent owner provide:**

   (A) A Certificate that the petition papers and the March 27, 2008 and October 21, 2008 papers have been served on the third party requester in accordance with 37 CFR 1.248(a); **and**

   (B) A detailed explanation or showing by the petitioner that the delay for period (2) under 37 CFR 1.137(b) as discussed above was unintentional.

   Note that any papers filed in these proceedings must be served in compliance with 37 CFR 1.248.

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)."**

---

[3] Obviously, if the papers have not yet been served, patent owner must first do so, before providing the Certificate to the Office.

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 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.

6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or in her absence to Pinchus M. Laufer, Legal Advisor at (571) 272-7726.

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

10-6-08
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED
FEB 18 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000230
PATENT NO. : 6563415
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
95/000,224	05/10/2007	6563415	723-2110	2632

7590 02/18/2009

EXAMINER

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
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DALLAS, TX 75248

ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2009

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

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United States Patents and Trademark Office
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FEB 18 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000224
PATENT NO. : 6563415
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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MAILED

FEB 18 2009

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(For 95/000,230 Third Party Requester)

In re Armstrong
Reexamination Proceeding
Control No. 95/000,224
Filed: May 10, 2007
For: U.S. Patent No. 6,563,415

In re Armstrong
Reexamination Proceeding
Control No. 95/000,230
Filed: April 19, 2007
For: U.S. Patent No. 6,563,415

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

This is a decision on the December 10, 2008 patent owner renewed petition entitled "RENEWED PETITION UNDER 37 CFR 1.137(b)" filed in response to the Decision mailed on November 10, 2008 in the above identified proceeding.

The petition and the merged reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The renewed petition is granted for the reasons set forth below.

DECISION

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding 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 previously supplied item (1). In addition, the required petition fee was submitted with the original petition filed on October 21, 2008; thus, item (2) has been satisfied, because no additional petition fee is required for a renewed petition under 37 CFR 1.137(b).

Petitioner did not previously satisfy item (3), for the reasons set forth at pages 2-4 of the November 10, 2008 Decision.

For the granting of the patent owner petition under 37 CFR 1.137(b), the following submissions were required in the November 10, 2008 Decision:

(A) A Certificate that the petition papers and the March 27, 2008 and October 21, 2008 papers have been served on the third party requester in accordance with 37 CFR 1.248(a); **and**

(B) A detailed explanation or showing by the petitioner that the delay for period (2) [1] under 37 CFR 1.137(b) as discussed in the November 10, 2008 Office decision was unintentional.

With respect to required item (A) above, petitioner certifies in the present renewed petition that the petition papers and the March 27, 2008 and October 21, 2008 papers have been re-served on third party requesters in accordance with 37 CFR 1.248(a). Petitioner also certifies that the present renewed petition has been served on third party requesters in accordance with 37 CFR 1.248(a).

However, patent owner does not explicitly indicate the date or the manner in which the petition papers and the March 27, 2008 and October 21, 2008 papers were re-served. Since the present renewed petition was served via first class mail on December 10, 2008, the Office construes the phrase "have been re-served on third party requesters in accordance with 37 CFR 1.248(a)" as "have been re-served on third party requesters via first class mail on December 10, 2008." Patent owner is required to inform the Office if these papers were not re-served by first class mail on December 10, 2008 and to designate the mode of service and date of service as required

[1] Period (2) is directed to the timing in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding.

by 37 CFR 1.248(b). If the mode of service is not sanctioned according to 1.248(a), then patent owner is required to re-serve the papers and notify the Office of the proper service.

With respect to required item (B) above, petitioner provides, in the present renewed petition, a detailed explanation that the delay for period (2) under 37 CFR 1.137(b) was unintentional. Therefore, the four month delay in seeking revival is excused.

As to the delay for period (3) [2] under 37 CFR 1.137(b) discussed on page 2 of the November 10, 2008 Decision, since petitioner promptly filed the present renewed petition under 37 CFR 1.137(b), there is no delay in filing an otherwise grantable petition pursuant to 37 CFR 1.137(b) to revive the present proceeding.

Accordingly, the March 27, 2008 patent owner response to the January 31, 2008 Office action is accepted as having been unintentionally delayed.

CONCLUSION

1. The present renewed petition under 37 CFR 1.137(b) is **granted.**

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for further examination and consideration of the patent owner amendment and response filed on March 27, 2008 and the third party requester comments filed on April 28, 2008.

3. **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

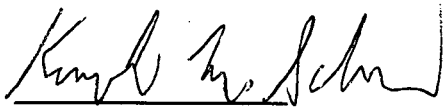
   By FAX to: (571) 273-9900
   Central Reexamination Unit

[2] Period (3) is directed to the timing in filing an otherwise **grantable** petition pursuant to 37 CFR 1.137(b) to revive the application/proceeding.

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

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

4. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



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

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6/20/07

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ATLANTA,GA 30357-0037

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 95/000231

PATENT NO. 7,007,439

ART UNI 3993

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

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,231	03/30/2007	7007439	3329.44REX01	8031

24113 7590 06/20/2007

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
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MINNEAPOLIS, MN 55402-2100

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2007

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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Patterson, Thuente, Skaar &
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(For Patent Owner)

MAILED

JUN 20 2007

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

(Third Party Requester) CENTRAL REEXAMINATION UNIT

In re Larson Manufacturing Company
Inter Partes Reexamination Proceeding
Control No.: 95/000,231
Filed: March 30, 2007
For: U.S. Patent No. 7,007,439

: **DECISION ON PETITION**
: **TO VACATE ORDER GRANTING**
: **REEXAMINATION**

This is a decision on the May 22, 2007 patent owner petition entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.181 TO VACATE *ULTRA VIRES* ORDER GRANTING *INTER PARTES* REEXAMINATION." In addition, on June 5, 2007, third party requester filed a paper opposing the patent owner's petition.

The petition, the opposition paper and the 95/000,231 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The patent owner's petition is dismissed for the reasons set forth below.

REVIEW SALIENT OF FACTS

1. U.S. Patent No. 7,007,439 (the '439 patent) issued to Oscar Dale Larson *et al* on January 14, 2003, and is currently assigned to Larson Manufacturing Company.

2. A request for *inter partes* reexamination of the '439 patent was deposited by a third party requester, Andersen Corporation, on February 9, 2007. The request was assigned Control No. 95/000,231 (the '231 *inter partes* reexamination proceeding), but was not granted a filing date.

3. A Notice was mailed on February 28, 2007 informing the parties that the request for *inter partes* reexamination deposited on February 9, 2007, did not satisfy all of the requirements for obtaining a filing date.

4. On March 30, 2007, the third party requester filed a response to the February 28, 2007 Notice. After review of the response, a filing date of March 30, 2007, was granted for the '231 *inter partes* reexamination proceeding.

5. Reexamination was ordered for the '231 *inter partes* reexamination proceeding on April 24, 2007.

6. Also on April 24, 2007, a non-final first Office action on the merits was mailed to the parties.

7. On May 22, 2007 the patent owner filed the present petition under 37 CFR 1.181 to vacate the reexamination order and the present '231 *inter partes* reexamination proceeding as *ultra vires*.

8. On June 5, 2007, third party requester filed an opposition to the May 22, 2007 patent owner petition. [1]

RELEVANT STATUTES AN EXAMINING PRACTICE

35 U.S.C. § 301 provides:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential."

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."

35 U.S.C. § 312(a) provides:

"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."

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."

[1] The third party requester opposition alludes to a petition filed by requester on May 18, 2007. That petition has not yet been matched with the record of the '231 *inter partes* reexamination proceeding.

MPEP § 2646 (I) provides in pertinent part:

> "A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where **no discretion** to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> (A) the reexamination order is not based on prior art patents or printed publications;
> (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).
>
> [Emphasis added.]

DECISION

I. Patent Owner's Position

Patent owner cites 35 U.S.C. §§ 301 and 311 for the proposition that *inter partes* reexamination that may be undertaken by the Office only if it is based on prior patents or printed publications. Patent owner argues that the every substantial new question of patentability upon which the '231 *inter partes* reexamination proceeding is based (in the reexamination order) includes at least one document that is neither a patent nor a printed publication. [2] Based on that argument, the patent owner concludes that the Order granting *inter partes* reexamination exceeds the authority of the Office, and is, therefore, unlawful. [3]

Patent owner has reached the conclusion that the Order granting *inter partes* reexamination improperly relies upon three documents that cannot, on this record, be considered to be patents or printed publications. These documents are:

a. "Mobella Price List";
b. "Mobella Brochure"; and
c. "Mobella M/S Offshore"

Patent owner points out that pursuant to *In re Klopfenstein*, 380, F.3d 1345 (Fed. Cir. 2004), public accessibility is an essential requirement for a reference to qualify as a prior art printed publication under 35 U.S.C. § 102(b). Patent owner further argues that *In re Hall*, 781 F2.d 897 (Fed. Cir. 1986) and *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990), as well as other cases, require that a party wishing to characterize a document as a printed publication has the burden of establishing public accessibility to the document, and that, in this instance, third party requester has not carried that burden. [4] Patent owner then applies the case law advanced in the petition to the three Mobella documents and concludes that they are not prior art printed publications.

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[2] See "Patent Owner's Petition Under 37 CFR 1.181 ...," paragraph bridging pages 3-4.
[3] *Id.*, at pages 4-6
[4] *Id.*, at page 4.

With respect to the Mobella Price List, it is patent owner's position that although the document includes the statement "Effective May 1st, 1994" on its first page, there is nothing in the record to establish that the document is authentic, or that it was ever actually publicly disseminated. [5]

As to the Mobella Brochure, patent owner notes that, in the Order granting reexamination, the examiner initially took the position that "this reference has not been properly identified or located in the file." [6] However, the examiner later stated that "[i]t is agreed that consideration of the Mobella Brochure (Exhibit 6) raises a substantial new question of patentability." [7] Patent owner points out there are apparently two versions of the document referred to as Exhibit 6:

(1) a six page document in the initially submitted (but incomplete) request for reexamination filed on February 9, 2007; and

2) a four page document referred to as Exhibit 6 in the substitute request for *inter partes* reexamination filed on March 30, 2007, which was accepted as being complete.

Patent owner states that the six page Exhibit 6 consists of three undated pages of drawings of a door handle, two pages printed from a website on January 3, 2007, that refer to an "M/S Compact" door handle, and one undated page bearing drawings of an unidentified object. Patent owner argues that there is nothing that links these three portions as a single "reference" or that indicates that they are in any way related to each other. [8] Patent owner also characterizes the examiner's assignment of a 2002 date to this document as being pure speculation, arguing that the string of numbers appearing on the document has not been established by the third party requester, or by the examiner, as in any way constituting a date. Patent owner concludes these deficiencies mean that Exhibit 6, as filed in the original (unacceptable) request for *inter partes* reexamination, cannot be a printed publication.

With respect to the Exhibit 6 as attached to the March 30, 2007 substitute request for *inter partes* reexamination, patent owner objects to the examiner having accorded Exhibit 6 a document a date of December 1, 1997 based upon the numerical strings "82-1-971201" and "82-2-971201" that appear on pages 1 and 2 of the documents. Patent owner argues that there is no evidence in the record that these numerical strings represent dates. [9] Patent owner also argues that there is no basis for according this version of the Mobella brochure any particular date at all, and so, it cannot qualify as prior art under 35 U.S.C. § 102.

Patent owner raises objections to using the Mobella M/S Offshore document as a printed publication for reasons similar to the objections raised with respect to the Mobella Brochure. The Mobella M/S Offshore document was attached to the informal request for *inter partes* reexamination that was deposited on February 9, 2007, as Exhibit 7. It is a six page document. Patent owner argues that the document attached as Exhibit 7 to the March 30, 2007 request for *inter partes* reexamination is a thirteen page document. Patent owner further argues that it is unclear which version of the document is being relied on by the examiner, that both versions appear to be blends of separate documents, that neither version has a clear publication date affixed thereto, and that neither document can therefore be relied upon as a printed publication that is prior art to the '439 patent. [10]

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[5] *Id.*, at page 5.
[6] Order Granting *Inter Partes* Reexamination, April 24, 2007, page 3.
[7] *Id.*, at page 7.
[8] "Patent Owner's Petition Under 37 CFR 1.181 ...," at pages 6-7.
[9] *Id.*, at page 7.
[10] *Id.*, at pages 8-9.

II. Third Party Requester's Position

Third party requester takes the position that each of the three documents discussed above are printed, dated, and of the type conventionally disseminated to the public. Therefore, in third party requester's view, these documents are publications and are prior art to the '439 patent.

For example, third party requester notes that the Mobella Price List is printed, dated as being "Effective May 1st 1994," and, as it is a "Net price list" which includes on the first page the "Sales Policy" and "Terms of Sale," is clearly a document that was created to inform the consuming public about a line of products available from Mobella company. [11] As another example, third party requester also states that the Mobella Price List and "Mobella Brochure" were obtained from Leif Andersson, General Manager of Southco MRC located at its Mobella operations in Eskilstuna, Sweden. [12] It is again noted that the third party opposition paper makes reference to an unmatched previously filed petition that is alleged to address any possible confusion on the part of the examiner. [13]

III. Patent Owner's Position is Not Persuasive

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 were 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 of the pending *inter partes* reexamination, the existence of a final, non-appealable Federal Court decision holding all claims of a patent for which *inter partes* reexamination has been ordered, (4) *inter partes* reexaminations order for the wrong patent, or on duplicate copies of the same request for *inter partes* reexamination, and (5) *inter partes* reexaminations ordered based entirely upon the same question of patentability previously considered in an early concluded examination of the patent by the Office.

Each of these circumstances addresses 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. In the present petition, patent owner argues only that the examiner's finding of a substantial new question of patentability in the '231 *inter partes* reexamination proceeding is barred by the reexamination statute, because it is not based upon prior patents or printed publications. However, for the reasons that follow, patent owner has not clearly established that the documents relied upon by the examiner to establish a substantial new question of patentability are so clearly not printed publications, and/or are so clearly not prior art to the '439 patent, as to support a conclusion that the Office lacks jurisdiction to conduct *inter partes* reexamination pursuant to 35 U.S.C. §§ 301, 311 and 312.

As will be discussed below, 35 U.S.C. 312(c) provides that an order granting reexamination "shall be final and non-appealable." Accordingly, a heavy burden is clearly on petitioner to establish an *ultra vires* act; it is not sufficient, in this instance to establish a question as to

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[11] "Requester's Opposition to Patent Owner's Petition Under 37 CFR 1.181," page 3.
[12] *Id.*
[13] See footnote 1.

whether the references applied in the order are prior art patents or printed publications. If a legitimate question is raised that the references applied in the order are prior art patents or printed publications, the requisite question of patentability has been satisfied, and reexamination must go forward in the examination stage to resolve that question. It is emphasized that nothing in this Decision is intended to reach the ultimate conclusion/resolution as to whether the documents that the examiner has relied on as being prior art printed publications that support an order granting reexamination are in fact printed publications that qualify as prior art. The gravamen of the instant petition is not whether it can be definitively established that the prior art documents relied on are printed publications, but only whether there is a colorable argument that the relied upon documents are printed publications and qualify as prior art to the '439 patent so that the ordered reexamination can move forward.

Only where there is no reasonable basis to believe that the documents relied upon by third party requester are printed publications that qualify as prior art to the '439 patent, and therefore would provide no basis for reexamination pursuant to the statute, could the '231 *inter partes* reexamination proceeding be vacated based on an *ultra vires* act in ordering reexamination. Barring that situation, the patent owner's statutory rights are those of (a) addressing the question of patentability raised during the examination phase of the proceeding, and (b) should the examiner continue to believe that the documents in question are prior art printed publications, and that such prior art is applicable to the patent claims, appealing a final agency decision in the '231 *inter partes* reexamination proceeding on the grounds that the applied references are not prior art printed publications (or do not meet the claims).

The Order granting *inter partes* reexamination addresses the issue of the dates for the various publications. [14] In doing so, it sets forth the examiner's concerns regarding variations between some of the documents as attached to the February 7, 2007 request for *inter partes* reexamination and the March 30, 2007 request for *inter partes* reexamination. The examiner has requested clarification from the third party requester on that issue. [15] It is also clear that the examiner has expressed concerns regarding the dates of these documents. However, as pointed out above, it is only necessary to establish that a legitimate question be raised as to the date of the references, and here the examiner has gone further and determined that the documents are *properly datable as prior art to the '439 patent.* It is also to be noted that the Internet website at http://www.archive.org (known as the WayBackMachine) is a recognized source for archiving earlier versions of Internet Web Pages, and that web pages in fact qualify as printed publications. Further, searching on the Internet is a recognized Office practice, discussed in full in MPEP § 904.02(c), entitled "Internet Searching." Also, MPEP § 707.05(e) provides an approved manner of citation for material posted on the Internet. That method of citation has been employed, in the present instance, by the third party requester. [16]

Thus, it is clear that the examiner's holding that the three documents in question are printed publications, and that they are prior art to the '439 patent, is not an arbitrary holding. Rather, it is founded in an analysis of the facts that is not facially without merit. The examiner's decision represents the exercise of discretion in reaching the conclusion that the requester has proffered prior art printed publications for consideration as the basis for the request for *inter partes*

[14] See page 3 of the "Order Granting Request for *Inter Partes* Reexamination" dated April 24, 2007.

[15] However, it is to be noted that both versions of the documents are available for the examiner to rely upon to determine the existence of a substantial new question of patentability; indeed, an examiner is free to conduct his or her own search for documents upon which to base the *inter partes* reexamination, if he desires to do so. See MPEP § 2644.

[16] See Information Disclosure Statement dated February 23, 2007 and list of references cited by applicant (*sic*, third party requester) attached to the "Order Granting Request for *Inter Partes* Reexamination" dated April 24, 2007.

reexamination of the '439 patent. 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 then 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 reexamination request properly raised a substantial new question of patentability.

As a final point, *Heinl* was decided for an ordered *ex parte* reexamination, and required that the proceeding go forward in examination. In *inter partes* reexamination, i.e., the present setting, the statute is even more clear as to its provision that the proceeding shall go forward in examination, despite a challenge to the order granting reexamination. 35 U.S.C. 312(a) requires that "the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request...." 35 U.S.C. 312(c) then provides that "[a] determination by the Director under subsection (a) shall be final and non-appealable." The *inter partes* reexamination statute calls for any challenge to the substantial new question of claim patentability set forth in an order for reexamination to be carried out via the examination and appeal provisions of reexamination, rather than by attacking the findings of the order for reexamination by petition.

For the forgoing reasons, the order granting reexamination will not be disturbed, and the '231 *inter partes* reexamination proceeding will continue in its examination stage.

CONCLUSION

1. The patent owner petition filed on May 22, 2007, is dismissed.

2. A copy of this decision will be made of record in the IFW of the '231 *inter partes* reexamination proceeding.

3. Jurisdiction over the '231 *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 the undersigned at 571-272-7710.

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

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June 8, 2007

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Knobbe Martens Olson & Bear LLP (For Patent Owner)
2040 Main Street
Fourteenth Street
Irvine, CA 92614

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OCT 12 2007

CENTRAL REEXAMINATION UNIT

John A. Griecci (For Third Party Requester)
The Law Office of John Griecci
703 Pier Avenue
Suite B657
Hermosa Beach, CA 90254

In re Ben Huang :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,234 : **GRANTING**
Filed: April 26, 2007 : **PETITION**
For: U.S. Patent No. 6,857,971 :

This is a decision on the August 24, 2007 patent owner petition entitled PETITION FOR TERMINATION OF REEXAMINATION PROCEEDINGS UNDER 37 CFR § 1.1.82 (hereinafter "Petition to Terminate"), as supplemented by the SUPPLEMENT TO THE PETITION FOR TERMINATION OF REEXAMINATION PROCEEDINGS UNDER 37 CFR § 1.182 filed by patent owner on September 13, 2007 (hereinafter "Supplemental Petition").

The Petition to Terminate and the Supplemental Petition, and *inter partes* reexamination control number 95/000,234 proceeding, are before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the patent owner petition is granted.

FEES

The patent owner petition is properly filed under 37 CFR 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be dismissed, stayed, or terminated. A single petition fee of $400.00 is required for consideration of both the Petition to Terminate and the Supplemental Petition. The fee is being charged to Deposit Account No. 11-1410 as authorized by petitioner patent owner. [1]

[1] See Petition dated August 24, 2007, paragraph bridging pages 2 and 3.

REVIEW OF FACTS

1. U.S. patent No. 6,857,971 ("the '971 patent") issued to Ben Huang on February 22, 2005, and is currently assigned to Winn, Inc.

2. A request for *inter partes* reexamination of the '971 patent was deposited on February 26, 2007, by third party requester John A. Griecci on behalf of Comgrip USA, Corp., and Hong-Sung Chu, an entity and a person who are identified in the request as the real parties in interest. The request was assigned control number 95/000,234 ("the'234 *inter partes* reexamination proceeding").

3. On March 7, 2007, a NOTICE OF *INTER PARTES* REEXAMINATION REQUEST FILING DATE was mailed for the '234 *inter partes* proceeding. The notice assigned a filing date of February 26, 2007, to the request for reexamination.

4. On April 6, 2007 the Office issued a DECISION *SUA SPONTE* VACATING *INTER PARTES* REEXAMINATION FILING DATE."

5. On April 26, 2007, the filing requirements under 37 CFR 1.915 were completed, and a filing date of April 26, 2007 was granted to the '234 *inter partes* reexamination proceeding.

6. On July 16, 2007, reexamination was ordered for patent claims 1, 6-10, 12-14, 21 and 23 of the '971 patent. A first Office action on the merits was mailed concurrently.

7. On July 19, 2007, patent owner and third party requester jointly filed a letter entitled REQUEST FOR TERMINATION FO REEXAMINATION PROCEEDINGS.

8. On August 24, 2007, the patent owner filed the present Petition to Terminate the '234 *inter partes* reexamination proceeding.

9. On September 13, 2007, the patent owner filed the present Supplemental Petition to terminate the '234 *inter partes* reexamination proceeding.

10. The '971 patent was the subject of litigation styled *Winn Inc. and Ben Huang v. Comgrip U.S.A. Corp and Hong-Sung Chu,* Civil Action No. SACV 06-66 VBF (MLGx) initiated in the United States District Court for the Central District of California on January 24, 2006.

11. The plaintiff in the above noted litigation is the patent owner in the '234 *inter partes* reexamination proceeding, and the defendants in that litigation are identified as being the real party in interest in the '234 *inter partes* reexamination proceeding.

DECISION

I. Relevant Statute, Regulations, and Examining Procedure

35 U.SC. § 317(b) provides:

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

37 C.F.R. § 1.907(b) provides:

> 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.

II. Patent Owner's Position

Patent owner's petition may be summarized as being based upon the following factors, which are argued by patent owner to weigh in favor of terminating the present reexamination proceeding: [2]

1) A final, nonappealable consent judgment was entered by the District Court in favor of patent owner, and against the real party in interest in the '234 *inter partes* reexamination proceeding. The judgment held that certain claims of the "971 patent were not shown to be invalid.

2) The issues in the litigation are the same issues as in this reexamination proceeding;

3) The references relied upon by Compgrip USA in the litigation are the same as those produced by Winn in the *inter partes* reexamination.

---

[2] See Petition to Terminate, pages 1-2.

III. Analysis and Findings

35 U.SC. § 317(b) provides that once a final decision has been entered against a party in a civil action involving the validity of a patent, and that party has not sustained its burden of proving the invalidity of any patent claim in suit, then an *inter partes* reexamination for that patent that had previously been requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office.

In the present '234 *inter* partes reexamination proceeding, a third party requester, John Griecci requested reexamination of claims 1, 6-10, 12-14, 21 and 23 of the '971 patent on behalf of a real party in interest identified as "Hong-Sung Chu, Comgrip U.S.A., Corp.". Hong-Sung Chu and Comgrip USA, Corp. were the defendants in a patent infringement suit initiated by plaintiffs Dr. Huang and his licensee Winn, Inc. In litigation styled *Winn Inc. and Ben Huang v. Comgrip U.S.A. Corp and Hong-Sung Chu*, Civil Action No. SACV 06-66 VBF (MLGx) filed January 24, 2006 in the United States District Court for the Central District of California, plaintiffs alleged that defendants infringed the '971 patent. A Final Consent Judgment dated July 13, 2007 has been issued in the litigation. It includes a finding that Comgrip U.S.A. Corp. and Hong-Sung Chu did not sustain their burden of proving the invalidity of the claims of the '971 patent, including claims 1, 6-10, 12-14, 21 and 23. [3]

Further, the Final Consent Judgment (in favor of the patent owner) is both final and not appealable. [4] Additionally, it is deemed that the issues raised in the litigation included the same issues that formed the basis for the decision by the court, and included all those raised in the reexamination proceeding. The prior art relied upon in the '234 *inter partes* reexamination proceeding was both available to defendants, and relied upon by defendants, in the litigation as a basis for invalidity of patent claims 1, 6-10, 12-14, 21 and 23, and that basis was not found to render the claims invalid by the court. [5]

A final, nonappealable judgment has been rendered by a District Court in which the claims for which *inter partes* reexamination was ordered have not been demonstrated by the defendant to be invalid, notwithstanding consideration of the same prior patents relied upon to order reexamination of those claims, in the '234 *inter partes* reexamination proceeding. The defendants who asserted claim invalidity in the litigation are the real parties in interest who requested the '234 *inter partes* reexamination. Therefore, in accordance with 35 U.S.C. § 317(b) and 37 CFR 1.907(b), the '234 *inter partes* reexamination proceeding must no longer be maintained by the Office. Accordingly, sufficient basis exists to grant patent owner the relief requested in the present Petition and Supplemental Petition, and to "terminate" the '234 *inter partes* reexamination proceeding.

In view of the above, based upon 35 U.S.C. 317(b), the prosecution of the present *inter partes* reexamination proceeding is hereby terminated, and the proceeding will now be processed to conclude it. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for the proceedings. The files will be assigned an 822 status. 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

[3] *Id.*, Exhibit A, paragraph 6.
[4] *Id.*, Exhibit A, paragraph 13.
[5] See, for example, Supplemental Petition, page 3.

CONCLUDED," and the annotated copy will then scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

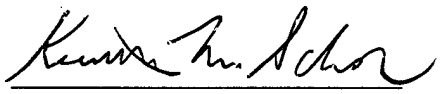
CONCLUSION

1. The patent owner petition is granted.

2. The prosecution of the present *inter partes* reexamination proceeding is hereby terminated, and the proceeding will be concluded.

3. Jurisdiction over the present *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit for further processing toward concluding the proceeding, as set forth above.

4. Telephone inquires related to this decision should be directed to Maria Nuzzollio, Legal Advisor, at (571) 272-8150 or Stephen Marcus, Legal Advisor, at (571) 272-7743, or 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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October 11, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,235	02/27/2007	6,919,001	95/000,235	9090

20027 7590 07/11/2007

STANLEY Z COLE
26620 ST FRANCIS ROAD
LOS ALTOS HILLS, CA 94022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2007

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

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7/12/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. McCOMBS,HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 95/000235
PATENT NO. 6,919,001
ART UNI 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 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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United States Patent and Trademark Office
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JUL 11 2007

CENTRAL REEXAMINATION UNIT

Stanley Z Cole
26620 St. Francis Road
Los Altos Hills, CA 94022

(For Patent Owner)

David L. McCombs
Haynes and Boone LLP
901 Main Street
Suite 3100
Dallas, TX 75202

(For Requester)

In re Fairbairn et al.
Reexamination Proceeding
Control No.: 95/000,235
Filed: June 28, 2005
For: U.S. Patent No. 6,919,001 B1

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the June 20, 2006 patent owner petition entitled "PETITION UNDER 37 CFR 1.183 TO WAIVE 37 CFR § 1.943." The petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed fifty (50) pages in length, to the extent that concurrently submitted patent owner response exceeds this fifty (50) page limit.

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. 6,919,001 (the '001 patent) issued on July 19, 2005.

2. A request for reexamination of the '356 patent was filed on February 27, 2007. The request was assigned control No. 95/000,235 (the '235 reexamination proceeding).

3. Reexamination was ordered for the '235 proceeding on April 20, 2007.

4. A first Office action rejecting claims 1-28, *i.e.* all of the patent claims, was mailed on April 20, 2007. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On June 20, 2007, 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 fifty (50) pages in length.

6. Concurrently with the instant petition the patent owner submitted a response to the April 20, 2007 office action that exceeds the fifty (50) page limit.

DECISION

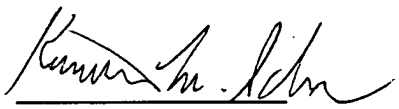
37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds 50 pages in length. In the instant petition, the patent owner requests relief from such limitation when the concurrent response to the Office action of April 20, 2007. Upon consideration of the petition, it is noted that the examiner incorporated heavily from a length request for reexamination, into the Office action of April 20, 2007, many of the rejections proposed by the requester. Additionally, the examiner proposed several new rejections also. Therefore, based upon the extensive incorporation by reference of the proposed rejections and the multitude of new rejections made by the examiner, the requested page length submitted that is beyond fifty is deemed equitable in addressing the Office action. Accordingly, the petition is granted but for only the concurrently submitted response by the patent owner in response to the April 20, 2007 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 permit a patent owner response to the April 20, 2007 first Office action to the extent that the concurrently submitted response exceeds fifty (50) pages in length.

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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 Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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(For Patent Owner)

David L. McCombs
Haynes and Boone LLP
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Dallas, TX 75202

(For Third Party Requester)

FAX RECEIVED

JUL 17 2007

CENTRAL REEXAMINATION UNIT

In re Intevac, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,235
Filed: February 27, 2007
For: U.S. Patent No. 6,919,001 B2

: **DECISION GRANTING**
: **THIRD PARTY REQUESTER**
: **PETITION UNDER 37 CFR 1.182**

This is a decision on the July 12, 2007 third party requester petition entitled "PETITION UNDER 37 CFR 1.182 TO CLARIFY TIME PERIOD FOR THIRD PARTY COMMENT." A patent owner opposition paper filed on July 13, 2007 entitled "RESPONSE TO PETITION UNDER 37 CFR 1.182 TO CLARIFY TIME PERIOD FOR THIRD PARTY REQUESTER COMMENTS" has also been filed.

The present third party petition, the patent owner opposition paper, and the 95/000,235 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The petition is granted.

FEES

The third party requester petition was filed under 37 CFR 1.182, and a $400.00 petition fee in accordance with 37 CFR 1.17(f) is required. The $400.00 petition fee will be charged to Deposit Account No. 08-1394 as authorized on page 2 of the third party requester petition.

The regulations do not provide for the patent owner opposition paper. Therefore, the paper is being considered under 37 CFR 1.182. The $400.00 petition fee required for the opposition paper will be charged to Deposit Account No. 19-4880 as authorized at page 3 of the patent owner opposition paper.

BACKGROUND

1. U.S Patent number 6,919,001 B1 ("the '001 patent") issued to Kevin P. Fairbairn *et al* on July 19, 2005, and is assigned to Intevac, Inc.

2. A request for *inter partes* reexamination of the '001 patent was filed by a third party requester on February 27, 2007, and it was assigned control No. 90/000,235 ("the '235 *inter partes* reexamination proceeding").

3. Reexamination was ordered for the '235 *inter partes* reexamination proceeding on April 20, 2007.

4. A first Office action rejecting claims 1-28, i.e. all of the patent claims, was mailed on April 27, 2007. A shortened statutory period (SSP) of two (2) months was set for the filing of a patent owner response to the first Office action.

5. On June 20, 2007, the patent owner filed a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that response by the patent owner in an *inter partes* reexamination proceeding not exceed fifty (50) pages in length.

6. Concurrently with the June 20, 2007 petition, patent owner submitted a response to the April 20, 2007 Office action that exceeds the fifty (50) page limit.

7. On July 11, 2007, the Office mailed a decision granting patent owner's June 20, 2007 petition, whereby the page limits of 37 CFR 1.943(b) were waived, and the proceeding was returned to the jurisdiction of the Central Reexamination Unit for processing.

8. On July 12, 2007, the third party requester filed the present petition requesting clarification of the time for filing requester's written comments in response to the patent owner's response.

9. On July 13, 2007, patent owner filed an opposition paper, opposing the July 12, 2007 third party requester petition.

RELEVANT REGULATIONS AND EXAMINING PRACTICE

37 CFR 1.943 provides, in pertinent part:

> (a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.
>
> (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.

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 § 2666.05 provides, in pertinent part:

> **I. TIMELINESS**
>
> A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the date of service of the patent owner's response on the third party requester. 37 CFR 1.947. The date that the Office receives the patent owner's response has no bearing on the time period for which the third party requester must file the comments.
>
> 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 comments. Any comments by the third party requester must be served upon the patent owner in accordance with 37 CFR 1.248, - see also MPEP § 2666.06.
>
> If the third party requester comments are filed after 30 days from the date of service of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).
>
> **II. CONTENT**
>
> The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response. The written comments filed by a third party requester should specify the issues and points in the Office action or the patent owner's response to which each comment is directed. Thus, the third party requester should (A) set forth the point or issue, (B) state the page of the Office action and/or the patent owner response where the point or issue is recited, and (C) then present the third party requester's discussion and argument as to the point or issue. If this is not done by the third party requester, the comments should not be held defective if the examiner can ascertain that all of the comments filed by the third party requester are directed to the issues and points in the Office action and/or the patent owner's response.
>
> Third party requester comments are limited to issues covered by the Office action or the patent owner's response. ...
>
> 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, ... , the written comments are improper.

DISCUSSION

On June 20, 2007, patent owner filed a timely paper responding under 37 CFR 1.943 to the outstanding first Office action of April 20, 2007. Recognizing that the response exceeds the number of pages permitted by 37 CFR 1.943(b), patent owner simultaneously filed a petition to waive the page limits set by 37 CFR 1.943(b).

37 CFR 1.947 provides that a third party requester may once file timely comments addressing any 37 CFR 1.943 patent owner response to an Office action. The third party requester comments must be filed not later than thirty (30) days from the date on which third party requester was served (see 37 CFR 1.903) with a copy of the patent owner response. In addition, the examining practice in MPEP 2666.05, which addresses the 37 CFR 1.947 filing and content of third party requester's comments, further provides that the third party requester comments under 37 CFR 1.947:

1) Must be directed to points and issues covered by the Office action and/or the patent owner's response; and

2) Should specify the issues and points in the Office action or the patent owner's response to which each comment is directed.

The submission of improper comments by the third party requester would result in the return of such comments to the third party requester and may result in the third party requester having to re-draft and re-submit such comments.

There is no discussion in MPEP §2666.05 of the appropriate course of action for a third party requester in an *inter partes* reexamination proceeding when a patent owner submits files a patent owner response to an Office action that is accompanied by a petition to waive the page limits imposed by 37 CFR 1.943 on such response. Third party requester has no way to know whether such a patent owner petition to waive 37 CFR 1.943 will be granted, and to what extent the regulation will be waived (*i.e.*, how many pages will be permitted for the patent owner response). Third party requester also does not know how quickly a decision on the petition to waive 37 CFR 1.1947 will be rendered, and if the petition is not granted, whether a reconsideration will be requested by the patent owner.

Therefore, third party requester is faced with preparing written comments that address all points raised by patent owner's response, knowing that some (or all) of the initially filed patent owner response may ultimately not become part of the record in the *inter partes* proceeding. If that were to take place and third party requester where to file written comments that addressed all of the points raised in the initially filed patent owner response, such written comments may later be held by the Office to be nonenterable under 37 CFR 1.947, and would have to be re-drafted (if the examiner so permitted).

Alternatively, third party requester might attempt to predict, in advance, whether the patent owner's petition will be denied, or granted-in-part, and (if the latter) which patent owner arguments will be of record The result may be that third party requester would draft and file written comments that would incompletely address the patent owner response to an outstanding Office action. 37 CFR 1.947 would then preclude third party requester from filing any supplemental written comments.

The above situation exists because, until the 37 CFR 1.183 petition to waive the page length is granted, or a length compliant response is filed (if the § 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed.... The response as completed is treated as a new response on-the-merits to the Office action;

thus, the third party requester is entitled to respond and has 30 days to do so." At the time the § 1.183 petition is granted, the patent owner response become complete, and the requester has 30 days from the date of the petition granting the § 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Where a petition is filed by patent owner to waive the page limit imposed by 37 CFR 1.943 on a patent owner response to an Office action, it is in the interest of economy of resources on the parties, and in the interest of special dispatch, to consider and grant a requester petition such as the present petition to set the time for filing third party requester comments to run from the date that the Office takes final action granting a patent owner petition to waive the 37 CFR 1.947 page limits imposed on a patent owner response to an Office action. (If the petition is not granted, requester can wait until the response is completed by the filing of a length compliant response.)

Nothing in the patent owner opposition paper to the present third party requester petition argues persuasively against granting the third party requester petition. In fact, the requester does not know with any degree of certainty "that, regardless of whether the PTO granted or denied Patentee's petition to waive the page limitation under 37 CFR 1.943, the Requester would have been faced with the same arguments." [1] As to patent owner's statement that "[T]he PTO's practice is not to deny a patent owner's response altogether when it denies a concurrently filed page limitation extension petition," [2] a requester is not in a position to know with certainty what content will ultimately be entered into the record after a MPEP 2667 I.A.2 notice is issued by the Office.

[1] "Response To Petition Under 37 CFR 1.182 To Clarify Time Period For Third Party Comments," July 13, 2007, page 2, 2nd full paragraph.
[2] *Id.*

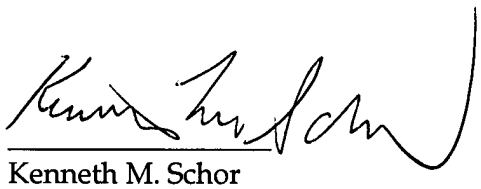
CONCLUSION

1. The third party petition is granted.

2. The period for the third party requester to file written comments addressing the patent owner response filed on June 20, 2007, runs THIRTY (30) DAYS from the July 11, 2007 mailing date of the petition decision granting patent owner a waiver of the page limitations set by 37 CFR 1.943.

3. Jurisdiction over the '235 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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 Stephen Marcus, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7743, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.



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

sm
July 16, 2007

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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KNOBBE, MARTENS, OLSON & BEAR, LLP (For Patent Owner)
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

MAILED

FEB 12 2009

CENTRAL REEXAMINATION UNIT

David L. Garrison (For Third Party Requester)
MERCHANT & GOULD
P.O. Box 2903
Minneapolis, Minnesota 55402-0903

In re McConnell et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,236
Filed: June 11, 2007
For: U.S. Patent No. 6,786,546

: **DECISION GRANTING**
: **PETITION TO TERMINATE**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the November 25, 2008 paper entitled "Joint Request For Termination of Reexamination Proceedings" to terminate the prosecution and conclude the instant reexamination proceeding, which is taken as a petition under 37 CFR 1.182 (hereinafter, "the petition to terminate") based on the November 20, 2008 stipulated final consent judgment and permanent injunction, issued from the U.S. District Court, Central District of California.[1]

The November 25, 2008 petition to terminate, and the record as a whole, are before the Office of Patent Legal Administration.

FEES

The petition is properly filed under 37 CFR 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be dismissed, stayed, or terminated. The petition fee required by 37 CFR 1.182 is hereby waived pursuant to 37 CFR 1.183, based upon the fact that the patent owner is providing notification to the Office regarding the concurrent litigation, as it was required to do pursuant to 37 CFR 1.985(a).

SUMMARY

The November 25, 2008 petition to terminate and conclude the instant *inter partes* reexamination proceeding 95/000,236 is **granted**.

[1] *Prince Lionheart, Inc. v. Sunshine Kids Juvenile Products, LLC*, Civil Action No. CV 06-1543 VBF (PJWx)(C.D. Cal. Nov. 20, 2008)

REVIEW OF FACTS

- On September 7, 2004, U.S. Patent No. 6,786,546 (the '546 patent) issued to McConnell et al.

- On February 27, 2007, the third party requester deposited a request for *inter partes* reexamination, and the resulting *inter partes* reexamination proceeding was assigned control number 95/000,236 (hereinafter, "the '236 proceeding").

- On May 11, 2007, a decision vacating the assigned filing date was mailed.

- On June 11, 2007, the third party requester filed a response to the May 11, 2007 decision, including a revised request for reexamination, and the '236 proceeding was assigned a filing date of June 11, 2007.

- On September 5, 2007, an order granting *inter partes* reexamination, and a first Office action on the merits, were mailed in the '236 proceeding.

- On November 7, 2007, the patent owner filed a response to the September 5, 2007 first Office action.

- On December 5, 2007, the third party requester filed comments following patent owner's November 7, 2007 response.

- On November 25, 2008, the present paper, taken as a petition to terminate the *inter partes* reexamination proceeding, was filed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 317(b) 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.

37 CFR 1.907(b) provides:

> 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.

37 CFR 1.985(a) provides:

> In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

MPEP 2686.04 V., Discussion Of Affect Of Litigation Where Requester Was A Party To The Litigation, provides, in pertinent part:

> Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may not 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 the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office; in such instance, the prosecution will be terminated and the proceeding will be concluded.

DECISION

Patent owner and the third party requester jointly petition the Director to terminate the '236 proceeding pursuant to 35 U.S.C. 317(b) and 37 CFR 1.907(b), based on the November 20, 2008 stipulated final consent judgment and permanent injunction, issued from the U.S. District Court, Central District of California.

Pursuant to 35 U.S.C. 317(b) and 37 CFR 1.907(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 the invalidity of any patent claim in suit, an *inter partes* reexamination requested by that party on the basis of issues that the party raised, or could have raised, in the civil action must not thereafter be maintained by the Office.

A copy of the November 20, 2008 stipulated final consent judgment and permanent injunction of the district court accompanied the November 25, 2008 petition to terminate. The November 20, 2008 court judgment states, in particular, that "Sunshine Kids did not sustain its burden of proving the invalidity of any claim of the '546 patent." The November 20, 2008 court judgment

further states that "[t]he parties affirmatively waive any and all rights to appeal this Stipulated Final Consent Judgment and Permanent Injunction."

The November 20, 2008 stipulated final consent judgment and permanent injunction was entered against the third party requester of the instant '236 proceeding, that the third party requester did not sustain its burden of proving the invalidity of any of the patent claims of the '546 patent, which are identical to the claims under reexamination in the instant '236 proceeding. Accordingly, based upon 35 U.S.C. 317(b), the prosecution of the '236 *inter partes* reexamination proceeding is hereby **terminated**.

Jurisdiction over the '236 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. 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 be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

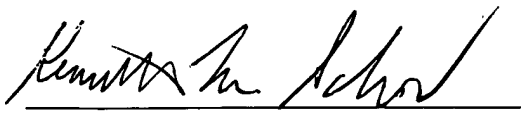
CONCLUSION

1. The petition is **granted.**

2. The prosecution of the '236 *inter partes* reexamination proceeding is hereby terminated, and the '236 proceeding will be concluded.

3. Jurisdiction over the '236 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing to conclude the '236 proceeding, as set forth above.

4. Any inquiry concerning this communication should be directed to 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,237	03/06/2007	7105091		2887

51414 7590 06/20/2008

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2008

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GOODWIN PROCTOR LLP.
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MASSACHUSETTS 02109-2881

(For Patent Owner)

BORIS M. KHUDENKO, Ph.D, P.E.
KHUDENDO ENGINEERING, INC.
744 MOORES MILL ROAD
ATLANTA, GA 30327

(For Third Party)

MAILED

JUN 20 2008

CENTRAL REEXAMINATION UNIT

In re: Daniel L. Miklos
Ex Parte Reexamination Proceeding
Control Number: 95/000,237
Filed: March 6, 2007
For: U.S. Patent 7,105,091

DECISION DISMISSING PETITION UNDER 37 CFR §1.181

This a decision on the petition of May 23, 2008 requesting that the Order Granting Inter Partes Reexamination mailed May 7, 2007 be reconsidered as invalid for failure to meet the requirements of 37 CFR 1.195(b)(3).

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

The Patent Owner has authorized payment of the required $400.00 to his deposit account.

The petition to reconsider and find invalid under 37 CFR 1.195(b)(3) the Order Granting Inter Partes Reexamination mailed May 7, 2007 is **dismissed** as untimely, without consideration of its merits.

Legal Basis

37 CFR 1.181(f) reads:

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 with **two months** of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This **two-month** period is not extendable. (Emphasis added.)

Analysis

The Order Granting Inter Partes Reexamination of claims 1 - 27 of U.S. Patent no. 7,105,091 was mailed May 7, 2007. On the same date, a First Office Action on the merits was also mailed. On April 24, 2008, the Action Closing Prosecution was mailed. Patent Owner's instant petition was filed May 23, 2008, over eleven months after the mailing of the Order Granting Inter Partes Reexamination. Since the Patent Owner is requesting relief from the Order mailed May 7, 2007, this petition under 37 CFR 1.181 is not timely. Since the two-month time period is not extendable, this petition is **dismissed**.

Conclusion

1. The Patent Owner's petition for reconsideration of the Order Granting Inter Partes Rexamination mailed May 7, 2007 is **dismissed** as untimely, without consideration of its merits.

2. Response may be submitted as follows:

By mail to: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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

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

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

/Deborah Jones/ for
Lissi Marquis,
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,237	03/06/2007	7105091		2887

51414 7590 05/20/2009

GOODWIN PROCTER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Boris M. Khudenko
744 Moores Mill Road
Atlanta GA 30327

MAILED

MAY 2 0 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,237*.

PATENT NUMBER *7,105,091*.

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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GOODWIN PROCTOR LLP. (For Patent Owner)
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MASSACHUSETTS 02109-2881

BORIS M. KHUDENKO, Ph.D, P.E. (For Third Party Requestor)
KHUDENDO ENGINEERING, INC.
744 MOORES MILL ROAD
ATLANTA, GA 30327

MAILED

MAY 2 0 2009

CENTRAL REEXAMINATION UNIT

In re: Daniel L. Miklos
Ex Parte Reexamination Proceeding
Control Number: 95/000,237
Filed: March 6, 2007
For: U.S. Patent 7,105,091

REQUEST FOR
RECONSIDERATION
OF DECISION DISMISSING
PETITION UNDER
37 CFR 1.181

This is a request for reconsideration of the decision mailed June 20, 2008 dismissing the petition of May 23, 2008.

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

The request is granted regarding reconsideration; however the petition decision remains **denied** for the reasons set forth below.

Statement of Pertinent Facts

1. On March 6, 2007, a request for inter partes reexamination was submitted and assigned control number 95/000,237..

2. On May 7, 2007, the order granting reexamination and a non-final Office action was mailed.

3. On July 6, 2007, patent owner submitted a response.

4. On August 2, 2007, third party requestor filed comments after non-final action.

5. On November 9, 2007, a Notice of Defective Paper was mailed to requestor indicating that comments by requestor are limited to 50 pages pursuant ot 37 CFR 1.943.

6. On November 16, 2007, requestor filed a corrected response.

7. On April 24, 2008, the Office issued an Action Closing Prosecution (ACP).

8. On May 23, 2008, patent owner submitted a response and a petition to (1) vacate the order for reexamination and expunge all papers in the case, (2) vacate the ACP and issue a new Office action, or (3) reopen prosecution to consider the attached amendment and response.

9. On June 20, 2008, requestor filed comments after ACP, and comments regarding the patent owner's petition.

10. On June 20, 2008, a decision dismissing the petition of May 23, 2008 was mailed.

11. On June 30, 2008, patent owner filed this petition to request reconsideration of the decision mailed on June 20, 2009 regarding the petition filed May 23, 2008.

12. On January 28, 2009, the third party requester filed a status request.

13. On February 13, 2009, a Notice of Defective Paper was mailed to requestor indicating that comments by requestor are limited to 50 pages pursuant ot 37 CFR 1.943.

14. On February 20, 2009, requestor filed a corrected response. The requestor also filed comments regarding the May 23, 2008 petition by the patent owner.

Legal Consideration

37 CFR 1.181(f) states:

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

Analysis

Patent owner's original petition, filed May 23, 2008, alleged the inter partes reexamination proceeding was invalid and requested relief by:

1. Vacating the inter partes reexamination filing date and expunging all papers filed or mailed in the case after March 6, 2007; or
2. Vacating the ACP, issuing an Office action that specifically identifies the combinations of references alleged to present an SNQ, and giving Patentee the opportunity of submit an amendment and response; or
3. Reopening prosecution so that the amendment and response filed with the petition will be considered and entered.

Patent owner asserts the request filed March 6, 2007 fails to meet the requirements of 37 CFR 1.915(b)(3), the non-final action did not remedy the failure of the request and the ACP also failed to provide a remedy to the request. Therefore, since there is no valid request for reexamination, the inter partes reexamination proceeding is this case is invalid. Since the patent owner was seeking relief from the Order mailed May 7, 2007, the petition was not considered timely and was dismissed. Patent owner argues that the petition also asserted the ACP was issued prematurely and prosecution should be reopened, and that the amendment and response accompanying the petition be considered and entered. It is the position of the patent owner that the petition was filed within 30 days of the mailing of the ACP and is therefore timely.

The third party requestor's comments were filed on February 20, 2009, within the 15 day response period set in the "Notice Re Defective Paper in *Inter Partes* Reexamination," mailed on January 28, 2009. The comments are directed to the petition filed on May 23, 2008 and respond mostly to the patent owner's allegation that the request for reexamination failed to meet the requirements in 37 CFR 1.915(b)(3). The third party requester did not make any comments regarding patent owner's petition, which was filed on June 20, 2008 and served to the third party requestor on June 20, 2008. Therefore, the third party requestor's comments were considered only to the extent that the comments respond to the issue that the ACP was allegedly improper.

Decision

At page 17 of the non-final Office action that was mailed on May 7, 2007, the examiner addressed the proposed rejection by third party requestor as follows:

Claim 1 is rejected under 35 USC 103(a) as being unpatentable over Drnevich (US Patent 4,183,808) in view of any of Khudenko '056, Khudenko '277, Khudenko '278, Khudenko '241, Khudenko '043, Khudenko '424, Khudenko '456, Khudenko '496, and Khudenko '459, hereinafter referred to as "the Khudenko patents."

The phrase "the Khudenko patents" is clearly defined and limited to Khudenko '056, Khudenko '277, Khudenko '278, Khudenko '241, Khudenko '043, Khudenko '424\, Khudenko '456, Khudenko '496, and Khudenko '459.
Each of the Khudenko patents has been discussed and their teachings compared to claim 1. See pages 17-18 in the Office action mailed May 7, 2007.

The rejections at issue were made in the non-final Office action of May 7, 2007 and responded to by patent owner on July 6, 2007. There was no mention at that time of the propriety of the granting of reexamination or of the proposed or

adopted rejections. These rejections were again adopted by the examiner in the ACP. See pages 27-32 in the ACP mailed April 24, 2008.

The petition to vacate the Order Granting Reexamination is not timely and was properly dismissed on June 20, 2008. Regarding the portion of the petition requesting to vacate the ACP, there are no grounds to vacate the ACP and issue an Office action that would "remedy' the Order Granting Reexamination. The petition states that the ACP is defective because it fails to specifically identify the combination of references. The ACP, however, clearly sets forth the combination of references applied in the rejections, as discussed above. The use of alternative secondary references that contain substantially similar teachings is not prohibited by reexamination procedures and policies. E.g., see MPEP 2617.[1] As discussed above, the ACP clearly explains how each of the alternative secondary teachings is applied to the claim limitations. The patent owner had notice of the rejections in the Office actions, and therefore, could adequately respond. It is noted that the patent owner did not raise these issues in their response to the non-final Office action, which contained the same rejection. Further, there is no indication the ACP was premature because the ACP did not introduce any new rejections that were not necessitated by amendments. See MPEP 2671.02.

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the Office action should be an ACP, and closed prosecution in the interest of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to issue an ACP.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

---

[1] Claim 2 is unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Jones **or** Harvey. (This could however be used if both Jones and Harvey provide a minor teaching which can be articulated in a sentence or two.)

Conclusion

1. The patent owner's request to reconsider the dismissal of the petition is granted; however the petition was properly dismissed. Inasmuch as this request is considered a petition to vacate the ACP, is it **denied**.

2. Any future response may be submitted as follows:

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

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

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

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

3. In response to the status inquiry by the third party requestor on January 28, 2009, this proceeding will continue by the examiner considering the entry of the compliant comments submitted after the ACP. The examiner will issue an Office action in due course.

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.

Irem Yucel,
Director, Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,237	03/06/2007	7105091	KEY-003C2RE	2887

51414 7590 07/08/2009

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2009

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CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,237*.

PATENT NUMBER *7,105,091*.

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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GOODWIN PROCTOR LLP.
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MASSACHUSETTS 02109-2881

(For Patent Owner)

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

BORIS M. KHUDENKO, Ph.D, P.E.
KHUDENDO ENGINEERING, INC.
744 MOORES MILL ROAD
ATLANTA, GA 30327

(For Third Party Requestor)

In re: Daniel L. Miklos
Ex Parte Reexamination Proceeding
Control Number: 95/000,237
Filed: March 6, 2007
For: U.S. Patent 7,105,091

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision in response to a petition, filed on June 19, 2009, to enter the amendment after Action Closing Prosecution (ACP) or, alternatively, enter the May 23, 2008 amendment for purposes of appeal. The petition seeks reconsideration of the decision mailed May 20, 2009.

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

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

Statement of Pertinent Facts

1. On March 6, 2007, a request for inter partes reexamination was submitted and assigned control number 95/000,237.

2. On May 7, 2007, the order granting reexamination and a non-final Office action was mailed.

3. On July 6, 2007, patent owner submitted a response.

4. On August 2, 2007, third party requestor filed comments after non-final action.

5. On November 9, 2007, a Notice of Defective Paper was mailed to requestor indicating that comments by requestor are limited to 50 pages pursuant ot 37 CFR 1.943.

6. On November 16, 2007, requestor filed a corrected response.

7. On April 24, 2008, the Office issued an Action Closing Prosecution (ACP).

8. On May 23, 2008, patent owner submitted a response and a petition to (1) vacate the order for reexamination and expunge all papers in the case, (2) vacate the ACP and issue a new Office action, or (3) reopen prosecution to consider the attached amendment and response.

9. On June 20, 2008, requestor filed comments after ACP, and comments regarding the patent owner's petition.

10. On June 20, 2008, a decision dismissing the petition of May 23, 2008 was mailed.

11. On June 30, 2008, patent owner filed a petition to request reconsideration of the decision mailed on June 20, 2009 regarding the petition filed May 23, 2008.

12. On January 28, 2009, the third party requester filed a status request.

13. On February 13, 2009, a Notice of Defective Paper was mailed to requestor indicating that comments by requestor are limited to 50 pages pursuant to 37 CFR 1.943.

14. On February 20, 2009, requestor filed a corrected response. The requestor also filed comments regarding the May 23, 2008 petition by the patent owner.

15. On May 20, 2009, a decision on the 6/30/08 petition was mailed. The petition was dismissed.

16. On June 5, 2009, a Right of Appeal Notice (RAN) was mailed.

17. On June 19, 2009 a Notice of Appeal was submitted concurrently with this petition and petitions under 1.182 and 1.183.

Legal Consideration

37 CFR 1.181(f) states:

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

37 CFR 1.116(b) and (d)(1) state:

> (b) After a final rejection or other final action (1.113) in an application or in an ex parte reexamination filed under 1.510, or an action closing prosecution (1.949) in an inter partes reexamination filed under 1.913, but before or on the same date of filing an appeal (41.31 or 41.61 of this title):
>
> (1) An amendment may be made canceling clams 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 my 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.
>
> (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 claims 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) of this title.

Analysis

This decision is solely in response to the petition under 37 CFR 1.181 to enter the amendment after ACP and reopen prosecution or enter the amendment for purposes of appeal. The petition requests reconsideration of the decision mailed

on May 20, 2009, which dismissed an earlier-filed petition under 37 CFR 1.181 to enter the amendment after ACP and to reopen prosecution.

The petition alleges the claim amendments listed in the response filed May 23, 2008 are necessary and could not have been presented earlier. Furthermore, closing prosecution without entering the amendments substantially deprives Patent Owner of its statutory rights.

In the first Office action, which issued May 7, 2007, the position of the examiner regarding the art cited by the requestor against the claims was clearly set forth. Patent owner was informed that submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced. The next Office action was, as intended, an ACP and included remarks directed toward the response to the first Office action. Patent owner's assertion that future rejections cannot be predicted is without merit. The rejections were clearly outlined in the first Office action and any amendment by patent owner should have been complete at that point, particularly in view of the fact that there is no provision for continuing reexamination practice. The record shows that substantially the same body of prior art was applied against the claims in both the first Office action and the ACP. The ACP did have to address the newly added limitations to all the independent claims and the new dependent claims 28-33, which were made by the proposed amendment of July 6, 2007. Therefore, the ACP did not present any new rejections that were not necessitated by the amendment filed on July 6, 2007. Patent owner has provided no ***showing*** of good and sufficient reasons why the amendment after ACP was necessary and was not earlier presented. The petition also makes no showing on how the amendment after ACP reduces issues for appeal. On the other hand, the examiner has made a showing that the amendment after ACP raises new issues that would require further consideration and search. See pages 2-4 of the Right of Appeal Notice mailed on June 5, 2009.

Patent owner further states that their "statutory rights" have been denied because they have not had a "fair opportunity" to reply to the new grounds of rejection in the ACP. See pages 7-8 of the petition. In support, patent owner contends that closing prosecution in the second Office action interferes with patent owner's right to present claim amendments under 35 USC 314 and to clearly develop issues for purposes of appeal. 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. 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. See MPEP 2672 and 2673. Accordingly, the Office's rules and procedures do not categorically deprive the patent owner of its statutory rights to present amendments in reexamination proceedings.

Upon review of the record, the examiner appropriately applied Office policies and procedures in determining that the Office action should be an ACP, and closed prosecution in the interest of "special dispatch." For the reasons set forth above and for the reasons set forth in the May 20, 2009 decision, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to issue an ACP.

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 patent owner's request to enter the amendments after ACP is **denied**.

2. The petition under 37 CFR 1.182 requesting continued reexamination, and the petition under 37 CFR 1.183 requesting waiver of a rule so as to receive an extension of time to file the appeal brief will be decided separately and decisions will issue in due course

3. Any future response may be submitted as follows:

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

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

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

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

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

Gregory Morse,
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,237	03/06/2007	7105091	KEY-003C2RE	2887

51414 7590 08/13/2009

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2009

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MAILED

AUG 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,237*.

PATENT NUMBER *7,105,091*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3991*.

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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 Patent Owner)

BORIS KHUDENKO P.H. D, P.E.
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ATLANTA, GA 30327

(For Third Party Requester)

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AUG 13 2009

CENTRAL REEXAMINATION UNIT

In re Miklos
Inter Partes Reexamination Proceeding
Control No.: 95/000,237
Filing Date: March 6, 2007
For: U.S. Patent No. 7,105,091

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

This is a decision on the June 19, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 - REQUEST FOR A WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," filed concurrently with a petition pursuant to 37 CFR 1.181 for review of the failure to enter amendments after Action Closing Prosecution and a petition pursuant to 37 CFR 1.182 for continued reexamination.

The present petition under 37 CFR 1.183 is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition under 37 CFR 1.183 to request for rule waiver and an extension of time is **granted** to the extent that the time for to file an Appellant Brief is extended to run 45 days from the mailing date of this decision.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 07-1700 as authorized on page 2 of the petition.

DECISION

37 CFR 1.183 states:

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

37 CFR 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

The present patent owner petition for an extension of time was filed concurrently with a Notice of Appeal on June 19, 2009. Upon filing a Notice of Appeal, by operation of rule 37 CFR 41.66(a), an appellant has a two month time period within which to file an Appellant Brief. In the present proceeding, the time for patent owner petitioner to file an Appellant Brief was due to expire on August 19, 2009. The concurrently filed petition under 37 CFR 1.181 and the outstanding petition under 37 CFR 1.182 for continued reexamination are under consideration.

Under 37 CFR 41.66(a), the time for filing an appellant's brief may not be extended.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petitions under 37 CFR 1.181 and 37 CFR 1.182. The decisions on the 37 CFR 1.181 and 1.182 petitions have not yet been rendered. In the event patent owner were to have filed an appellant's brief to keep the proceeding pending to obtain the result of the petition 37 CFR 1.182, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under 37 CFR 1.182 be granted.

Under the current facts and circumstances of the proceeding, 37 CFR 41.66(a) is waived to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 45 days from the mailing date of this decision.

If the petition under 37 CFR 1.182 has not yet been decided at the point where the time for patent owner to file an Appellant's Brief becomes less than one month prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Kery Fries at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed February 27, 2009 for filing an Appellant Brief is **granted to the extent stated.**

2. The time for to file an Appellant's Brief is extended to run 45 days from the mailing date of this decision.

3. Telephone inquiries related to this decision should be directed to Kery Fries, Legal Advisor, at (571) 272-7757, or in his absence, to Kenneth M. Schor at (571) 272-7710.

Kenneth M. Schor

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,237	03/06/2007	7105091	KEY-003C2RE	2887

51414 7590 08/14/2009

GOODWIN PROCTER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/14/2009

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,237*.

PATENT NUMBER *7,105,091*.

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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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ATLANTA, GA 30327

(For Third Party Requester) MAILED

AUG 14 2009

CENTRAL REEXAMINATION UNIT

In re Miklos
Inter Partes Reexamination Proceeding
Control No.: 95/000,237
Filing Date: March 6, 2007
For: U.S. Patent No. 7,105,091

: **CORRECTED DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.183**

This is a corrected decision on the June 19, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 - REQUEST FOR A WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," filed concurrently with a petition pursuant to 37 CFR 1.181 for review of the failure to enter amendments after Action Closing Prosecution and a petition pursuant to 37 CFR 1.182 for continued reexamination.

This decision is being mailed to correct two errant facts in the decision mailed August 13, 2009. First, the decision stated that the extension was from the notice of appeal date of Feb. 2009. However, the actual notice of appeal date was June 19, 2009. Second, the decision said that the petition under 37 CFR 1.181 and 1.182 are both pending. Rather the petition under 37 CFR 1.181 has been denied and the petition under 37 CFR 1.182 remains pending.

The present petition under 37 CFR 1.183 is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition under 37 CFR 1.183 to request for rule waiver and an extension of time is **granted** to the extent that the time for to file an Appellant Brief is extended to run 45 days from the mailing date of this decision.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 07-1700 as authorized on page 2 of the petition.

DECISION

37 CFR 1.183 states:

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

37 CFR 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

The present patent owner petition for an extension of time was filed concurrently with a Notice of Appeal on June 19, 2009. Upon filing a Notice of Appeal, by operation of rule 37 CFR 41.66(a), an appellant has a two month time period within which to file an Appellant Brief. In the present proceeding, the time for patent owner petitioner to file an Appellant Brief was due to expire on August 19, 2009. The petition under 37 CFR 1.181 has been denied. The petition under 37 CFR 1.182 remains under consideration.

Under 37 CFR 41.66(a), the time for filing an appellant's brief may not be extended.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petitions under 37 CFR 1.181 and 37 CFR 1.182. The decision addressing the 37 CFR 1.182 petition has not yet been rendered. In the event patent owner were to have filed an appellant's brief to keep the proceeding pending to obtain the result of the petition 37 CFR 1.182, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under 37 CFR 1.182 be granted.

Under the current facts and circumstances of the proceeding, 37 CFR 41.66(a) is waived to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 45 days from the mailing date of this decision.

If the petition under 37 CFR 1.182 has not yet been decided at the point where the time for patent owner to file an Appellant's Brief becomes less than one month prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event,

petitioner is advised to contact Kery Fries at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed June 19, 2009 for filing an Appellant Brief is **granted to the extent stated.**

2. The time for to file an Appellant's Brief is extended to run 45 days from the mailing date of this corrected decision.

3. Telephone inquiries related to this decision should be directed to Kery Fries, Legal Advisor, at (571) 272-7757, or in his absence, to Kenneth M. Schor at (571) 272-7710.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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95/000,237	03/06/2007	7105091	KEY-003C2RE	2887

51414 7590 09/16/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2009

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Atlanta GA 30327

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SEP 16 2009

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BOSTON, MA 02109

(For Patent Owner)

MAILED

SEP 16 2009

CENTRAL REEXAMINATION UNIT

BORIS KHUDENKO P.H. D, P.E.
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744 MOORES MILL ROAD
ATLANTA, GA 30327

(For Third Party Requester)

In re Miklos
Inter Partes Reexamination Proceeding
Control No.: 95/000,237
Filing Date: March 6, 2007
For: U.S. Patent No. 7,105,091

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

This is a decision on the September 14, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 - REQUEST FOR A WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," filed on September 14, 2009 awaiting decision on the June 19, 2009 petition pursuant to 37 CFR 1.182 for continued reexamination.

The present petition under 37 CFR 1.183 is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition under 37 CFR 1.183 to request for rule waiver and an extension of time is **granted** to the extent that the time for to file an Appellant Brief is extended to run 30 days or one month, whichever is greater, from the mailing date of this decision.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 07-1700 as authorized on page 2 of the petition.

DECISION

37 CFR 1.183 states:

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

37 CFR 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

The present patent owner petition for an extension of time was filed on September 14, 2009. The Office previously awarded an extension on August 14, 2009 for a period of 45 days. Upon filing a Notice of Appeal, by operation of rule 37 CFR 41.66(a), an appellant has a two month time period within which to file an Appellant Brief. In the present proceeding, the time for patent owner petitioner to file an Appellant Brief was originally set to expire on August 19, 2009. In the decision of August 14, 2009, it was extended to expire on September 28, 2009. The petition under 37 CFR 1.182 remains under consideration.

Under 37 CFR 41.66(a), the time for filing an appellant's brief may not be extended. However, in this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petition 37 CFR 1.182, which has not yet been rendered. In the event patent owner were to have filed an appellant's brief to keep the proceeding pending to obtain the result of the petition under 37 CFR 1.182, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under 37 CFR 1.182 be granted.

Under the current facts and circumstances of the proceeding, 37 CFR 41.66(a) is waived to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run on 30 days or one month whichever is greater days from the mailing date of this decision.

If the petition under 37 CFR 1.182 has not yet been decided at the point where the time for patent owner to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Kery Fries at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed September 14, 2009 for filing an Appellant Brief is **granted to the extent stated in the next paragraph.**

2. The time for to file an Appellant's Brief is extended to 30 days or one month, whichever is greater, from the mailing date of this decision.

3. Telephone inquiries related to this decision should be directed to Kery Fries, Legal Advisor, at (571) 272-7757

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,237	03/06/2007	7105091	KEY-003C2RE	2887

51414 7590 10/02/2009

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Boris M. Khudenko
744 Moores Mill Road
Atlanta GA 30327

MAILED

OCT 02 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,237*.

PATENT NUMBER *7,105,091*.

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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OCT 02 2009

CENTRAL REEXAMINATION UNIT

GOODWIN PROCTER LLP
EXCHANGE PLACE
BOSTON, MA 02109

(For Patent Owner)

BORIS KHUDENKO P.H. D, P.E.
KHUDENKO ENGINEERING INC.
744 MOORES MILL ROAD
ATLANTA, GA 30327

(For Third Party Requester)

In re Miklos
Inter Partes Reexamination Proceeding
Control No.: 95/000,237
Filing Date: March 6, 2007
For: **U.S. Patent No. 7,105,091**

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

This decision is in response to patent owner's June 19, 2009 petition titled "PETITION UNDER 37 CFR § 1.182- REQUEST FOR CONTINUED REEXAMINATION," seeking continued reexamination of the present proceeding .

FACTS

1. On March 6th, 2007, a request for *inter partes* reexamination was filed and was assigned control proceeding number 95/000,237.

2. On May 7th, 2007, an order granting reexamination and a non-final Office action were mailed.

3. On July 6th, 2007, patent owner filed a response to the non-final Office action .

4. On August 2, 2007, requester filed comments after the patent owner response.

5. On November 9th, 2007, a Notice of Defective Paper was mailed to requester indicating that the comments filed by requester are limited to 50 pages pursuant to 37 CFR 1.943.

6. On November 16th, 2007, requester filed corrected comments in response to the November 9, 2007 Notice of Defective paper.

7. On April 24th, 2008, the Office issued an Action Closing Prosecution (ACP).

8. On May 23rd, 2008, patent owner submitted a response and a petition under 37 CFR 1.181 to (1) vacate the order for re-examination and expunge all papers in the proceeding; (2) vacate the ACP and issue a new Office action; or (3) reopen prosecution to consider the amendment and response.

9. On June 20th, 2008 requester filed comments in response to patent owner's reply to ACP and to patent owner's petition.

10. On June 20th, 2008, a petition decision dismissing patent owner petition of May 23, 2008 was mailed.

11. On June 30th, 2008, patent owner requested reconsideration of the petition decision mailed on June 20th 2008.

12. On January 28th, 2009, requester submitted a status inquiry.

13. On February 13th, 2009, a Notice of Defective paper was mailed to requester indicating the comments must be limited to 50 pages pursuant to 37 CFR 1.943.

14. On February 20th, 2009 requester filed corrected comments and also filed comments regarding the May 23, 2008 petition by patent owner.

15. On May 20th, 2009, a decision on the June 30th, 2008 reconsideration petition was mailed.

16. On June 5th, 2009, the Office mailed a Right of Appeal Notice (RAN).

17. On June 19th, 2009, a Notice of Appeal was submitted concurrently with petitions pursuant to 37 CFR §§ 1.181, 1.183, and the instant petition pursuant to 37 CFR 1.182.

18. On July 8, 2009, the Office denied patent owner's June 19th, 2009 petition under 37 CFR 1.181 to enter the amendment after ACP.

19. On August 13, 2009, the Office granted patent owner's June 19th, 2009 petition under 37 CFR 1.183 to waive the two-month rule as to the filing of the appeal brief. On August 14, 2009, the Office mailed a corrected decision that waived the two-month rule for filing an appeal brief and set the date due for the appeal brief as 45 days from the mail date of the August 14th, 2009 decision.

20. On September 16, 2009, the Office issued a decision granting an additional petition under 37 CFR 1.183 to waive the two-month rule as to filing the appeal brief. The Office extended the filing of the appeal brief until October 14, 2009, so that a decision on the § 1.182 petition could be rendered.

Statutes and Regulations

37 CFR 1.182 provides:

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

Findings and Analysis

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *inter partes* reexamination setting, where 35 U.S.C. 314 mandates that *inter partes* reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the action closing prosecution. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

---

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

In this instance, patent owner's response includes a submission directed towards the entry of claim amendments and accompanying remarks, as described in patent owner's instant petition. These amendments were denied entry in the Right of Appeal Notice of June 5, 2009. These amendments are alleged to address the rejections by resolving an issue of claim construction to avoid applied prior art (see, *e.g.*, page 6 of the instant petition), and further the prosecution of the '237 proceeding.

Patent owner's response is not persuasive as to the reasons why the need for all of the proffered amendments could not have been anticipated earlier. Patent owner argues that no claim amendments were earlier thought desirable because the patent owner was of the opinion that the rejections could be overcome by arguments against the claim interpretations used as the bases for the rejections. The interpretations addressed by the amendment relate to the term "off-line treatment area" and the Office's broad interpretation of the term, which patent owner asserts is contrary to the ordinarily accepted meaning of such term. Patent owner asserts that it could not have been predicted that the Office would maintain its initial interpretation of such term in the Action Closing Prosecution. Accordingly, because the Office did maintain such interpretation, patent owner in response asserts that it must now amend the claims to address such interpretation.

As conceded by patent owner, the claim interpretations have not changed since the first Office action. In subsequent actions, the examiner merely attempted to present an explanation of his interpretation that addresses the concerns set forth in the patent owner's responses. The original rejection addressed the term "off-line area treatment" in its rejection and cited where such term could be found in the prior art. Patent owner, in its amendment, did not address the terminology but rather amended the claim to address the "controlling step" rather than the definition of "off-line area treatment." The ACP repeated such phrasing, and provided a detailed response to patent owner's concerns in the remarks section of that action. Furthermore, patent owner admitted, at page 12 of remarks filed May 23, 2008, that the Office maintained the same interpretation of the clause in the first Office action and the ACP that subsequently issued. The proposed amendments are not in response to non-anticipated newly raised issues; instead, the amendments address issues that have been present since the first Office action.

A grant of continued reexamination is not for the purpose of simply providing an additional opportunity to address a previously raised issue (e.g., claim construction of the term "off-line area treatment"), after the examiner refuses to accept an argument as to the issue in a final rejection, but, rather, patent owner must show that the examiner, in the action closing prosecution, is providing some new reason for the position taken that would not have been reasonably anticipated. A statement by the patent owner that an amendment is now required because the patent owner could not have predicted that the examiner would maintain an argument is not persuasive, because such a statement merely acknowledges that the same issues have been present since the first Office action rather than being newly raised in the ACP. Patent owner could have simply provided claims addressing the Office's position as to the "off-line area treatment," while retaining other claims to which patent owner's position was directed. Patent owner chose not to do so.

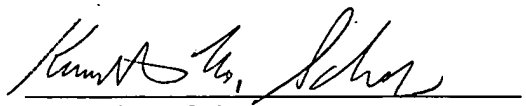
As to the allegations of the patent owner being deprived of procedural due process, such allegations are not persuasive. There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. A petition under 37 CFR 1.182 can provide relief for patent owners in an instance where further examination after an action closing prosecution, to address an new amendment, would serve to advance prosecution to further the requirement of special dispatch (e.g., by resolving issues on appeal by further limiting the claims or defining terms). The grant of a petition under 37 CFR 1.182 depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request. In the instant situation, patent owner has pursued the option of relief under 37 CFR 1.182. As detailed above, the Office has fully considered the merits of granting such relief, and has found that a grant of continued examination in the instant reexamination proceed would not serve the statutory mandate of special dispatch, given the patent owner's ability to have dealt with the "off-line area treatment" after first Office action as pointed out in the previous paragraph.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. 314 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Any inquiry concerning this decision should be directed to Kery Fries, Senior Legal Advisor, at (571) 272-7757.



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

October 1 , 2009
kenpet7/RCR/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,243	06/13/2007	7,100,061	33142.24	6789

7590 03/19/2008

WAGNER,MURABITO & HAO LLP
TWO NORTH MARKET STREET
THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/19/2008

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CENTRAL REEXAMINATION UNIT

Murabito, Hao & Barnes LLP
Two North Market Street, Third Floor
San Jose, CA 95113

(For Patent Owner)

David L. McCombs, Esq.
Haynes and Boone, LLP
901 Main Street Suite 3100
Dallas, TX 75202

(For Requester)

In re Halepete et al.
Reexamination Proceeding
Control No.: 95/000,243
Filed: June 13, 2007
For: U.S. Patent No. 7,100,061 B2

: DECISION GRANTING
: PETITION UNDER
: 37 CFR 1.183

This is a decision on the petition under 37 CFR 1.183 filed by the third party requester on September 26, 2007, titled "PETITION UNDER 37 CFR § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY COMMENTS UNDER 37 CFR § 1.943(b)," requesting waiver of 37 CFR 1.943(b) that requires the third party requester's comments on the patent owner's response not to exceed fifty (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.

FEES

A petition under 37 CFR 1.183 requires a fee set forth in 37 CFR 1.17(f). The instant petition (in the last paragraph on page 2) filed on September 26, 2007, provides an authorization to charge the petition fee to the Deposit Account No. 08-1394. Therefore, a petition fee under 37 CFR 1.17(f) in the amount of $400.00 is being charged to the Deposit Account No. 08-1394 as authorized.

03/21/2008 JWHITFIE 00000001 504160 95000243
01 FC:1462 400.00 DA

REVIEW OF FACTS

1. U.S. Patent No. 7,100,061 (the '061 patent) issued on August 29, 2006.

2. A request for reexamination of the '061 patent was filed on June 13, 2007. The request was assigned control No. 95/000,243 (the '243 reexamination proceeding).

3. Reexamination was ordered for the '243 proceeding on June 26, 2007.

4. Also, on June 26, 2007, a first Office action on the merits was mailed rejecting claims 1-59 of the patent. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On August 30, 2007, the patent owner filed a response to the Office action mailed on June 26, 2007.

6. On September 26, 2007, the third party requester filed written comments that include two exhibits (each six pages in length), total fifty-eight (58) pages in length.

7. On September 26, 2007, the third party requester also filed the instant petition under 37 CFR 1.183 requesting a waiver of the requirement under 37 CFR 1.943(b) that the written comments by the third party requester not exceed fifty (50) pages in length.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943 states (in part):

> (a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.
>
> (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.

37 CFR 1.943(b) prohibits a third party requester in an *inter partes* reexamination proceeding from filing written comments which exceed fifty (50) pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

In the instant petition, the third party requester requests relief from the fifty-page limit under 37 CFR 1.943(b). The third party requester, however, did not specify the number of additional pages. Since the instant petition was filed concurrently with the written comments that have fifty-eight (58) pages in length, the instant petition is treated as requesting for an additional eight (8) pages.

The record reveals that the Office action mailed on June 26, 2007, exceeds a hundred (100) pages in length. A response filed by the patent owner on August 30, 2007, exceeds forty (40) pages in length, excluding amendments, and added nine (9) new claims to the pending fifty-nine (59) claims. The third party requester alleges that additional pages are needed to effectively address the new claims. Based upon the above facts and the individual circumstances of this proceeding, the written comments filed by the third party requester that included an additional eight (8) pages is deemed equitable to address the patent owner's response.

Accordingly, the petition is granted:

(A) For the written comments filed by the third party requester on September 26, 2007; and

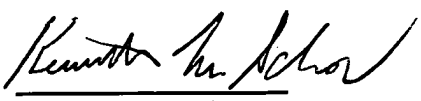
(B) To permit the written comments filed by the third party requester on September 26, 2007, to contain an additional eight (8) pages, total fifty-eight (58) pages in length.

CONCLUSION

1. The petition under 37 CFR 1.183 filed by the third party requester on September 26, 2007 for waiver of the requirements of 37 CFR 1.943(b) is granted to the extent set forth above.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to process all party papers. After the Central Reexamination Unit has processed all party papers, 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 Joni Y. Chang, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7720.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

March 19, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,243	06/13/2007	7,100,061	33142.24	6789

45590 7590 12/30/2008

TRANSMETA C/O MURABITO, HAO & BARNES LLP
TWO NORTH MARKET STREET
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SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Haynes and Boone LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
Dallas, TX 75219

Date:
DEC 30 2008

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000243
PATENT NO. : 7100061
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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DEC 30 2008

(For Patent Owner)

TRANSMETA C/O MURABITO, HAO & BARNES LLP
TWO NORTH MARKET STREET
THIRD FLOOR
SAN JOSE CA 95113

(For Third Party Requester)

HAYNES AND BOONE LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

In re: Halepete *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,243
Request Deposited: March 19, 2007
For: U.S. Patent No. 7,100,061

: DECISION ON PETITION
: FILED UNDER 37 CFR 1.181

This is a decision on the September 8, 2008, patent owner petition entitled "PETITION UNDER 37 CFR §1.181 TO WITHDRAW ACTION CLOSING PROSECUTION". The petition is before the Director of the Central Reexamination Unit for consideration.

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. 7,100,061 ("the '061 patent") issued to Halepete *et alia* on August 29, 2006.

2. On March 19, 2007, an *inter partes* request for reexamination of the '061 patent, assigned control No. 95/000,243 ("the '243 reexamination"), was filed by a third party requester (3PR).

3. On June 26, 2007, the Office issued an order granting the request for *inter partes* reexamination, and an accompanying Office action.

4. On August 30, 2007, Patent Owner filed an amendment.

5. On September 26, 2007, 3PR filed comments with a petition to waive the page limit.

6. On March 19, 2008, the petition to waive the page limit was granted.

7. On June 24, 2008, the Office issued an Action Closing Prosecution (ACP). The ACP was remailed July 3, 2008.

8. On September 8, 2008, the present petition was filed.

DECISION

Patent Owner "submits that the ACP was premature and requests that it be withdrawn". The petition is considered pursuant to 37 CFR 1.181, and, thus, no fee is required.

I. Patent Owner Petitioner's Position:

The Patent Owner argues that, after non-final, the claims were amended and that the Examiner rejected the claims under 35 USC 112 1st paragraph. Patent Owner also notes that the Examiner incorporated by reference portions of 3PR's initial request and subsequent response. Patent Owner also argues that the response to the ACP should be entered.

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 rejection which 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.

III. Analysis and Findings

The allegation that the July 3, 2008 Office Action is an improper ACP as it rejected claims under 112 1st and incorporated portions of 3PR papers is not deemed persuasive.

The new rejections made in the ACP were clearly directed to the amended material "without analysis of a task to be performed". Thus, the new grounds of rejection were necessitated by the amendment.

The fact that portions of 3PR papers were incorporated by reference into the actions is irrelevant as to the properness of the action closing prosecution.

The determination as to whether the amendment after ACP will be entered or not has not yet been made. Therefore, there is no relief to be requested at the moment and the request to enter the amendment ACP is premature.

In view of the above, the petition is DISMISSED.

CONCLUSION

1. Patent Owner's request to find the ACP mailed July 3, 2008 premature is dismissed.

2. The proceeding is being forwarded to the Examiner for appropriate action.

3. **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.

Eric Keasel for

Gregory Morse
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 04/15/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JAMES W. MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

Date:

MAILED

APR 152009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
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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APR 15 2009

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

(For Requester)

JAMES W. MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

In re Bednar et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,244	:	FOR REOPENING
Filed: April 26, 2007	:	PROSECUTION
For: U.S. Patent No.: 6,336,312	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on February 27, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 – REQUEST TO ENTER AMENDMENTS AFTER ACTION CLOSING PROSECUTION AND TO RE-OPEN PROSECUTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and reopen prosecution by withdrawing the Action Closing Prosecution issued on May 27, 2008.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated February 27, 2009 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,244.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,336,312 (hereinafter, the '312 patent) issued on January 8, 2002.

2. A corrected request for *inter partes* reexamination, assigned control No. 95/000,244, was filed by a third party requester on April 26, 2007, which was compliant with the filing date requirements.

3. *Inter partes* reexamination was ordered for the '244 reexamination proceeding on July 16, 2007. On the same day, a non-final Office action was mailed in the '244 reexamination proceeding.

4. The patent owner filed a response to the non-final Office action on October 16, 2007. The response included proposed new claims 28-36.

5. The third party filed comments on November 15, 2007 to the patent owner's response, which included proposed rejections for the new proposed claims 28-36.

6. On February 29, 2008, the patent owner filed an information disclosure statement.

7. On May 27, 2008, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP essentially continued to adopt the same grounds of rejections, as set forth in the July 16, 2007 Office action, and adopted the new proposed rejections based upon prior art, as proposed by the third party requester and set forth new rejections under 35 U.S.C. 112 for the proposed new claims.

8. On June 27, 2008, patent owner filed remarks and a proposed amendment to proposed new claims 28-36.

9. On July 28, 2008, the third party requester filed comments.

10. On January 27, 2009, the Office mailed a Right to Appeal Notice (RAN) in which it is stated that the proposed amendment of June 27, 2008 will not be entered. The RAN addressed the patent owner's remarks and the third party requester's comments to the extent the remarks and comments are applicable to the claims prior to the June 27, 2008 proposed amendment.

11. On February 27, 2009, the patent owner filed the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened. The petition was received unsigned. A signed copy of this petition was received on April

1, 2009. The petition includes further proposed amendments to proposed new claims 28-26, which are different amendments than presented in the June 27, 2008 response. The patent owner also filed a notice of appeal, a petition under 37 CFR 1.182 requesting continued reexamination, and a petition under 37 CFR 1.183 requesting waiver of a rule so as to receive an extension of time to file the appeal brief. The petitions under 37 CFR 1.182 and 1.183 will be decided separately and decisions will issue in due course.

12. On March 10, 2009, the third party requester filed comments pertaining to the petition under 37 CFR 1.181. The third party requester also states that their comments apply equally to the petition under 37 CFR 1.182.

DECISION

The patent owner (petitioner) states that the patent owner is seeking "...relief under 37 C.F.R. § 1.181 to have amendments that were not entered after the ACP entered by entering the present amendment" and requesting that prosecution be reopened. Patent owner contends that:

"A. The claims amendments listed in the 6/27/08 amendments are necessary and could have not been earlier presented.

B. Closing prosecution without entering the 6/27/08 amendments substantially deprives the patent owner of its statutory rights.

C. Entry of the 6/27/08 amendment is not contrary to the principle of special dispatch.

D. The 6/27/08 amendments do not broaden under 35 U.S.C. § 305, as the Examiner suggests.

E. Entry of the amendments filed herewith will not result in an undue burden ..."

See page 2 of the petition.

The third party requester comments that the examiner correctly denied entry of the June 27, 2008 amendments and issued a Right of Appeal Notice (RAN). The third party requester states that prosecution should not be reopened to so that the patent owner can "... have the ability to repeatedly amend the claims in a reexamination in a slight, incremental fashion...," and notes that the patent owner did not contest the appropriateness of making the second Office action an Action Closing Prosecution (ACP). See pages 2 to 3 of the March 10, 2009 comments. In addition, third party requester states that the patent owner, by presenting different amendments in this petition than the June 27, 2008 amendment, provides evidence that the examiner correctly determined that the June 27, 2008 amendment did raise issues under 35 USC 112. See page 4 of the comments. Finally, the third party requester contends that the examiner correctly denied entry of the June 27, 2008 amendment because:

1. the proposed recitation of the deck plates connected to a downwardly opening space raised issues under 35 USC 112, first and second paragraphs;
2. the issue of impermissible claim enlargement under 35 USC 305 was presented; and

3. The added specifics of the deck plate holes had not previously been considered and would therefore require further search and consideration beyond a mere cursory review.

See pages 5-13 of the comments dated March 10, 2009.

Review of the Examiner's Decision to Not Enter the June 27, 2008 Amendment and Issue a RAN

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed amendment of June 27, 2008, 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 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 ACP sets forth essentially the same grounds of rejection based on prior art as set forth in the first Office action of July 16, 2007, and adopted the proposed rejections for the new proposed claims 28-36, based on substantially the same prior art

applied in the first Office action. The ACP did make new rejections under 35 U.S.C. 112 on proposed new claims 28-36. These new rejections were caused by the amendment that added the proposed new claims in the paper of October 16, 2007. Therefore, the examiner could not have made the rejections under 35 U.S.C. 112 or the prior art rejections to claims 28-36 prior to the ACP.

In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed amendment of June 27, 2008 because the proposed amendment are necessary and could not have been earlier presented. In support of this allegation, the patent owner states that they "...cannot predict future rejections, and therefore cannot amend the claims or modify the claim amendments based upon the unknown" as their showing of why the amendment could not have been earlier presented. It is noted, however, that the ACP rejects proposed new claims 28-36 based upon substantially the same prior art used in rejecting the patented claims in the first Office action (e.g., see the rejections to claims 19 and 20). Therefore, the patent owner was on notice as to what the prior art of record teaches. Given that claim 28 cites similar claim limitations to claim 19 and claim 35 cites similar claim limitations to claim 1, the patent owner should have anticipated that the prior art of record in the reexamination proceedings are applicable to the proposed new claims.

Patent owner further states that their "statutory rights" have been denied because they have not had a "fair opportunity" to reply to the new grounds of rejection in the ACP. See pages 6-8 of the petition. In support, patent owner contends that closing prosecution in the second Office action interferes with patent owner's right to present claim amendments under 35 USC 314 and to clearly develop issues for purposes of appeal. 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. 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. See MPEP 2672 and 2673. Accordingly, the Office's rules and procedures do not categorically deprive the patent owner of its statutory rights to present amendments in reexamination proceedings. Second, the Board of Patent Appeals and Interferences (BPAI) would not be hearing arguments and considering evidence or amendments for the "very first time." As stated above, the Office rules and procedures encourage examiners to analyze the facts in each proceeding and appropriately weigh the equities prior to issuing an ACP or RAN. No new amendments or evidence are permitted after issuance of a RAN so that the BPAI would not have to consider any claims or evidence that the examiner has not already addressed. It is noted that even though the examiner did not enter the claim amendments, the examiner considered and responded to all arguments and evidence submitted by the patent owner and third party requester after the ACP. Therefore, no issues that were not addressed by the examiner will be before the BPAI.

As pointed out by the third party requester, the first Office action explicitly told the patent owner to expect that the next Office action will be an Action Closing Prosecution (see page 9 of the

July 16, 2007 action). As already acknowledged by the patent owner, reexamination proceedings are required, by statute, to proceed with special dispatch. The examiner followed the Office's rules and procedures and analyzed the facts in this reexamination proceeding and weighed the equities. The examiner specifically found that the June 27, 2008 amendment:

1. Raised new issues under 35 USC 112, first and second paragraph, due to the new limitation that the deck plates connect to the downwardly opening space.
2. Raised new issues that would require further search and consideration due to the new limitations pertaining to the deck plate holes.
3. Raised new issues that would require further search and consideration due to the new limitations pertaining to the height of cut features
4. Raised new issues that may require a rejection under 35 USC 305 due to broadening.

See pages 2 to 4 of the RAN.

Upon review of the record, it is found that the examiner correctly determined that the June 27, 2008 amendment raised new issues pertaining to 35 USC 112, and also introduced new limitations to the proposed new claims that would require more than just a cursory review. For example, it is clear that the new limitations require a plurality of vertically spaced holes, which is a feature that was not claimed before and would require more than just a cursory review of the record to determine the patentability of the claims, as proposed to be amended in the June 27 2008 response. In other words, these issues would require further search and consideration by the examiner. Also, the fact that patent owner is introducing a different amendment, included in this petition, which addresses the issues raised by the examiner supports the examiner's determination to not enter the June 27, 2008 amendment.

Accordingly, the examiner appropriately denied entry of further amendments to proposed new claims 28-26, and mailed a RAN in the interest of "special dispatch." The determination of whether claims 28 and 35, as presented in the June 27, 2008 amendment, are impermissibly broadening the scope of the patent claims need not be addressed because there are other reasons to support the examiner's decision to not enter the June 27, 2008 amendment. Moreover, the examiner only stated that the June 27, 2008 amendment raised issues pertaining to broadening, which would require further consideration. In other words, the examiner did not make an explicit determination of broadening (e.g. did not make a new rejection), but was only showing how the June 27, 2008 amendment raises new issues that would require more consideration.

Entry of the Amendments included in the February 27, 2009 petition:

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 1.183 states:

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

37 CFR 1.953(c) states:

(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. [emphasis added in bold]

A petition under 37 CFR 1.181 is to invoke the supervisory authority of the Director to review an examiner's decision. See 37 CFR 1.181(a)(3). The present petition, dated February 27, 2009, requests more than supervisory review of the examiner's decision to not enter the amendment dated June 27, 2008 by requesting entry of the amendment, included in the petition, after a RAN. 37 CFR 1.953(c) clearly states that "[n]o amendments can be made in response to the Right of Appeal Notice." Therefore, patent owner's request to enter the amendments included in the February 27, 2009 petition is clearly prohibited by 37 CFR 1.953(c). Accordingly, patent owner must file a separate, grantable petition under 37 CFR 1.183 requesting waiver of the requirement in 37 CFR 1.953(c) in order for entry of the amendment filed with the February 27, 2009 petition to be considered.

In summary, the request to enter the amendments filed within the February 27, 2009 petition is denied because entry of amendments after a RAN is prohibited by 37 CFR 1.953(c). Patent owner must file a separate petition under 37 CFR 1.183 for this matter.

RAN is allegedly unclear, raises new rejections or issues, and is inconsistent with Office policies:

Patent owner raises several issues that call into question the adequacy of the RAN. Patent owner contends that the RAN does not clearly set forth what arguments and evidence has been fully

considered by the examiner. See pages 11-12 and 16-18 of the petition. Patent owner also argues that the examiner issued a new ground of rejection because the examiner "adopted new reasoning." See pages 12-14 of the petition. Patent owner finally alleges that the rejections in the Office actions rely upon an actual device instead of the disclosures in printed publications and patents. See pages 21-22 of the petition

These above-mentioned issues touch 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."

Patent owner also states that RAN introduces a new ground of rejection by relying on new reasoning and new issues by relying on new evidence, and therefore, issuing a RAN was not proper. First, it is noted that the rejection to claims 1-3, 8, 9, 10, and 24-27 under 35 U.S.C. 103(a) based on the Hoffmeyer reference has not changed and remains adopted as proposed in the request for reexamination. Second, the examiner's response in last paragraph on page 22 in the RAN is consistent with the prior interpretation of the claim (see the last paragraph on page 23 in the ACP stating that the claims do not require any particular mower deck width. The examiner must rebut any arguments presented in the patent owner's response and must reflect consideration of any comments made by the third party requester in the RAN, and the examiner did so in the RAN. As to the "new issues" raised in the RAN, it is pointed out that the third party requester is permitted to comment on any issues raised by the examiner and the patent owner. By filing the June 27, 2008 response, the patent owner allowed the third party requester to comment on issues, which they did on July 28, 2008, and included a declaration by Mr. Allan Moffat. The examiner considered both the patent owner's and third party requester's argument and evidence and addressed such in the RAN. As stated above, the examiner followed Office policy by stating agreement or disagreement with the positions of the patent owner and third party requester and providing reasons for the examiner's position. It would be impossible to ever close prosecution if the examiner could not to do so if he or she addressed any new arguments and evidence provided for in the responses after the ACP. The statutory requirement of special dispatch is clear that prosecution is not meant to continue without end. Upon review, the examiner's rebuttal is consistent with the prior position taken by the examiner, and therefore does not constitute a *de facto* new ground of rejection by addressing the arguments and evidence submitted after the ACP. Accordingly, the examiner did not make a *de facto* new grounds of rejection in his response to the remarks and comments filed after the ACP.

In regard to the rejection of claims 28 and 30-34 under 35 USC 103(a) based upon the Risboro reference (see pages 31-32 of the ACP), this rejection was inadvertently left out of the RAN. There was no intention by the examiner to withdraw this rejection, which is apparent by the RAN because the examiner did not make a statement that the rejection is being withdrawn. This

rejection was made in the ACP, and therefore, clarifying the RAN to include this rejection will not be a new ground of rejection. Accordingly, the supplemental communication dated April 14, 2009, which clarifies that this rejection is maintained, does not introduce a new ground of rejection, but instead rectifies an unintentional mistake. Therefore, patent owner and third party requester are on notice that this rejection is maintained.

In regard to the broadening issues, as stated above, the examiner did not make a rejection but simply indicated that such issues may have to be considered if the amendment of June 27, 2008 is entered. Therefore, there is no need for patent owner to respond because a rejection was not made and would not be before the BPAI upon appeal.

Furthermore, it is noted that many of the patent owner's arguments pertain to the alleged unfairness resulted in the closing of prosecution. These arguments are more appropriate in a petition under 37 CFR 1.182 requesting continuing reexamination.

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the amendment of June 27, 2008 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 his discretion in deciding to not enter the amendment of June 27, 2008 and issuing a RAN.

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 amendment dated June 27, 2008 and reopening of prosecution of the '244 reexamination proceeding is denied.

2. The petition under 37 CFR 1.182 requesting continued reexamination, and the petition under 37 CFR 1.183 requesting waiver of a rule so as to receive an extension of time to file the appeal brief will be decided separately and decisions will issue in due course.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 07/15/2009

HARNESS, DICKEY & PIERCE, P.L.C.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JAMES W. MILLER
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MINNEAPOLIS, MN 55402

Date:

MAILED

JUL 15 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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MINNEAPOLIS, MN 55402

(For Third Party Requester)

In re Bednar et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,244
Filing Date: April 26, 2007
For: U.S. Patent No. 6,336,312

DECISION ON PETITION UNDER 37 CFR 1.183

This is a decision on the February 27, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 - REQUEST FOR A WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," filed concurrently with a petition pursuant to 37 CFR 1.181 for review of the failure to enter amendments after Action Closing Prosecution, a petition pursuant to 37 CFR 1.182 for continued reexamination, and a Notice of Appeal.

The present petition under 37 CFR 1.183 is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition under 37 CFR 1.183 to request for rule waiver and an extension of time is **granted** to the extent that the time for to file an Appellant Brief is extended to run 45 days from the mailing date of this decision.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 50-4494 as authorized on page 2 of the petition.

DECISION

37 CFR 1.183 states:

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

37 CFR 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

The present patent owner petition for an extension of time was filed concurrently with a Notice of Appeal on February 27, 2009. A corrected Notice of Appeal was filed on May 13, 2009. Upon filing a Notice of Appeal, by operation of rule 37 CFR 41.66(a), an appellant has a two month time period within which to file an Appellant Brief. In the present proceeding, the time for patent owner petitioner to file an Appellant Brief was due to expire on July 13, 2009. The concurrently filed petition under 37 CFR 1.181 has been dismissed in a decision mailed April 15, 2009. The outstanding petition under 37 CFR 1.182 for continued reexamination, a corrected copy of which was received on April 4, 2009, is currently under consideration by the Office.

Under 37 CFR 41.66(a), the time for filing an appellant's brief may not be extended.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petitions under 37 CFR 1.181 and 37 CFR 1.182. A decision on the 37 CFR 1.182 petition has not yet been rendered. In the event patent owner were to have filed an appellant's brief to keep the proceeding pending to obtain the result of the petition 37 CFR 1.182, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under 37 CFR 1.182 be granted.

Under the current facts and circumstances of the proceeding, 37 CFR 41.66(a) is waived to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 45 days from the mailing date of this decision.

If the petition under 37 CFR 1.182 has not yet been decided at the point where the time for patent owner to file an Appellant's Brief becomes less than one month prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed February 27, 2009 for filing an Appellant Brief is **granted to the extent stated.**

2. The time for to file an Appellant's Brief is extended to run 45 days from the mailing date of this decision.

3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus Laufer at (571) 272-7726.

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.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 08/06/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JAMES W. MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

Date:
MAILED
AUG 06 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
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

HARNESS, DICKEY, & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

(For Patent Owner)

JAMES W, MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

(For Requester)

In re Bednar et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,244
Filed: April 26, 2007
For: U.S. Patent No.: 6,336,312

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the February 27, 2009 patent owner petition entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination."

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

The petition fee of $400.00 under 37 CFR 1.17(f) has been charged to deposit account 50-4494, as authorized at page ii of the instant petition.

The petition is **granted to the extent set forth below**.

BACKGROUND

1. On April 26, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,244 ("the '244 proceeding").

2. On July 16, 2007, *inter partes* reexamination was ordered for the '244 proceeding. On the same day, a non-final Office action was mailed in the '244 proceeding.

3. On October 16, 2007, the patent owner filed a response to the non-final Office action, including proposed new claims 28-36. The third party requester filed comments, including proposed rejections for the new claims, on November 15, 2007.

4. On February 29, 2008, the patent owner filed an information disclosure statement.

5. On May 27, 2008, the Office issued an Action Closing Prosecution (ACP) which addressed the patent owner's response and the third party comments. The ACP essentially continued to adopt the same grounds of rejections as set forth in the July 16, 2007 Office action, and adopted the new proposed rejection based upon prior art as proposed by the third party requester, and set forth new rejections under 35 USC 112 for the proposed new claims.

6. On June 27, 2008, patent owner filed remarks and a proposed amendment to proposed new claims 28-36. Third party requester filed comments on July 28, 2008.

7. On January 27, 2009, the Office issued a Right of Appeal Notice (RAN) in which it was stated that the proposed amendment of June 27, 2008 would not be entered.

8. On February 27, 2009, patent owner filed a Notice of Appeal.

9. On February 27, 2009, patent owner filed an unsigned petition under 37 C.F.R 1.181, entitled "Petition Under 37 CFR 1.181 – Request to Enter Amendments After Action Closing Prosecution and to Re-open Prosecution."

10. On February 27, 2009, patent owner filed **the instant petition under 37 C.F.R 1.182**, entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination," requesting entry of certain amendments filed with the petition.

11. On February 27, 2009, patent owner filed a petition under 37 C.F.R 1.183, entitled "Petition Under 37 C.F.R. § 1.183 – Request for a Waiver of the Prohibition of an Extension of Time for Filing an Appeal Brief and a Request for an Extension of Time for Filing an Appeal Brief."

12. On March 10, 2009, third party requester filed comments in opposition to patent owner's petitions under 37 C.F.R. 1.181 and 1.182.

13. On April 14, 2009, a Notice for Defective Notice of Appeal was issued.

14. On April 15, 2009, the Office issued a decision dismissing patent owner's petition under 37 C.F.R. 1.181, as resubmitted with a proper signature on April 1, 2009.

15. On May 13, 2009, patent owner filed a corrected Notice of Appeal.

16. On July 15, 2009, the Office issued a decision granting patent owner's petition under 37 CFR 1.183, extending the period for response set forth in 37 CFR 41.66 for 45 days.

17. On July 15, 2009, the Office received a patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 1.943," requesting waiver of the page

limit requirement to permit a 55 page Appeal Brief, and additionally, a patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 41.67(c)(2), requesting waiver of the prohibition against filing new affidavits or evidence concurrently with an Appeal Brief.

18. On an even date herewith, the Office issued two additional decisions dismissing as moot the two July 15, 2009 patent owner petitions.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

DECISION

1. The Patent Owner Petition for Continued Prosecution

The February 27, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of an evidence submission previously denied. 37 CFR 1.182 provides for relief that is not currently provided by an existing rule. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination

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

proceeding **to seek entry of an amendment and/or evidence that was denied entry** after an action closing prosecution in an inter partes reexamination proceeding [emphasis added].

The § 1.182 petition procedure was created to address a need for an amendment or evidence submission, the need for which was not apparent until the issuance of the final rejection or action closing prosecution. The filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 314that "[a]ll inter partes reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. In keeping with the requirement of special dispatch, a petition under 37 CFR 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues, by better defining the issues for appeal, or by placing the claims in condition for the issuance of a reexamination certificate. Furthermore, patent owner should set forth reasons why the need for the submission could not have been anticipated earlier.

On February 27, 2009, patent owner timely filed the instant petition. In the instant petition, patent owner requests "that the 6/27/08 amendments be entered, that the amendments presented herein be entered, and that reexamination continue." It is first noted that the concurrently filed amendment and the 6/27/08 amendment both amend the same set of claims - claims 28-36. The instant petition is therefore understood as requesting entry of the concurrently filed amendment only.

The petition meets the threshold requirement of § 1.182 in that the relief requested is not provided for elsewhere in the regulations, because the prosecution has closed in the proceeding with the issuance of the January 27, 2009 Right of Appeal Notice (RAN), and patent owner's February 27, 2009 petition under 37 CFR 1.181 has been dismissed by the Office on April 15, 2009. Therefore, there is no regulation providing for entry of the concurrently filed amendment, and relief may be sought under § 1.182.

The petition presents reasons why the need for the evidence could not have been anticipated earlier. As noted in the April 15, 2009 Office decision dismissing patent owner's 1.181 petition, the May 27, 2008 ACP made new rejections under 35 U.S.C. 112 on proposed new claims 28-36. Patent owner's instant amendment addresses these §112 rejections, as well as newly raised issues under 35 U.S.C. 314, and could not have been submitted before the ACP was mailed. In this instance, based on the totality of the circumstances, the patent owner has met the burden of presenting evidence why the need for the submission could not have been anticipated earlier.

Additionally, the requirement that the amendment have been previously denied entry has been met. The petition was filed after an action closing prosecution in an *inter partes* reexamination proceeding to seek entry of an amendment not previously considered that was previously denied entry in the January 27, 2009 RAN. The February 27, 2009 amendment has been denied entry as set forth in the April 15, 2009 Office decision dismissing patent owner's 1.181 petition.

Finally, the effect of entry of the amendment is determined to be in accordance with conducting the proceeding with special dispatch. In the instant case, a notice of appeal was filed on February 27, 2009, and a corrected notice of appeal was filed on May 13, 2009, to keep the

proceeding pending. While the patent owner has filed a notice of appeal, an appeal brief has not been filed. Therefore, any delay caused by the submission of the May 13, 2009 corrected notice of appeal is not significant enough to outweigh the benefit to be obtained by consideration of the proffered amendment. The facts in this case indicate that continuation of examination through entry of the February 27, 2009 amendment would best further prosecution and satisfy the overall needs of special dispatch. On balance, the entry of the February 27, 2009 amendment would best serve the efficient resolution of the question of patentability arising from the art of record. For these reasons, the § 1.182 petition is deemed to satisfy the requirements set forth in the Notice.

In view of the above, the closing of prosecution rendered via the May 27, 2008 Action Closing Prosecution is withdrawn, and prosecution of the proceeding is reopened to the following extent:

The February 27, 2009 response will be entered by the Central Reexamination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.

2. The March 10, 2009 Third Party Requester Comments

The third party requester opposition filed March 10, 2009 requested denial of two patent owner February 27, 2009 petitions filed separately under 37 CFR 1.181 and 1.182. Based on the primary focus of the petition, the petition was taken as an opposition to the patent owner petition under § 1.181 and addressed in the decision on the petition under § 1.181. The Office decision of April 15, 2009, which denied the patent owner petition under § 1.181, addressed this opposition; see, e.g., page 5 of the decision.

The filing of a single paper to address issues presented in two separate papers, particularly in a situation in which each paper addresses a different rule and is to be considered by a separate part of the Office, is improper under 37 CFR 1.4(c). 37 CFR 1.4(c) requires separate submissions for each separately distinct and different matter. In the instant situation, the March 10, 2009 third party requester paper was addressed by the Office decision of April 15, 2009, with regard to its primary focus, in order to give some effect to the paper. However, the March 10, 2009 requester paper will not be taken up for consideration of its subsidiary issues raised in that paper, because, in accordance with § 1.4(c), a separate submission would be required for consideration of any issues raised in the March 10, 2009 requester paper related to the present § 1.182 petition.

It is to also be noted that a third party requester's opposition to a patent owner's petition requesting continuing reexamination is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is not permitted as a submission of written comments to a patent owner's response to an Office action, since no such response has been filed, nor is such a response permitted following the January 27, 2009 RAN. Furthermore the instant third party written comments are directed solely towards the dismissal of the petition.

While the requester may oppose a patent owner challenge to an Office finding that an amendment does not comply with the requirements of 37 CFR 1.116 and 37 CFR 1.951(a),[2] or a patent owner challenge to jurisdiction over a proceeding by the Office,[3] the consideration of a request for continued reexamination is clearly within the Office's jurisdiction,[4] and the Office may exercise its discretion to grant or deny such relief to provide a limited reopening of prosecution. Therefore, a third party requester's opposition to patent owner's request for continued reexamination, even if filed in a separate paper, would not be enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's request.

CONCLUSION

- The petition is **granted to the extent set forth herein**.

- The prosecution of the present '244 *inter partes* reexamination proceeding is continued. **No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances.**

- The closing of prosecution rendered via the May 27, 2008 Action Closing Prosecution is withdrawn, and prosecution of the proceeding is reopened to the extent stated in the next paragraph.

- The February 27, 2009 submission will be entered by the Central Reexamination Unit, and will then be considered by the examiner. The submission will be treated as a response by patent owner received **after** a first Office action.

- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

---

[2] MPEP 2673.02 provides for third party requester to once file comments responsive to a patent owner petition under 37 CFR 1.181 requesting entry of an amendment on the grounds that the amendment satisfies the requirements of 37 CFR 1.951(a) and 37 CFR 1.116. Since the Central Reexamination Unit deciding official lacks the discretion to enter an amendment that fails to satisfy the requirements of 37 CFR 1.951(a) and 37 CFR 1.116, third party comments are permitted as directed towards the merits of the proceeding.

[3] 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.

[4] As to the granting of patent owner's § 1.182 petition being a matter within the jurisdiction of the Office, 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." The Office clearly has the authority to exercise its discretion to reopen prosecution.

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700 or in his absence, to Pinchus M. Laufer, at (571) 272-7726.

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

August 5, 2009
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 08/06/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
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EXAMINER	
ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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MINNEAPOLIS, MN 55402

Date:

MAILED

AUG 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
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 Patent Owner)

MAILED

AUG 06 2009

CENTRAL REEXAMINATION UNIT

JAMES W, MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

(For Requester)

In re Bednar et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,244
Filed: April 26, 2007
For: U.S. Patent No.: 6,336,312

DECISION
DISMISSING PETITION
TO WAIVE 37 CFR 41.67(c)(2)
UNDER 1.183

This is a decision on the July 15, 2009 patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 41.67(c)(2)," requesting waiver of the prohibition against filing new affidavits or evidence concurrently with an Appeal Brief. The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of $400.00 under 37 CFR 1.17(f) has been charged to deposit account 07-1700, as authorized at page 1 of the instant petition.

The petition is **dismissed as moot**.

BACKGROUND

1. On April 26, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,244 ("the '244 proceeding").

2. On July 16, 2007, *inter partes* reexamination was ordered for the '244 proceeding. On the same day, a non-final Office action was mailed in the '244 proceeding.

3. On October 16, 2007, the patent owner filed a response to the non-final Office action, including proposed new claims 28-36. The third party requester filed comments, including proposed rejections for the new claims, on November 15, 2007.

4. On February 29, 2008, the patent owner filed an information disclosure statement.

5. On May 27, 2008, the Office issued an Action Closing Prosecution (ACP) which addressed the patent owner's response and the third party comments. The ACP essentially continued to adopt the same grounds of rejections as set forth in the July 16, 2007 Office action, and adopted the new proposed rejection based upon prior art as proposed by the third party requester, and set forth new rejections under 35 USC 112 for the proposed new claims.

6. On June 27, 2008, patent owner filed remarks and a proposed amendment to proposed new claims 28-36. Third party requester filed comments on July 28, 2008.

7. On January 27, 2009, the Office issued a Right of Appeal Notice (RAN) in which it was stated that the proposed amendment of June 27, 2008 would not be entered.

8. On February 27, 2009, patent owner filed a Notice of Appeal.

9. On February 27, 2009, patent owner filed an unsigned petition under 37 C.F.R 1.181, entitled "Petition Under 37 CFR 1.181 – Request to Enter Amendments After Action Closing Prosecution and to Re-open Prosecution."

10. On February 27, 2009, patent owner filed a petition under 37 C.F.R 1.182, entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination," requesting entry of certain amendments filed with the petition.

11. On February 27, 2009, patent owner filed a petition under 37 C.F.R 1.183, entitled "Petition Under 37 C.F.R. § 1.183 – Request for a Waiver of the Prohibition of an Extension of Time for Filing an Appeal Brief and a Request for an Extension of Time for Filing an Appeal Brief."

12. On March 10, 2009, third party requester filed comments in opposition to patent owner's petitions under 37 C.F.R. 1.181 and 1.182.

13. On April 14, 2009, a Notice for Defective Notice of Appeal was issued.

14. On April 15, 2009, the Office issued a decision dismissing patent owner's petition under 37 C.F.R. 1.181, as resubmitted with a proper signature on April 1, 2009.

15. On May 13, 2009, patent owner filed a corrected Notice of Appeal.

16. On July 15, 2009, the Office issued a decision granting patent owner's petition under 37 CFR 1.183, extending the period for response set forth in 37 CFR 41.66 for 45 days.

17. On July 15, 2009, the Office received a patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 1.943," requesting waiver of the page limit requirement to permit a 55 page Appeal Brief, and additionally, the instant patent

owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 41.67(c)(2)," requesting waiver of the prohibition against filing new affidavits or evidence concurrently with an Appeal Brief.

18. On an even date herewith, the Office issued a decision granting the February 27, 2009 patent owner petition under 37 C.F.R 1.182, entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination," and issued a decision dismissing as moot the July 15, 2009 patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 1.943."

APPLICABLE RULE(S)

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.

DECISION

On an even date herewith, the Office issued a decision granting patent owner's petition under § 1.182 petition, therefore reopening prosecution in the '244 proceeding. The February 27, 2009 response will be entered by the Central Reexamination Unit, and will then be considered by the examiner. These papers are being treated as a response by patent owner received **after** a first Office action.

Since prosecution has been reopened, the claims in the proceeding are not under final rejection. Pursuant to 35 U.S.C. 134, the proceeding is not ripe for appeal by the patent owner. Therefore, consideration of patent owner's petition for waiver of the prohibition against filing new affidavits or evidence under 37 CFR 41.67(c)(2) would not be appropriate at this time. The instant petition under 37 CFR 1.183 is thus dismissed as moot. Should patent owner, at some future date, refile an appeal to the Board of Patent Appeals and Interferences, the fee for the appeal need not be paid again, as set forth in 35 U.S.C. 134(b). Patent owner retains the option of filing a renewed petition under 37 CFR 1.183, if at some future date relief a situation requiring waiver of 37 CFR 41.67(c)(2) arises. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183.

CONCLUSION

- The petition is **dismissed as moot**.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700 or in his absence, to Pinchus M. Laufer, at (571) 272-7726.

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

August 3, 2009

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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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HARNESS, DICKEY, & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

(For Patent Owner)

MAILED

AUG 06 2009

CENTRAL REEXAMINATION UNIT

JAMES W, MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

(For Requester)

In re Bednar et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,244
Filed: April 26, 2007
For: U.S. Patent No.: 6,336,312

DECISION
DISMISSING PETITION
TO WAIVE 37 CFR 1.943
UNDER 1.183

This is a decision on the July 15, 2009 patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 1.943," requesting waiver of the page limit requirement to permit a 55 page Appeal Brief. The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of $400.00 under 37 CFR 1.17(f) has been charged to deposit account 07-1700, as authorized at page 1 of the instant petition.

The petition is **dismissed as moot**.

BACKGROUND

1. On April 26, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,244 ("the '244 proceeding").

2. On July 16, 2007, *inter partes* reexamination was ordered for the '244 proceeding. On the same day, a non-final Office action was mailed in the '244 proceeding.

3. On October 16, 2007, the patent owner filed a response to the non-final Office action, including proposed new claims 28-36. The third party requester filed comments, including proposed rejections for the new claims, on November 15, 2007.

4. On February 29, 2008, the patent owner filed an information disclosure statement.

5. On May 27, 2008, the Office issued an Action Closing Prosecution (ACP) which addressed the patent owner's response and the third party comments. The ACP essentially continued to adopt the same grounds of rejections as set forth in the July 16, 2007 Office action, and adopted the new proposed rejection based upon prior art as proposed by the third party requester, and set forth new rejections under 35 USC 112 for the proposed new claims.

6. On June 27, 2008, patent owner filed remarks and a proposed amendment to proposed new claims 28-36. Third party requester filed comments on July 28, 2008.

7. On January 27, 2009, the Office issued a Right of Appeal Notice (RAN) in which it was stated that the proposed amendment of June 27, 2008 would not be entered.

8. On February 27, 2009, patent owner filed a Notice of Appeal.

9. On February 27, 2009, patent owner filed an unsigned petition under 37 C.F.R 1.181, entitled "Petition Under 37 CFR 1.181 – Request to Enter Amendments After Action Closing Prosecution and to Re-open Prosecution."

10. On February 27, 2009, patent owner filed a petition under 37 C.F.R 1.182, entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination," requesting entry of certain amendments filed with the petition.

11. On February 27, 2009, patent owner filed a petition under 37 C.F.R 1.183, entitled "Petition Under 37 C.F.R. § 1.183 – Request for a Waiver of the Prohibition of an Extension of Time for Filing an Appeal Brief and a Request for an Extension of Time for Filing an Appeal Brief."

12. On March 10, 2009, third party requester filed comments in opposition to patent owner's petitions under 37 C.F.R. 1.181 and 1.182.

13. On April 14, 2009, a Notice for Defective Notice of Appeal was issued.

14. On April 15, 2009, the Office issued a decision dismissing patent owner's petition under 37 C.F.R. 1.181, as resubmitted with a proper signature on April 1, 2009.

15. On May 13, 2009, patent owner filed a corrected Notice of Appeal.

16. On July 15, 2009, the Office issued a decision granting patent owner's petition under 37 CFR 1.183, extending the period for response set forth in 37 CFR 41.66 for 45 days.

17. On July 15, 2009, the Office received the instant patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 1.943," requesting waiver of the page limit requirement to permit a 55 page Appeal Brief, and additionally, a patent

owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 41.67(c)(2), requesting waiver of the prohibition against filing new affidavits or evidence concurrently with an Appeal Brief.

18. On an even date herewith, the Office issued a decision granting the February 27, 2009 patent owner petition under 37 C.F.R 1.182, entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination," and issued a decision dismissing as moot the July 15, 2009 patent owner petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 41.67(c)(2)."

APPLICABLE RULE(S)

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.

DECISION

On an even date herewith, the Office issued a decision granting patent owner's petition under § 1.182 petition, therefore reopening prosecution in the '244 proceeding. The February 27, 2009 response will be entered by the Central Reexamination Unit, and will then be considered by the examiner. These papers are being treated as a response by patent owner received **after** a first Office action.

Since prosecution has been reopened, the claims in the proceeding are not under final rejection. Pursuant to 35 U.S.C. 134, the proceeding is not ripe for appeal by the patent owner. Therefore, consideration of patent owner's petition for waiver of the page limit requirements under 37 CFR 1.943 would not be appropriate at this time. The instant petition under 37 CFR 1.183 is thus dismissed as moot. Should patent owner, at some future date, refile an appeal to the Board of Patent Appeals and Interferences, the fee for the appeal need not be paid again, as set forth in 35 U.S.C. 134(b). Patent owner retains the option of filing a renewed petition under 37 CFR 1.183, if at some future date a situation requiring waiver of 37 CFR 1.943 arises. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183.

CONCLUSION

- The petition is **dismissed as moot**.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700 or in his absence, to Pinchus M. Laufer, at (571) 272-7726.

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

August 3, 2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 11/04/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JAMES W. MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
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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P.O. Box 1450
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In re Application of 6,336,312
Appl. No.: 95/000,244
Filed: April 26, 2007
For: Gang-type Rotary Lawn Mower With Multiple Rear Rollers

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed February 29, 2008, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until conclusion of the reexamination proceedings and the mailing of the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that documents under tabs 93-104 and 161-205 contained in boxes 2-6 of the Information Disclosure Statement filed February 29, 2008, be expunged from the record. Petitioner states that the information contains trade secret material, proprietary material and/or material that is subject to a protective order dated February 26, 2006 issued in Civil Action No. 05-486 (GMS) by the United States District Court for the District of Delaware, which material has not been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

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

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(For Patent Owner)

MAILED

APR 29 2010

JAMES W, MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

(For Requester) CENTRAL REEXAMINATION UNIT

In re Bednar *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,244
Filed: April 26, 2007
For: U.S. Patent No.: 6,336,312

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the January 4, 2010 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 FOR RELIEF NOT OTHERWISE PROVIDED FOR UNDER THE RULES – TO WITHDRAW FINALITY OF AN ACTION CLOSING PROSECUTION," requesting entry and consideration of evidence in the form of two affidavits.

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

The petition is **dismissed as moot**.

BACKGROUND

1. On April 26, 2007, a request for *inter partes* reexamination was filed by the third party requester. The request was assigned *inter partes* reexamination control number 95/000,244 ("the '244 proceeding").

2. On July 16, 2007, *inter partes* reexamination was ordered for the '244 proceeding. On the same day, a non-final Office action was mailed in the '244 proceeding.

3. On October 16, 2007, patent owner filed a response to the non-final Office action, including new claims 28-36.

4. On November 15, 2007, third party requester filed comments, including proposed rejections of new claims 28-36.

5. On May 27, 2008, the Office issued an Action Closing Prosecution (ACP), which addressed patent owner's response and the third party requester's comments.

6. On June 27, 2008, patent owner filed remarks and a proposed amendment to proposed new claims 28-36.

7. On July 28, 2008, third party requester filed comments.

8. On January 27, 2009, the Office issued a Right of Appeal Notice (RAN) which stated that patent owner's proposed amendment of June 27, 2008 would not be entered.

9. On February 27, 2009, patent owner filed a Notice of Appeal and three petitions: (1) a petition under 37 C.F.R 1.181, entitled "Petition Under 37 C.F.R. 1.181 – Request to Enter Amendments After Action Closing Prosecution and to Re-open Prosecution," which was unsigned; (2) a petition under 37 C.F.R 1.182, entitled "Petition Under 37 C.F.R. §1.182 for Relief Not Otherwise Provided For Under the Rules – Request for Continued Reexamination," requesting entry of certain amendments filed with the petition; and (3) a petition under 37 C.F.R 1.183, entitled "Petition Under 37 C.F.R. § 1.183 – Request for a Waiver of the Prohibition of an Extension of Time for Filing an Appeal Brief and a Request for an Extension of Time for Filing an Appeal Brief."

10. On March 10, 2009, third party requester filed comments in opposition to patent owner's petitions under 37 CFR. 1.181 and 1.182.

11. On April 1, 2009, patent owner resubmitted the February 27, 2009 petition filed under 37 CFR 1.181 with a signature.

12. On April 14, 2009, the Office issued a Notice for Defective Notice of Appeal.

13. On April 15, 2009, the Office issued a decision dismissing patent owner's February 27, 2009 petition under 37 C.F.R. 1.181, as resubmitted with a proper signature on April 1, 2009.

14. On May 13, 2009, patent owner responded to the April 14, 2009 Office Notice of Defective Notice of Appeal, filing a corrected Notice of Appeal.

15. On July 15, 2009, the Office issued a decision granting patent owner's February 27, 2009 petition under 37 CFR 1.183, extending the period for response set forth in 37 CFR 41.66 by 45 days.

16. On July 15, 2009, the Office received two patent owner petitions, a first petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 1.943," requesting waiver of the page limit requirement to permit a 55 page Appeal Brief, and a second petition entitled "Petition Under 37 CFR 1.183 to Suspend Requirement of 37 CFR 41.67(c)(2), requesting waiver of the prohibition against filing new affidavits or evidence concurrently with an Appeal Brief.

17. On August 6, 2009, the Office granted patent owner's February 27, 2009 petition under 37 CFR 1.182 granting the request to enter certain amendments filed with the petition after ACP and continue reexamination.

18. Also on August 6, 2009 the Office issued two decisions dismissing as moot the two July 15, 2009 patent owner petitions in light of the decision granting patent owner's February 27, 2009 petition under 37 CFR 1.182.

19. On September 8, 2009, third party requester filed comments in response to patent owner's amendment entered by the August 6, 2009 petition decision grant.

20. On November 4, 2009, the Office issued a new Action Closing Prosecution (ACP), which addressed patent owner's response and third party requester's comments.

21. On November 19, 2009, patent owner filed a petition under 37 CFR 1.956 requesting a one month extension of time to respond to the November 4, 2009 ACP.

22. On November 24, 2009, the Office granted patent owner's November 19, 2009 extension of time setting the time period for response to run an additional month until January 4, 2009.

23. On January 4, 2010, patent owner filed a response to the November 4, 2009 ACP, which included two affidavits. Patent owner concurrently filed the instant petition entitled "PETITION UNDER 37 CFR 1.182 FOR RELIEF NOT OTHERWISE PROVIDED FOR UNDER THE RULES – TO WITHDRAW FINALITY OF AN ACTION CLOSING PROSECUTION," requesting entry and consideration of the two affidavits.

24. On February 2, 2010, third party requester filed comments in response to patent owner's January 4, 2010 comments.

25. On even date with this decision the Office issued a Right of Appeal Notice, entering and considering the two affidavits submitted with patent owner's January 4, 2010 comments.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

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 2665 provides (in part):

> Affidavits submitted after an ACP are subject to the same treatment as amendments submitted after an ACP. This is analogous to the treatment of affidavits submitted after a final rejection in an application. *See In re Affidavit Filed After Final Rejection*, 152 USPQ 292, 1966 C.D. 53 (Comm'r Pat. 1966).

DECISION

The January 4, 2010 patent owner petition is filed under 37 CFR 1.182 requesting entry and consideration of evidence in the form of two affidavits under 37 CFR 1.132 submitted on January 4, 2010. As of the time of filing the petition under 37 CFR 1.182, the Office had not yet rendered a decision on the entry of the patent owner submission. The patent owner submission has been addressed by the Central Reexamination Unit as a response under 37 CFR 1.951(a), as on even date with this decision a RAN has issued entering and considering the two affidavits patent owner filed on January 4, 2010. Since the Office has entered and considered the two affidavits, the request for continuation of prosecution is rendered moot.

Accordingly, the petition is **dismissed as moot.**

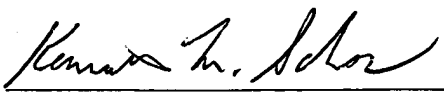
CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed as moot.

2. Prosecution is not being reopened by this decision

3. Jurisdiction is being returned to the Central Reexamination Unit.

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



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

Kenpet8 April 28, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,245	04/26/2007	6,336,311	26.0.3.235/B	9126

27572 7590 01/04/2008

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/04/2008

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

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Harness, Dickey & Pierce, PLC (For Patent Owner)
PO Box 828
Bloomfield Hills, MI 48303

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JAN 0 4 2008

CENTRAL REEXAMINATION UNIT

James W. Miller (For Requester)
527 Marquette Ave.
Suite 1960 Rand Tower
Minneapolis, MN 55402

In re Richard D. Bednar :
Reexamination Proceeding : DECISION DIMISSING
Control No.: 95/000,245 : PETITION UNDER
Filed: April 26, 2007 : 37 CFR 1.183
For: U.S. Patent No. 6,336,311 B1 :

This is a decision on the November 15, 2007 third party requester petition entitled "PETITION UNDER 37 CFR 1.183 TO WAIVE 37 CFR § 1.943." The petition requests waiver of the 37 CFR 1.943(b) requirements that written comments by the third party requester not exceed fifty (50) pages in length, to the extent that concurrently submitted comments exceed this fifty (50) page limit. On December 17, 2007, patent owner filed an opposition paper.

The petition and opposition paper are before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is dismissed.

The November 15, 2007 written comments by requester are being expunged from the record and requester is being granted 30 days (not-extendable) to re-submit comments, as discussed below.

REVIEW OF FACTS

1. U.S. Patent No. 6,336,311 (the '311 patent) issued on January 8, 2002.

2. A request for reexamination of the '311 patent was filed on April 26, 2007. The request was assigned control No. 95/000,245 (the '245 reexamination proceeding).

3. Reexamination was ordered for the '245 proceeding on July 16, 2007.

4. Also on July 16, 2007, a first Office action rejecting all of the patent claims was mailed. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On August 10, 2007, the patent owner filed a petition under 37 CFR 1.956 requesting thirty (30) day extension of time.

6. On August 15, 2007, the Office issued a decision granting patent owner's request for a thirty (30) day extension of time to respond to the July 16, 2007 Office Action.

7. On October 16, 2007, the patent owner filed a response that consisted of 51 pages of remarks, but where the final page consisted of only formal elements (fee payment and signature block). The response also added new claims 13-20.

8. On November 15, 2007, the third party requester submitted written comments consisting of 69 pages of remarks, but the final page consisted of only formal elements (signature block).

9. Concurrently with the November 15, 2007 response, the third party requester submitted the present petition, requesting a waiver of the fifty-page limit set forth by 37 CFR 1.943.

10. On December 17, 2007, patent owner filed a paper entitled "PETITION OPPOSING EXCESSIVE COMMENTS BY THIRD PARTY REQUESTER."

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.915(b) states (in part):

> (b) A request for *inter partes* reexamination must include the following parts:
>
> (1) An identification of the patent-by-patent number and every claim for which reexamination is requested.
>
> (2) A citation of the patents and printed publications, which are presented to provide a substantial new question of patentability.
>
> (3) 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.

37 CFR 1.939(a) states:

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

37 CFR 1.943 states (in part):

> (a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.
>
> (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.

MPEP § 2667(I), "Types of Papers Returned with Technology Center Director or Reexamination Legal Advisor Approval Required," provides, in pertinent part:

> "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."
>
> The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper third party requester submission will not be considered."

DISCUSSION

A. Patent Owner's Response Paper

On July 9, 2007, the Office issued a sixteen (16) page non-final Office action. The sixteen (16) pages consists of two pages of transmittal/party address information, an Office action summary page (PTOL-2064), nine pages of on the merits substantive matters related to the factual and legal issues of the instant case, and four pages of administrative/formal matters, e.g. form paragraphs regarding reexamination amendment practice, extension of time practice, notice practice, correspondence/contact information and examiner signature/conferee initialing. Thus, *in toto,* the entire sum of the substance of the July 9, 2007 Office action consisted of nine (9) pages of text.

B. Patent Owner's Response Paper

The patent owner paper filed, on October 16, 2007, a response to the Office action, complying with the length requirements as set by 37 CFR 1.943 which limits the response to 50 pages, but excludes amendments, appendices of claims and reference materials, i.e. submissions comprised of formal matters and submissions of evidence. See Item 7 of the Review of Facts above.

C. Third Party Requester's Written Comments

The third party requester's November 15, 2007 written comments includes sixty-nine pages of remarks, which are subject to the 50-page limit. The sixty-nine pages of requester remarks include a signature page; thus, the comments *per se* contain sixty-eight pages of written comments, and this exceeds the 50–page limit established by 37 CFR 1.943(b) by eighteen (18) pages. Third party requester asserts four separate arguments in the November 15, 2007 petition to justify exceeding the page limit by eighteen pages:

> 1) The July 9, 2007 Office action is exceedingly complex by employing fifteen separate grounds of rejections using a total of twenty-three references, six of which are "primary references," to reject twelve claims, causing third party requester to dedicate an inordinate portion of their fifty page limit to the "exceedingly complex" rejection pattern.
>
> 2) The patent owner comments, in response to the July 9, 2007 Office action, raises new issues in regards to the propriety of the prior art status of some of the

references utilized in the July 9, 2007 Office Action, causing third party requester to bring forward corroborating evidence and dedicate a portion of their fifty page limit to those newly raised issues.

3) The patent owner comments, in response to the July 9, 2007 Office action, points to objective evidence implicating non-obviousness, causing third party requester to dedicate a portion of their fifty page limit to rebut the objective evidence.

4) The patent owner's response to the July 9, 2007 Office action includes eight new claims, which third party requester must now dedicate a portion of their fifty page limit to analyze in regard to the United States' statutory patentability standards.

Each of requester's four arguments will be addressed below. Considering the equities, having to respond to patent owner's fifty (50) page rule compliant response, which added new claims 13-20, in addition to the July 9, 2007 Office action which consisted of nine (9) pages of substance, permitting a third party requester response of sixty-eight (68) pages of substance *does not* balance the equities between the parties in this *inter partes* proceeding. In this instance, exceeding the page limits of 37 CFR 1.943(b) by third party requester rather disturbs the equitable balance set by the length-limiting rule in light of the facts and circumstances of the instant case. Therefore, the third party requester comments will not be entered into the IFW record, and thus will not be reviewed as to their substance.

In general, the third party requester is advised to review and evaluate what is contained in the sixty eight (68) page remarks section submitted on November 15, 2007, and rearrange and clearly delineate what is administrative/formal elements from that which is substantive. For example, the "road map" section could easily be converted into a table of contents and combined with the caption data to remove two pages from the substantive page count. It is noted that neither the merits of the case, nor any of the legal issues/arguments presented by patent owner in their October 16, 2007, are found to be new and/or inordinately complex issues of patent law, but instead are found to be common issues of patent law that arise in many patent examination proceedings, e.g., anticipation, obviousness or availability of a reference to serve as prior art, etc.

Specifically, in response to third party requester's four enumerated arguments in regards to an assertion of a need for equitable relief, the following discussion is provided (arranged in numerical order relative to third party's four arguments in support of a page limit waiver):

Argument # 1:

The pattern of reference usage against the twelve claims is not found ***extraordinarily*** complex to the extent that justice compels a grant of equitable relief by waiver of the rule. The patent owner was faced with the same complexity of the Office action as was requester, and complied with the regulatory length requirement.

The examiner of record in the July 9, 2007 Office action adopted and incorporated by reference all the grounds for a substantial new question of patentability as proposed by the **third party requester** in its request for reexamination. Thus the sum and substance of the actual rejections and analysis is already on the record, the way requester wanted to present it. Third party requester need merely employ the same citation to the record methodology as employed by the examiner of record, and add comments deemed appropriate to address relevant patent owner

points, in order to efficiently identify the rejections and then present any relevant counter arguments.

Argument # 2:

The need for presentment of counterarguments regarding the propriety of a reference's status as prior art alone does not constitute an ***extraordinary*** situation for which justice compels a grant of equitable relief. There is no indication on the record that the patent owner has presented an extraordinary voluminous assertion in regards to the propriety of the references being eligible as prior art. The number of references involved is small, four (4), and the patent owner dedicated only a few pages (approximately four to five pages) to the issue. The third party requester is free to merely cite the record where these matters are raised and make counter arguments in regards to the issue of whether or not a reference constitutes prior art, again to make efficient use of the regulatory fifty (50) page limit.

In regards to the need to bring forward corroborating evidence to prove a given reference is available as prior art, such a submission, if directed purely to evidence, would not count against the submitting party, as it would be in an evidentiary appendix. Only legal commentary regarding the evidence would count as substantive remarks that would count against the fifty (50) page limit of 37 CFR 1.943(b). If there is a portion of the comments that is directed purely to "evidence" rather than opinion and argument based on such evidence, it would not be included in the page count; however, requester did not point to such.

Argument #3:

The need for presentment of counterarguments regarding the propriety of an evidentiary showing of secondary considerations alone does not constitute an ***extraordinary*** situation for which justice compels a grant of equitable relief. There is no indication on the record that the patent owner has presented an extraordinary voluminous showing of objective evidence for secondary considerations regarding obviousness. The patent owner's discussion of its submitted objective evidence consists of approximately fourteen pages. Third party requester is free to merely cite the record where these matters are raised, and, for each such citation, make counter arguments in regards to the issue of whether or not patent owner's position has merit, again to make efficient use of their fifty (50) page limit.

In regards to any need to bring forward objective evidence to prove to the contrary any assertions made by patent owner in regards to the objective evidence currently on the record, as is pointed out above, such a submission would not count against the submitting party, as it would be in an evidentiary appendix. Only legal commentary regarding the evidence would count as substantive remarks that would count against the fifty (50) page limit of 37 CFR 1.943(b).

Argument #4:

The need for presentment of arguments/proposed rejections regarding newly added claims 13-20, approximately one and a half of pages in length double spaced, and consisting of two new independent claims and six dependent claims, the addition of such a number and length of claims does not constitute an ***extraordinary*** situation for which justice compels a grant of equitable relief. *In toto*, only 18 claims are currently subject to reexamination, and the claims are not of such a voluminous nature as to create such a compelling need for a third party requester to address them in a manner that would require a waiver of the fifty (50) page length. Requester has not pointed out why an additional 18 pages are needed to deal with newly added claims 13-

20, more than two pages per claim, especially in light of the fact that requester used only approximately 9 pages to address the newly added claims on pages 58-67 of the November 15, 2007 response.

Finally, in addition to the above discussion that none of the above arguments individually make out an **extraordinary** basis for which justice would compel the requested equitable relief; a combination of all four arguments do not implicate an ***extraordinary*** situation for which justice compels a grant of equitable relief. All the above arguments cited by third party requester are the sum and substance of an ordinary and routine set of facts and circumstances of a *inter partes* reexamination for which the reexamination rules were written to govern. Accordingly, waiver of 37 CFR 1.943(b) 50-page limit to accept the third party requester's written comments of November 15, 2007 containing sixty-eight (68) pages of substantive remarks will not be provided. Therefore, the entire third party requester submission filed on November 15, 2007, is improper and is subject to return to the third party requester. See MPEP 2667, Part I.B.2. The copy of the November 15, 2007 submission was, however, scanned into the electronic Image File Wrapper (IFW) of the proceeding, before the discovery of the impropriety. Thus, the copy cannot be physically returned to the requester. Rather, the IFW copy of the paper is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

THIRD PARTY REQUESTER OPTIONS

For the reasons given above, waiver will not be provided for the November 15, 2007 comments by the third party requester, which exceed the 50-page limit established by 37 CFR 1.943(b). It is apparent, however, from the record that the third party requester's comments are a *bona fide* attempt to respond and to advance the prosecution.

Accordingly, the third party requester may, **within 30 days from the date of this notice**, exercise one of the following two options:

(1) Submit re-drafted written comments that do not exceed the 50 page limit of 37 CFR 1.943(b); or,

(2) File a copy of the original written comments, with pages redacted to satisfy the 50-page limit requirement of 37 CFR 1.943(b).

This 30-day period for reply is **not extendable**. Although MPEP 2667 Part I.B.2. provides for a 15-day period, 30 days is being given in this instance, in view of the need to reduce the comments by 18 pages.

Third party requester is reminded that under the requirements of 37 CFR 1.903, any paper submitted pursuant to this Notice must be served on the patent owner.

If no response from the third party requester is received, jurisdiction over the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments (and attachments) by the third party requester.

ADDITIONAL DISCUSSION

This decision is directed merely at the page-limit issue, and does not review the propriety of presentation of the new patents and printed publications. The Central Reexamination Unit (CRU) will review that matter, when jurisdiction over the proceeding is returned to the CRU. Please note the need for compliance with 37 CFR 1.948(a).

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is dismissed.

2. The November 15, 2007 third party requester paper is an improper paper and has not been considered as to its substance. The November 15, 2007 paper is being expunged by closing it in the '245 proceeding's Image File Wrapper (IFW) and marking it "non-public." The November 15, 2007 paper will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of public record.

4. The third party requester is granted a 30-day **non-extendable** time period to submit a response to this decision.

5. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers, at the point in time when 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 with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

Harness Dickey & Pierce, PLC
P.O. Box 828
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(For Patent Owner)

James W. Miller
527 Marquette Ave.
Suite 1960 Rand Tower
Minneapolis, MN 55402

(For Requester)

In re Textron Innovations Inc.
Reexamination Proceeding
Control No.: 95/000,245
Filed: April 26, 2007
For: U.S. Patent No. 6,336,311 B1

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR § 1.183
: AND PROVISONALLY
: SEALING PAPERS

This is a decision on the December 1, 2008 patent owner petition under 37 CFR 1.183 titled "PETITION UNDER 37 CFR § 1.183." The petition requests waiver of the provisions 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.

Summary: The petition is dismissed. The patent owner papers filed on December 1, 2008 are provisionally sealed.

Pursuant to 37 CFR 1.17(f), the petition fee for filing a petition under 37 CFR 1.183 is $400.00. Patent owner has included at page 3 of the present petition authority for the Office to charge the $400.00 fee to Deposit Account No. 50-4494.

SALIENT FACTS

1. U.S. Patent No. 6,336,311 (the '311 patent) issued on January 8, 2002.

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2. A request for reexamination of the '311 patent was deposited by a third party requester ("requester" on March 23, 2007, and was assigned control No. 95/000,245 ("the '245 reexamination proceeding").

3. On April 5, 2007, the Office mailed a Notice to requester identifying certain informalities in the March 23, 2007 request papers, and setting a time limit for correction of the informalities in order to receive a filing date for the '245 reexamination proceeding.

4. On April 26, 2007, requester filed a paper correcting the informalities, and a filing date of April 26, 2007 was granted for the request for reexamination.

5. Reexamination was ordered for the '245 reexamination proceeding on July 16, 2007, and the order was accompanied by a first Office action on claim patentability.

6. Prosecution has proceeded, and the Office has mailed a non-final Office action on October 1, 2008.

7. On December 1, 2008, the patent owner filed a response to the October 1, 2008 that exceeds the number of pages for such a response that is permitted by the provisions of 37 CFR 1.943, together with the present petition under 37 CFR 1.183 to waive those provisions.

RELEVANT AUTHORITY

37 CFR 1.181 provides:

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

37 CFR § 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I)(A)(2) provides, in part:

Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:

(A)Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B)File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

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.

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).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count. [Emphasis added.]

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 December 1, 2008. The basis for the request is that the October 1, 2008 Office action is sixty-seven (67) pages in length. Patent owner requests that the provisions of 37 CFR 1.943(b) be waived to the extent that patent owner be permitted to file a response that is sixty-three (63) pages in length.

A review of the response filed by patent owner on December 1, 2008 shows that it facially includes far more than sixty-three pages (63) pages, because at least one of the affidavit documents (the Supplemental Declaration of Richard B. Troxel) contains arguments directed to overcoming an outstanding rejection) and the claim charts applying the prior art to claims (Exhibit A attached in the response) also contain arguments directed to claim patentability. As discussed in MPEP § 2667(I)(A)(2), claim charts and affidavits or declarations that include any argument directed at claim patentability are counted against the page limitations imposed by 37 CFR 1.943(b).

Based on the foregoing reasons, there is no basis for granting the relief requested by patent owner, since the patent owner's response far exceeds the sixty-three (63) pages that are requested via waiver of the provisions of 37 CFR 1.943(b). Instead, patent owner's entire December 1, 2008 response is being provisionally sealed, pending the filing by patent owner of:

1. Redacted versions of the papers filed on December 1, 2008 that will to limit the number of pages presented that discuss claim patentability to sixty-three (63) pages; or

2. A renewed 37 CFR 1.183 petition requesting waiver of the provisions of 37 CFR 1.943(b) to permit a response including the number of pages in the present response together with the number of pages in every submitted declaration that contains argument directed to claim patentability and the number of pages of declarations submitted that contain argument requesting claim patentability; or

3. A renewed petition requesting waiver of 37 CFR 1.943(b) to provide for a patent response of a given number of pages, together with redacted or completely new papers that provide for not more than that number of pages.

Patent owner must, when choosing an option, identify with specificity the precise documents to be permanently sealed and replaced by either redacted versions of papers that have been filed on December 1, 2008, or by entirely new papers. Further, patent owner must point out why it is in the interest of justice that the provisions of 37 CFR 1.943 (b) be waive to provide the number of requested pages for which waiver is sought. Merely pointing to the number of pages in the outstanding Office action may provide some basis for increasing the number of pages in patent owner's response, but patent owner must also justify why the specifically requested number of pages is necessary and will not involve cumulative or repetitious arguments directed to the outstanding Office action

As discussed in MPEP § 2667, patent owner is required to make its submission within **FIFTEEN (15) DAYS** of the mailing date of the present decision. The December 1, 2008 patent owner papers are being provisionally sealed by being marked as "closed" and "non-public" in the electronic Image File Wrapper (IFW). If patent owner files a response to this decision, 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 as modified to conform to this decision, **within THIRY (30) DAYS from the date of service of the patent owner's response to the present decision.**

ADDITIONAL DISCUSSION

It is also noted that patent owner has submitted the transcript of a videotaped deposition of Kevin Tomas Conry conducted on Wednesday, November 1, 2006 and the transcript of a videotaped deposition of Chad Moe conducted on Thursday, October 19, 2006. Both transcripts are labeled as being "Confidential – Attorney Eyes Only" documents from litigation in the United States District Court for the District of Delaware in litigation. That litigation is styled as Textron Innovations Inc., Plaintiff vs. The Toro Company Defendant (CA No. 05-486(GMS).

Any response filed to the present decision **must** include an explanation of the basis for filing documents marked as confidential in litigation, and, if the documents are to not be expunged from the record as documents filed in violation of a court order of confidentiality, any document from that litigation that authorizes the submission of those confidential documents in the publicly accessible '245 reexamination proceeding. Otherwise, the documents will be expunged from the record.

Further, if patent owner does demonstrate that patent owner is permitted to file those documents in the publicly available '245 reexamination proceeding, patent owner must inspect those voluminous submissions. If **any** information therein argues for claim patentability with respect to overcoming prior art being relied on in the '245 reexamination proceeding to defeat claim patentability, patent owner must either identify those pages and include such pages in the page count for which waiver is sought, or provide redacted versions of the transcript(s) pages in which such arguments occur. Patent owner must then file together with a response to the present petition a separate petition to expunge these transcript materials from the record in the event that the examiner does not find them to be material to claim patentability. See MPEP 724 *et seq.*

CONCLUSION

1. The present patent owner petition under 37 CFR 1.183 is dismissed.

2. Patent owner is provided with a period of **FIFTEEN (15) DAYS** from the date of this decision to:

   a. File redacted versions of the papers filed on December 1, 2008 to properly limit the number of pages of the response to sixty-three (63) pages; or, to

   b. File a renewed petition requesting waiver of 37 CFR 1.943(b) to provide the actual number of pages of argument presently of record; or to

   c. File a renewed petition requesting waiver of 37 CFR 1.943(b) to a given number of pages together with redacted and/or replacement papers limited to that given number of pages.

3. Patent owner must also demonstrate its authority to have filed papers marked as "Confidential-Attorney Eyes Only" in litigation proceedings, redact those papers as may be appropriate with respect to arguments for claim patentability, and if patent owner does demonstrate that it is authorized to file those papers, file a separate petition to expunge those papers if they are determined by the examiner to not be material to patentability.

4. Pending a response to this decision by patent owner, the December 1, 2008 papers filed by patent owner are being provisionally sealed by being marked as "closed" and "non-public" in the IFW.

5. Requester will have a period of **THIRTY (30) DAYS** from the date of service of any patent owner response to the present petition in which to take such action as it deems appropriate under the provisions of 37 CFR 1.947.

6. Jurisdiction over the '245 reexamination proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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.

7. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Senior Legal Advisor, Office of Patent Legal Administration, 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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MINNEAPOLIS, MN 55402

In re Richard D. Bednar
Inter Partes Reexamination Proceeding
Control No. 95/000,245
Filed: April 26, 2007
For: U.S. Patent No. 6,336,311

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 CFR 1.183**
: **FOR WAIVER OF**
: **37 CFR 1.943(c)**

This is a decision on the patent owner petition filed February 4, 2010 entitled "PETITION UNDER 37 CFR § 1.183."

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

The patent owner's February 4, 2010 petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.183 was charged to patent owner's deposit account on February 23, 2010.

BACKGROUND

1. On January 8, 2002, U.S. Patent No. 6,336,311 ("the '311 patent") issued to Richard D. Bednar.

2. On April 26, 2007, a corrected request for *inter partes* reexamination of the '311 patent was deposited by a third party requester, which request was assigned control number 95/000,245 ("the '245 proceeding") and granted a filing date of April 26, 2007.

3. On July 16, 2007, an order granting *inter partes* reexamination in the '245 proceeding was mailed.

4. The '245 proceeding progressed to the point where, on November 5, 2009, a Right of Appeal Notice (RAN) was mailed.

5. On December 4, 2009, patent owner filed a Notice of Appeal in the '245 proceeding.

6. On February 4, 2010, patent owner filed an appeal brief in the '245 proceeding.

7. Concurrently, on February 4, 2010, patent owner filed the instant "PETITION UNDER 37 CFR § 1.183" ("the petition under 37 CFR 1.183") requesting waiver of 37 CFR 1.943(c) for patent owner's concurrently-filed appeal brief.

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.

37 CFR 41.67 provides, in-part:

> ****
>
> (c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.
>
> ****
>
> (ix) *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 appellant 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 brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

****

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

MPEP § 2667 I.A.2 provides, in-part:

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). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

DECISION

I. Patent Owner Petition of February 4, 2010

On February 4, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with an appeal brief. In the petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(c) for entry of the February 4, 2010 appeal brief, which patent owner asserts exceeds

the 30-page limit of 37 CFR 1.943(c) by 6 pages.[1] Patent owner asserts that the appeal brief comprises a total of 42 pages, only 36 pages of which include argument that count toward the page limit.[2] In the petition, patent owner also requests waiver of 37 CFR 1.943(c) for entry of Exhibits 54-56 of the Evidence Appendix to the February 4, 2010 appeal brief, in the event these portions of the Evidence Appendix are deemed to count toward the page limit.[3]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

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. Patent owner asserts that it "has exercised considerable restraint in limiting its Response to this 63-page RAN. For example, because of Patent Owner's desire to conclude these reexamination proceedings as expeditiously as possible, Patent Owner does not appeal the rejections of claim 1. Additionally, in the Appeal Brief, Patent Owner incorporates by reference, instead of repeating, several arguments relating to the prior art rejections where those arguments were made in previous papers of record."[4]

Further in support of its request for waiver of 37 CFR 1.943(c), patent owner has substantiated its request with specific facts regarding the November 5, 2009 RAN. In particular, patent owner asserts that that RAN is 63 pages and "incorporates by reference detailed rejections made in previous papers by both the Examiner and the Requester."[5] Patent owner also asserts that "[b]eyond rejections under 35 U.S.C. §§ 102, 103 and 112, the Office Action addresses issues related to dates and corroboration of alleged prior art documents, substantial amounts of secondary indicia of nonobviousness offered by Patent Owner and counter-arguments offered by Requester, declarations of numerous experts, and new matter, among other issues."[6] Patent owner also asserts that "[t]he RAN enumerates 24 prior art 'grounds' of rejections covering eighteen claims," that "[e]ach ground of rejection combines as many as five, six, and up to 10 documents in order to establish the rejection," and that "many of the grounds of rejections advanced in the Office Action rely on a multitude of documents 'lumped' together ambiguously, in which each document apparently is applied separately and individually, although the Office Action does not make this clear."[7] Finally, patent owner asserts that the RAN incorporates by reference pages from the April 26, 2007 request for *inter partes* reexamination "which totals 84 pages, including claim charts."[8]

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[1] Petition under 37 CFR 1.183 at page 3.
[2] Id. at page 1.
[3] Id. at page 2.
[4] Id.
[5] Id.
[6] Id.
[7] Id.
[8] Id.

II. Analysis and Findings

1. Determining Page Length of Appeal Brief Submission

As noted in MPEP 2667(I)(A)(2), the provisions of 37 CFR 1.943(c) have been waived to the extent that certain content, including that of the table of contents pages, table of case law pages, and the pages of the claims, is not counted toward the 30-page limit of the appeal brief. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's brief required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[9] are deemed to be included in "reference materials" that do not count toward the page limit. However, if any portion of the relevant section includes material that goes beyond that which is required by those regulatory sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

2. Format Requirement for Appeal Brief Submission with Request for Page Limit Waiver

To obtain a waiver of the 30-page length requirement of 37 CFR 1.943(c), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner appeal brief submission that:

1) is double-spaced or one and a half-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In this instance, patent owner's February 4, 2010 appeal brief does not satisfy the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c). The February 4, 2010 appeal brief appears to be single-spaced and with a font size of less than 12-point. Thus, when formatted for readability and reproducibility in accordance with the guidelines set forth above, patent owner's appeal brief will exceed the 30-page limit of 37 CFR 1.943(c) by more than 6 pages. Moreover, pages 1-39 of the February 4, 2010 appeal brief count toward the page limit pursuant to the guidance set forth herein in section II.1.[10]

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[9] *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 37 CFR 41.67(c)(1)(viii) *Claims Appendix* is already explicitly identified in 37 CFR 1.943(c) as being excluded from the page count.

[10] The *Summary of Claimed Subject Matter* and the *Issues to be Reviewed on Appeal* sections are included in the page limit count. It is noted that the *Summary of Claimed Subject Matter* section also includes 11 additional pages submitted in an attachment to appeal brief.

3. Content Requirements for Evidence Appendix

The Evidence Appendix required in 37 CFR 41.67(c)(1)(ix) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection. The appendix must include a statement where the evidence was entered into the record. The evidence appendix should not include copies of the patent under reexamination, copies of Office actions in related cases or copies of prior art references. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits. Reference to unentered evidence is not permitted in the brief.

In this instance, patent owner did not include a statement as to where the evidence submitted in the Evidence Appendix was previously entered into the record of the '245 proceeding. Further, the Evidence Appendix appears to include information that goes beyond evidence that which was entered into the record in accordance with the rule. For example, Exhibit 1 ("Statement of Facts Patent Owner's Appeal Brief") and Exhibit 2 ("Timeline of Events") do not appear to be evidence that has been entered into the record of the '245 proceeding pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection pursuant to the rule. Additionally, Exhibits 54-56 are copies of patent owner responses previously made of record in the '245 proceeding. While patent owner properly incorporates by reference, instead of repeating in the appeal brief, arguments that were made in these previous papers of record, it is not necessary for patent owner to submit copies of these papers that are already of record in the '245 proceeding.[11] Thus, all of these items may be counted toward the page limit if resubmitted.

Further, it is noted that prior art references should be identified and made of record through a listing of patents and printed publications as provided for in 37 CFR 1.98. *See* MPEP 2657. It is not necessary or desirable to file duplicate copies of references and Office actions with the appeal brief.

4. Decision

In this instance, the February 4, 2010 patent owner appeal brief does not satisfy the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c). Moreover, Exhibits 54-56 are copies of patent owner responses previously made of record in the '245 proceeding and are not required to be submitted as part of the Evidence Appendix in the appeal brief. Even further, the brief goes beyond evidence that which was entered into the record. Because submission of such papers is unnecessary (and in one instance, inappropriate), waiver of the 30-page limit of 37 CFR 1.943(c) to accommodate the submission of such papers is not warranted in this instance. Accordingly, for all of these reasons, patent owner's February 4, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is dismissed.

Additionally, the February 4, 2010 patent owner appeal brief is an improper paper because the Evidence Appendix does not include a statement identifying where the information submitted

[11] *See* petition under 37 CFR 1.183 at page 2.

therein was previously entered into the record of the '245 proceeding and (as pointed out in the previous paragraph) includes information that goes beyond that which is permitted to be submitted in the Evidence Appendix pursuant to 37 CFR 41.67(c)(1)(ix). Accordingly, patent owner's February 4, 2010 appeal brief submission is an improper paper, and as such, is being expunged from the image file wrapper (IFW) of the '245 proceeding by marking the papers "closed" and "not public."

Pursuant to 37 CFR 41.67(d), patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file either (a) a new brief in compliance with the regulations, or (b) a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) with an appeal brief submission that complies with the formatting guidelines set forth herein and with the Evidence Appendix requirements of 37 CFR 41.67(c)(1)(ix); patent owner's February 4, 2010 appeal brief submission will be deemed defective and will not be considered. The time for filing an appeal brief may not be extended. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c), no additional fee need be submitted.

CONCLUSION

1. Patent owner's February 4, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) for patent owner's concurrently-filed appeal brief is dismissed.

2. Pursuant to 37 CFR 41.67(d), patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file either (a) a new brief in compliance with the regulations, or (b) a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) with an appeal brief submission that complies with the formatting guidelines set forth in this decision and with the Evidence Appendix requirements of 37 CFR 41.67(c)(1)(ix); otherwise, patent owner's February 4, 2010 appeal brief submission will be deemed defective and will not be considered. The time for filing an appeal brief may not be extended.

3. The February 4, 2010 appeal brief submission is an improper paper, and it is being expunged from the IFW of the '245 proceeding by marking the papers "closed" and "not public."

4. Jurisdiction for the '245 proceeding is being returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

5/25/10
KenAppeal/length

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(For Patent Owner)

MAILED

JUN 28 2007

CENTRAL REEXAMINATION UNIT

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2020 Main Street
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(For Third Party Requester)

In re Semiconductor Energy Laboratory Co, Ltd.
Inter Partes Reexamination Proceeding
Control No. 95/000,246
Filed: M arch 22, 2007
For: U.S. Patent No. 6,756,258

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the May 24, 2007 patent owner petition entitled "RESUBMISSION AND RENEWAL OF PETITION TO DISMISS OR STAY REQUEST FOR AN INTER PARTES REEXAMINATION AND EXHIBITS," (hereinafter "the renewed petition"). In addition, third party requester filed a paper on June 7, 2007 entitled 'REQUESTER'S OPPOSITION TO PATENT OWNER'S "RENEWED" PETITION TO DISMISS OR STAY REQUEST FOR *INTER PARTES* REEXAMINATION" (hereinafter "the opposition paper").

The renewed petition, the opposition paper, and *inter partes* reexamination control number 95/000,246 are before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the patent owner petition is granted to the extent that the petition has been considered, but is dismissed with respect to granting the relief requested.

FEES

The patent owner renewed petition is taken as a petition under 37 CFR 1.182 because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be dismissed or stayed. The renewed petition is also taken as a petition under 37 CFR 1.183 to waive the provisions 37 CFR 1.939. A single petition fee of $400.00 is required for the renewed petition, and is being charged to Deposit Account No. 50-2280 as authorized by petitioner patent owner. [1,2]

[1] 37 CFR 1.182 and 1.183 each require a petition fee as set forth in 37 CFR 1.17(f). Effective October 16, 2006, the fee pursuant to 37 CFR 1.17(f) is $400.00.

[2] See patent owner's Renewed Petition, paragraph bridging pages 1 and 2.

The third party requester opposition paper also requires a waiver of the provisions of 37 CFR 1.939. Accordingly, a $400.00 petition fee is being charged to Deposit Account No. 08-3038 as authorized by third party requester. [3]

REVIEW OF FACTS

1. U.S. patent No. 6,756,258 ("the '258 patent") issued to Hongyong Zhang *et al* on June 29, 2004, and is currently assigned to Semiconductor Energy Laboratory Co., Inc. ("SEL").

2. A request for *inter partes* reexamination of the '258 patent was filed on March 22, 2007, by Chi Mei Optoelectronics Corp., ("CMC"), an entity that identified itself in the request as the third party requester, and the request was assigned control number 95/000,246 ("the '246 *inter partes* reexamination proceeding").

3. On April 9, 2007, patent owner SEL filed a petition entitled "PETITION TO DISMISS OR STAY REQUEST FOR AN *INTER PARTES* REEXAMINATION."

4. On April 23, 2007, third party requester CMC filed a paper entitled "REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO DISMISS OR STAY REQUEST FOR INTER PARTES REEXAMINATION," ("the opposition paper")"

5. On May 7, 2007, patent owner filed a reply to the April 23, 2007 third party requester opposition paper.

6. On May 15, 2007, third party requester filed a paper in response to the May 7, 2007, patent owner reply paper.

7. Also on May 15, 2007, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '246 *inter partes* proceeding. The notice assigned the filing date of 03/22/2007, (*i.e.*, March 22, 2007), to the request for reexamination.

8. On May 16, 2007, the Office mailed a paper entitled "Decision Discarding Improper Papers,"("Decision"), in which it was stated that inasmuch as no petition fee had been tendered and a filing date had not yet been granted for the request for *inter partes* reexamination deposited on March 22, 2007 at the time the petition was filed, the April 9, 2007 patent owner petition was an improper paper.

9. The May 16, 2007 Decision also held that the April 23, 2007 third party opposition paper was an improper paper because it, too, was filed prior to the granting of a filing date for the '246 *inter partes* reexamination proceedings.

10. The May 16, 2007 Decision further held that the April 9, 2007 patent owner petition and the April 23, 2007 third party requester opposition would not be considered, would not be entered into the Image File wrapper (IFW) filed record, and would be "returned" to the parties. [4,5]

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[3] See third party requester's Opposition, at page 1.

[4] It appears that the papers mentioned in Facts 5 and 6 were not present in the IFW file record when the May 16, 2007 office Decision was mailed.

[5] Papers cannot be physically removed from an IFW file record. Therefore, "return" of the papers mentioned in Facts 3 and 4 was accomplished by marking the papers "closed" and "non-public."

11. On May 24, 2007, patent owner filed the present renewed petition, again seeking to have the '246 *inter partes* reexamination proceeding either dismissed or stayed.

12. An Order Granting *Inter Partes* Reexamination for all of the '258 patent claims, (*i.e.* claims 1-32), was mailed on June 5, 2007.

13. On June 7, 2007, third party requester filed an opposition to the May 24, 2007 patent owner renewed petition.

14. The '258 patent is currently the subject of litigation between patent owner and third party requester [6] styled *Semiconductor Energy Laboratory Co., Ltd. v. Chi Mei Optoelectronics Corp. et al.*, Case No. C 04 4675 MHP (N.D. Cal.).

15. A decision treating the papers listed in Facts 5 and 6 is being mailed concurrently with the present decision.

DECISION

I. Relevant Statute, Regulations, and Examining Procedure

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."

35 U.SC. § 317(b) provides:

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

37 CFR 1.987 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."

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[6] Third party requester CMC is also identified as being the real party in interest (35 U.S.C. § 317(b)). See page 202 of the Request for *Inter Partes* Reexamination, (page 212 of the 234 document in the IFW file record).

MPEP § 2686.04 ("Reexamination and Litigation Proceedings") provides, in pertinent part:

"III. Reexamination With Concurrent Litigation But Ordered Prior to Federal Court Decision

In view of the statutory mandate to make the determination on a request for reexamination within 3 months, the determination on the request based on the record before the examiner will be made without awaiting a decision by the Federal Court. It is not realistic to attempt to determine what issues will be treated by the Federal Court prior to the Court's decision. Accordingly, the determination on the request will be made without considering the issues allegedly before the Court. If reexamination is ordered, the reexamination generally (see discussion immediately below) will continue until the Office becomes aware that a court decision has issued. At such time, the request will be reviewed in accordance with the guidelines set forth below.

...

35 U.S.C. 314 provides for *inter partes* reexamination the clause, "[U]nless otherwise provided by the Director for good cause, " which clause is not present in 35 U.S.C. 305 for *ex parte* reexamination. Accordingly, where there is good cause for the Director of the USPTO to suspend (stay) reexamination proceedings pending the conclusion of litigation, a suspension will be effected. 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). In addition, see subsection V. below for the situation where there is pending litigation having the potential to terminate a reexamination prosecution under 35 U.S.C. 317(b).

...

V. Discussion of Affect of Litigation Where Requester Was a Party to Litigation

... the following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.

(A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims.

Where there are non-litigated claims for which reexamination had been requested in the inter partes reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).

(B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request.

If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued.

If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding
if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

(D) Is there a concurrent *ex parte* reexamination proceeding for the patent?

As stated in MPEP § 2286: "The issuance of a final Federal Court decision upholding validity during an ex parte 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." If there is a concurrent *ex parte* reexamination proceeding having overlapping issues with an *inter partes* reexamination proceeding where the estoppel has the potential to attach, but no final decision has been issued, then the Office may in some instances (depending on the individual facts and circumstances), to go forward with statutorily required "special dispatch" as per *Ethicon* in a merged proceeding containing both the inter partes reexamination and the *ex parte* reexamination. This is a matter of administrative convenience to avoid rework and make the process more efficient. Again, OPLA should be consulted.

(E) Some examples of where this estoppel issue was actually addressed by the Office.

In reexamination control numbers 95/000,093 and 95/000,094 (the '093 and '094 proceedings), action was suspended based on ongoing litigation. After a District Court decision adverse to requester, it was determined that "good cause" existed to wait for the outcome of the Federal Circuit appeal, because the reexamination proceedings were only at their beginning stages, while the concurrent litigation was potentially near its final resolution. It was noted that requester had chosen to permit the District Court litigation to proceed for three years before filing its requests for reexamination, the filing taking place only after judgment was entered in patent owner's favor in the litigation. Had requester filed its requests for reexamination earlier, the reexamination proceedings would 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 requester 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, requester was not in a position to complain that a suspension of the '093 and '094 reexamination proceedings would deprive requester of a chance to obtain the Office's decision, when there was a strong possibility that the Federal Circuit's decision would estop the Office from issuing any decision at all. In short, requester could not have it both ways. Requester 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 could in no way be affected by any decision on its reexamination requests. Requester's delay was the reason that the '093 and '094 reexaminations could very well be mooted before any reexamination decision issued and the USPTO Director found "good cause" to suspend the proceedings. Requester chose its route and had to deal with the consequences of its decision, i.e., a suspension of the reexamination proceedings.

On the other hand, see reexamination control numbers 95/000,020, 95/000,071 and 95/000,072, for decisions in which action was not suspended, because the specific facts dictated otherwise. [All emphasis in the original.]"

II. Patent Owner's Position

The present patent owner petition resubmits and renews the previously filed patent owner petition, which was returned to patent owner because it had been filed prior to the granting of a filing date for the '246 *inter partes* reexamination proceeding and did not include the requisite petition fee.

Patent owner's petition may be summarized as being based upon the following four factors, all of which are argued by patent owner to weigh in favor of staying or dismissing the present reexamination proceeding: [7]

1) The claims at issue in the *Semiconductor Energy* litigation mentioned in Fact 14 are the same claims at issue in the present *inter partes* reexamination proceeding;

2) The issues in the litigation are the same issues in the reexamination proceeding;

3) The *Semiconductor Energy* litigation is close to a final decision; and

4) There is no concurrent *ex parte* reexamination proceeding pending for the patent at issue in the present *inter partes* reexamination proceeding.

III. Third Party Requester's Position

Third party requester's petition raises three procedural challenges, [8] and also a substantive challenge, [9] to the patent owner's renewed petition.

The procedural issues raised by third party requester are:

1) The patent owner renewed petition should be summarily dismissed because it is precluded by 37 CFR 1.939;

2) Patent owner has failed to show extraordinary circumstances justifying a waiver of the regulations as required by 37 CFR 1.183; and

3) The patent owner petition fails to comply with 37 CFR 1.103(a) because the regulation is applicable to reexamination, and authorizes a suspension for good cause, and only for a period not to exceed six months.

Third party requester's substantive challenge is that patent owner has not shown "good cause" for suspension of the present *inter partes* reexamination proceeding.

IV. Analysis and Findings

35 U.S.C. § 314(c) requires that the USPTO Director conduct an *inter partes* proceeding with special dispatch, unless there exists "good cause" not to do so. Pursuant to Section 314(c), 37 CFR 1.987 provides that USPTO Director may determine whether to suspend an *inter*

[7] See Renewed Petition, at page5.
[8] See third party requester Opposition, items I-III, at pages 5 and 6, respectively.
[9] *Id.*, items IV, at page 7.

partes reexamination, in which the patent that is being reexamined is concurrently in litigation.

Initially, it is noted that patent owner has not advanced any grounds upon which the present '246 *inter partes* reexamination proceeding should be "dismissed." Patent owner has not asserted that the Order granting the request for *inter partes* reexamination was in any way improper (*e.g., ultra vires*). Therefore, the request to that effect must be summarily dismissed. The sole issue remaining for consideration is whether patent owner has established that there is good cause for suspension of the '246 *inter partes* reexamination proceeding in accordance with the provisions of 37 CFR 1.987.

The decision in *Sony Computer Entertainment America Inc., et al v. Jon W. Dudas,* No. 1:05cv1447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006), (hereinafter "*Sony*"), is instructive with respect to the question of whether good cause exists to support suspension of an *inter partes* reexamination proceeding. In *Sony,* the court reviewed the propriety of a decision by the Office to suspend two (related) *inter partes* reexamination proceedings in light of concurrent litigation involving the validity of the patents that were the subjects of the two proceedings. The court held, *inter alia,* that the 35 U.S.C. § 314 authorizes the USPTO Director to suspend an *inter partes* reexamination proceeding "for good cause," and that 37 CFR 1.987 was a proper exercise of the Director's rule making authority to the extent that concurrent litigation of a patent subject to an existing *inter partes* reexamination proceeding may provide good cause to suspend the *inter partes* reexamination proceeding. *Id.*, at *18.

The court analyzed the facts and circumstances that existed in the *Sony* situation, to determine whether the Office had properly found that good cause existed to suspend the two *inter partes* reexamination proceedings in question. The court recognized that while the *inter partes* reexamination statute provides for concurrent litigation and *inter partes* reexamination of the same patent, 35 U.S.C. §§ 315(c) and 317(b) also provide that the completion of one proceeding will estop the other parallel proceeding. *Id.*, at *19. The court held that in light of the fact that the litigation was at the stage in which the Court of Appeals for the Federal Circuit was about to decide an appeal, while the *inter partes* reexamination proceedings were just beginning, the suspension of the two *inter partes* reexamination proceedings was a proper exercise of the USPTO Director's discretion. *Id.*, at *20. This holding was rendered notwithstanding the possibility that a determination of the appeal by the Federal Circuit would not necessarily have amounted to a "final" decision, because the Director had correctly determined that, on balance, that possibility did not outweigh the factors favoring suspension. *Id.* The basis for the court's ratification of the position taken by the USPTO Director was that to decline to suspend the *inter partes* reexamination proceedings would have risked wasting Office resources, as well as wasting resources of the parties, to conduct administrative proceedings that could soon be mooted by the conclusion of the concurrent litigation. *Id.* The court further held that the Director has wide discretion with respect to *inter partes* reexamination, and may reexamine less than all of the patent claims after ordering *inter partes* reexamination. Thus, even if the litigation in *Sony* would result in a disposition of fewer than all of the patent claims that were the subject of the suspended *inter partes* reexamination proceedings, the reexamination proceedings could then have been resumed with respect to the remaining claims, in the event that the litigation was to be resumed at the District Court level. *Id.*, at *21-*37.

Third party requester correctly points out, and the record confirms, that unlike the circumstances that existed in *Sony*, [10] the litigation between patent owner and third party requester involving the instant '258 patent is in a relatively preliminary stage. The parties are presently awaiting a decision on summary judgment motions in the District Court. While it is true that the litigation is about two and one-half years old, the litigation is, nevertheless, only at the stage where trial is set *to begin* on June 26, 2007. If the summary judgment does not dispose of all issues, than a trial will commence. If a trial is necessary, or even if summary judgment were to be granted for all of the claims of the '258 patent that remain in the '246 *inter partes* reexamination proceeding, [11] there is a substantial likelihood that the litigation will not become "final" (so as to trigger the estoppel provisions of 35 U.S.C. § 317(b)) based upon the trial result or the summary judgment. Rather, post-judgment motions and/or post-trial motions would be available, and ultimately an appeal may be filed.

Thus, with respect to the four factors advanced by patent owner as favoring suspension of the present '246 *inter partes* reexamination proceeding by the Office, it is clear that, as argued by the third party requester, there is presently no "good cause" to dismiss or stay the '246 *inter partes* reexamination proceeding. Notwithstanding that the concurrent litigation has been on-going for two and one-half years, it is nevertheless not so near to conclusion as to make it likely that a final (*i.e.* non-appealable) decision in the litigation as to all of the '258 patent claims will be forthcoming in the near future. [12] Therefore, it is premature to suspend the '246 *inter partes* reexamination proceeding because it is unlikely that the estoppel provisions of the reexamination statute will apply to all of the '258 patent claims in the near future.

Aside from the timing issues, it is to be noted, that in *Sony*, the District Court had provided a decision for the patent owner, which was final for purposes of the District Court, and was subject to appeal in the Federal Circuit. Unlike the *Sony* scenario, in this instance, no judgment has been rendered by any tribunal in patent owner's favor, which would provide a substantial likelihood of patent owner's success.

None of the other three factors advanced by patent owner as a basis for establishing good cause to suspend the '246 *inter partes* reexamination proceeding is considered to provide a sufficient basis for suspending the '246 *inter partes* reexamination. Notwithstanding that 35 U.S.C. § 314(c) allows for suspension of an *inter partes* reexamination for good cause, the statute still requires that the Office treat *inter partes* reexamination proceedings with special dispatch *absent good cause for suspension*. Thus, even though identical claims are being reexamined and litigated, identical issues with respect to those claims are being raised in

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[10] In *Sony*, the two *inter partes* reexamination requests were filed after trial had been completed, on the day that Sony's post-verdict motions were denied. An appeal to the Court of Appeals for the Federal Circuit was thereafter filed within one month, and the Decision on Petition by which Office suspended the two *inter partes* reexamination proceedings was mailed five months later. *Sony*, at *4-*9.

[11] Claims 1, 2 16, 17 and 32 of the '258 patent have been disclaimed by patent owner, and a terminal disclaimer of patent claims 1-32 (sic) of the '258 patent has been filed. See Renewed Petition, paragraph bridging pages 9 and 10.

[12] The estoppel provisions of 35 U.S.C. § 317(b) appeal on a claim-by-claim basis, so that a decision in favor of the validity of fewer than all of the '258 patent claims would not oust the jurisdiction of the Office to conduct *inter* partes reexamination of the remaining patent claims for which reexamination has been ordered in the '246 *inter partes* reexamination proceeding.

reexamination and litigation, and no *ex parte* reexamination exists,[13] there is simply no good cause, at present, to suspend the '246 *inter partes* reexamination proceeding. These three factors do not change the fact that it is unlikely that the results of the concurrent litigation will be final (*i.e.*, non-appealable) in the foreseeable future so as to estop *inter partes* reexamination of all of the '258 patent claims. Patent owner remains free to renew a petition for an appropriate (*i.e.*, partial or complete) suspension of the '246 *inter partes* reexamination proceeding if circumstances change such that it appears likely that the provisions of 37 CFR 317(b) will be triggered with respect to some or all of the claims in the '246 *inter partes* reexamination proceeding substantially in advance of the termination of prosecution in the present '246 *inter partes* reexamination proceeding. In this regard, patent owner should also note the provisions of 37 CFR 1.985. Further, it is to be noted that any petition for suspension will be dismissed if there is an outstanding Office action requiring patent owner response.

For completeness, it is pointed out that none of third party requester's three procedural bases for opposing the renewed patent owner petition (that the renewed petition is precluded by 37 CFR 1.939, that extraordinary circumstances do not exist so as to support a waiver of 37 CFR 1.939, and that 37 CFR 1.103 provides for a six month suspension only, with suspensions to be granted only if a reply to an Office action is not outstanding) is persuasive.

With respect to first procedural issue raised by third party requester, the renewed patent owner petition is being taken, in part, as a petition to waive 37 CFR 1.939.

As to the second procedural issue, it is sufficient that petitioner patent owner desires certain relief, has correctly alleged that the requested relief is procedurally barred by the regulations, and that there are circumstances that would, in the opinion of a reasonable patent owner, injure patent owner unless the regulations are waived to permit consideration of the request for relief such that the relief may be granted. In this instance, if petitioner patent owner were in fact able to demonstrate good cause under 37 CFR 1.987 for suspension of the '246 *inter partes* reexamination proceeding, a delay engendered by the procedural provisions of 37 CFR 1.939 in obtaining that suspension would potentially be damaging to patent owner. That circumstance is deemed to be "extraordinary," and justice requires that the patent owner's renewed petition be reviewed on its merits. Third party requester's position (that there cannot be an extraordinary circumstance to consider the patent owner petition at this time, because petitioner patent owner has not, in third party requester's opinion, established the requisite good cause to suspend the '246 *inter partes* reexamination proceeding) amounts to a prejudgment by requester of the merits of the petition, which would unfairly preclude consideration of the merits of the petition by the Office. Third party requester's position would raise an insurmountable hurdle for a petitioner seeking to invoke the provisions of 37 CFR 1.183 to obtain relief from the provisions of 37 CFR 1.939.

The third procedural challenge raised by third party requester is clearly without merit. 37 CFR 1.937 specifically provides that *inter partes* reexamination will "conducted in accordance with §§ 1.104 through 1.116." The provisions of 37 CFR 1.103 concerning suspension of patent applications, is, therefore, inapplicable to an *inter partes* reexamination

[13] If an *ex parte* reexamination proceeding was ongoing as to the '258 patent, a final, non-appealable holding of validity in the litigation would not completely preclude reexamination proceedings in the Office, because 35 U.S.C. § 305 provides a non-qualified requirement for special dispatch in *ex parte* reexamination proceedings.

proceeding. [14] Suspension of an *inter partes* reexamination proceeding is not provided for by rule;[15] thus 37 CFR 1.182 would govern the present situation. 37 CFR 1.182 does not contain either of the limitations on suspending an *inter partes* reexamination proceeding that appear in 37 CFR 1.103(a) that are relief upon by third party requester as a basis to oppose the renewed patent owner petition.

CONCLUSION

1. The patent owner petition is dismissed.

2. Any request for reconsideration of this Decision must be filed in accordance with the provisions of 37 CFR 1.181(f).

3. Jurisdiction over the present *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit for appropriate action.

4. Telephone inquires related 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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June 21, 2007

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[14] It is to be noted that a reexamination proceeding is not "an application for patent."
[15] While 37 CFR 1,987 provides for suspension of an *inter partes* reexamination proceeding *sua sponte* by the Office, this is no provision of the rules permitting/authorizing a petition by a party for a suspension in reexamination.

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CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/000,247
Filed: March 30, 2007
For: U.S. Patent No. 6,432,133

: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the May 9, 2007 patent owner petition entitled "PETITION TO SUSPEND *INTER PARTES* PROCEEDINGS," (hereinafter "the petition to suspend"). The third party requester filed a paper on May 25, 2007 entitled 'THIRD PARTY REQUESTER'S PETITION *AND* OPPOSITION UNDER 37 CFR 1.183 IN RESPONSE TO PATENT HOLDER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING" (hereinafter "the opposition paper"). In addition, on August 7, 2007 the third party requester filed "SECOND PETITION *AND* SUPPLEMENT TO OPPOSITION UNDER 37 C.F.R. 1.183 IN RESPONSE TO PATENT HOLDER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDINGS" (hereinafter "supplemental opposition"). The patent owner filed a paper on August 21, 2007 entitled "PETITION IN RESPONSE TO THIRD PARTY REQUESTOR'S SECOND PETITION IN OPPOSITION TO PATENT HOLDER'S REQUEST TO SUSPEND *INTER PARTES* REEXAMINATION" (hereinafter "response to the supplemental opposition.").

The above-mentioned papers and *inter partes* reexamination control number 95/000,247 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petitions are dismissed.

FEES

The patent owner petition to suspend is taken as a petition under 37 CFR 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended (stayed) or dismissed. The petition to suspend is also taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939, which precludes the filing of a paper prior to the first Office action on the merits (*i.e.*, the first Office action addressing claim patentability). A single petition fee of $400.00 is required for the patent

owner petition to suspend. A single petition fee of $400.00 is also required for the patent owner petition paper in response to the third party requester's supplemental opposition paper. [1]

The third party requester opposition to patent owner's petition is also a paper that would require both a petition fee for a petition filed under 37 CFR 1.182, because the rules do not provide for such paper, and a petition fee for a petition filed under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939. A single $400.00 petition fee has been charged to Deposit Account No. 03-3975 in accordance by third party requester. [2] A single $400.00 petition fee for the third party requester's supplemental opposition paper has also been charged to the third party requester's Deposit Account.

DECISION

I. Relevant Statute, Regulations, and Examining Procedure

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

II. Analysis

An initial review of the patent owner and third party requester papers that are present before the Office of Patent Legal Administration does not reveal that patent owner has remitted either the $400.00 petition fee for the patent owner's petition to suspend the present '247 *inter partes* reexamination proceeding, or the $400.00 petition for the patent owner's response to the third party requester's supplemental opposition paper. Accordingly, both patent owner petitions are dismissed without formal consideration on the merits.

As patent owner's petitions have been dismissed for lack of fee, the patent owner papers and requester papers will remain in the file, and will not be addressed.

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[1] A petition filed under 37 CFR 1.182 and a petition fee filed under 37 CFR 1.183 would each require, if each was filed separately (e.g., to address different matters), a petition fee of $400.00 for each, but only one such fee is required per "1.182/1.183 petition" in this instance.

[2] *See*: Third party requester's opposition, at page 1.

ADDITIONAL DISCUSSION

The aforementioned initial review of papers also shows that patent owner filed a paper entitled "CONDITIONAL STATUTORY DISCLAIMER" concurrently with the May 11, 2007 petition to suspend the '247 *inter partes* reexamination proceeding. It does not appear that patent owner has submitted the necessary $130.00 large entity fee for the statutory disclaimer as required by 37 CFR 1.20(d). [3] Further, the statute and regulations do not provide for a conditional disclaimer predicated on the grant of an accompanying petition, or a disclaimer that is otherwise conditional. On facts analogous to the present record, any grant of a petition to suspend would appear to require, *inter alia*, that the claims in the litigation involving the patent being reexamined in the '247 *inter partes* reexamination proceeding and the claims pending in that reexamination proceeding be identical. If its petitions are renewed, the patent owner may wish to consider that the claims in the two proceedings cannot be identical unless the claims not at bar in the litigation unless the claims are unconditionally disclaimed (without addition of other claims via the reexamination proceeding).

CONCLUSION

1. The patent owner petition is dismissed.

2. A non-extendible period of **thirty (30) days or one (1) month, whichever is longer,** is set in which patent owner may file the necessary $400.00 petition fees for the patent owner petition paper dated May 11, 2007 and the $400.00 petition fee for the patent owner response to third party requester's supplemental opposition paper. The filing of these fees will constitute a calling up for action of these patent owner papers, but will not entitle patent owner to file any additional petition paper regarding suspension of the '247 *inter partes* reexamination proceeding or any supplement to the existing petition papers.

3. If desired, patent owner may also file an unconditional statutory disclaimer, together with the fee therefor, **during the time period set in part two of this Conclusion.**

4. In the event that patent owner does not renew the petition to suspend, and the opposition to third party requester's supplemental opposition paper, third party requester may request a refund of the petition fees submitted with respect to those third party papers. In the event that patent owner does renew the petitions, requester may, within 15 days of being served with the patent owner renewal papers, renew it opposition papers, without payment of a further petition fee for same.

5. Jurisdiction over the present *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit for such action as may be appropriate.

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[3] See:37 CFR 1.321(a)(4).

6. Telephone inquires related 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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October 22, 2007

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CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/000,247
Filed: M arch 30, 2007
For: U.S. Patent No. 6,432,133

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the May 11, 2007 patent owner petition entitled "PETITION TO SUSPEND *INTER PARTES* PROCEEDINGS," (hereinafter "the petition to suspend"). The third party requester filed a paper on May 25, 2007 ,entitled 'THIRD PARTY REQUESTER'S PETITION *AND* OPPOSITION UNDER 37 CFR 1.183 IN RESPONSE TO PATENT HOLDER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING" (hereinafter "the opposition paper"). In addition, on August 7, 2007, the third party requester filed a "SECOND PETITION *AND* SUPPLEMENT TO OPPOSITION UNDER 37 C.F.R. 1.183 IN RESPONSE TO PATENT HOLDER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDINGS" (hereinafter "supplemental opposition"). The patent owner filed a paper on August 21, 2007, entitled "PETITION IN RESPONSE TO THIRD PARTY REQUESTOR'S SECOND PETITION IN OPPOSITION TO PATENT HOLDER'S REQUEST TO SUSPEND *INTER PARTES* REEXAMINATION" (hereinafter "response to the supplemental opposition.").

The above-mentioned papers and *inter partes* reexamination control number 95/000,247 are before the Office of Patent Legal Administration for consideration.

Summary: The petitions of the parties are granted to extent that the papers have been considered, but for the reasons set forth below, the substantive relief requested in the patent owner petition is dismissed.

FEES

The patent owner petition to suspend is taken as a petition under 37 CFR 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended (stayed) or dismissed. The petition to suspend is also taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939, which precludes the filing of a paper prior to the first Office action on the merits (*i.e.*, the first Office action addressing

claim patentability). A single petition fee of $400.00 is required for the patent owner petition to suspend. A single petition fee of $400.00 is also required for the patent owner petition paper in response to the third party requester's supplemental opposition paper. [1] Pursuant to this decision, the two $400.00 petition fees will be charged to Deposit Account No. 06-2425, as authorized in the patent owner paper filed on January 10, 2008.

The third party requester opposition to patent owner's petition is also a paper that would require both a petition fee for a petition filed under 37 CFR 1.182, because the rules do not provide for such paper, and a petition fee for a petition filed under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939. A single $400.00 petition fee was previously charged to Deposit Account No. 03-3975 in accordance with requester's instructions. [2] A single $400.00 petition fee for the third party requester's supplemental opposition paper was also previously charged to the third party requester's deposit account.

REVIEW OF SALIENT FACTS

1. U.S. patent No. 6,432,133 ("the '133 patent") issued to Lilip Lau *et al* on August 13, 2002, and was assigned to Advanced Cardiovascular Systems, Inc., now by change of name, Abbott Cardiovascular Systems.

2. A request for *ex parte* reexamination of claims 1-3, 8 and 9 of the '133 patent was filed on January 23, 2006, by Jack S. Barufka as the third party requester, and the request was assigned control number 90/007,888 ("the '888 *ex parte* reexamination proceeding"). [3]

3. On February 14, 2006, *ex parte* reexamination was ordered for claims 1-15 of the '133 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability for claims 1-3, 8 and 9 of the '133 patent. [4]

4. A request for *inter partes* reexamination of claims 1-9 and 11 of the '133 patent was filed on March 30, 2007, by Jack S. Barufka as the third party requester, in which Medtronic Vascular, Inc. was identified as the real party in interest. This request was assigned control number 95/000,247 ("the '247 *inter partes* reexamination proceeding").

5. On April 24, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the March 30, 200 request raised a substantial new question of patentability for claims 1-9 and 11 of the '133 patent.

6. There has been no further Office action in the '247 *inter partes* reexamination proceeding, but, on December 21, 2006, an Office action was mailed in the '888 *ex parte* reexamination proceeding that confirmed the patentability of claims 10, 11 and 15 of the '133 patent.

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[1] A petition filed under 37 CFR 1.182 and a petition fee filed under 37 CFR 1.183 would each require, if each was filed separately (e.g., to address different matters), a petition fee of $400.00 for each, but only one such fee is required per "1.182/1.183 petition" in this instance.

[2] *See*: Third party requester's opposition, at page 1.

[3] Mr. Barufka was, and remains, a registered patent practitioner in Pillsbury Winthrop Shaw Pittman LLP firm.

[4] Office practice is that *ex parte* reexamination may be ordered for claims that reexamination was not requested, provided that at least one substantial new question of patentability is demonstrated in the request for any claim for which reexamination was requested. See MPEP § 2243 – "The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested, it is permitted to do so."

7. Patent owner filed a response to the December 21, 2006 Office action on March 3, 2007.

8. The '133 patent had been subject to litigation in the district court - *Advanced Cardiovascular Systems Inc. et al v. Medtronic Vascular, Inc. et al*, [5] which had commenced prior to the filing of both reexamination requests. On May 2, 2007, judgment was entered in favor of patent owner, pursuant to a district court decision that claims 1-3 and 9 of the '133 patent were valid and had been infringed by Medtronic (the real party in interest for the '247 *inter partes* reexamination proceeding request).

9. On May 9, Medtronic filed a Notice of Appeal to the Court of Appeals for the Federal Circuit. [6]

10. On May 11, 2007, patent owner filed a petition to suspend the '247 *inter partes* reexamination proceeding and to waive the provisions of 37 CFR 1.939 to permit consideration of the petition to suspend.

11. On May 11, 2007, concurrently with the filing of patent owner's petition to suspend the '247 *inter partes* reexamination proceeding, patent owner filed a paper styled as "Conditional Statutory Disclaimer."

12. On May 25, 2007, the third party requester ("requester") filed a paper opposing the May 11, 2007 patent owner petition. The opposition paper included a petition to waive the provisions of 37 CFR 1.939 to permit consideration of the opposition paper

13. On August 1, 2007, the appeal by Medtronic was dismissed by the Federal Circuit as being premature, and the case was remanded to the District Court for additional consideration of certain matters. [7]

14. On August 7, 2007, requester filed a paper supplementing the May 25, 2007 opposition paper that also included a petition to waive the provisions of 37 CFR 1.939.

15. On August 21, 2007, patent owner filed a response to the August 7, 2007 requester paper together with a petition to waive 37 CFR 1.939 to permit consideration of the response.

16. On November 15, 2007, the patent owner's petition papers were both dismissed for failure to remit the $400.00 petition fee required for each paper.

17. On December 6, 2007, patent owner filed a paper remitting the necessary petition fees, but the paper was not executed.

18. On December 14, 2007, requester filed a paper renewing its opposition and petition papers.

19. On January 10, 2008, patent owner filed an executed paper authorizing the charging of the necessary petition fees.

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[5] See: *Advanced Cardiovascular Systems, Inc. et al v. Medtronic Vascular Inc. et al*, 485 F. Supp. 2d 519, 522; 2007 U.S. Dist LEXIS 23181,**5 (D. Del, March 29, 2007) See also: May 11, 2007 "Petition to *Suspend*... ," page 5.

[6] See: Third Party Requester's Petition and Opposition ... ," page 8.

[7] *Advanced Cardiovascular Systems Inc. et al v. Medtronic Vascular, Inc. et al*, slip. op. No. 2007-1365 (Fed. Cir. August 1, 2007)

DECISION

I. Relevant Statute, Regulations and Examining Procedure

35 U.S.C. § 253 provides, in part:

> Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

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.

35 U.S.C. § 317(b) provides, in part:

> 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 ... 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.

37 CFR 1.25(b) provides:

> A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed.

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 1.321(a) provides:

> A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee

and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

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.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

37 CFR 1.987 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.

MPEP § 509.01 provides, in part:

In addition, a general authorization does not apply to document supply fees under 37 CFR 1.19, such as those required for certified copies, to post issuance fees under 37 CFR 1.20, such as those required for maintenance fees, or to miscellaneous fees and charges under 37 CFR 1.21, such as assignment recording fees.

MPEP § 1490 provides, in part:

Pursuant to the last sentence of 35 U.S.C. 253, "any patentee or applicant may disclaim or dedicate to the public... any terminal part of the term, of the patent granted or to be granted". Accordingly, the disclaimer must be of a terminal portion of the term of the entire patent to be granted. A disclaimer of a terminal portion of the term of an individual claim, or individual claims will not be accepted. It is further noted that a disclaimer of the term of individual claims would not be appropriate since the claims of a pending application or proceeding are subject to cancelation, amendment, or renumbering. **The statute does not provide for conditional disclaimers** and accordingly, a proposed disclaimer which is made contingent on the allowance of certain claims cannot be accepted. The disclaimer should identify the disclaimant and his or her interest in the application and should specify the date when the disclaimer is to become effective. [Emphasis added.]

MPEP § 2243 and MPEP § 2643 each provide, in part:

The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested, it is permitted to do so.

MPEP § 2684.04, Subsection III provides, in pertinent part:

35 U.S.C. 314 provides for *inter partes* reexamination the clause "Unless otherwise provided by the Director for good cause" which clause is not present in 35 U.S.C. 305 for *ex parte* reexamination. Accordingly, where there is good cause for the Director of the USPTO to suspend (stay) reexamination proceedings pending the conclusion of litigation, a suspension will be effected. 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). In addition, see subsection V. below for the situation where there is pending litigation having the potential to terminate a reexamination prosecution under 35 U.S.C. 317(b). If the examiner believes there is "good cause" to suspend (stay) reexamination proceedings, the case should be brought to the Office of Patent Legal Administration (OPLA) for consideration of such by a Reexamination Legal (RLA). See also subsection V. below.

II. Background

Both an *ex parte* request for reexamination of the '133 patent and an *inter partes* request for reexamination of the '133 patent have been granted by the Office. In the '888 *ex parte* reexamination proceeding, claims 1-15, (i.e., all of the claims) of the '133 patent are subject to reexamination based upon a finding by the examiner the request for reexamination has demonstrated the existence of a substantial new question of patentability for patent claims 1-3, 8 and 9. [8,9] In the '247 *inter partes* reexamination proceeding, reexamination was requested for claims 1-9 and 11 of the '133 patent. [10] In the '247 *inter partes* reexamination proceeding, the examiner found that a substantial new question of patentability for claims 1-9 and 11 of the '133 patent was established by the request. The examiner did not indicate that any claims other than patent claims 1-9 and 11 of the '133 would be the subject of *inter partes* reexamination. [11] No action on the patentability of the claims has been promulgated by the Office in either reexamination proceeding.

The '133 patent has been the subject of litigation in the U. S. District Court for the District of Delaware. In the litigation, plaintiff Advanced Cardiovascular Systems alleged, *inter alia*, that Medtronic infringed certain claims of the '133 patent, and defendant Medtronic alleged, *inter alia*, that those claims were invalid. The litigation had been filed prior to the filing of either reexamination proceeding. Ultimately, the district court found that claims 1-3 and 9 of the '133 patent were valid, and had been infringed by Medtronic, the real party in interest in the '247 *inter partes* reexamination proceeding. [12] Thereafter, Medtronic filed a notice of appeal to the Court of Appeals for the Federal Circuit. However, the appeal has been dismissed by the Federal Circuit and the litigation has been remanded to the district court. [13]

On May 11, 2007, patent owner filed the present petition to suspend the '247 *inter partes* reexamination proceeding subsequent to the filing of Medtronic's notice of appeal, but prior to the Federal Circuit's remand. [14] The petition was opposed by requester in a paper filed on May

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[8] *Order Granting/Denying Request for Ex Parte Reexamination*, Decision on Request for Reexamination, February 14, 2006, page 9.

[9] Request for *Ex Parte* Reexamination Transmittal Form, January 23, 2006.

[10] Request for *Inter Partes* Reexamination Transmittal Form, March 30, 2007.

[11] *Order Granting/Denying Request for Inter Partes Reexamination*, Decision on Request, February 14, 2006, page 9.

[12] See footnote 5.

[13] See footnote 7.

[14] All petition/opposition papers filed by patent owner and third party requester include a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939 that precludes the filing of any paper by either party to an *inter partes* reexamination proceeding prior to the issuance of a first Office action on the merits (*i.e.* the patentability of the claims of the patent for which reexamination is requested). All of the petition/opposition papers also include a petition under 37 CFR 1.182 for relief not provided by the regulations, because the regulations do not provide for the filing of either a petition to suspend an *inter partes* reexamination proceeding, or a paper opposing such a petition.

25, 2007. Requester also filed a second opposition paper on August 7, 2007, to supplement its May 25, 2007 opposition paper by bringing the Federal Circuit's remand of the litigation to the attention of the Office. Patent owner filed a paper on August 21, 2007 opposing the third party's second opposition paper. The patent owner's petitions were dismissed in a decision dated November 15, 2007, for failure to remit the required petition fees. Patent owner has now remitted the petition fees, and requester has renewed its opposition papers.

III. Summary of Patent Owner's Position [15]

Patent owner's May 11, 2007 petition acknowledges that the provisions of 37 CFR 1.939 precluded the filing of the petition, because no initial Office action had issued. Accordingly, a waiver of the provisions 37 CFR 1.939 has been requested under 37 CFR 1.183. Patent owner argues in favor of such waiver by quoting from a petition decision in the record of *inter* partes reexamination proceeding Control No. 95/000,120 (the '120 *inter partes* reexamination proceeding) to the effect that "if a suspension is warranted in an *inter partes* proceeding, in the interests of justice that such suspension takes place prior to an action on the patentability of the claims." [16]

In addition, patent owner requests that suspension of the '247 *inter partes* reexamination proceeding be granted pursuant to 37 CFR 1.182. Patent owner requests suspension in accordance with the rationale by which the Office granted a suspension of *inter partes* reexamination proceeding Control Nos. 95/000,093 and 95/000,094 (the '093 and '094 *inter partes* reexamination proceedings) in a final agency action dated November 17, 2005. [17] Specifically, patent owner argues that, in light of a statutory disclaimer that patent owner filed concurrently filed with patent owner's petition, the claims at issue in the litigation are the same claims as those involved in the reexamination proceeding. [18] Further, patent owner also argues in the original petition that the litigation is near to completion, because the litigation was on appeal to the Federal Circuit, while the '247 *inter partes* reexamination proceeding was at an early stage in which no examination on the patentability of the claims for reexamination was ordered has been promulgated. [19] Patent argues that these factors closely align the status of the '247 *inter partes* reexamination proceeding with the status of the '093 and '094 *inter partes* reexamination proceedings at the time which suspension of the latter proceedings was granted by the Office, and later upheld by the district court. Patent owner argues that the same rationale that mandated suspension in the '093 and '094 *inter partes* reexamination proceedings applies with equal weight in the '247 *inter partes* reexamination proceeding, and that suspension of the latter is, therefore, proper.

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[15] All arguments submitted in patent owner's May 11, 2007 and August 21, 2007 petition papers have been carefully considered. The failure to expressly mention any given argument should not be taken as an indication that such argument was not so considered.

[16] A copy of this unpublished petition decision is available in the Image File Wrapper (IFW) of the '120 *inter partes* reexamination proceeding, and has also been provided as Exhibit 8 attached to the May 11, 2007 patent owner petition.

[17] A copy of this unpublished petition decision is available in the IFW of each of the involved *inter partes* reexamination proceedings, and has also been provided as an Exhibit 7 attached to the May 11, 2007 patent owner petition. The decision that granted suspension of the '093 and '094 *inter partes* reexamination proceedings was upheld in Sony *Computer Entertainment America Inc. et al., v. Jon W. Dudas*, No. 1:05cv1447, 2006 U.S. Dist. LEXIS 36856 (E.D. VA, May 22, 2006)

[18] The statutory disclaimer was filed to disclaim the patent claims for which reexamination had not been ordered in the '247 *inter partes* reexamination proceeding in order to place identical claims at issue in both the reexamination proceeding and the litigation.

[19] In the patent owner's August 21, 2007 paper responsive to third party requester's August 7, 2007 paper pointing out that the Federal Circuit dismissed the appeal and remanded the litigation to the district court, patent owner argues that the appeal "could go forward at the end of the year," (*i.e.* 2007).

IV. Summary of Third Party Requester's Position [20]

Requester's opposition paper filed May 25, 2007 argues that the Office will not save resources by suspending the '247 *inter partes* reexamination proceeding, because the concurrently pending '888 *ex parte* reexamination proceeding (and pending *ex parte* reexamination proceedings in patents related to the '133 patent) will certain "core issues" that are involved in the '247 *inter partes* reexamination proceeding. Third party requester opines that administrative burden will be increased if all of these proceedings are not addressed by the Office simultaneously.

Requester also argues that the facts in the '247 *inter partes* reexamination proceedings are more similar to the facts that existed in *inter partes* reexamination proceeding 95/000,020 (the '020 *inter partes* reexamination proceeding) than the facts in the '093 and '094 *inter partes* reexamination proceeding. The argument is that in the '020 *inter partes* reexamination proceeding, there were also multiple copending *ex parte* reexamination proceedings.

V. Analysis and Findings

a. The Issue of "Good Cause" for Suspension of an *Inter Partes* Reexamination

35 U.S.C. § 305, last sentence, provides without qualification, that "[a]ll reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office." In *Ethicon v. Quigg*, 849 F.2d 1422; 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit addressed the issue of the propriety of suspension or stay of an *ex parte* reexamination in order to await the outcome of a district court case involving allegations of claim invalidity as to the patent being reexamined in an *ex parte* reexamination proceeding. The Federal Circuit considered the language of 35 U.S.C. §§ 302-305, and concluded that: "[R]ead together, the statutes say: '*Any* person at *any time* may request reexamination and all reexamination procedures will be conducted with *special dispatch*.' The issue for us is whether 'special dispatch' contemplates that a reexamination be suspended pending the outcome of a district court case involving allegations of invalidity of the same patent. We conclude that it does not." [Emphasis in the original.] *Id.*, at 1426; at 1154.

In contrast, 35 U.S.C. § 314(c) specifically states that *inter partes* reexamination proceedings will be conducted with special dispatch within the Office, "[U]nless otherwise provided by the Director for good cause." Thus, it has been held that the Office has discretion to suspend an *inter partes* reexamination proceeding based upon finding "good cause" to suspend the proceeding. *See Sony Computer Entertainment America Inc. et al., v. Jon W. Dudas*, No. 1:05cv1447, 2006 U.S. Dist. LEXIS 36856 (E.D. VA, May 22, 2006). In *Sony Computer*, the court upheld the finding by the Office that good cause to suspend the '093 and '094 *inter partes* reexamination proceedings existed based upon the totality of the circumstances in those proceedings. It follows that "good cause" to suspend any *inter partes* reexamination proceeding must be determined on a case-by-case basis.

In the '093 and '094 *inter partes* reexamination proceedings, litigation involving the validity of claims of the patents that were the subject of *inter partes* reexamination was in a relatively advanced stage. Specifically, a notice of appeal to the Federal Circuit from the decision of a district court had been filed in a litigation in which the validity of certain patent claims had

[20] All arguments submitted in third party requester's May 25, 2007 and August 7, 2007 petition papers have been carefully considered. The failure to expressly mention any given argument should not be taken as an indication that such argument was not so considered.

been at issue. Further, briefs had been filed in the appeal to the Federal Circuit. In contrast, the '093 and '094 *inter partes* reexamination proceedings were at a relatively beginning stage. Although *inter partes* reexamination had been ordered, no action on the merits of the patentability of the claims to be reexamined had been promulgated. The Office considered that it would promote administrative efficiency to suspend the '093 and '094 *inter partes* reexamination proceedings, rather than to begin a lengthy process of reexamination, when the litigation was close to a resolution that might statutorily require termination of those *inter partes* reexamination proceedings.

Further, the claims that were subject to reexamination in the '093 and '094 *inter partes* reexamination proceedings were identical to the claims that were the subject of the litigation. The patent owner filed a statutory disclaimer, making the claims subject to reexamination identical to the claims that were the subject of the litigation. Thus, issues of the patentability of the claims not involved in the litigation, (which issues would quite possibly be of interest to members of the public, not parties to the litigation), would no longer be decided in the '093 and '094 *inter partes* reexamination proceedings. No claim validity issues existed in the litigation, for which there was not a corresponding patentability issue in the reexamination proceedings.

b. At Present, Patent Owner Has Not Established That Good Cause Exists To Suspend The '247 *Inter Partes* Reexamination Proceeding

The circumstances that resulted in the finding that there was good cause for the Office to exercise its discretion and suspend the '093 and '094 *inter partes* reexamination proceedings do not exist with respect to the present '247 *inter partes* reexamination proceeding.

First, the appeal to the Federal Circuit has been dismissed, and the litigation has been remanded to the district court. This differs from the situation in the '093 and '094 *inter partes* reexamination proceeding in which suspension was granted based in part upon the fact that an appeal to the Federal Circuit was pending and party briefs had been filed. In the present '247 *inter partes* reexamination proceeding, petitioner patent owner has not established that there is any reason to believe that resolution of the issues by the district might occur in the near future, or within a predictable amount of time. Although patent owner has opined that the appeal in the '133 patent litigation could go forward by the end of 2007, patent owner has not informed the Office that such has come to pass. Of greater importance, petitioner patent owner has not attempted to establish that if another appeal to the Federal Circuit is filed after the district court has rendered a decision on the remand, that is likely that resolution of the appeal will occur so rapidly that it would conserve Office resources and foster administrative efficiency to await the results of the appeal.

It is to be noted that a renewed appeal to the Federal Circuit may not result in resolution of the questions of patentability such that the estoppel provisions of 35 U.S.C. § 317(c) would require termination of the '247 *inter partes* reexamination proceeding. While this would be true of any appeal, here it is coupled with the uncertainty regarding when conclusion of the remanded district court proceedings might occur, and the uncertainty of when any subsequent appeal to the Federal Circuit is likely to be resolved; it is clear that patent owner has not established any basis for concluding that resolution of the litigation will occur so rapidly that it would be a waste of Office resources to proceed with the '247 *inter partes* reexamination proceeding. In this regard, it must also be remembered that the public, as well as the parties and the Office, have an interest that the '247 *inter partes* reexamination proceeding be resolved with special dispatch.

Second, in the '093 and '094 *inter partes* reexamination proceedings, the claims that were the subject of the pending litigation were precisely those claims that that were the subject of *inter partes* reexamination proceedings. This circumstance resulted from the filing of a statutory disclaimer by patent owner disclaiming claim 1 of the patents that were the subject of both the litigation and the reexamination proceedings, such that the claims in the litigation and the reexamination proceedings would be only the claims that were subject to *inter partes* reexamination. In the '247 *inter partes* reexamination proceeding, *inter partes* reexamination has been ordered for claims 1-9 and 11 of the '133 patent. In the pending litigation of the '133 patent, only claims 1-3 and 9 of the '133 patent were litigated in the district court.

In this instance, patent owner has filed a "Conditional Statutory Disclaimer" in an attempt to disclaim claims 4-8 and 11 of the '133 patent such that only those patent claims that are the subject of the pending litigation would be the subject of the '247 *inter partes* reexamination proceeding. However, the "Conditional Statutory Disclaimer" filed by patent owner is ineffective to disclaim claims 4-8 and 11 of the '133 patent, because it cannot be entered. First, as stated in MPEP § 1490, 35 U.S.C. § 253 does not authorize the Office to accept a "conditional" disclaimer. A statutory disclaimer must be an unequivocal, unconditional legal instrument. Second, even if the Office had the authority to accept and enter a "conditional" disclaimer, patent owner has not remitted the fee required by 37 CFR 1.20(d) for the filing of a statutory disclaimer. [21] No express authorization to charge the fee for filing a statutory disclaimer accompanied the filing of the "Conditional Statutory Disclaimer." Although patent owner's paper dated January 10, 2008 authorizes Office "to charge any deficiency in fees or credit any overpayment" to a deposit account, as discussed in MPEP § 509.01, a general fee authorization, is not acceptable with respect to authorizing the Office to charge any post issuance fee under 37 CFR 1.20.

Thus, in its present posture, the '247 *inter partes* reexamination proceeding will address issues of claim patentability that will remain outstanding even if a final, non-appealable decision that claims 1-3 and 9 of the '133 are valid is ultimately issued. Therefore, even if the litigation becomes final and non-appealable and the final holding is that patent claims 1-3 and 9 are invalid, the estoppel provisions of 35 U.S.C. § 317(c) would not be triggered to require termination of the '247 *inter partes* reexamination proceeding. Such proceeding would continue perforce, with of the issue of the patentability of the claims that were not subject to the litigation remaining for resolution. There would be no good cause for suspending the '247 *inter partes* reexamination, since a suspension would simply delay the resolution of the remaining issues of the patentability of certain patent claims, in contravention of the statutory requirement that an *inter partes* reexamination must be conducted with special dispatch in the Office.

In summary, good cause to suspend the '247 *inter partes* reexamination proceeding has not been shown. There is, at present, no assurance that a suspension will promote administrative efficiency, since the concurrent litigation of the '133 patent is not at the appeal stage, and there is no indication that the appeal stage will be reached in any particular period of time (and certainly no indication of when a final resolution of the litigation might be forthcoming. Further, even if a final, non-appealable decision would be rendered in the concurrent litigation that holds claims 1-3 and 9 of the '133 patent invalid, the '247 *inter partes* reexamination proceeding would necessarily continue, because the estoppel provisions of 35 U.S.C. § 317(c) would not require termination of the proceeding with respect to patent claims 4-8 which are subject to the reexamination.

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[21] It should be noted that the November 15, 2007 "Decision Dismissing Petition" expressly advised patent owner of the necessity of remitting the fee for filing a statutory disclaimer, and the Office had no authority to accept a "conditional" disclaimer.

CONCLUSION

1. The patent owner petitions are granted to the extent that the petition and the response to third party requester's second opposition paper have been considered pursuant to a waiver of the regulations under 37 CFR 1.183. However, the patent owner petition is dismissed with respect to the requested relief that the '247 *inter partes* reexamination proceeding be suspended.

2. The third party petitions are granted to the extent that the third party opposition papers have been considered pursuant to a waiver of the regulations under 37 CFR 1.183.

3. Jurisdiction over the present *inter partes* reexamination proceeding will be returned to the Central Reexamination Unit in due course.

4. Telephone inquires related 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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January 28, 2008

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CENTRAL REEXAMINATION UNIT

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Ex parte Reexamination Proceeding :
Control No. 90/007,888 :
Filed: January 23, 2006 :
For: U.S. Patent No. 6,432,133 : **DECISION,*SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**

Inter Partes Reexamination Proceeding :
Control No. 95/000,247 :
Filed: March 30, 2007 :
For: U.S. Patent No. 6,432,133 :

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

REVIEW OF SALIENT FACTS

1. U.S. patent No. 6,432,133 ("the '133 patent") issued to Lilip Lau *et al* on August 13, 2002, and was assigned to Advanced Cardiovascular Systems, Inc., now by change of name, Abbott Cardiovascular Systems.

2. A request for *ex parte* reexamination of claims 1-3, 8 and 9 of the '133 patent was filed on January 23, 2006, by Jack S. Barufka as the third party requester, and the request was assigned control number 90/007,888 ("the '888 *ex parte* reexamination proceeding").

3. On February 14, 2006, *ex parte* reexamination was ordered for claims 1-15 of the '133 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability for claims 1-3, 8 and 9 of the '133 patent.

4. A request for *inter partes* reexamination of claims 1-9 and 11 the '133 patent was filed on March 30, 2007, by Jack S. Barufka as the third party requester in which Medtronic

Vascular, Inc. was identified as the real party in interest. The request was assigned control number 95/000,247 ("the '247 *inter partes* reexamination proceeding").

5. On April 24, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the March 30, 200 request raised a substantial new question of patentability for claims 1-9 and 11 of the '133 patent.

6. There has been no further Office action in the '247 *inter partes* reexamination proceeding, but, on December 21, 2006, an Office action was mailed in the '888 *ex parte* reexamination proceeding that confirmed the patentability of claims 10, 11 and 15 of the '133 patent.

7. Patent owner filed a response to the December 21, 2006 Office action on March 3, 2007, in which reconsideration of the rejection of the rejected patent claims was requested without amendment.

8. Although judgment was entered pursuant to a district court decision that claims 1-3 and 9 of the '133 patent were valid and had been infringed by Medtronic, and Medtronic filed a Notice of Appeal to the Court of Appeals for the Federal Circuit, on August 1, 2007, the appeal by Medtronic was dismissed by the Federal Circuit as being premature, and the case was remanded to the District Court for additional consideration of certain matters. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '247 proceeding) is an *inter partes* proceeding. The *inter partes* proceeding is still pending, and has not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/000,247 and 90/007,888 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

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[1] *Advanced Cardiovascular Systems Inc. et al v. Medtronic Vascular, Inc. et al*, slip. op. No. 2007-1365 (Fed. Cir. August 1, 2007)

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 neither the claims nor the specification have been amended in either reexamination proceeding, so that the claims and the specification are currently 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, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. Therefore, the third party requester has the full *inter partes* reexamination participation rights in the merged proceeding that are set forth in 37 CFR 1.902 through 1.997.

It is noted that reexamination was ordered for claims 1-15 of the '133 patent (*i.e.*, all of the patent claims) in the '888 *ex parte* reexamination proceeding. [2], but the Order Granting *Inter Partes* Reexamination in the '247 *inter partes* reexamination proceeding did not specify which claims of the '133 patent would be subject to *inter partes* reexamination. The examiner will conduct reexamination in the merged proceeding for all of the claims of the '133 patent, (*i.e.*, claims 1-15 whether in original form or as amended during subsequent prosecution), and for any new claims subsequently entered as a result of amendment in the merged proceeding.

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
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

[2] Order Granting *Ex Parte* Reexamination, February 14, 2006, paragraph bridging pages 8 and 9.

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 papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as indicated above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, (which incorporates the provisions of 37 CFR 1.530), and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP §2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* requester) which may be filed, even though the brief relates to merged multiple proceedings and copies usually must be filed (as pointed out above) for each file in the 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. 95/000,247 and *ex parte* Reexamination Control No. 90/007,888 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to the undersigned, at 571-272-7743, or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

Stephen Marcus, Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,247	03/30/2007	6432133	67448-0000004	6782

24201 7590 10/02/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2008

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MAILED

OCT 02 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,247*. ₹ 90/007,888

PATENT NUMBER *6,432,133*.

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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MAILED

OCT 02 2008

CENTRAL REEXAMINATION UNIT

Ex parte Reexamination Proceeding :
Control No. 90/007,888 :
Filed: January 23, 2006 : **DECISION DISMISSING**
For: U.S. Patent No. 6,432,133 : **AND EXPUNGING**
: **PARTY PETITIONS**
: **AND, *SUA SPONTE*,**
Inter Partes Reexamination Proceeding : **EXPUNGING IMPROPER**
Control No. 95/000,247 : **PARTY PAPERS**
Filed: March 30, 2007 :
For: U.S. Patent No. 6,432,133 :

This is a decision on the petition filed on August 29, 2008 entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 AND COMMUNICATION TO EXAMINER" ("the petition"). This decision also treats the paper filed on September 11, 2008 entitled "PATENT OWNER'S REBUTTAL PETITION TO THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 AND COMMUNICATION TO EXAMINER" ("the opposition petition").

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

The third party requester and patent owner petitions are dismissed, and various papers are being expunged from the record, as will be discussed below.

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Third party requester has authorized a charge against Deposit Account No. 03-3975 in the amount of $400.00 for the petition fee required by 37 CFR 1.183 and 1.17(f). That amount will be charged in the record of the reexamination control number 95/000,247. Patent owner also remitted the necessary $400.00 petition fee, and payment of the fee has been recorded in the record of reexamination control number 95/000,247.

RELEVANT BACKGROUND

1. U.S. patent No. 6,432,133 ("the '133 patent") issued to Lilip Lau et al on August 13, 2002, and was assigned to Advanced Cardiovascular Systems, Inc., now by change of name, Abbott Cardiovascular Systems.

2. A request for *ex parte* reexamination of claims 1-3, 8 and 9 of the '133 patent was filed on January 23, 2006, by Jack S. Barufka as the third party requester, and the request was assigned control number 90/007,888 ("the '888 *ex parte* reexamination proceeding").

3. On February 14, 2006, *ex parte* reexamination was ordered for claims 1-15 of the '133 patent.

4. A request for *inter par*tes reexamination of claims 1-9 and 11 the '133 patent was filed on March 30, 2007, by Jack S. Barufka as the third party requester, in which Medtronic Vascular, Inc. was identified as the real party in interest. The request was assigned control number 95/000,247 ("the '247 *inter partes* reexamination proceeding").

5. On December 21, 2006, an Office action was mailed in the '888 *ex parte* reexamination proceeding that confirmed the patentability of claims 10, 11 and 15 of the '133 patent.

6. On March 3, 2007, patent owner filed a response to the '888 proceeding December 21, 2006 Office action, in which reconsideration of the rejection of the rejected patent claims was requested without amendment.

7. On April 24, 2007, *inter partes* reexamination was ordered for claims 1-9 and 11, but an Office action on claim patentability was not mailed at that time.

8. Although judgment was entered pursuant to a district court decision that claims 1-3 and 9 of the '133 patent were valid and had been infringed by Medtronic, and Medtronic filed a Notice of Appeal to the Court of Appeals for the Federal Circuit, on August 1, 2007, the appeal by Medtronic was dismissed by the Federal Circuit as being premature, and the case was remanded to the District Court for additional consideration of certain matters.

9. On February 7, 2008, the Office mailed a decision, *sua sponte*, merging the '888 ex parte reexamination proceeding and the '247 *inter partes* reexamination proceeding into a single combined reexamination proceeding ("the merged proceeding") to be conducted in accordance the rules and procedures that govern an *inter partes* reexamination proceeding.

10. On March 3, 2008, a non-final Office action was mailed in the merged proceeding.

11. After securing a one-month extension of time, patent owner filed a timely response to the March 3, 2008 Office action on June 5, 2008. The response included a 37 CFR 1.8 certificate of mailing dated June 3, 2008.

12. On July 3, 2008, third party requester filed written comments directed to both the March 3, 2008 Office action and the June 5, 2008 patent owner response.

13. On July 10, 2008, patent owner filed a paper entitled "Supplemental Information Disclosure Statement ("IDS").

14. On August 28, 2008, third party requester filed the present original petition.

15. On September 11, 2008, patent owner filed the present opposition petition.

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 1.906 provides:

> (a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.
> (b) Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.
> (c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

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.
> (b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

37 CFR 1.945 provides:

> (a) 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.
> (b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:
> (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
> (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
> (3) A compelling reason to enter the supplemental response.

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 1.948 provides:

(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 1.985 provides:

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender. [Emphasis added.]

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." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

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.) ...

MPEP §724.04(c) provides, in part:

> Any materials, i.e., information, 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) Any materials, i.e., information, properly submitted under MPEP § 724.02 in a reexamination proceeding will be sealed from public view. 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 material to patentability. A petition to expunge (37 CFR 1.59) should accompany the submission of proprietary materials, and in any event, must be filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC). If the petition to expunge is not filed in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process, or the petition is filed, and denied/dismissed, then the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file. ...

DECISION

I. Consideration of the Third Party Requester Petition

Third party requester has apparently recognized that having once filed written comments on July 3, 2008 that are directed to the March 3, 2008 non-final Office action and the June 5, 2008 patent owner response thereto, the written comments (in the form of a "communication" to the examiner) that are incorporated into the present petition and the three exhibits that were filed concurrently with the present petition do not enjoy an entry right under the provisions of 37 CFR 1.947 and 37 CFR 1.948. Therefore, third party requester has petitioned for waiver of the provisions 37 CFR 1.939, which would preclude consideration of these papers.

Requester has not, however, demonstrated that an extraordinary situation exists such that the written comments and accompanying exhibits must be entered at the present stage of the proceeding, whereby the regulations should be waived in the interest of justice. Rather, the record shows that the merged reexamination proceeding is only at the stage where the examiner will act on party responses and written comments to a non-final rejection. Requester has not demonstrated why these comments and information could not be submitted at a later stage of the proceeding.

Also, it is stated in the present petition that at least some one of the information in the attached exhibits is not particularly relevant to the prior patent to which the information in the document is directed. [1] That being the case, it is found that this information is not of such character that the failure of the examiner to consider it at the present stage of the merged reexamination proceeding would preclude requester from obtaining "justice" in the present merged proceeding.

Further, the submitted documents are marked "Confidential - Outside Attorney's Only," and so are presumably subject to a protective order issued by a court of competent jurisdiction. However, this information was not submitted in an envelope clearly labeled as including confidential material or with a petition to expunge, as required by MPEP §§ 724.02 and 724.04.

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[1] "Third Party Requester's Petition ... ," last paragraph on page 3 and continuing on page 4.

Finally, the present petition contains a comment directed to the conduct of patent owner based on patent owner having submitted the confidential information to third party requester. [2] A reexamination proceeding, (which is an administrative proceeding conducted under the provisions of the reexamination statute and rules, not a litigation before a court), is limited by the provisions of 37 CFR 1.906 to issues of patentability based on prior patens and printed publications. Comments on party conduct are not proper in the merged reexamination proceeding. The Office will not waive the provisions of 37 CFR 1.906, because such provisions are contained in the reexamination statute that limits reexamination proceedings to consideration of prior patents and printed publications. [3]

For the foregoing reasons, the relief requested by third party requester will not be granted. Further, as the present petition contains remarks precluded by 37 CFR 1.906, the petition paper will be expunged from the record by being marked "closed" and "non-public" in the electronic Image File Wrapper (IFW) of the files comprising the merged reexamination proceeding. [4] The submitted documents themselves have been marked as being non-public, and are not accessible to the public.

II. Consideration of the Patent Owner's Opposition Petition

The patent owner opposition paper is moot in view of the disposition of the third party requester petition. However, the opposition paper also includes a comment directed to the conduct of third party requester, and for that reason, will be expunged from the record in the manner discussed above.

III. Patent Owner's Response to the March 3, 2008 Office Action

A review of the record occasioned by the party petition and opposition papers has shown that the June 5, 2008 patent owner response to the non-final Office action mailed on March 3, 2008 contains material that is not provided for by 37 CFR 1.906. Such material appears at footnote 4 of the paper, which is directed to an issue of conduct on the part of the third party requester. As noted in Section I, above, comments directed to the conduct of another party are not are not proper in reexamination proceedings before the Office. Accordingly, the patent owner response of June 5, 2008, but not the attachments thereto, will be expunged in the manner discussed in Section I.

Patent owner is provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the June 5, 2008 response, that does not include comments directed to party comments. Patent owner should review the entire document carefully; submission of a redacted version that includes any comment directed to conduct of the third party requester will result in a final refusal to accept a patent owner response to the March 3, 2008 Office action. The redacted submission may not include any changes beyond redaction of material that constitutes a comment directed to the conduct of the third party requester.

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[2] Beginning at the top of page 3, and also in the first paragraph of subsection A on page 3.
[3] See: 35 U.S.C. §§ 301 and 311.
[4] Papers that have been scanned into the electronic IFW cannot be physically removed.

IV. Third Party Requester's July 3, 2007 Written Comments

A review of the record occasioned by the party petition and opposition papers has shown that the July 3, 2008 written comments to the March 3, 2008 Office action and the June 5, 2008 patent owner response to that Office action mailed on March 3, 2008 contains a section entitled "Update to Related Litigation." 37 CFR 1.985(b) provides that "any person," (including a third party requester) may call attention to a concurrent proceeding *e.g.*, concurrent litigation on the patent that is the subject of an *inter partes* reexamination proceeding, the notice of which must be strictly limited to bare notice of the concurrent proceeding. In this case, the Notice is not so limited because, the information is provided within the written comments paper. The information contained in the submitted as a separate paper, as required by 37 CFR 1.985(b); however, in this instance the information is not provided for in a paper that is limited to the notice regarding the related litigation. so limited. Rather, the "Update to Related Litigation is not provided in a separate paper as required by the rule. Accordingly, the July 3, 2008 third party written comments, but not the attachments thereto, are being expunged from the record in the manner discussed in Section I, above.

Third party requester is provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the July 3, 2008 written comments, which does not include information regarding the concurrent litigation. Requester may then also file a separate paper directed to the status of the concurrent litigation limited to bare notice thereof. Requester should review the entire document carefully; submission of a redacted version that includes any information regarding the status of the concurrent litigation will result in a final refusal to accept third party requester comments directed to the March 8, 2008 Office action and the patent owner response thereto..

V. Treatment of Patent Owner's IDS Filed July 10, 2008

A review of the IDS paper filed on July 10, 2008 shows that the submitted paper includes a letter from patent owner's counsel to third party requester's counsel. That letter is not "prior art," and perforce, cannot contain information material to patentability of the claimed invention in the merged reexamination proceedings. Further, the letter also contains statements that have been redacted, but it is stated in the paper that such statements will show that certain positions taken by the third party requester are "inconsistent" with arguments made by requester to the Office. As such, submission of the letter appears to be for the purpose of rebutting a position taken by the third party requester, and is, therefore, improper pursuant to the provisions of 37 CFR 1.945 absent a showing of why such a supplemental response should be entered, pursuant to 37 CFR 1.945(b).

The letter from patent owner's counsel has been expunged from the record in the manner discussed in Section I, above.

ADDITIONAL DISCUSSION

The parties are advised that the Office intends to conduct the present merged proceeding with special dispatch. Accordingly, the parties are advised to carefully review the reexamination statute and rules, and the practice guidelines set forth in the Manual of Patent Examining Procedure, prior to filing any papers in this proceeding. A paper that appears to be filed in clear violation of the statutes, rules or procedures, or that appears to

be interposed for purposes of delay, does not meet the requirements of 37 CFR 10.18(b). The filing of such a paper will result in consideration of referral to the Office of Enrollment and Discipline for such action as it may deem to be appropriate.

CONCLUSION

1. The third party requester petition is dismissed, and is being expunged from the record.

2. The patent owner petition is dismissed as being moot, and is being expunged from the record.

3. The June 5, 2008 patent owner response paper, but not the attachments thereto, is being expunged from the record.

4. Patent owner is being provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the June 5, 2008 patent owner response paper.

5. The July 3, 2008 third party requester written comments paper, but not the attachments thereto, is being expunged from the record.

6. Third party requester is being provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the July 3, 2008 requester written comments paper.

7. The letter from patent owner's counsel to third party requester's counsel submitted on by patent owner on July 10, 2008 is being expunged from the record.

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

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

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September 29, 2008

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CENTRAL REEXAMINATION UNIT

In re Rambus, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,250
Originally Deposited: April 4, 2007
Filed: June 28, 2007
For: U.S. Patent No. 6,452,863

DECISION DISMISSING PETITION

This is a decision on the patent owner petition filed on September 27, 2007 entitled "Renewed Petition to Vacate the Filing Dates and Orders Granting Inter Partes Reexamination or, Alternatively, to Suspend the Proceedings" (hereinafter "renewed petition"). Receipt is also acknowledged of papers filed on October 3, 2007 by third party requester entitled "Renewed Third-Party Requester's Petition and Opposition to Petition to Vacate the Filing Dates and Orders Granting *Inter Partes* Reexamination or, Alternatively, to Suspend the Proceedings" and "Updated Renewed Third-Party Requester's Petition and Opposition to Petition to Vacate the Filing Dates and Orders Granting *Inter Partes* Reexamination or, Alternatively, to Suspend the Proceedings" (hereinafter collectively "renewed opposition"). [1]

The September 27, 2007 patent owner renewed petition, the October 3, 2007 third party renewed opposition, and the '250 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

[1] The originally filed third party requester opposition did not oppose suspension of the 95/000,250 *inter partes* reexamination proceeding, because at that time, *inter partes* reexamination had not been ordered in that proceeding, therefore, no suspension could be granted in light of the requirement in 35 U.S.C. § 312(a) that a determination (*i.e.*, reexamination Order) must be mailed by the Office within three months of the filing date of the request for *inter partes* reexamination, and neither patent owner nor the third party requester argued for or against suspension of the 95/000,250 inter partes reexamination proceeding. Patent owner requested that arguments made for suspension in petitions filed in related inter partes reexamination proceedings be incorporated in this proceeding; see page 3, footnote 1, in the September 27, 2007 renewed patent owner petition that are now applicable because *inter partes* reexamination has been ordered in the 95/000,250. The Updated Renewed Petition and Opposition paper filed by third party requester merely incorporates arguments opposing suspension of the 95/000,250 *inter partes* reexamination proceedings that were made by third party requester in those same related *inter partes* reexamination proceedings that are now applicable because *inter partes* reexamination has been ordered in the 95/000,250. It is equitable to view the Renewed and Updated Renewed third party requester papers that were filed concurrently as being a single paper.

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No fee is required for the September 27, 2007 patent owner renewed petition or for the October 3, 2007 renewed opposition paper filed by the third party requester. These papers merely call up for action the patent owner petition to vacate or suspend that was previously filed on May 15, 2007, and the June 14, 2007 opposition thereto that was previously filed by the third party requester. The May 15, 2007 and June 14, 2007 papers were held in abeyance because the originally granted filing date was vacated on other grounds. [2] Each party had remitted the necessary $400.00 petition fee for their respective papers that had been held in abeyance. The present decision is a decision in respect to the May 15, 2007 patent owner petition to suspend or vacate and the June 14, 2007 third party requester opposition thereto.

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,452,863 ("the '863 patent") issued to Michael Farmwald *et al* on July 30, 2002, and is assigned to Rambus, Inc.

2. On April 4, 2007, a request for *inter partes* reexamination of the '863 patent was deposited by a third party requester, David L. McCombs, and was assigned control No. 90/000,250 ("the '250 *inter partes* reexamination proceeding").

3. On May 15, 2007, patent owner filed a petition requesting that the April 4, 2007 filing date accorded to the request for *inter partes* reexamination of the '863 patent be vacated on the grounds that the request did not properly identify the real party in interest in accordance with the reexamination statute and regulations.

4. On May 31, 2007, the Office mailed a Notice advising third party requester that third party requester had the right to file an opposition to the May 15, 2007 patent owner petition, and establishing a fifteen (15) day time period for third party requester to do so.

5. On June 14, 2007, third party requester timely filed the present papers opposing the May 15, 2007 patent owner petition ("hereinafter, the present third party opposition").

6. On June 20, 2007, a decision, *sua sponte*, was mailed vacating the filing date that had been originally accorded to the '250 *inter partes* reexamination proceeding. The patent owner petition and third party opposition thereto were, necessarily, held in abeyance until such time as a corrected request for *inter partes* reexamination was filed and accorded a filing date.

7. On June 28, 2007, a redacted version of the original Request for *Inter Partes* Reexamination was filed in response to the June 20, 2007 decision that had vacated the originally accorded filing date. The redacted version of the Request for *Inter Partes* Reexamination was accorded a filing date of June 28, 2007.

8. The redacted request for *inter partes* reexamination also identified Samsung Electronics Co., Ltd. as the real party in interest.

9. On September 5, 2007, reexamination was ordered for claims 1-35 of the '863 patent.

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[2] See Fact 6, *infra*.

10. On September 27, 2007, the patent owner filed the renewed patent owner petition to vacate or suspend the '250 *inter partes* reexamination proceeding, effectively calling the May 15, 2007 patent owner petition up for action.

11. On October 3, 2007, the requester filed the renewed opposition to the September 27, 2007 patent owner petition, effectively calling the May 15, 2007 requester opposition petition up for action.

12. The '863 patent is currently involved in a number of litigation proceedings. [3]

RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a) IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.– The request shall–
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

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.35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

(a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of

[3] It appears that claim 16 of the '863 patent has been held to be "not invalid." See Special Verdict Form, attached as Exhibit 2 to the present patent owner petition.

any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907 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 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2614 provides, in part:

> The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

DISCUSSION

On April 4, 2007, the third party requester deposited papers requesting *inter partes* reexamination of the '863 patent. Patent owner then filed a petition on May 15, 2007 in which patent owner requested that the Office vacate the filing of the '250 *inter partes* reexamination proceeding. The patent owner's request to vacate the filing date was based upon the assertion that the third party requester had not correctly identified the "real party of interest," as required by 35 U.S.C. 311(b)(1) and 37 CFR 1.915(b)(8) and 1.919(a). Due to the nature of the issues raised by the patent owner, the Office mailed a Notice on May 31, 2007 inviting third party requester to file a paper opposing the May 15, 2007 patent owner petition. On June 14, 2007, third party requester did file such an opposition paper. However, when the request papers were processed by the technical support in the Central Reexamination Unit, it was deemed that the request was not entitled to a filing date. A decision, *sua sponte*, was mailed on June 20, 2007 that so informed the patent owner and the third party requester. The request for inter partes reexamination having not been accepted and accorded a filing date, the petition and opposition thereto were necessarily held in abeyance. Thereafter, a redacted request for *inter partes* reexamination was deposited on, and accorded a filing date of, June 28, 2007. *Inter partes* reexamination was ordered on September 5, 2007.

It is now appropriate, in light of patent owner having called the May 15, 2007 patent owner petition up for action, and the third party requester having called the opposition thereto up for action, that a decision on whether patent owner is entitled to have the '250 *inter partes* reexamination proceeding vacated, or in the alternative, suspended (an issue now appropriate because *inter partes* reexamination has been ordered).

I. Vacatur of the '250 *Inter Partes* Reexamination Proceeding

A. Summary of Patent Owner's Position [4]

35 U.S.C. § 311(b)(1), 37 CFR 1.915(b)(8) and 37 CFR 1.919(a) require that a third party requester who files a request for *inter partes* reexamination identify the real party in interest. The principal basis for patent owner's petition for vacatur of the '250 *inter partes* reexamination proceeding is that the request for *inter partes* reexamination of the '863 patent fails to properly identify the real party in interest (RPI). [5] Specifically, patent owner alleges the third party requester has failed to properly identify the RPI because certain parties asserted to be RPIs have not been identified by the request. Patent owner argues that because these parties have not been identified as real parties in interest, patent owner will

[4] The positions of both parties have been summarized in subsections A and B of Sections I and II of this decision. This decision reflects consideration of all arguments presented by the parties, and any failure to specifically mention a particular argument of either party does not reflect a failure to have considered that argument.

[5] All of the requests for *inter partes* reexamination of the '863 patent have named the same real party in interest, and so the May 15, 2007 petition, although originally addressed to the October 12, 2006 request for *inter partes* reexamination, is also applicable to the June 28, 2007 request for *inter partes* reexamination.

be subject to multiple requests for *inter partes* reexamination in contravention of both 35 U.S.C. § 317(a) and the legislative intent that a patent owner not be harassed by such multiple requests. [6] Patent owner further alleges that the failure to identify all of the real parties in interest will mean that the unidentified parties will be able to evade the estoppel restrictions of 35 U.S.C. §§ 315(c) and 317(b). [7] Patent owner also alleges that third party requester delayed in pursuing this reexamination proceeding for strategic reasons to enable the filing of a series of *inter partes* reexamination requests aimed at patents that are "related" to the '863 patent, all of which are involved in litigation with the identified real party in interest and the other parties in interest who have not been identified. [8]

Patent owner bases these allegations on the fact that, with respect to the '863 patent and the other identified related patents, there are in fact multiple litigations in which patent owner has sued one or more defendants for patent infringement, that the litigations are in different stages along the path to a final determination of patent validity, that the '863 patent and the other patents have been found to be infringed and not invalid (at the district court level), that co-defendants in the litigation have formed an entity called the Advanced DRAM Technology consortium to develop future DRAM technologies and assess and minimize intellectual property related risks, and that there is a "joint defense group" that includes the presently identified real party in interest and other co-defendants in the litigations. [9] Patent owner also states that two of the parties, Samsung and Micron are, and have been, represented by the same counsel. [10]

Patent owner argues that although the reexamination statute does not define "real party in interest," the purposes behind the requirement (that a third party requesting *inter partes* reexamination identify the real party in interest) must be (1) to preclude harassment of the patent owner by the filing (particularly the serial filing) of multiple requests for *inter partes* reexamination, and (2) to provide a basis for allowing a patent owner to avail itself of the estoppel provisions of the reexamination statute. Patent owner presumes that to carry out the intent behind the real party in interest requirement, the phrase real party in interest "is meant to include entities working together with the reexamination requester and entities having a legal relationship with the requester." [11]

B. Summary of Third Requester's Position

Third party requester takes the position that, in accordance with 37 CFR 1.915(b), the real party in interest has been properly identified, because such identification need only be sufficient so that a party wishing to file an *inter partes* reexamination request will be able to determine whether that party is in privity with the identified real party in interest, and if not, will then be able to make the certification required by 37 CFR 1.915(b)(7). [12] Third party requester argues out that the issue of whether a party is in privity with another "must be decided on a case-by-case (*sic*, basis), evaluating all of the facts and circumstances of each individual situation. [13] Third party requester points out that:

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[6] Petition to Vacate or Suspend, May 15, 2007, page 2.
[7] *Id.*
[8] *Id.*, at page 2 and the first paragraph of page 3.
[9] *Id.*, at pages 3-7.
[10] *Id.*, at pages 10.
[11] *Id.*, at page 9.
[12] Petition and Opposition to Petition to Vacate or Suspend, June 14, 2007, page 5.
[13] *Id.*, at page 6, citing Response to General Comment 4, 37 CFR Part 1 *Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule*, 65 FR 76759 (Dec. 7, 2000).

> ... the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of § 1.907 do not prohibit the filing of the inter partes reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would need to be addressed. [14]

Third party requester then argues that patent owner has not challenged the accuracy of the certification in the request for reexamination in the present '250 *inter partes* reexamination proceeding (that Samsung is a real party in interest), that the Office has no present need to do so, that Samsung was not a requester in an earlier *inter partes* reexamination proceeding for the '863 patent, and no estoppel against Samsung, having filed the request for the present '250 *inter partes* reexamination, exists. Third party requester further argues that because no other party controls or is substantially participating in the '250 *inter partes* reexamination proceeding, no other party is a real party in interest. [15] Third party requester concludes that, as the only party controlling and participating in the '250 *inter partes* reexamination proceeding, Samsung is the only real party in interest, and was properly identified as such in the request for *inter partes* reexamination.

C. Analysis and Findings

Note is taken of patent owner's argument that co-defendants of third party requester, and/or members of a "joint defense group," are required to be named as real parties in interest in the '250 *inter partes* reexamination proceeding; however, the argument is not persuasive. The fact that Samsung's co-defendants may benefit from this reexamination request, and/or that Samsung may be cooperating with others in a concurrent litigation involving the '863 patent and in other concurrent litigation involving related patents, would not, *per se*, show that those co-defendants or "joint defense group" members are real parties in interest in this *inter partes* reexamination proceeding.

It does not appear that the Office is in any way required to investigate and determine the accuracy of a certification made by a third party who files a request for *inter partes* reexamination of a patent. The reexamination statute does not require the Office to investigate the matter, nor does it provide the tools for the Office to do so. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination - - nor did Congress authorize the Office to impose punitive sanctions for non-compliance. Such evidentiary tools and sanctions are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest." [16]

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[14] *Id.*

[15] *Id.*, at pages 6-7.

[16] Attention is invited to *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), where the court took note of parties' availability of the court's investigative powers, to address the absence of same to the Office.

> "During ex parte PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under 37 C.F.R. Section 1.132 (1993). Moreover, if applicants wish to cross-examine the authors of written hearsay assertions, under 35 U.S.C. Section 145 (1988) they may bring a civil action in the United States District Court for the District of Columbia seeking adjudication that they are entitled to receive a patent. In such an action, testimony could be compelled by subpoena under Federal Civil Procedure Rule 45. See Gould v. Quigg , 822 F.2d 1074, 1076, 3 USPQ2d 1302, 1303 (Fed. Cir. 1987) ("While the evidentiary record before the

To expand, courts have discovery, testimony and other evidentiary tools (e.g., subpoena power and sanctions) available, and are the forums best equipped to determine who is, and who is not, the "real party in interest." Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if such an *inter partes* reexamination request was filed by one of the other parties in the civil action, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 USC 301-302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest. [17] In addition, if (1) a decision in the present *inter partes* proceeding is ultimately made which is adverse to the requester, and (2) the issue is presented before a court, any estoppel considerations which may or may not apply from the *inter partes* reexamination statute, depending on the court's resolution of the "real party in interest" issue, can be addressed by the court at that time.

It is also to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) [18] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees [19]. Where such precedent requires a party whose disclosure has been challenged to provide support for the disclosure, the examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. The Office does not possess subpoena, discovery, hearing and sanction tools that a court and certain other tribunals possess. A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so.

Board serves as the 'evidentiary nucleus' of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence."). [32 F.3d at 1565, 31 USPQ2d at 1821]

Note MPEP 2010 which states:

"The Office is not the best forum in which to determine whether there was an 'intent to mislead'; such intent is best determined when the trier of facts can observe demeanor of witnesses subjected to cross-examination. A court, with subpoena power, is presently the best forum to consider duty of disclosure issues under the present evidentiary standard for finding an 'intent to mislead'."

See also MPEP 2686.04(III) which points to this difference between the Office and the courts stating:

"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)."

[17] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

[18] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[19] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

With respect to 37 CFR 1.915(b) regarding the issue of "real party in interest," the following discussion is provided. 37 CFR 1.915(b)(8) requires "[a] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy." As argued by third party requester, Samsung is identified as the "real party in interest." Samung further has been identified sufficiently for a party to know where it is located, and which business it operates under. Parties who would seek to file subsequent requests for *inter partes* reexamination of the '863 patent, and/or who may be subject to estoppels in litigation involving the '863 patent (if any such estoppels should result from the present '250 *inter partes* reexamination proceeding), have been provided with sufficient information to make an informed determination as to whether any relationship that they might have with third party requester Samsung would trigger a statutory estoppel. To the extent that petitioner construes 37 CFR 1.915(b)(8) to require inclusion of the identity of all parties who would be related or co-defendants of Samsung, such a construction would be unreasonable. As pointed out by third party requester, simply because a party may be related to, or is, a co-defendant of Samsung does not necessarily make that party a "real party in interest," because such party does not necessarily direct or control input into the '250 *inter partes* reexamination proceeding in any way. To the extent that petitioner patent owner has characterized requester's identification of the "real party of interest" as improper or erroneous, patent owner has not shown that any party other than the party identified in the request for *inter partes* reexamination is in fact in control or is a directly contributing "real party in interest"; patent owner has simply shown that the co-defendants are simply -- co-defendants in one or several civil suits who have formed a "joint defense group" for the purposes of that litigation. The Office is unaware of any authority that equates co-defendants in a civil suit with "real parties in interest" in an *inter partes* reexamination proceeding, and petitioner patent owner has cited none.

As a final point regarding requester's identification of the real party of interest, the Office relies on factual assertions made before it as true. See 37 CFR 10.18(b) ("By presenting to the Office . . . any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that . . . statements made therein of the party's own knowledge are true . . ."). And, as explained earlier, the Office is not equipped with the proper evidentiary tools to scrutinize the veracity of such asserted facts.

II. Suspension of the '250 *Inter Partes* Reexamination Proceeding

A. Summary of Patent Owner's Position

Patent owner argues that suspension of the '250 *inter partes* reexamination proceeding is warranted because of concurrent litigation that involves claim invalidity issues on grounds that cannot properly be decided in *inter partes* reexamination, such as invalidity under 35 U.S.C. § 112 written description issues. In this regard, patent owner draws attention to a verdict that has already been rendered in which a patent claim of the '863 that has been litigated has been held to be "not invalid" on such issues. [20]

Patent owner further argues that the litigation involves issues that district courts "can resolve more readily" through the use of discovery and their subpoena powers. [21,22] Patent

[20] Petition to Vacate or Suspend, May 15, 2007, pages 13-14.
[21] *Id.*, at page 14.
[22] Interestingly, patent owner argues here that he district courts can, by virtue of such powers, require other members of the joint defense group to address their participation in the present *inter partes* reexamination

owner also argues that suspension of the proceedings will lessen the burden on the Office that results from an alleged strategy on the part of the named real party in interest of serially filing delayed *inter partes* reexamination requests. Patent owner notes that the '250 *inter partes* reexamination proceeding is not at an advanced stage, while the litigations are far advanced, and that these facts support suspension of the '250 *inter partes* reexamination proceeding. [23]

B. Third Party Requester's Position

The third party requester argues that no good cause exists for suspension of the '250 *inter partes* reexamination proceeding. In this regard, third party requester argues that the Office has discretion to determine whether or not to suspend, and that there is no basis for the exercise of that discretion. Requester argues that there are no issues pending in the district court cases that would effect the issues in the '250 *inter partes* reexamination proceeding, that the courts subpoena powers would not have any effect on patentability issues in the '250 *inter partes* reexamination proceeding, and that there has been no final decision in the litigation on claim validity with respect to the issues involved in the '250 *inter partes* reexamination proceeding. [24]

C. Analysis and Findings

In *Sony Computer Entertainment America, Inc. et al v. Jon W. Dudas*, 2006 U.S. Dist. LEXIS, 36856 (E.D. Va. 2006), the court noted that 35 U.S.C. § 314(c) afforded the USPTO Director discretion to suspend an *inter partes* reexamination for good cause. *Id.*, at *15. The court went on to hold that the USPTO Director has wide latitude in exercising this discretion. The court refused to overturn the suspension of the two *inter partes* reexamination proceedings that had been ordered by the Office. [25]

The circumstances in which the Office had ordered suspension of the *inter partes* reexamination proceedings that were before the district court in *Sony* were:

1. The *inter partes* reexamination proceedings were in an early stage of prosecution;

2. Copending litigation involving the same patents that were the subject of the *inter partes* reexamination proceedings were near to a final disposition, because the litigation was before the United States Court of Appeals for the Federal Circuit; and

3. A decision on claim validity in the litigation would dispose of all issues of claim validity in the reexamination proceeding because:

   a. The prior art before the court and before the Office was identical and

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proceeding. It is noted that this argument buttresses the position stated in Section I(C) with respect to why patent owner's position regarding the issue of the identification of "real party in interest" is not persuasive.

[23] Petition to Vacate or Suspend, May 15, 2007, pages 15-17.

[24] In general, see Petition and Opposition to Petition to Vacate or Suspend, June 14, 2007, pages 7-10 for all of the arguments advanced by third party requester as bases for not suspending the '250 *inter partes* reexamination proceeding.

[25] Decision Granting Petitions to Suspend, Nov. 17, 2005, (Spar, Director) of record in *inter partes* reexamination proceedings 95/000,093 and 95/000,094.

b. The claims before the court and before the Office were identical.

These factors were determined by the Office to constitute "good cause" for suspension of an *inter partes* reexamination proceeding, and the Sony court agreed that the Office had properly exercised its discretion under 35 U.S.C. § 314(c) to suspend the two *inter partes* reexamination proceedings.

In the present instance, it is true that the '250 *inter partes* reexamination proceeding is at an early stage of prosecution. However, petitioner patent owner has not demonstrated that the copending litigation involving the '863 patent that is the subject of the '250 *inter partes* reexamination proceeding is at an advanced stage wherein a decision on the merits of all issues that the Office must address in the '250 *inter partes* reexamination proceeding will be determined by a final, nonappealable court decision in the foreseeable future. It is to be noted that although patent owner has pointed out that one of the '863 patent claims has been held to be "not invalid" with respect to written description issues in the *Hynix* litigation, patent owner has not alleged that there has been even an initial (*i.e.*, district court) validity determination in any litigation for all of the claims of the '863 patent that are subject to reexamination in the present '250 *inter partes* reexamination proceeding (*i.e.*, patent claims 1-35). Patent owner has merely alleged that "[A]lthough the claims at issue in these proceedings are not identical to those in the litigations, decision by the Federal Circuit following the district court litigations might cast light on the appropriate disposition of any claims that remain in the reexamination." The speculative nature of the effect that a final decision that is not yet near to being rendered might have is, in balance, insufficient to provide sufficient good cause that would outweigh the statutory mandate that *inter partes* reexamination proceedings are to be conducted with special dispatch within the Office. That mandate is one that is concerned not only with the interests of patent owners and parties adverse to patent owners, but is also concerned with the public interest.

Further, patent owner has not demonstrated that all of the '863 patent claims that are being reexamined before the Office are also the subject of the copending litigation. The public is entitled to a determination conducted with special dispatch in the Office of the issues involving claims that are being reexamined in the '250 *inter partes* reexamination proceeding which will not be subject to a validity determination in copending litigation. Patent owner has not demonstrated any good cause to deprive the public of such a determination merely because patent owner may, at some point in the future which is highly uncertain, obtain a final, nonappealable determination on validity in copending litigation that involves only some of the clams that are being reexamined in the '863 *inter partes* reexamination proceeding.

Thus, although the '250 *inter partes* reexamination proceeding is still in an early stage, the petitioner patent owner has failed to demonstrate that the copending litigation involving the '863 patent is near to a final, nonappealable determination of invalidity of any of the clams currently being reexamined in the '250 *inter partes* reexamination. Further, petitioner patent owner has not shown that any final, nonappealable determination of validity that might someday result from the copending litigation will, at least potentially, require termination of the '250 *inter partes* reexamination as to all of the '863 patent claims. [26] The

[26] Only a final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). While a patent owner cannot predict the final outcome of litigation that is copending with a reexamination proceeding in the Office, it is clear that if fewer than all of the patent claims that are being reexamined are the subject of such copending

failure of petitioner patent owner to make a satisfactory showing on these points argues against suspension of the '250 *inter partes* reexamination proceeding. The public interest, and the interests of the third party requester in the '250 *inter partes* reexamination proceeding argue in favor of the '250 *inter partes* reexamination proceeding continuing with special dispatch in the Office, rather than being suspended. Petitioner patent owner has not demonstrated that there is sufficient "good cause" to suspend the '250 *inter partes* reexamination proceeding.

CONCLUSION

1. The petition to vacate, or in the alternative, to suspend the '250 *inter partes* reexamination proceeding is granted only to the extent that the petition has been considered and entered into the record by way of waiver of 37 CFR 1.939. However, the petition is dismissed as to the requested vacatur, and as to the requested suspension, of the reexamination proceeding.

2. The parties to the '250 *inter partes* reexamination proceeding should keep the Office apprised of the progress of the litigation involving the '863 patent.

3. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, 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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November 9, 2007

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litigation, then even a final, nonappealable decision in that litigation will not dispose of all of the claims that are being reexamined.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 12/12/2007

EXAMINER	
ART UNIT	PAPER NUMBER

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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DATE MAILED: 12/12/2007

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

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(For Patent Owner)

MAILED
DEC 12 2007
CENTRAL REEXAMINATION UNIT

David L. McCombs
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(For Third Party Requester)

In re Rambus, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,250
Filed: June 28, 2007
For: U.S. Patent No. 6,452,863

: **DECISION DISMISSING**
: **PETITION TO**
: **VACATE-IN-PART THE**
: **ORDER GRANTING**
: **REEXAMINATION**

This is a decision on the September 27, 2007 patent owner petition denominated "PETITION TO VACATE-IN-PART THE ORDER GRANTING REEXAMINATION." Petitioner patent owner requests waiver under 37 CFR 1.183 of 37 CFR 1.939 to allow entry and consideration of this paper. Patent owner has paid the requisite petition fee by remitting a check in the amount of $400.00.

The September 27, 2007 papers also include Exhibits A-C, and a certificate of service showing service of the petition and Exhibits A-C on the reexamination requester

The petition and the 95/000,250 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The patent owner's petition is dismissed for the reasons set forth below.

Summary: The request to vacate-in-part the order of reexamination by withdrawing various substantial new questions is not persuasive. An order to reexamine is a determination by the Director that the Office has jurisdiction to reexamine the patent claims. Once jurisdiction is established based upon a finding that a proper substantial new question of patentability (SNQ), statement of further grounds for jurisdiction is irrelevant to the question of jurisdiction. The relief requested - withdrawal of the finding of an SNQ grounded on the intervening art - does not affect the jurisdictional issue that is the sole purpose of the order.

This decision also addresses in detail the various arguments put forth by patent owner as to the propriety of addressing priority benefit for the patent claims within the context of reexamination. The decision explains why the citations provided by patent owner as support for its position as to SNQ, among others, are not persuasive under the facts in the '250 reexamination proceeding. The decision finds that if and when a rejection is instituted

based upon the examiner's findings of SNQ that patent owner is challenging in the present petition, the correct venue for obtaining relief is by appeal to the Board of Patent Appeals and Interferences (BPAI), not by petition to the Director.

BACKGROUND

1. U.S Patent number 6,452,863 ("the '863 patent") issued to Michael Farmwald *et al* on September 17, 2002, and is assigned to Rambus, Inc.

2. On April 4, 2007, a request for *inter partes* reexamination of the '863 patent was filed by a third party requester, David L. McCombs, and was assigned control No. 90/000,250 ("the '250 *inter partes* reexamination proceeding").

3. The third party requester identified Samsung Electronics Co., Ltd. as being "the real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b).

4. On May 15, 2007, patent owner filed a petition requesting that the April 4, 2007 filing date accorded to the request for *inter partes* reexamination of the '863 patent be vacated on the grounds that the request did not properly identify the real party in interest in accordance with the reexamination statute and regulations.

5. On May 31, 2007, the Office mailed a Notice advising third party requester that third party requester had the right to file an opposition to the May 15, 2007 patent owner petition, and establishing a fifteen (15) day time period for third party requester to do so.

6. On June 14, 2007, third party requester timely filed papers opposing the May 15, 2007 patent owner petition.

7. On June 20, 2007, prior to a decision on the April 4, 2007 papers requesting *inter partes* reexamination of the '863 patent, the Office mailed a decision *sua sponte* vacating the reexamination filing date, which (1) vacated the April 4, 2007 filing date for the papers requesting *inter partes* reexamination of the '863 patent, and (2) set a thirty (30) day period for the third party requester to file a response to the June 20, 2007 Decision that would make the request papers filing-date compliant.

8. On July 12, 2007, the Office mailed a decision holding in abeyance the May 15, 2007 patent owner petition and the June 14, 2007 third party requester petition in opposition to the patent owner petition.

9. On June 28, 2007, requester filed a redacted request for reexamination of the '863 patent. This redacted request was granted a filing date of June 28, 2007, and retained the '250 control number.

10. On September 5, 2007, the Office mailed an order granting reexamination for claims 1-35 of the '863 patent.

11. On September 27, 2007, the patent owner filed a renewed patent owner petition to vacate or suspend the '250 *inter partes* reexamination proceeding, on the grounds that the request did not properly identify the real party in interest, effectively calling the May 15, 2007 patent owner petition up for action.

12. On September 27, 2007, patent owner filed the instant petition requesting that the reexamination order be vacated-in-part.

13. On October 3, 2007, the requester filed a renewed opposition to the September 27, 2007 patent owner petition, effectively calling the May 15, 2007 requester opposition petition up for action.

14. On November 9, 2007, the Office mailed a decision dismissing the petition to vacate the entire proceeding based upon improper identification of the real party in interest.

DECISION

I. Relevant Statute, Regulations, and Examining Procedure

The relevant portions of the statute, regulations and MPEP are reproduced below.

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 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 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).."

II. Patent Owner's Position

Patent owner puts forth the position that four of the bases asserted by requester to raise substantial new questions of patentability rely on publications that would not qualify as prior art if the patent under reexamination was afforded the effective filing dates of the prior applications of which it claims benefit under 35 USC § 120. Patent owner objects to the designation of these four bases that are asserted to demonstrate substantial new questions of patentability in the order as being beyond the authority of the Office because "[w]here a patent has essentially the same disclosure as the priority document, the priority determination becomes a reassessment of whether that patent provides written description support for the claims under 35 USC § 112, ¶ 1, which is beyond the Office's authority in reexamination " [1] Patent owner, cites to MPEP § 2617, and various papers in other Office proceedings [2] in support of this position.

Patent owner requests that the order be vacated-in-part and that the "scope of the reexamination be limited to issues that do not relate to whether the claims have written description support." [3]

III. Analysis and Findings

The Order Granting Reexamination Was Not An *Ultra Vires* Action

The question of whether an order granting reexamination is based upon 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 not based wholly or **in part** upon prior art patents or printed publications, (*i.e.*, the order granting reexamination is based wholly upon consideration of subject matter that is not permitted by the statute), then the granting of a request for reexamination is said to be an *ultra vires* action that is outside of the authority of the Office. However, a substantive determination to order reexamination based upon grounds permitted by the statute is not subject to judicial review. [4]

The request for reexamination, filed on June 28, 2007, cited numerous patents and printed publications upon which requester asserted grounds for finding a substantial new question of patentability. One of the cited publications is identified as the iAPX Manual. [5] The iAPX manual's publication year of 1982 is a date earlier than the earliest date recited in the benefit claim of the '863 patent. The iAPX publication was not of record during the original examination of the application that matured into the '863 patent.

The order for reexamination mailed September 5, 2007, found multiple substantial new questions of patentability (SNQs) with respect to each of the claims of the '863 patent.

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[1] Petition at page 2.
[2] Exhibits A-C.
[3] Petition at page 6.
[4] *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)
[5] iAPX 432 Interconnect Architecture Reference Manual, published 1982.

Accordingly, the Office took jurisdiction over the patent by ordering reexamination in the '250 proceeding.

Specifically, the examiner's order granting reexamination held that the iAPX manual [6] on its own raised a substantial new question of patentability with respect to claims 1-20 and 24-35, and that in combination with other appropriately qualified prior art publications it raised a substantial new question with respect to claims 21-23 as well. [7] The examiner therefore granted the request for reexamination. [8] Pursuant to 35 U.S.C. § 313 [9] and MPEP § 2643, [10] the examiner ordered reexamination of all patent claims.

The order granting *inter partes* reexamination, having been based upon prior art publications that raised a substantial new question of patentability with respect to one or more of the '863 patent claims, was thus 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, the examiner's order granting reexamination was not an *ultra vires* act on the part of the Office.

The examiner's decision represents the exercise of discretion in reaching the conclusion that the requester has proffered prior art printed publications for consideration as the basis for the request for *ex parte* reexamination of the '863 patent. 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 then 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."

In this instance, the Office clearly has not acted in 'brazen defiance' of its statutory authorization, in finding that it has jurisdiction to order reexamination, and as such, the order for reexamination must stand.

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[6] See issues 4 and 7-13.

[7] The '863 patent contains claims 1-35.

[8] See Order Granting Reexamination dated September 5, 2007, at page 5.

[9] 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.)

[10] 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."

Patent owner contends that the additional grounds for granting reexamination on allegedly intervening prior art [11] was an *ultra vires* act that should be set aside.

> "Specifically, the portion of the order granting reexamination based on a question as to the patent's priority date is beyond the Office's authority because the patent at issue in this proceeding has the same or essentially the same disclosure as the application relied on for priority." [12]

The patent owner's belief that the SNQ which the examiner based upon some of the art advanced is legally impermissible in this proceeding does not, however, convert the proceeding into a question of the examiner's jurisdiction to reexamine, which would create a petition right to contest the propriety of taking that action. Rather, the patent owner is free to contest such an issue before the patent owner, and then the Board of Patent Appeals and Interferences ("Board"), if the claims are rejected based upon the contested references. 37 CFR 1.181(a)(1) permits petitions only from matters that are not subject to appeal; in this instance, if a rejection based on the contested references would be made and maintained, the route to contest that rejection would be via appeal.[13] Even if the contested references are not tenable to provide a substantial new question of patentability, the above-referred-to iAPX manual conferred the Office with jurisdiction to order the reexamination, and there was no *ultra vires* action on the part of the Office.

After a review of the record, it is found that patent owner has not established that the Office "clearly exceeded its statutory authority," or acted "in brazen defiance of its statutory authorization," in the Office's determination that the reexamination request properly raised a substantial new question of patentability.

For the forgoing reasons, the order granting reexamination will not be disturbed, and the '250 *inter partes* reexamination proceeding will continue in its examination stage.

IV. Additional Discussion

A. The Director can not "vacate-in-part" the order granting reexamination.

A decision granting reexamination is a determination that a sufficient basis has been raised for the Office to assume jurisdiction over the patent in question and to proceed with reexamination of at least those claims for which a proper substantial new question of patentability has been raised. As pointed out above, review of the order granting reexamination reveals that at least one SNQ has been raised for each and every claim of the '863 patent based upon references that qualify as prior art, irrespective of the priority date

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[11] These grounds are referred to as issues 1-3 and 6 in the request and the order and are based on a US patent to Park (filed Dec 29, 1995), the JEDEC standard (published in 1999) and the Hynix publications.

[12] Petition, bridging pages 1-2.

[13] Briefly, in this instance, benefit under 35 USC § 120 is challenged based on a question of whether specific claim elements find support in the priority applications for which benefit is claimed. This, combined with intervening art based upon the later effective filing date to be afforded the claims, is a legitimate issue for treatment in reexamination, should a rejection be made. Patent owner's arguments as to the authority of the Office to find a substantial new question of patentability based upon allegedly intervening prior art in the circumstances of this specific proceeding will however be addressed at length below.

benefit granted to the claims of the '863 patent. Accordingly, there is no basis for vacating reexamination with respect to any claim of the '863 patent. The Office's jurisdiction over the proceeding is not taken in-part; either the Office has jurisdiction to reexamine or it does not. In this case, the Office does have jurisdiction.

B. The allegedly intervening prior art properly raise substantial new questions of patentability

Patent owner attempts to characterize the grounds for reexamination proposed by requester and accepted by the examiner as whether the specification of the patent has adequate written description (under 35 U.S.C. 112 first paragraph) to support the claims. This mischaracterizes the request for reexamination and the order granting reexamination. Rather, the issue is whether the patent claims to be reexamined [14] are entitled to benefit under 35 U.S.C. 120 of the filing date(s) of one or more prior filed applications, to thereby avoid the asserted art, or whether they are not so entitled. The issue of whether the instant specification satisfies the written description requirement of 35 USC 112 first paragraph is not raised nor implicated in the order granting reexamination.

The '863 patent claims priority directly from US Patent 6,034,918 (the '918 patent) filed February 19, 1999 which claims priority from US Patent 6,038,195 (the '195 patent) filed November 20, 1998 and through a further chain of applications ultimately claims benefit of the April 18, 1990 filing date of application number 07/510,898.

As a precursor to applying intervening art, the request propounds the position that the '863 patent is not entitled to benefit of the filing date of its immediate parent (the '918 patent).

The first argument [15] put forth by the requester with respect to the granting of priority for the '863 patent is based on the filing of a copy of a declaration in the '918 patent from the original '898 application, which perforce did not make reference to a concurrently filed preliminary amendment. Thus, it is argued, that under the rules then in effect, the preliminary amendment in the '918 application is not part of the original filing and cannot be relied upon for establishing priority.

The second and related argument as to priority is simply that there is no support for certain specific claims of the '863 patent in the prior application. Pages 10-19 of the request are devoted to a detailed elaboration [16] of elements of claims 1-3, 6-16, 19-23, 25-30 and 32-35 of the '863 patent, presenting specific arguments as to why the specification of the '918 patent does not provide written description support of these elements.

Petitioner patent owner, focusing on the first prong, contends that this argument is fallacious because "it would apply to almost all patents that result from continuations" and that accepting this argument "would subject every continuation to a priority attack ... just because an applicant files a continuation application, presents, a preliminary amendment, and files a copy of an oath or declaration from the parent application." [17]

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[14] This analysis must be carried out on a claim-by-claim basis.

[15] Request for reexamination Section A.2 on pages 9-10

[16] This is in contrast to the Gorra decision discussed below in which the Examiner found that there was no specificity to requester's allegations of lack of support.

[17] Petition at paragraph bridging pages 5 and 6.

Petitioner misses the point. In fact, every application is subject to a priority attack without regard to the declaration filed. Every continuing application, irrespective of designation, must contain support for the claims in the parent application in order to derive benefit of the filing date of the earlier application. The issue raised in this request relates to the declaration in the '918 parent patent. [18] The argument is that because of the rule in place at that time, the preliminary amendment is not entitled to the benefit of the filing date of the application, and thus can not be relied on when seeking support for the claims of the current patent in the disclosure of the '918 patent. [19]

Note that the request does not merely rely on the declaration, but enumerates specific claim elements and presents argument as to the lack of support in the prior application for the claimed element.

The order cites both these reasons [20] as raising a question of the appropriate priority date and then proceeds to find that the intervening references are adequate to raise a substantial new question of patentability for the relevant claims.

C. If Examiner issues a rejection that would be appealable to Board.

Patent owner requests that the Director preempt the examiner from issuing any rejections based upon the intervening art provided by the requester. This, however, is not a petitionable issue, as discussed above. It is the Board of Patent Appeals and Interferences ("Board") which reviews the decision of the examiner as to whether a rejection should be made. There is also no showing that making a rejection based upon the intervening art advanced by the requester would be an abuse of the examiner's discretion. If the examiner determines that (a) there are claim elements that are not supported in the prior applications and (b) that the art reads upon the claims then the examiner has the discretion to issue a rejection upon the claims, and the Board may review it, if appealed to the Board by the patent owner.

Stated another way, patent owner's belief that any rejection based upon the intervening publications is legally impermissible in this proceeding would not convert the examiner's promulgation of such a 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 with the Board. [21] Any rejection maintained and made final by the examiner issuing a Right of Appeal Notice [22] in this proceeding, may

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[18] Insofar as any similar comment was made by the examiner with respect to the declaration in the patent now under reexamination, it has no bearing on any priority benefit.

[19] Note further, that the order points petitioner to a course of action that may result in the elimination of this issue.

[20] Order granting reexamination, paragraph bridging pages 7-8.

[21] See 35 U.S.C. § 315; see also 37 CFR 1.959 and 41.61.

[22] See 37 CFR 1.953.

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, 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 '863 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 in Section III above, the Office had clear jurisdiction to order reexamination.

Thus, 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 from a decision reviewing an adverse decision on petition. [23] 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 allegedly based upon subject matter not proper for consideration in reexamination is properly determined by appeal, and not by way of petition.

V. Supporting authority for petition decision

BPAI decision dated September 25, 2007, in Reexamination Control No. 90/006,621

The situation in *ex parte* reexamination proceeding 90/006,621 (the '6621 proceeding) is closely analogous to the fact situation before the Office in this case and sheds light on the proper approach to the issue of the appropriateness of assessing the entitlement of a benefit claim within the context of a prior art rejection during reexamination.

The '6621 proceeding was a reexamination of U.S. Patent No. 5,964,604 (the '604 patent) which issued on December 12, 1997 from an application filed in March of 1994. The '604 patent claimed priority (as a continuation of) to U.S. patent No. 5,964,603 (the '603 patent) which also issued on December 12, 1997, but was filed in March of 1990. The '603 patent further claimed benefit of two other applications filed in 1985 and 1982 respectively.

The examiner in the '6621 reexamination proceeding determined that the '604 patent was not entitled to 35 U.S.C. 120 benefit of any of the 3 parent applications for the claims under reexamination, because various claim features were not supported by the disclosures in the prior applications, and the examiner accordingly rejected many of the claims over a reference with a 1988 date.

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[23] In *Patlex*, reexamination had been order based upon five substantial new questions of patentability. See *Patlex*, at page 35.

Patent owner pointed out that the applications were designated as continuations [24] and contained identical disclosures and argued, that in such a situation, raising the issue of affording benefit amounted to questioning the sufficiency of the written description of the patent under reexamination - something clearly precluded by the reexamination statute.

In a decision [25] rendered September 25, 2007, a panel of the Board found that the question of affording benefit under 35 U.S.C. 120 was within the jurisdiction of the Office. The Board explained that the issue was not how the relationship of the applications was characterized, but whether support existed in the prior application.

> "The question of whether the '604 patent is properly labeled a 'continuation' ... is a collateral issue to the real issue of whether there is written description for the term ... in the 1982 application. [26]

> "Regardless of what an application is called, there is only priority for common subject matter actually disclosed in the earlier application." [27]

The panel then proceeded to address each contested claim element and determined whether there was support in the prior applications that provided the benefit of the earlier filing dates. The Board supported the examiner's position and affirmed the rejections based upon the intervening prior art.

VI. Analysis of authorities cited in Patent Owner's petition

Patent owner relies on various documents in support of the proposition that a determination of the right to priority is precluded in a reexamination proceeding because it is a collateral attack on the written description support of the patent under reexamination.

The following subsections address each of these citations [28] in turn and explain why they are not controlling under the facts in this proceeding.

1. The Fischell Decision: Exhibit A - June 30, 2005 Decision on petition in Reexamination Control No. 90/007,355 .

A request for reexamination of U.S. patent No. 6,527,817 (the '817 patent) was filed on December 22, 2004, and resulted in an order issued by the examiner on March 15, 2005, denying reexamination. On April 15, 2005, the requester filed a petition under 37 CFR 1.181 asking the Director to review the decision of the examiner. On June 30, 2005, the Office issued a decision (referred to by the instant petitioner as the "Fischell Decision") on the 37 CFR 1.181 petition determining that the examiner was correct in denying reexamination of the '817 patent based on the request under review.

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[24] "a continuation application does not contain new matter, and all claims issuing from it are entitled to the filing date of the parent." Decision in Appeal 2007-1217 at 66, quoting from patent owner's brief .

[25] Appeal 2007-1217 Decision dated September 25, 2007, mailed October 2, 2007

[26] *id.* at 66

[27] *id.* at 67

[28] Exhibit C, a decision in 95/000,089 needs no discussion as it supports the position that if a reexamination is properly ordered, rejections are resolved by resort to appeal, not by way of petition.

Patent owner relies on the Fischell decision for the proposition that "reassessment [of a benefit claim] is not appropriate with respect to a continuation ... patent having a disclosure that is essentially identical to the disclosure in its parent patent." [29] Petitioner further contends "that the Office has acknowledged that it is precluded from reconsidering in reexamination a claim for priority under 35 USC 120 where the continuing application contains essentially the same disclosure." [30]

Patent owner's reliance on the Fischell decision is misplaced because (a) petitioner's selective use of a portion of a single paragraph of the full decision is not representative of the context and the holding; (b) the facts and holding were directed to a case where the issue of benefit was not properly raised; (c) the paragraph repeatedly cited by petitioner was not needed for the decision upholding the denial of reexamination; and finally (d) a decision by a group director in one proceeding (although informative) is not binding precedent on another group director (or Central Reexamination Unit director) in a different proceeding.

The following is cited from the '7355 decision to clarify the aforementioned points.

> "A review of the position taken by requester in the ex parte reexamination request clearly shows that the request is predicated on showing that the claims of the '817 patent are based upon a specification that is alleged to be defective under 35 USC 112, first paragraph because the specification allegedly fails to enable the practice of the subject matter claimed in the '817 patent. Although petitioner argues that the reexamination request merely addresses the question of whether the '817 patent is entitled to 35 USC § 120 benefit of the three prior United States patents, ***the request in fact is not directed to the issue of whether the '817 is entitled to a given prima facie date of invention*** for any or all of its claimed subject matter based upon the parent patents ***or is limited to its actual filing date. Instead, the request for reexamination is premised on evidence, and argument based on that evidence, which allegedly demonstrates that the claims of the '817 patent are not enabled by the specification of the '817 patent under 35 USC § 112, first paragraph."*** [31] [Emphasis added]

The decision then addresses the specific evidence provided in support of the request, stating:

> ***"Given the manner in which the reexamination request repeatedly emphasizes that the '817 patent does not enable the claimed invention,*** petitioner's attempt to characterize the request for reexamination as not being based on lack of enablement and failure to meet the written description requirement in the '817 patent itself, because such attack would clearly be "prohibited by the rules", is simply not persuasive. The request quite clearly indicates that the specification of the '817 patent does not enable the claimed invention in the '817, and does not merely argue that the '817 patent is

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[29] Petition at 4, citing Fischell Decision at 4 n. 21.

[30] Petition at 4, citing Fischell Decision at 4-5

[31] Fischell Decision at 3. Emphasis added.

> restricted to its actual filing date as the prima facie date for the invention claimed therein." [32] [Emphasis added]

The decision then goes on (as cited by petitioner) to state that, in any event, since the specification of the patent under examination is essentially identical to the parent applications from which it seeks benefit, review of the benefit claim is inappropriate. However, in the interest of addressing all possible contentions, the decision concludes:

> "And even if the reexamination request were somehow perceived as being confined only to the question of whether the parent patent(s) support a particular invention date for the claims of the '817 patent, the evidence presented on that question is not regarded as being of sufficient clarity and detail so as to support a finding that substantial new question of patentability is raised by the request for ex parte reexamination." [33]

As seen by the first two paragraphs reproduced above, in this instance where the bulk of the evidence and argument was directed to the sufficiency of the disclosure of the '817 patent itself, the issue that the requester set forth was outside the realm of reexamination. Under these facts, the Director did not find petitioner's attempt to recharacterize the request as an attack on the right to claim benefit to be credible and thus found that the examiner correctly denied reexamination. Further, one basis for the decision was that the request did not provide enough "clarity and detail" to negate the parent patent(s) support of a particular invention date for the claims of the '817 patent.

2. The Gorra Order: Exhibit B - Reexamination Control Number 95/000,108.

Patent owner relies on the examiner's decision denying reexamination of U.S. patent 6,936,104 (the '104 patent) to support the proposition that within a reexamination proceeding, the Office is generally precluded from determining whether an application relied upon for benefit of a priority date supports the claimed invention. [34]

As a preliminary matter, it is worth noting that the "Gorra order" was a determination by an examiner, and therefore does not have binding precedential value. The requester did not challenge the decision.

A request for *inter partes* reexamination of the '104 patent was filed on August 30, 2005. The request put forth the position that the '104 patent contained new matter with respect to the patent from which it claimed benefit under 35 USC 120, and thus was unpatentable based on intervening art published before its filing date.

The examiner issued an order denying the request for reexamination on October 20, 2005. With respect to the issue of the proper effective filing date for the application the examiner noted [35] "... the Requester has failed to provide any specific analysis why a given limitation in a given claim lacks support in the parent. . . . The requester has not provided a discussion

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[32] Fischell Decision at 4. Emphasis added

[33] Fischell Decision at 6.

[34] Petition at 4, citing pages 6-7 of the Order Denying Reexamination mailed October 20, 2005, in control no. 90/000,108.

[35] See paragraph 16 on page 8 of the Gorra Order

of which specific claim in the patent undergoing reexamination contains which specific limitation that is not supported in the parent application."

Thus, unlike the situation in the '250 proceeding, the requester only alleged that the second patent did not qualify as a proper continuation (a finding irrelevant to the question of priority) and did not establish an adequate basis for questioning the granting of the benefit for any claim of the patent for which reexamination was requested.

The section of the examiner's decision relied on by petitioner relied on two other decisions. Specifically, the examiner stated:

> "Both *Patlex Corporation v. Quigg*, 680 F.Supp. 33, 37 (D.D.C. 1988) and Ex parte Hyatt, Appeal No. 98-1912, Reexamination Control No. 90/001,896 (Bd. Pat. Appl. & Inter. 1999, unpublished)[36] appear to stand for the proposition that the Office lacks jurisdiction to "reexamine" the sufficiency of the specification of a parent application (to support patent claims) during the reexamination of a patent that claimed 35 U.S.C. § 120 benefit of that parent application. In a proceeding to reexamine a continuation or divisional patent, the Office is generally precluded from reexamining the 35 U.S.C. § 112, first paragraph, claim support for the 35 U.S.C. § 120 benefit of the parent application, because there is a presumption (in absence of a strong showing to the contrary) that the Office already determined (in the examination of the child application that became the patent) that the child's claims were supported by the disclosure of the parent and the child is a proper continuation or divisional. If the child's claims were not supported by the disclosure of the parent, the Office would presumably have rejected those claims under 35 U.S.C. § 112, first paragraph. Since the Office has presumably already considered the issue and determined that any patent or publication not having a date prior to the effective filing date of the parent is unavailable against the child patent's claims, it may not reconsider the issue in a reexamination proceeding. Criticism of the specification of the parent application as not supporting the child patent claims would generally be precluded for the case of a continuation or divisional child patent. That is the scenario of the Patlex and Hyatt decisions relied upon by the patent owner. "

As will be demonstrated below, each of these decisions presented a fact scenario that negated the existence of a "new" question, and thus neither of these decisions can be relied upon for the proposition that a priority benefit cannot be attacked as part of a reexamination. In addition, there is no presumption that the Office evaluated the benefit claim. **Examiners are instructed not to examine the sufficiency of a 120 benefit claim in the ordinary course of examination**. Pursuant to MPEP 706.02(k) "[t]he claim for 35 U.S.C. 120 benefit will be permitted without examination of the earlier application for disclosure and support of at least one claim of the later filed application under 35 U.S.C. 112, first paragraph unless it becomes necessary to do so, for example, because of an intervening reference."

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[36] The correct reexamination control number is '1869 and the correct appeal number is 1998-1913

3. BPAI May 28, 1999 decision in Reexamination Control Number 90/001,869 (*Hyatt*)

The examiner's reliance on *Hyatt* was misplaced. **In *Hyatt*, the Board held [37] that the examiner had already disposed of this issue in the initial prosecution and thus it could not be raised again in reexamination.**

> "The record before us reflects that the examiner in the original prosecution of this patent undergoing reexamination was presented with the question of whether appellant was entitled to the filing date of Hyatt '022. The examiner decided this question in appellant's favor and gave appellant the benefit of the filing date of Hyatt '022. Even though the claims before us are not all identical to the claims considered during the course of the original examination, we think it was improper for the Board[38] to raise the **very same question** which appellant had successfully prosecuted before the original examiner. [39]
>
> ...
>
> "Even the proper grant of a request for reexamination, as is the case here, does not allow the PTO to again raise issues which had already been determined by the original examiner. A patentee should not have to keep winning the same issue over and over every time a reexamination of a patent is granted." [40] [Emphasis added.]

Thus the *Hyatt* decision merely stands for the proposition that one may not revisit, on reexamination, an issue, including a claim benefit issue, that was resolved in the previous examination as to the patent.

4. *Patlex v. Quigg*, 680 F.Supp. 33 (D.D.C. 1988)

The examiner's reliance on the *Patlex* decision is similarly misplaced. In *Patlex* the issue as stated by the court was [41]

> "whether the Commissioner has jurisdiction, once reexamination has been ordered, to consider on the merits whether a 'great-grandparent' application that contains the same specification as its 'great-grandchild' complies with the requirement of 35 U.S.C. sec. 112 that the specification contain an enabling disclosure ***where the first examiner, at the time the 'great-grandchild' was issued, had found that the 'great-grandparent' contained an enabling disclosure.*** [Emphasis added]

In rendering its decision the court made a specifically finding of fact that the examiner had made a notation on the file that the issue of priority was considered and resolved in applicant's favor.

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[37] Appeal 98-1913, paper #85 in Reexamination Control No. 90/001,869, Decision date May 28, 1999 at pages 34-36.

[38] This appeal is from a rejection instituted by a panel of the BPAI in a previous appeal in this proceeding which was maintained by the examiner.

[39] *Hyatt* decision at page 35..

[40] *Hyatt* decision at 35-36.

[41] *Patlex* at 36.

> "In allowing the claims, the first examiner made the handwritten notation that undue breadth has been considered as well as sufficiency of the disclosure (note 'Reasons for Allowance' attached for co-pending case of applicants).' Office Action of November 21, 1978, Commissioner's Exhibit 1 at page 0140. The 'Reasons for Allowance' incorporated by reference relate to laser amplifiers and conclude that Gould's 1959 specification for laser amplifiers met the enablement requirement. The Court therefore finds that the examiner in the original examination determined enablement as of 1959." [42]

Of particular note is that the court did not summarily dismiss the rejection as should have been the result if a challenge to benefit was absolutely precluded [43] when the patent under reexamination was a continuation (with substantially identical disclosure) as the parent file. Instead, the court reviewed the record on prosecution, finding that the issue had already been addressed during the original prosecution of the patent and was thus not subject to being reintroduced during a reexamination, because the question, although possibly "substantial," did not qualify as a "new" question.

CONCLUSION

1. The petition to vacate-in-part the '250 *inter partes* reexamination proceeding is granted only to the extent that the petition has been considered and entered into the record by way of waiver of 37 CFR 1.939. However, the petition is dismissed as to the requested relief.

2. Jurisdiction over the proceeding is being forwarded to the examiner of record for appropriate action.

3. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

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

12-10-07
C:\Kiva\Kenpet6\IP\UV\95_0250 pet to vacate_order_ in_part-claim 120 benefit.doc

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[42] *Id.*

[43] In fact, the court specifically declined to address this question, stating: "The Court wishes to make clear that it is not deciding whether the Commissioner has jurisdiction in a reexamination to inquire into the sufficiency of the specification of a "parent" application where the sufficiency of the "parent" application *vis-a-vis* the claims of the patent being reexamined was not previously determined by the PTO or a court. Resolution of this issue should await a future case." *Patlex* at 37.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 06/17/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. MCCOMBS
HAYNES AND BOONE LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

Date:

MAILED

JUN 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
ART UNIT : 3900

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

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

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Paul Anderson
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4440 El Camino Real
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(For Patent Owner)

MAILED

JUN 17 2008

CENTRAL REEXAMINATION UNIT

David L. McCombs
Haynes and Boone LLP
901 Main Street
Suite 3100
Dallas, TX 75202

(For Third Party Requester)

In re Rambus, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,250
Originally Deposited: April 4, 2007
Filed: June 28, 2007
For: U.S. Patent No. 6,452,863

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on the patent owner petition filed on January 23, 2008 entitled "PETITION FOR RECONSIDERATION OF DECISIONS DISMISSING RAMBUS'S PETITIONS TO VACATE FILING DATES AND ORDERS GRANTING INTER PARTES REEXAMINATION" (hereinafter "request for reconsideration"). Receipt is also acknowledged of a paper filed on February 6, 2008 by third party requester entitled "THIRD PARTY REQUESTER'S PETITION AND OPPOSITION TO RAMBUS'S FIFTH PETITION FILED JANUARY 23, 2008 (hereinafter "renewed opposition").

The January 23, 2008 patent owner request for reconsideration, the February 6, 2008 third party renewed opposition, and *inter partes* reexamination proceeding control number 95/000,250 are before the Office of Patent Legal Administration for consideration.

Summary:

1) The renewed petition is granted to the extent that the "Decision Dismissing Petition" dated November 9, 2007 has been reconsidered as follows:

The present reconsideration extends only to the patent owner's request for, and arguments directed to, vacatur of the filing date and reexamination Order for *inter partes* reexamination proceeding control number 95/000,250.

Reconsideration of the Decision Dismissing Petition dated November 9, 2007 does not extend to the issue of suspension of *inter partes* reexamination proceeding control number 95/000,250, because no arguments on that issue have been presented by petitioner patent owner.

Reconsideration further does not extend to the December 12, 2007 "Decision Dismissing Petition to Vacate-in-Part the Order Granting Reexamination" which is

also requested in the present patent owner petition. [1] Patent owner may file a separate reconsideration petition directed to the December 12, 2007 Office decision.

2) The renewed petition is denied to the extent of granting the relief requested by patent owner as to vacatur of the filing date and Order granting reexamination for *inter partes* reexamination proceeding control number 95/000,250.

3) The present decision is designated as a final agency action under 5 U.S.C. § 704.

FEES

Petitioner patent owner has remitted the $400.00 petition fee required for the present petition that is necessitated by the fact that petitioner requests suspension of the provisions of 37 CFR 1.939, [2] to permit consideration of the substance of the renewed petition. In addition, the Office will charge a $400.00 fee against Deposit Account No. 08-1394 as authorized by third party requester, to permit consideration of the substance of the renewed opposition through suspension of 37 CFR 1.939.

REVIEW OF FACTS

1. U.S. Patent number 6,452,863 ("the '863 patent") issued to Michael Farmwald *et al* on September 17, 2002, and is assigned to Rambus, Inc.

2. On April 4, 2007, a request for *inter partes* reexamination of the '863 patent was deposited by a third party requester, David L. McCombs, and was assigned control No. 95/000,250 ("the '250 *inter partes* reexamination proceeding").

3. In the request for *inter partes* reexamination, the third party requester identified Samsung Electronics Co., Ltd. as being "the real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). [3]

4. On May 15, 2007, patent owner filed a petition requesting that the April 4, 2007 filing date accorded to the request for *inter partes* reexamination of the '863 patent be vacated on the grounds that the request did not properly identify the real party in interest in accordance with the reexamination statute and regulations, or in the alternative, that the proceeding be suspended.

5. On May 31, 2007, the Office mailed a Notice advising third party requester that third party requester had the right to file an opposition to the May 15, 2007 patent owner petition, and establishing a fifteen (15) day time period for third party requester to do so.

---

[1] Pursuant to 37 CFR 1.4(c), "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." Thus, the present patent owner petition is subject to dismissal. However, in the interest of the statutory mandate for special dispatch in reexamination proceedings, the filing date threshold filing date issue of the October 1, 2007 petition and November 9, 2007 will be addressed in this decision. The issue of the propriety of the order granting reexamination can be addressed as a later date, should patent owner separately request reconsideration as to that issue.

[2] 37 CFR 1.939 precludes filing of any party paper prior to the issuance of the first Office action on the merits of patentability in an *inter partes* reexamination proceeding.

[3] However, note fact numbers 20-23, and Decision, Section I, *infra*.

6. On June 14, 2007, third party requester timely filed papers opposing the May 15, 2007 patent owner petition.

7. On June 20, 2007, the Office mailed a decision, *sua sponte*, in which the April 4, 2007 filing date of the '250 *inter partes* reexamination proceeding was vacated.

8. On June 28, 2007, third party requester filed a redacted request for *inter partes* reexamination of the '863 patent.

9. On July 12, 2007, the Office mailed a decision, *sua sponte*, holding the May 15, 2007 patent owner petition and the third party requester opposition paper filed on June 14, 2007 in abeyance due to the vacatur of the April 4, 2007 filing date of the '250 *inter partes* reexamination proceeding.

10. On July 16, 2007, the Office mailed papers to the parties granting a filing date of June 28, 2007 for the '250 *inter partes* reexamination proceeding based upon the redacted request for *inter partes* reexamination.

11. The redacted request for *inter partes* reexamination also identified Samsung Electronics Co., Ltd. as the real party in interest. [4]

12. On September 5, 2007, reexamination was ordered for claims 1-35, (*i.e.*, all of the claims), based on the June 28, 2007 redacted request for *inter partes* reexamination.

13. On September 27, 2007, patent owner filed a renewed patent owner petition to vacate or suspend the '250 *inter partes* reexamination proceeding, effectively calling the May 15, 2007 patent owner petition up for action patent owner filed a petition to vacate the filing.

14. On October 3, 2007, third party requester filed papers opposing the September 27, 2007 patent owner petition, which opposition papers effectively called up for action the June 14, 2007 third party requester opposition papers.

15. On October 11, 2007, patent owner filed a petition to vacate-in-part the September 5, 2007 Order Granting *Inter Partes* reexamination.

16. On November 9, 2007, a decision dismissing the September 27, 2007 patent owner petition to vacate the filing date or to suspend the proceeding was mailed.

17. On December 12, 2007, a decision dismissing the October 11, 2007 patent owner petition to vacate-in-part was mailed.

18. On January 23, 2008, patent owner filed the present renewed petition.

19. On February 6, 2008, third party requester filed the present renewed opposition.

20. On February 22, 2008, the Office issued an Order to Show Cause why the '250 *inter partes* reexamination proceeding should not be terminated in view of certain ambiguities that

[4] Again, also note fact numbers 20-23, and Decision, Section I, *infra*.

appear in third party requester's identification of the named real party in interest in the various request papers filed by third party requester described in fact numbers 2 and 8.

21. On March 4, 2008, third party requester filed a response to the February 22, 2008 Order to Show Cause.

22. On March 19, 2008, patent owner filed comments on the March 4, 2008 third party requester response.

23. On April 7, 2008, the Office issued a decision accepting the February 22, 2008 third party requester response to the Order to Show Cause, and accepted the unambiguous identification of Samsung Electronics Co, Ltd. as the real party in interest in the '250 *inter partes* reexamination proceeding for purposes of satisfying, *nunc pro tunc*, the requirements of 37 CFR 1.915(b)(8).

24. The '863 patent is currently involved in a number of litigation proceedings, as indicated in the May 15, 2007 patent owner petition to vacate or suspend, the June 14, 2007 third party requester opposition thereto, and the Notice of Prior and Concurrent Proceedings filed by patent owner concurrently with the January 23, 2008 renewed patent owner petition.

RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

> (a) IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
> (b) REQUIREMENTS.– The request shall–
> (1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

> (a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
> (b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes

reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.

Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2614 provides, in part:

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

PRELIMINARY MATTER

It is noted that the present patent owner petition seeks review of two separate petition decisions that addressed two separately filed petitions in which different forms of relief were requested based upon different issues raised in the separate petitions. The "Decision Dismissing Petition" mailed on November 9, 2007 addressed the relief requested in the September 27, 2007 patent owner petition that was a renewed petition to vacate the filing date of the '250 *inter partes* reexamination proceeding, or in the alternative, to suspend the

proceeding. The "Decision Dismissing Petition to Vacate-in-Part the Order Granting Reexamination" mailed on December 12, 2007 addressed the separate patent owner petition, filed on October 11, 2007, which requested that the '250 *inter partes* reexamination proceeding be vacated in part. A review of the two petition decisions shows that the decisions responded to two different and wholly separate issues requiring separate consideration with appropriate, but different, rationales. For example, if the September 27, 2007 petition to vacate had been granted, then the October 11, 2007 petition to vacate the order in part would have been rendered moot. Pursuant to 37 CFR 1.4(c), "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." Thus, the present patent owner petition is subject to dismissal. However, in the interest of furthering the statutory mandate for special dispatch in reexamination proceedings, the threshold filing date issue of the petition vacate or suspend and the November 9, 2007 decision will be addressed in this decision, and the issue as to the merits of the order granting reexamination will be addressed at a later date, should patent owner file a separate reconsideration petition on that issue (i.e., directed to the December 12, 2007 Office decision). Accordingly, the present petition decision will reconsider only the November 9, 2007 petition decision.

DISCUSSION

I. The November 9, 2007 Decision - The Issue of Vacatur of the '250 *Inter Partes* Reexamination Proceeding Filing Date

The November 9, 2007 Office decision dismissed the September 27, 2007 patent owner petition (which called up for action the petition originally filed by patent owner on May 15, 2007) for a number of reasons. Patent owner had argued that because:

(1) Patent owner is the plaintiff in litigation in which the '863 patent has been asserted against a number of defendants; and
(2) The real party in interest identified in the request for reexamination of the '863 patent, "Samsung," [5] is one of those co-defendants; and
(3) Samsung and certain co-defendants have formed a "joint defense group";

the third party requester did not properly identify the real party in interest, given that only Samsung is named as the real party in interest in the '250 *inter partes* reexamination proceeding. Patent owner reasoned that based on the alleged improper identification of the real party in interest, the Office was required to vacate both the filing date of the '250 *inter partes* reexamination proceeding and the order granting *inter partes* reexamination.

The November 9, 2007 Office decision found that patent owner's position was not deemed to be persuasive because:

(A) The mere fact that a given party was a co-defendant of Samsung in the '863 patent litigation, or a member of a "joint defense group" together with Samsung in that litigation, would not necessarily mean that such a party was entitled to direct or control input into the conduct of '250 *inter partes* reexamination proceeding, or had ever done so.
(B) Patent owner failed to provide any factual showing that would support an allegation that any of Samsung's co-defendants in the '863 patent litigation, or who are

[5] As determined by the April 7, 2008 Decision, Samsung Electronics, Inc., Ltd. (hereinafter "Samsung").

members of the "joint defense group" in that litigation together with Samsung, actually is in control of, or is directly contributing input into the prosecution of, the '250 *inter partes* reexamination proceeding.

(C) There is no requirement of the reexamination statute that the Office conduct an investigation into the accuracy of the certification made by a third party requester that files a request for reexamination.

(D) Congress has not provided the Office with investigative tools of subpoena powers or discovery, [6] or the ability to conduct hearings to elicit testimony or to conduct cross-examination. Further, Congress has also not provided the Office with authority to impose punitive sanctions for noncompliance with a failure to cooperate in such an inquiry.

(E) Investigative evidentiary tools and the ability to impose sanctions are available to the courts.

(F) There is precedent showing that the courts have the ability to rule on the issue of "real party in interest" in matters ranging from diversity or amount of suit [7] to matters in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees. [8]

(F) Patent owner did not explain why patent owner had not approached the District Court for relief as, for example by investigation into the matter and issuing an appropriate order.

(G) The identification by third party requester is deemed to be adequate for purposes of 37 CFR 1.915(b)(8), because a subsequent party wishing to file an *inter partes* reexamination request for the '863 patent, or who may be subject to estoppels resulting from the present *inter partes* reexamination proceeding, would be able to determine for itself whether any relationship with *Samsung* would bar the *inter partes* reexamination request or trigger statutory estoppel.

(H) Pursuant to 37 CFR 10.18(b), the Office relies on factual assertions made before the Office as being true. [9]

II. Patent Owner is Not Entitled to Vacatur of the Filing Date

Patent owner has renewed its argument that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter par*tes reexamination proceeding, and has the duty to investigate the accuracy of the identification of the real party in interest in the '250 *inter partes* reexamination proceeding. All of patent owner's arguments have been carefully considered. However, for the reasons that follow, patent owner's arguments are not persuasive that patent owner is entitled to the requested relief of vacatur of the filing date and the resultant vacatur of the order granting *inter partes* reexamination in the '250 *inter partes* reexamination proceeding.

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[6] While 35 U.S.C. §§ 23 and 24 do authorize the Office to establish rules for taking affidavits and depositions required in cases in the Office, no such rules have been established with respect to taking affidavits or depositions with respect to reexamination proceedings, or with respect to parties not before the Office in a given proceeding whose compliance cannot be compelled by the Office. Further, these provisions do not appear to be directed to conducting discovery in a proceeding before the Office, such as a reexamination proceeding.

[7] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[8] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

[9] As discussed further with respect to the present petition for reconsideration, *infra*, the ability of the Office to require a party to a matter before the Office to address ambiguities or inaccuracies in a factual assertion made by that party to resolve the ambiguity is a wholly different matter from the Office having the statutory authority or the evidentiary tools to conduct an investigation regarding parties not before the Office based upon mere allegations that such an investigation is desired by a party before the Office.

A. When the Identification of the Real Party in Interest Is Not Facially Inaccurate Or Ambiguous, the Office Lacks the Authority and the Tools to Question That Identification

The arguments presented in the patent owner petition for reconsideration fail to establish that the Office has either the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in an *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

Patent owner's argument that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding is based upon drawing an analogy between the requirement of 37 CFR 1.915(b)(8) that the request for reexamination identify the real party in interest and the requirement of 37 CFR 1.915(b)(7) that the request for reexamination include a statement certifying the filing of the request is not barred by 37 CFR 1.907. [10] Patent owner begins by pointing out that the legislative history of 35 U.S.C § 311(b) shows that Congress enacted the requirement for identification of the real party in interest in order to prevent harassment of the patent owner. [11] Patent owner then alleges that the Office has the stated in the *inter partes* reexamination rulemaking that it has the authority to investigate the accuracy of a third party requester's certification under 37 CFR 1.915(b)(7) (*i.e.*, that the estoppel provisions of 37 CFR 1.907 do not preclude the filing of the request for **inter partes** reexamination). [12] Patent owner then states the Office's November 9, 2007 Decision on Petition to have taken the position that the Office does not have the ability or authority to investigate the accuracy and identification of the real party in interest. Patent owner opines that these positions are inconsistent. Patent owner argues that the Office must take consistent positions, and therefore, patent owner concludes that the Office has the authority and the tools to investigate allegations of requester misidentification of the real party in interest in the same manner that it would investigate the accuracy of a requester's 37 CFR 1.915(b)(7) certification statement. Patent owner concludes the Office has must conduct such an investigation in the '250 *inter partes* reexamination proceeding, that as a result of such investigation the Office will find that the real party in interest has not been properly identified, and that the Office should thereafter vacate both the filing date of the '250 *inter partes* reexamination proceeding, and the Order granting reexamination.

Patent owner's argument is not, however, persuasive, because it does not reflect the intent or plain language of the provisions of 37 CFR 1.915(b)(7) and (b)(8).

A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rulemaking at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

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[10] The estoppel provisions of 37 CFR 1.907 incorporate the estoppel provisions established by 35 U.S.C. §§ 315(c) and 317. These provisions will be referred to collectively as "statutory estoppel."

[11] Intellectual Property and Communications Omnibus Reform Act of 199, H.R. Conf. Rep. 10-464, 1999 WL 1095089, *133.

[12] See: MPEP § 2612; see also 65 Fed. Reg. 76756 at pages 76759 and 76764 (stating that "where a challenge to the accuracy of the certification is raised by the patent, that the question would then need to be addressed.")

> "It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the inter partes reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed."

A substantially identical statement also appears at MPEP § 2612. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the issue of the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rulemaking does not, in any way, discuss the type or depth of investigation that can and will be undertaken, and, more importantly, does not anywhere state or imply that an investigation can or will be undertaken by the Office. Rather, it is the duty of the party moving in favor of vacating a reexamination proceeding to provide the facts of any investigation establishing its position, including what it has obtained by resort to the courts' investigative power. It is nowhere in the statue, rules, or Office procedural guidelines stated or indicated that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

While the Office would clearly query an ambiguous or facially inaccurate 37 CFR 1.915(b)(7) certification statement, such a query is based on an ambiguity or inaccuracy provided by the record of the proceeding. A third party making such a statement for the record is a party appearing before the Office. Therefore, a third party requester may appropriately be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate on the record. In such a case, the third party requester would be called upon to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the third party requester, and would have no need to try to obtain information from parties not before the Office in the *inter partes* reexamination. Similarly, where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, a third party requester that is before the Office can be queried by the Office. In fact, the record in the present '250 *inter partes* reexamination proceeding shows that the third party requester was required to clarify its identification of the real party in interest, because the identification was facially ambiguous on the record. Third party requester promptly clarified the ambiguity; accordingly, the present record in the '250 *inter partes* reexamination proceeding is not ambiguous as to the identification of the real party in interest.

Patent owner additionally relies on the decisions in *Lacavera v. Dudas*, 441 F.3d 1380, 1382 (Fed. Cir. 2006); *Stevens v. Tamai*, 366 F.3d 1325, 1333 (Fed. Cir. 2004; and *In re Bogese*, 303 F.3d 1362, 1368 (Fed. Cir. 2002) as authority for the proposition that the Office can for conduct an investigation to determine the accuracy of a third party requester's identification of the real party in interest in an *inter partes* reexamination proceeding.

In the *Lacavera* decision, the court discussed the authority of the Office to regulate attorney practice before it pursuant to 35 U.S.C. § 2(b)(2)(D). The *Stevens* case involved an interference proceeding, and the court's decision in *Stevens* cited 35 U.S.C. § 2(b)(2)(A) as giving the Office authority to establish rules not inconsistent with law to govern the conduct of proceedings in the Office. The *Bogese* case concerned the authority of the Office to reject claims in a patent application based upon laches arising from unreasonable and

unexplained delay in prosecution, notwithstanding that the applicant complied with pertinent statutes and rules. None of these decisions have been found to be relevant to the authority of the Office to conduct an investigation into the identity of a real party in interest, as to whether other parties are involved (included). Rather, the cases involve circumstances in which the patent statute provides authority for the Office to promulgate regulations not inconsistent with law that will govern the conduct of proceedings in the Office, as well as the recognition and conduct of parties before the Office (including practitioners, applicants and other parties).

Patent owner fails to point to any established regulation that would provide a mechanism for conducting an investigation of the sort patent owner envisions, other than 37 CFR 1.105. Although patent owner opines that the Office can conduct an investigation into a third party requester's identification of the real party in interest in a request for *inter partes* reexamination, and require information from a third party requester under the provisions of 37 CFR 1.105, patent owner is simply mistaken. 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132 - statutes that relate to the examination of applications and the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability. [13] 37 CFR 1.105 has no applicability to requesting information from a third party requester regarding that requester's identification of the real party in interest in an *inter partes* reexamination proceeding, which would require investigation into activity by parties not party to the proceeding before the Office. The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability that applies to an applicant for patent and to a patent owner (and other 37 CFR 1.56(c) parties) in a reexamination proceeding. [14] Further, patent owner has not adequately explained the basis under which the Office would proceed to require a third party requester to supply information regarding the identity of the real party in interest, or to conduct an investigation into the identity of the real party in interest, given that there is no ambiguity or facial inaccuracy in the third party requester's identification of the real party in interest. And, to the extent that it would be necessary to obtain information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, patent owner has not explained how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Rather than the Office conducting an investigation based on a raw allegation that a patent believes an identification of the real party in interest to be facially inaccurate, the courts are the appropriate venue in which the patent owner should seek relief in the form of an investigation. [15] (This point is especially relevant here, where the identification appears to be

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[13] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[14] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability, (or any duty of disclosure), that attaches to a reexamination third party requester.

[15] See: *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), where the court took note of party's availability of the court's investigative powers, to address the absence of same to the Office.

> "During ex parte PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under 37 C.F.R. Section 1.132 (1993). Moreover, if applicants wish to cross-examine the authors of written hearsay assertions, under 35 U.S.C. Section 145 (1988) they may bring a civil action in the United States District Court for the District of Columbia seeking adjudication that they are entitled to receive a patent. In such an action, testimony could be compelled by subpoena under Federal Civil Procedure Rule 45. See Gould v. Quigg, 822 F.2d

unambiguous on the record, and it is patent owner that is alleging an inaccuracy.) It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees (*e.g.*, assignee estoppel or *res judicata*). [16] Where such precedent requires a party whose disclosure has been challenged to provide support for the disclosure, the examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, take testimony and employ other evidentiary tools (*e.g.*, subpoena power and sanctions). Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when a party has a doubt as to the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief with respect to patents, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action, or as to the filing of subsequent civil action. Even if an *inter partes* reexamination request is filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination has been filed by the same real party in interest. [17]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so. Patent owner's argument that it is the Office, not a district court, "that administers the patent statute," is wholly unpersuasive. The Office may consider that it is "the sole agency that administers the patent statute," [18] in conducting the *inter partes* proceeding. However, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rulemaking) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the provenance of the Office, and enforcing an estoppel provision of Federal law as a matter of

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1074, 1076, 3 USPQ2d 1302, 1303 (Fed. Cir. 1987) ("While the evidentiary record before the Board serves as the 'evidentiary nucleus' of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence."). [32 F.3d at 1565, 31 USPQ2d at 1821]

[16] See, for example: *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995) (presence of diversity or amount of suit); *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999) (application of the principle of "real party in interest" applied to prevent multiple or conflicting lawsuits by persons such as assignees.

[17] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

[18] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.

equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

B. The Office Has No Duty To Investigate The Identity Of The Real Party In Interest In The '250 *Inter Partes* Reexamination Proceeding

(1) Patent Owner Does Not Allege A Present Injury

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest ... ." [19] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy." [20] Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding and the identification is not facially inaccurate.

In the present '250 *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. [21] The identification of the real party is not found to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. [22] However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the '250 *inter partes* reexamination proceeding, because there is no established reason to do so.

Further, it is also to be noted that in the present '250 *inter partes* reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the '250 *inter partes* reexamination proceeding. Rather, patent owner's concern is that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the '863 patent by a party that should have been identified as a real party in interest in the '250 *inter partes* reexamination proceeding, but was not so

[19] 35 U.S.C. § 311(b)(1).
[20] 37 CFR 1.915(b)(8).
[21] It is to be noted that although the identification of the real party in interest was ambiguous in the various requests for reexamination filed by the third party requester in the '250 *inter partes* reexamination proceeding, such ambiguity has been resolved and a decision so stating was issued on April 7, 2008. The present identification of Samsung Electronics Inc., Ltd. as the real party in interest applies to this proceeding *nunc pro tunc*, and will allow any subsequent party to draw the necessary conclusions for purposes of 37 CFR 1.907 and statutory estoppel in *inter partes* reexamination.
[22] In fact, the Office has required third party requester to clarify an ambiguous identification of the real party in interest in the present '250 *inter partes* reexamination proceeding, and third party requester has done so.

identified. Such a party, as a real party in interest in the '250 *inter partes* reexamination proceeding, would (if one existed) be subject to a statutory estoppel that would preclude the filing of such a request by that third party requester. While a patent owner is entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the '863 patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists in the '250 *inter partes* reexamination proceeding. No additional requests for *inter partes* reexamination of the '863 patent have been filed, so clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the '863 patent. Accordingly, there is presently no basis for granting the relief requested by patent owner in the present '250 *inter partes* reexamination proceeding, since patent owner cannot, at this point, have been injured by the filing of another request for *inter partes* reexamination for the '863 patent that would be barred by statutory estoppel.

(2) Patent Owner Has Presented No Evidence That The Real Party in Interest Has Not Been Properly Identified

A further reason why the Office will not conduct an investigation into the identity of the real party in interest in the '250 *inter partes* reexamination proceeding is that patent owner has not presented any factual basis that would establish that the third party requester's identification of the real party in interest is inaccurate or ambiguous. Rather, patent owner relies solely on the fact that third party requester is one of a number of co-defendants in litigation directed to the '863 patent and that certain co-defendants have formed a "joint defense group," of which the identified real party in interest is a member, as providing the reason why the Office must investigate the accuracy of the identification of the real party in interest in the request for reexamination of the '863 patent. However, patent owner *has not provided any factual showing* that would suggest that one or more of members of the "joint defense group" has, in fact: (a) participated in the filing of the request for reexamination of the '863 patent any way or was involved in the decision to file, or (b) in any way participated in the prosecution of the resulting '250 *inter partes* reexamination proceeding or was involved in the decision as to prosecution. Assuming, *arguendo*, that (1) the Office has authority to conduct an investigation and to require that third party requester provide information in the form of documents, or answers to interrogatories, requiring information, and (2) that patent owner believed that it had been injured due to the filing of another request for *inter partes* reexamination of the '863 patent by a party subject to statutory estoppel, patent owner still has not provided the Office with any evidentiary basis to justify conducting an investigation into the accuracy of a third party requester's identification of the real party in interest in the '250 *inter partes* reexamination proceeding. Patent owner's belief that one or more unnamed entities are also real parties in interest is not evidence. The Office will not act on mere beliefs, any more than a court would act on allegations that are not supported by facts. The record in the '250 *inter partes* reexamination proceeding shows that third party requester has unambiguously identified the real party in interest in the request. The record does not show that Office has been provided with any concrete evidence suggesting reason to doubt the accuracy of requester's identification of the real party in interest. On the present record, the Office can only conclude that further inquiry by the Office directed to the third party requester regarding the identity of the real party in interest would merely result in third party requester confirming that that "Samsung Electric Co, Limited" is the real party in interest, as third party requester has previously stated. Note is taken that such a statement by a party appearing before the Office is a certification

that such statement is believed to be true. [23] The record in the '250 *inter partes* reexamination proceeding provides no basis for the Office to doubt the statement, and accordingly, provides no basis to investigate the accuracy of that statement.

III. Suspension of the '250 *Inter Partes* Reexamination Proceeding

It does not appear that petitioner patent owner has requested reconsideration of the refusal to suspend the '250 *inter partes* reexamination proceeding. It appears, therefore, that petitioner patent owner has chosen to abandon its prior petition for suspension. Accordingly, no further decision on that issue is necessary.

IV. Synopsis

Patent owner has filed a petition paper on January 23, 2008, requesting reconsideration of the petition decisions dated November 9, 2007 and December 12, 2007. This decision treats the request for reconsideration only to the extent that November 9, 2007 decision has been reconsidered, and only to the extent that reconsideration was requested as to the refusal to vacate the filing date of the '250 *inter partes* reexamination proceeding and the refusal to vacate the Order granting *inter partes* reexamination. [24] Patent owner has not demonstrated that the Office has the authority or the procedural tools to conduct an investigation into the otherwise facially unambiguous and facially accurate identification of the real party in interest in this *inter partes* reexamination proceeding. Also, patent owner has not demonstrated any present injury in the '250 *inter partes* reexamination that would warrant the requested relief. Even further, patent owner has not provided any evidence showing that the present identification of the real party in interest in the '250 *inter partes* reexamination is in any way facially ambiguous or facially inaccurate. Accordingly, patent owner has not demonstrated any basis for the requested relief of vacatur of the filing date of the '250 *inter partes* reexamination proceeding and the Order granting reexamination. On the other hand, requester has unequivocally stated that Samsung ("Samsung Electric Co, Limited") is the only real party in interest for the present proceeding, and pursuant to 37 CFR 10.18(b), the Office relies on factual assertions made before the Office as being true. Therefore, the requested relief is denied, and this decision is being designated as a final agency action within the meaning of 5 U.S.C. § 704.

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[23] 37 CFR 10.18(b)

[24] Patent owner has elected not to request reconsideration of the November 9, 2007 petition decision with respect to the refusal to suspend the '250 *inter partes* reexamination proceeding. The relief requested in the December 12, 2007 petition will be addressed in a separate petition decision.

ADDITIONAL DISCUSSION

As this decision is designated as a final agency action under 5 U.S.C. § 704, patent owner is advised that to the extent that patent owner may disagree with the disposition of the issues in this decision, those issues are now ripe for judicial review. Any further patent owner petition paper directed to the issues decided herein, will not be considered unless accompanied by a strong showing of additional facts warranting further review by the Office. The filing by patent owner of a petition paper directed the issues decided herein, that does not include such showing may be construed as being a paper interposed for purposes of delay.

CONCLUSION

1. The January 23, 2008 petition to vacate '250 *inter partes* reexamination proceeding is granted only to the extent that the petition requested vacatur of the filing date and the Order granting reexamination has been considered and entered into the record by way of waiver of 37 CFR 1.939.

2. The January 23, 2008 petition is denied as to the requested vacatur of the filing date of, and the Order granting reexamination in, the '250 *inter partes* reexamination proceeding.

3. The reconsideration given in this decision does not extend to the December 12, 2007 "Decision Dismissing Petition to Vacate-in-Part the Order Granting Reexamination" which is also requested in the present patent owner petition. Patent owner may file a separate reconsideration petition directed to the December 12, 2007 Office decision.

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

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

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

sm
June 16, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 03/06/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356

69090 7590 03/06/2009

EXAMINER	
ART UNIT	PAPER NUMBER

RAMBUS, INC.
C/O Ann Williams
4440 EL CAMINO REAL
LOS ALTOS, CA 94022

DATE MAILED: 03/06/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. MCCOMBS
HAYNES AND BOONE LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

Date:

MAILED

MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
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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Date: MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
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

RAMBUS, INC.
C/O ANN WILLIAMS
4440 EL CAMINO REAL
LOS ALTOS, CA 94022

(For Patent Owner)

MAILED

MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

DAVID L. MCCOMBS, ESQ.
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202-3789

(For 95/000,250 Requester)

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET 53rd FLOOR
HOUSTON, TX 77002

(For 95/001,124 Requester)

NAVEEN MODI
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(Courtesy Copy)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,250
Filed: June 28, 2007
For: U.S. Patent No. 6,452,863

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,124
Filed: November 24, 2008
For: U.S. Patent No. 6,452,863

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,452,863 (the '863 patent) issued to Farmwald et al. on September 17, 2002, with 35 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ('250 proceeding), was initially deposited by third party requester on April 4, 2007, and received a filing date of June 28, 2007. Samsung Electronics, Co. Ltd. is identified as the real party in interest.

3. An order granting reexamination of claims 1-35 of the '863 patent was mailed for the '250 reexamination proceeding on September 5, 2007.

4. An Office action containing at least one rejection of each of claims 1-35 of the '863 patent was mailed for the '250 reexamination proceeding on July 3, 2008.

5. Patent owner filed a timely response on September 5, 2008, retaining original patent claims 1-35 as unamended.

6. Third party requester filed timely comments on October 3, 2008, pursuant to 37 CFR 1.947.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,124 ('1124 proceeding), was filed November 24, 2008, by third party requester Micron Technology, Inc.

8. An order granting reexamination of claims 14-16 of the '863 patent was mailed for the '1124 reexamination proceeding on January 16, 2009.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1124 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '250 and the '1124 reexamination proceedings 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 rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,250 and 95/001,124 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,250 and 95/001,124 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 proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

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

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents

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

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

By hand (or delivery service):

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

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

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '250 proceeding and (3) the '1124 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022. Accordingly, all future correspondence will be directed to RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same should be done for the reexamination proceedings).

It is further noted that different attorneys are of record for the two reexamination proceedings. In order to permit filing of patent owner papers in the now merged proceeding by one attorney alone, the two proceedings must given a single attorney of record, with appointment being made as appropriate. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to do so. If there is a newly designated attorney, patent owner must supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,250 and *inter partes* Reexamination Control No. 95/001,124 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address and attorney of record in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 05/13/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356

22852 7590 05/13/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. MCCOMBS
HAYNES AND BOONE LLP IP SECTION
2323 VICTORY AVENUE SUITE 700
DALLAS, TX 75219

Date:

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
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.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
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

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

(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

David L. McCombs
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

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

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,250
Deposited on: 28 June 2007
For: US Patent No. 6,452,863

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,124
Deposited on: 24 November 2008
For: US Patent No. 6,452,863

This is a decision on the 23April 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing

Prosecution mailed 20 March 2009, be extended by forty-five (45) days. 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 17 September 2002 US patent No. 6,452,863 was granted to Farmwald *et alia.*

2. On 28 June 2007 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/000,250.

3. On 5 September 2007 an Order Granting Request for *Inter Partes* Reexamination 95/000,250 was mailed.

4. On 24 November 2008 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/001,124.

5. On 16 January 2009 an Order Granting Request for *Inter Partes* Reexamination 95/001,124 was mailed.

6. On 06 March 2009 a decision s*ua sponte* was mailed merging proceedings 95/000,250 and 95/001,124.

7. On 20 March 2009 a non-final Office action was mailed was mailed in the abovementioned proceedings.

8. On 23 April 2009 the instant petition for a forty-five (45) day 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 non-final Office action mailed 20 March 2009, which set a two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 23 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).
>
> ...
>
> 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 forty-five (45) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always

the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 20 March 2009. The patent owner submitted a timely filed the petition on 23 April 2009 with the appropriate fee and certificate of service.

The petition dated 23 April 2009 cites the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. The requester further states that they have contacted a technical expert and are assessing the need for a declaration. While concurrent proceedings are generally no considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 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 June 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

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.
95/000,251	09/20/2007	6721178		4312

27572 7590 03/18/2010

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,251	09/20/07	6721178	

Darin J. Gibby
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8th FLOOR
SAN FRANCISCO, CA 94111

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

DATE MAILED:

03/18/10

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
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Alexandria, VA 22313-1450
www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,251	09/20/07	6721178	

Darin J. Gibby
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8th FLOOR
SAN FRANCISCO, CA 94111

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

DATE MAILED:

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

Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303

(For Patent Owner)

Darbin J. Gibby
Townsend and Townsend and Crew LLP
Two Embarcadero Center
8th Floor
San Francisco, CA 94111

(For Third Party Requester)

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

In re Richard A. Clark
Inter Partes Reexamination Proceeding
Control No. 95/000,251
Filed: September 20, 2007
For: U.S. Patent No. 6,721,178

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

This is a decision on the October 20, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response in the above-identified reexamination proceeding ("the October 20, 2009 patent owner petition").

The October 20, 2009 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the October 20, 2009 patent owner petition has been paid.

The October 20, 2009 patent owner petition is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

35 U.S.C. 314(a) provides, in pertinent part:

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 of this title.

37 CFR 1.137 provides, in pertinent part:

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

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

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.957(c) provides, in pertinent part:

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 1.958(b) provides, in pertinent part:

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), this reexamination proceeding prosecution was limited under 37 CFR 1.957(c) due to patent owner's failure to timely submit a response to the requirement set forth in the February 26, 2009 Right of Appeal Notice ("the February 26, 2009 RAN") to resubmit the October 31, 2008 amendment in rule-compliant form. The February 26, 2009 RAN gave the patent owner a time period of one month or thirty days, whichever is longer, from the mailing date of the RAN to respond to the requirement. A response to the requirement was not filed until October 20, 2009; thus the response was untimely. However, for the purpose of evaluating whether the October 20, 2009 patent owner petition is a grantable petition, the submission of the October 20, 2009 response satisfies item (1).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted with the October 20, 2009 patent owner petition, which satisfy items (2) and (3), respectively.

Accordingly, the October 20, 2009 patent owner petition is **granted**.

CONCLUSION

1. The October 20, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992.

3. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

/Kenneth M. Schor/

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

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TREVOR KING
133-23 161 Street
Jamaica NY 11434

(For Patent Owner)

MAILED

DEC 2 02007

CENTRAL REEXAMINATION UNIT

RICHARD WILDER
SIDLEY AUSTIN LLP
1501 K Street NW
Washington, DC 20005

For Requester

DECISION DENYING
PETITION FOR EXTENSION
OF TIME
[37 CFR 1.956]

In re: Trevor King
Inter Partes Reexamination Proceeding
Control No. 95/000,255
Filed: 20 July 2007
For: US Patent No. 6,750,386

This is a decision on the 5 December 2007, patent owner "Petition for Extension of Time To Respond To Decision Granting Inter Partes Reexaxamination," requesting that the time or responding to the decision mailed 5 October 2007 to be extended by one-month.

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

The petition is DENIED for the reasons set forth below.

Discussion

The Patent Owner requests a one month extension of time in which to file a response to the Decision [sic] Granting reexamination proceeding 95/000,255. The non-final Office action was mailed 5 October 2007. The present petition for extension of time was filed on 5 December 2007. The petition request correctly notes the requirement for a $200. petition fee under 37 CFR 1.17 (g) . The petition request does not however provide the necessary petition fee.

> *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.

Decision

While the petition requests an extension of time to respond to the decision granting reexamination, the petition should correctly request an extension to request time to respond to the outstanding Office action. This is however a moot point absent the petition fee. There is no petition fee provided with the petition request.

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed.

The Patent Owner first seeks an extension of time stating that the reasons to support a "sufficient cause" for granting an extension of time. The patent owner notes that time was lost because there was an initial "attorney who agreed to defend this case on the Patent Owner's behalf ultimately decided to not handle the matter." Since there was no attorney listed to represent the Patent Owner to date, it is unknown what if any time was lost.

The statement further that the time was needed to prepare the case, gather evidence, obtain witnesses and documents has no supporting statements as to what actions the Patent Owner has undertaken thus far to support such an allegation. As such, there is no support for what actions in spite of actions undertaken thus far, the additional time is needed.

Further, the attorney submitting the Request for Extension of time, does not have standing before the Office to represent the Patent Owner. Should the Patent Owner wish to obtain legal council, there must be submitted documents authorizing any individual(s) to act on behalf of the Patent Owner before the US Patent & Trademark Office.

Lastly, there is no indication that attorney Daryll Boyd Jones is a registered practitioner to practice before the US Patent & Trademark Office.

Since there is no required petition fee, there no indication that the attorney submitting this request is either registered to practice before the USPTO, nor indication that the practitioner is authorized to act on behalf of the Patent Owner and there is no showing of "sufficient cause" the petition presumably under 37 CFR 1.956 is denied.

Conclusion

1. The Patent Owner's petition for extension of time filed on 5 December 2007 is **denied** as insufficient for the reasons given *supra*.

2. The period for response is not extended beyond the shortened statutory period for response of two-months as recited in the outstanding Office action mailed 5 October 2007.

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611, and in his absence to Eric Keasel, Supervisory Patent Examiner who may be reached at 571-272-4929.

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

for
Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,259	05/10/2007	6850464	WILDW003USRE01	1832

24247 7590 03/06/2009

TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY, UT 84110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michael S. Sherrill
Sherrill Law Offices PLLC
4756 Banning Avenue Suite 212
White Bear Lake MN 55110

Date: MAILED

MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000259
PATENT NO. : 6850464
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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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(For Patent Owner)

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY, UT 84110

MAILED

MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

MICHAEL S. SHERRILL
SHERRILL LAW OFFICES, PLLC
4756 BANNING AVENUE, SUITE 212
WHITE BEAR LAKE, MN 55110

In re Carlsruh et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,259	:	FOR REOPENING
Filed: May 10, 2007	:	PROSECUTION
For: U.S. Patent No.: 6,850,464	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on October 17, 2008. The petition is entitled "PATENT OWNER'S PETITION PURSUANT TO 37 CFR § 1.181 FOR WITHDRAWAL, AS PREMATURE, OF OFFICE ACTION CLOSING PROSECUTION UNDER 37 CFR § 1.949 IN INTER PARTES REEXAMINATION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and reopen prosecution by withdrawing the Action Closing Prosecution issued on September 19, 2008.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated October 17, 2008 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,259.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,850,464 (hereinafter, the '464 patent) issued on February 1, 2005.

2. A request for *inter partes* reexamination, assigned control No. 95/000,259, was filed by a third party requester on May 10, 2007.

3. *Inter partes* reexamination was ordered for the '259 reexamination proceeding on August 3, 2007. On the same day, a non-final Office action was mailed in the '259 reexamination proceeding.

4. The patent owner filed a response to the non-final Office action on October 1, 2007. The response did not include any proposed amendments to the claims.

5. The third party filed comments on October 31, 2007 to the patent owner's response, and introduced additional prior art.

6. On September 19, 2008, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP continued to adopt the same grounds of rejections, as set forth in the August 3, 2007 Office action.

7. On October 17, 2008, the patent owner filed the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened.

8. On November 14, 2008, the third party requester filed comments in response to the patent owner's petition under 37 CFR 1.181.

DECISION

The patent owner (petitioner) states that the ACP dated September 19, 2008 "prematurely" cuts off prosecution, and asserts that the examiner's comments (in paragraph 8 of the ACP) in response to the remarks of the patent owner and third party request constitute "a *de facto* new ground of rejection." Patent owner states that the examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to which the patent owner is entitled. The patent owner states that they deem that the ACP, *de facto*, contains a new ground of rejection for the following reasons:

1. The examiner, for the first time, discussed his interpretation of the claim terms "length" and "width" in the ACP under paragraph 8.
2. The examiner, for the first time, discussed his interpretation that the claim term "platform" may be a moving platform, and that the claim did not require a stationary platform in the ACP under paragraph 8.

3. The examiner, for the first time, discussed that he relied on Figures 1, 2, 13 and 19 of the Stinger '009 reference in the ACP under paragraph 8.

Patent Owner argues that since the ACP contains a *de facto* new ground of rejection, the ACP was premature and cites to 37 CFR 1.949 and MPEP 2671.02 for support. Because of this ground, petitioner requests that prosecution be reopened.

Third party requester states that patent owner's acknowledgement that the rejections set forth in the ACP are verbatim the same rejections set forth in the first Office action is "... tantamount to an admission that the Examiner has raised no new grounds of rejection...." See page 1 of the comments of November 14, 2008. The third party requester argues that the further explanation provided by the examiner in the ACP in response to patent owner's arguments pertaining to the meaning of the terms "length" and "width" did not change the underlying rejection. Furthermore, in regard to the discussion that the platform may be a moving platform, the third party requester stated that the examiner "...simply points out the obvious..." that the claims are not limited to a stationary platform. See page 4 of the comments dated November 14, 2008. In regard to the Stringer '009 reference, the third party requester pointed out that the ACP contains the same explanation as the first Office action regarding the use of this reference, and that the reference was used in exactly the same manner and for exactly the same purpose in both Office actions. Accordingly, the third party requester concluded that the ACP was proper and should not be withdrawn.

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. 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. Furthermore, MPEP 2671.02 states that "[t]he ACP should address all the issues as to the patents or printed publications," and that "the ACP must also include a rebuttal of any arguments raised in the patent owner's response and must reflect consideration of any comments made by the third party requester."

Turning to the facts in this proceeding, the ACP sets forth the identical grounds of rejection as set forth in the first Office action of August 3, 2008, and the patent owner admits this fact on page 2 of the petition ("On September 19, 2008, the Examiner issued an ACP which, in numbered paragraphs 1-7 contain, *verbatim*, the same rejections asserted in the August 3, 2007 Office Action."). In the petition, patent owner alleges that the examiner's response to the comments made by the Patent Owner in their response of October 1, 2008 and the third party requester's comments of October 31, 2008 resulted in a *de facto* new ground of rejection in the ACP.

In support of this allegation, the patent owner states that examiner, for the first time, discussed his interpretation of the claim terms "length," "width," and "platform" and stated that he relied on Figures 1, 2, 13, and 19 of the Stringer '009 reference in the ACP under paragraph 8. In comparing what the examiner stated in paragraph 8 in the ACP with the statements made in the body of the rejection in paragraphs 3, 6, & 7 in the first Office action of August 3, 2008[1], it is determined that the examiner did not set forth any new definitions for the claim terms or stated that he is now relying of different figures. Specifically, the rejection, in paragraph 3 of both Office actions, stated that the terms "length" and "width" are arbitrary, and applied the teachings of the prior art accordingly. Paragraph 6 of both Office actions consisting apply the prior art to the term "platform" as not being restricted to a stationary platform (e.g., a moving platform). Paragraph 7 of both Office actions stated that the examiner is relying on Figures 1, 2, 13, and 19 of the Stringer '009 reference. The examiner's response in paragraph 8 in the ACP is consistent with the prior interpretation of the claim terms, and the fact that the examiner already stated he is relying on Figures 1, 2, 13, and 19 of the Stringer '009 reference. Accordingly, the examiner did not make a *de facto* new grounds of rejection in his response to the remarks and comments filed after the first Office action.

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the Office action should be an ACP, and closed prosecution in the interest of "special dispatch." As stated above, the examiner must rebut any arguments raised in the patent owner's response and must reflect consideration of any comments made by the third party requester in the ACP, and the examiner did so in paragraph 8 of the ACP. Upon review, the examiner's rebuttal in paragraph 8 is consistent with the prior position taken by the examiner in the first Office action, and therefore does not constitute a *de facto* new grounds of rejections.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to issue an ACP.

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 Action Closing Prosecution dated September 19, 2008 and reopening of prosecution of the '259 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

[1] As stated above, paragraphs 1-7 of the ACP are identical to paragraphs 1-7 of the first Office action dated August 3, 2008.

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

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or Jeanne Clark at (571) 272-7714, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,259	05/10/2007	6850464	WILDW003USRE01	1832

24247 7590 06/11/2009

TRASKBRITT, P.C.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2009

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4756 Banning Avenue Suite 212
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Date:

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JUN 11 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000259
PATENT NO. : 6850464
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 Patent Owner)

MAILED

JUN 11 2009

CENTRAL REEXAMINATION UNIT

MICHAEL S. SHERRILL
SHERRILL LAW OFFICES, PLLC
4756 BANNING AVENUE, SUITE 212
WHITE BEAR LAKE, MN 55110

(For Requester)

In re Carlsruh et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,259
Filed: May 10, 2007
For: U.S. Patent No. 6,850,464

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the April 6, 2009 patent owner petition entitled "PATENT OWNER'S PETITION PURSUANT TO 37 CFR 1.182 FOR CONTINUING REEXAMINATION IN INTER PARTES REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On May 10, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,259 ("the '259 proceeding").

- Prosecution progressed until, on September 19, 2008, an Action Closing Prosecution (ACP) was issued.

- On October 17, 2008, patent owner submitted a petition under 37 CFR 1.181, requesting that prosecution be reopened. Patent owner submitted claim amendments and remarks with the petition.

- On March 6, 2009, the Office issued a decision denying a patent owner petition under 37 CFR 1.181, filed October 17, 2008.

- On April 6, 2009, a Right of Appeal Notice was issued, denying entry of the amendment filed by the patent owner on October 17, 2008.

- On April 6, 2009, patent owner filed the instant petition entitled "PATENT OWNER'S PETITION PURSUANT TO 37 CFR 1.182 FOR CONTINUING REEXAMINATION IN INTER PARTES REEXAMINATION," requesting entry of the amendment and remarks filed on October 17, 2008.

- On May 5, 2009, patent owner filed a Notice of Appeal.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination

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

setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the action closing prosecution. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In this instance, patent owner's response includes a submission directed towards the entry of claim amendments and accompanying remarks, as described in patent owner's instant petition. These amendments were denied entry in the Right of Appeal Notice of April 6, 2009. These amendments are alleged to address the rejections by resolving an issue of claim construction to avoid applied prior art (see, e.g., page 9 of the instant petition), and further the prosecution of the '259 proceeding.

Patent owner's response is not persuasive as to the reasons why such amendments could not have been presented earlier. Patent owner argues that no claim amendments were earlier thought desirable because the patent owner was of the opinion that the rejections could be overcome by arguments against the claim interpretations used as the bases for the rejections. The interpretations addressed by the amendment are whether the claim term "platform" is limited to a stationary platform or includes a moving platform, and the proper interpretation of the terms "length" and "width."

However, the claim interpretations have not changed since the first Office action. In subsequent actions, the examiner has merely attempted to present an explanation of his interpretation that addresses the concerns set forth in the patent owner's responses. The original rejection applied a platform that was a moving platform, thus setting forth a consistent interpretation of "platform" as including both stationary and moving platforms. The ACP repeated such phrasing, and provided a detailed response to patent owner's concerns in the remarks section of that action. The original rejection also set forth the fact that the applied reference stated that "length" and "width" are arbitrary terms. The ACP repeated such phrasing, and provided a detailed response to patent owner's concerns in the remarks section of that action. The proposed amendments are not in response to newly raised issues; instead, the amendments address issues that have been present since the first Office action.

It is noted that patent owner "continues to believe" that an amendment is unnecessary (page 3). This comment makes it clear that patent owner is not addressing an issue newly raised at final rejection. A grant of continued reexamination is not for the purpose of simply providing an additional opportunity to address a previously raised issue (e.g., whether the platform must be interpreted to be stationary), after the examiner refuses to accept an argument as to the issue in a final rejection, but, rather, patent owner must show that the examiner, in the final rejection, is

providing some new reason for the position taken that would not have been reasonably anticipated.

As to the allegations of the present petition directed towards insufficiency in the detail or legal standards of previous Office actions, including the issue of the reliance upon an alleged "old art" embodiment set forth in the first Office action and repeated in the ACP as discussed at page 2 of the instant petition, such allegations are properly addressed through 37 CFR 1.181, not through § 1.182. On March 6, 2009, the Office issued a decision denying patent owner's October 17, 2008 petition under 37 CFR 1.181, addressing these allegations. If the patent owner is seeking relief on the basis that a previous Office action is incorrect, the proper avenue for such relief is a petition for review of the decision denying the patent owner's petition under 37 CFR 1.181. 37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is, according to the terms of the regulation, not the appropriate mechanism for relief.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. 314 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

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

By 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 decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

June 9, 2009
C:\Kiva\Kenpet7\IP

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.
95/000,261	05/07/2007	6590220	5841-04201	2599

27890 7590 10/30/2007

STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2007

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
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OCT 30 2007

CENTRAL REEXAMINATION UNIT

Steptoe & Johnson LLP (For Patent Owner)
1330 Connecticut Avenue, N.W.
Washington, DC 20036

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. (For Requester)
P.O. Box 398
Austin, TX 78767-0398

In re: Kalley *et alia*
Reexamination Proceeding
Control No. 95/000,261
Request Deposited: May 7, 2007
For: U.S. Patent No. 6,590,220

: DECISION ON PETITION
: FILED UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed October 24, 2007, to expunge information from the above identified application.

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

Petitioner requests that documents entitled:

Memo to All Ritchie Reps re New Leak Scanner Product; February 10, 1997

New Leak Scanner Products Catalog and Price Sheet, Corrections/Additions; Wholesale Net 96-W2; Product Additions 3/14/97; P. 2

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69390-Rediebean UV System; P. 13; March 17, 2007

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69440 - Don't Use - P/N 69441; P. 14-15; March 17, 2007

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69700 - CS.6 A/C Dye Applicator; P. 16; March 17, 2007

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69740 - MINI LAMP, GLASSES, CLIP; March 17, 2007

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69790 - Micro Led - 3 UV 2 Blue; P. 18; March 17, 2007

Chromatech Solutions Record, P. 19 (undated document)

Ritchie Engineering Company Inc. - Receiving History Report, 1/1/1993 - 3/17/2007; P. 20-21; March 17, 2007

Ritchie Engineering Company Inc. - Receiving History Report, 1/1/1989 - 3/17/2007; P. 22-72; March 17, 2007

Memo to A.P. Bindra, Subject: Chromatech - Try 30 with back-up invoices; P. 3-11; January 24, 1990

, filed October 16, 2007, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time. It is noted that the documents outlined above have been closed from public view on October 29, 2007.

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

Eric Kassel For

Lissi Mojica Marquis, Director
Central Reexamination Unit

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OCT 30 2007

CENTRAL REEXAMINATION UNIT

Steptoe & Johnson LLP (For Patent Owner)
1330 Connecticut Avenue, N.W.
Washington, DC 20036

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. (For Requester)
P.O. Box 398
Austin, TX 78767-0398

In re: Kalley *et alia*
Reexamination Proceeding
Control No. 95/000,261
Request Deposited: May 7, 2007
For: U.S. Patent No. 6,590,220

: DECISION ON PETITION
: FILED UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed October 24, 2007, to expunge information from the above identified application.

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

Petitioner requests that documents entitled:

Memo to All Ritchie Reps re New Leak Scanner Product; February 10, 1997

New Leak Scanner Products Catalog and Price Sheet, Corrections/Additions; Wholesale Net 96-W2; Product Additions 3/14/97; P. 2

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Ritchie Engineering Company Inc. - Costed Bill of Materials, 69700 - CS.6 A/C Dye Applicator; P. 16; March 17, 2007

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69740 - MINI LAMP, GLASSES, CLIP; March 17, 2007

Ritchie Engineering Company Inc. - Costed Bill of Materials, 69790 - Micro Led - 3 UV 2 Blue; P. 18; March 17, 2007

Chromatech Solutions Record, P. 19 (undated document)

Ritchie Engineering Company Inc. - Receiving History Report, 1/1/1993 - 3/17/2007; P. 20-21, March 17, 2007

Ritchie Engineering Company Inc. - Receiving History Report, 1/1/1989 - 3/17/2007; P. 22-72; March 17, 2007

Memo to A.P. Bindra, Subject: Chromatech - Try 30 with back-up invoices; P. 3-11; January 24, 1990

, filed October 16, 2007, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time. It is noted that the documents outlined above have been closed from public view on October 29, 2007.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

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STEPTOE & JOHNSON LLP (For Patent Owner)
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

MAILED

JUN 15 2009

CENTRAL REEXAMINATION UNIT

Eric B. Meyertons (For Requester)
MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

In re Kalley et al. :
Inter Partes Reexamination Proceeding : **DECISION**
Control No.: 95/000,261 : **GRANTING**
Filed: May 5, 2007 : **PETITION**
For: U.S. Patent No.: 6,590,220 :

This is a decision on the April 23, 2009 patent owner petition entitled "Petition Under 37 C.F.R. § 1.183 to Request a Waiver of an Extension of Time for Filing an Appeal Brief."

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is granted-in-part, to the extent that patent owner is given a **ONE MONTH** extension of time to file an Appellant Brief. Accordingly, the patent owner's Appellant Brief is due no later than July 24, 2009.

The requisite petition fee of $400.00 for a petition under 37 CFR 1.183 has been charged to petitioner's deposit account as authorized in the petition.

RELEVANT BACKGROUND

1. U.S Patent number 6,590,220 (the '220 patent) issued on July 8, 2003.
2. On May 5, 2007, a request for *inter partes* reexamination of the '220 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,261 (the '261 reexamination proceeding).
3. On July 20, 2007, the Office issued an order, in the '261 reexamination proceeding, granting *inter partes* reexamination of the '220 patent.
4. The '261 reexamination proceeding progressed to the point where, on September 19, 2008, the Office mailed an Action Closing Prosecution (ACP).

5. On October 20, 2008, the patent owner filed a response to the ACP including a proposed amendment to the claims.

6. On November 19, 2008, the third party requester filed written comments in response to patent owner's response.

7. On March 24, 2009, the Office mailed a Right of Appeal Notice (RAN). The RAN stated that the proposed amendment to the claims filed October 20, 2008 has not been entered.

8. On April 23, 2009, the patent owner filed a petition under 37 CFR 1.181 requesting entry of the amendment filed October 20, 2008. The patent owner concurrently filed the instant petition under 37 CFR 1.183.

9. On April 24, 2009, the patent owner filed a notice of appeal.

10. On May 21, 2009, the third party requester filed written comments regarding the petition under 37 CFR 1.181.

RELEVANT REGULATORY PROVISION

37 CFR 1.183 states:

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

DECISION

The present April 23, 2009 petition under 37 CFR 1.183 was filed concurrently with a petition under 37 CFR 1.181 requesting entry of the amendment filed on October 20, 2008. The patent owner then filed a notice of appeal on April 24, 2009. In the 37 CFR 1.183 petition, the patent owner requests (1) a waiver of the prohibition of an extension of time for filing an Appellant Brief, and (2) an extension of the time period to file the Appellant Brief until after a decision on the 37 CFR 1.181 petition.

Upon filing a Notice of Appeal, by operation of 37 CFR 41.66(a), an appellant has a two month time period within which to file an Appellant Brief. In the present proceeding, the two month time period would expire on June 24, 2009. Since there is less than two weeks until the June 24, 2009 deadline and the petition under 37 CFR 1.181 has not yet been decided, the situation is deemed an extraordinary circumstance that warrants suspension of 37 CFR 41.66(a) to the extent that it prohibits an extension of time for filing an Appellant Brief, and to the extent set forth in this decision.

Pursuant to 37 CFR 1.183, to the extent "justice requires," a requirement of the regulations which is not a requirement of the statutes may be suspended or waived. In this instance, no more than a one month extension has been justified by petitioner. Accordingly, the patent owner is given a **ONE MONTH** extension of time to file an Appellant Brief, and patent owner's Appellant Brief is due no later than July 24, 2009.

If the April 23, 2009 petition under 37 CFR 1.181 has not yet been decided at the point where the time for patent owner to file an Appellant Brief becomes less than one month prior to the July 24, 2009 deadline, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Eugenia Jones at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed - in order to expedite its review.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.183 is granted-in-part, to the extent that patent owner is given a **ONE MONTH** extension of time to file an Appellant Brief.

2. The patent owner's Appellant Brief is due no later than July 24, 2009.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit for consideration of the petition under 37 CFR 1.181 filed April 23, 2009.

4. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

6-12-09
Kenpet7/IP

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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Harold H Fox
STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON DC 20036

(For Patent Owner)

MAILED

JUN 17 2009

CENTRAL REEXAMINATION UNIT

Eric B Meyertons
MEYERTONS, HOOD, KIVLIN,
KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

(For Third Party Requester)

DECISION DISMISSING PETITION TO ENTER AFTER ACP AMENDMENT
37 CFR § 1.181

In re: Kalley *et alia*
Inter Partes Reexamination Proceeding
Control No: 95/000,261
Deposited on: 07 May 2007
For: US Patent No: 6,590,220

This is a decision on the 23 April 2009 patent owner "Petition Under 37 CFR § 1.181 to Request Entry of Claim Amendments Filed on October 20, 2008." The petition seeks entry of claim amendments filed after the mailing of the Action Closing Prosecution (ACP).

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

The petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 8 July 2003 US Patent No. 6,590,220 was granted to Kalley *et alia.*

2. On 07 May 2007 a request for *inter partes* reexamination was submitted by a third party requester identified by control number 95/000,261.

3. On 20 July 2007 the Order was granted for *inter partes* reexamination in control number 95/000,261.

4. On 16 August 2007 a non-final Office action was mailed.

5. On 19 September 2008 an Action Closing Prosecution was mailed.

6. On 20 October 2008 amendments and remarks were received from the patent owner.

7. On 19 November 2008 the requester submitted remarks to the proceeding.

8. On 24 March 2009 the examiner in charge of the proceeding mailed a Right of Appeal Notice was mailed which noted that the amendment after Action Closing Prosecution was not entered

9. On 23 April 2009 the instant petition was submitted.

DISCUSSION

The patent owner petitions the director of the Central Reexamination Unit for consideration of entry of the amendment filed 20 October 2008 filed under 37 CFR § 1.951(a). The amendment was submitted subsequent to the mailing of the Action Closing Prosecution on 19 September 2008. 37 CFR § 1.116(b) is the authority for which the evaluation is made. The petition is dismissed.

CITATION OF RELEVANT AUTHORITY

§ 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.

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal. (in-part)

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.
(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 application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

MPEP § 2673 Examiner Consideration of Submissions After ACP and Further Action (in-part)

III. ACTION TAKEN BY EXAMINER
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 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.

DECISION REGARDING EXCERCISING SUPERVIRORY AUTHORITY

The statement of facts listed in the petition is generally correct.

The patent owner's petition maintains that the claim amendments in the 20 October 2008 submission "present the rejected claims in better form for consideration on appeal" pursuant to 37 CFR § 1.116(b)(2). "An amendment presenting rejected claims in better form for consideration on appeal may be admitted..."

The examiner wrote in the Right of Appeal notice dated 24 March 2009 on pages 45 to 49 the detailed explanation as to why the amendment dated 20 October 2008 was not entered. The examiner noted that the amendment raises questions as to consideration for compliance under 37 CFR § 112 first and second paragraphs while not reducing the issues on appeal. Further the petition does not provide a "showing of good and sufficient reasons why the amendment is necessary and was not earlier presented" pursuant to 37 CFR 1.116(b)(3). Lastly the amendment does not merely cancel rejected claims.

The proposed amendment of 20 October 2008 was given sufficient consideration to determine whether the claims would be in condition for allowance and/or whether the issues on appeal are simplified in the amendment were to be entered. The amendment clearly presented limitations which were not previously before the examiner that would require substantial consideration. As pointed out by the examiner, the proposed amendment to the claims raises issues of indefiniteness under both 37 CFR 112, first and second paragraphs. Entry of amendments after Action Closing Prosecution is limited to directly addressing the rejections of record or presenting the claims in better form for appeal. Finally, there is insufficient showing as to why the amendment filed 20 October 2008 could not have been earlier presented.

Accordingly, it appears that the examiner followed the policies set forth in the regulations and MPEP in refusing entry of the amendment presented 20 October 2008.

CONCLUSION

1. The patent owner's petition for entry of the amendment dated 20 October 2008 is dismissed.

2. The patent owner's Appellant brief is due 24 July 2009, as noted in the petition decision of 15 June 2009.

3. Future correspondence may be directed as follows:

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

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

By Hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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STEPTOE & JOHNSON LLP (For Patent Owner)
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

MAILED

AUG 26 2009

CENTRAL REEXAMINATION UNIT

Eric B. Meyertons (For Requester)
MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

In re Kalley et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,261
Filed: May 7, 2007
For: U.S. Patent No.: 6,590,220

DECISION
REFUSING ENTRY
OF PAPER

This is a decision on the August 10, 2009 third party requester paper entitled "Requester's Written Comments Regarding Response To Petition Under 37 C.F.R. § 1.182 To Request Entry of Claim Amendments Mailed July 17, 2009 In *Inter Partes* Reexamination of U.S. Patent No. 6,590,220."

The third party requester paper is before the Office of Patent Legal Administration.

The third party requester paper is refused entry into the record, without consideration on the merits, for the reasons set forth below.

RELEVANT BACKGROUND

1. U.S Patent number 6,590,220 (the '220 patent) issued on July 8, 2003.

2. On May 7, 2007, a request for *inter partes* reexamination of the '220 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,261 (the '261 reexamination proceeding).

3. On July 20, 2007, the Office issued an order, in the '261 reexamination proceeding, granting *inter partes* reexamination of the '220 patent.

4. The '261 reexamination proceeding progressed to the point where, on September 19, 2008, the Office mailed an Action Closing Prosecution (ACP).

5. On October 20, 2008, the patent owner filed a response to the ACP including a proposed amendment to the claims.

6. On November 19, 2008, the third party requester filed written comments in response to patent owner's response.

7. On March 24, 2009, the Office mailed a Right of Appeal Notice (RAN). The RAN stated that the proposed amendment to the claims filed October 20, 2008 has not been entered.

8. On April 23, 2009, the patent owner filed a petition under 37 CFR 1.181 requesting entry of the amendment filed October 20, 2008. The patent owner concurrently filed a petition under 37 CFR 1.183 requesting an extension of time to file the appeal brief.

9. On April 24, 2009, the patent owner filed a notice of appeal.

10. On May 21, 2009, the third party requester filed written comments regarding the petition under 37 CFR 1.181.

11. On June 15, 2009, the Office mailed a decision granting-in-part the April 23, 2009 petition under 37 CFR 1.183. Patent owner was given a ONE MONTH extension of time to file an Appellant Brief and thus patent owner's Appellant Brief was due no later than July 24, 2009.

12. On June 17, 2009, the Office mailed a decision dismissing the April 23, 2009 petition under 37 CFR 1.181.

13. On July 17, 2009, patent owner filed a petition under 37 CFR 1.182 requesting entry of the claim amendments filed on October 20, 2008, The patent owner concurrently filed a petition under 37 CFR 1.183 requesting an extension of time to file the Appellant Brief until after a decision on the petition under 37 CFR 1.182 is issued.

14. On July 24, 2009, the patent owner filed an Appellant Brief.

15. On August 10, 2009, the third party requester filed the instant paper (i.e., the paper addressed by this decision) in response to patent owner's July 17, 2009 petition under 37 CFR 1.182.

RELEVANT AUTHORITY

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 1.939(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 1.947 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 1.957(a) states:

> If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

DECISION

The August 10, 2009 third party requester paper opposing patent owner's July 17, 2009 petition under 37 CFR 1.182 requesting entry of the amendment filed on October 20, 2008, does 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 date of service of a patent owner's response to an Office action on the merits pursuant to 37 CFR 1.945. A petition under 37 CFR 1.182 to request entry of an amendment after an action closing prosecution is **not** a response to an "Office action on the merits." 35 U.S.C. 314(b)(2) does not provide any right for the third party requester to file an opposition to, or otherwise comment on, the patent owner's petition under 37 CFR 1.182. The petition under 37 CFR 1.182 is an issue that goes to the discretion of the Office and equities, rather than to the merits of the reexamination proceeding. 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 a petition under 37 CFR 1.182 to enter an amendment after an action closing prosecution. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress. A third party requester's opposition to the patent owner's petition under 37 CFR 1.182 is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Third party requester's opposition to patent owner's petition under 37 CFR 1.182 therefore is not enterable into the record.

It is noted that whether the patent owner's petition under 37 CFR 1.182 is grantable is a matter within the jurisdiction of the Office. Whether the Office should grant a petition to the USPTO Director to enter an amendment after an action closing prosecution and permit continued prosecution is clearly a matter within the discretion of the USPTO Director. While the requester

may oppose a patent owner challenge to jurisdiction over a proceeding by the Office,[1] the consideration of the present petition under 37 CFR 1.182 is clearly within the Office's jurisdiction, as discussed above. Therefore, the requester's opposition to patent owner's petition is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's petition. Accordingly, the opposition is refused entry as an improper paper.

Pursuant to 37 CFR 1.939(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." For the reasons discussed above, the third party requester's August 10, 2009 paper does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original paper cannot be physically returned to the third party requester. Rather, the third party requester's paper will be expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP § 2667. A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. The August 10, 2009 third party requester opposition paper is refused entry into the record, as it is an improper paper.

2. The August 10, 2009, third party requester paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The paper will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.

4. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit.

5. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

8-25-09

[1] 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.

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AUG 26 2009

CENTRAL REEXAMINATION UNIT

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In re Kalley et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,261
Filed: May 7, 2007
For: U.S. Patent No.: 6,590,220

DECISION
DISMISSING PETITION
UNDER 37 CFR 1.182

This is a decision on the July 17, 2009 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182 to Request Entry of Claim Amendments Filed on October 20, 2008."

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.182 is dismissed.

The requisite petition fee of $400.00 for a petition under 37 CFR 1.182 has been charged to petitioner's deposit account as authorized in the petition.

RELEVANT BACKGROUND

1. U.S Patent number 6,590,220 (the '220 patent) issued on July 8, 2003.
2. On May 7, 2007, a request for *inter partes* reexamination of the '220 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,261 (the '261 reexamination proceeding).
3. On July 20, 2007, the Office issued an order, in the '261 reexamination proceeding, granting *inter partes* reexamination of the '220 patent.
4. The '261 reexamination proceeding progressed to the point where, on September 19, 2008, the Office mailed an Action Closing Prosecution (ACP).

5. On October 20, 2008, the patent owner filed a response to the ACP including a proposed amendment to the claims.

6. On November 19, 2008, the third party requester filed written comments in response to patent owner's response.

7. On March 24, 2009, the Office mailed a Right of Appeal Notice (RAN). The RAN stated that the proposed amendment to the claims filed October 20, 2008 has not been entered.

8. On April 23, 2009, the patent owner filed a petition under 37 CFR 1.181 requesting entry of the amendment filed October 20, 2008. The patent owner concurrently filed a petition under 37 CFR 1.183 requesting an extension of time to file the appeal brief.

9. On April 24, 2009, the patent owner filed a notice of appeal.

10. On May 21, 2009, the third party requester filed written comments regarding the petition under 37 CFR 1.181.

11. On June 15, 2009, the Office mailed a decision granting-in-part the April 23, 2009 petition under 37 CFR 1.183. Patent owner was given a ONE MONTH extension of time to file an Appellant Brief, and thus, patent owner's Appellant Brief was due no later than July 24, 2009.

12. On June 17, 2009, the Office mailed a decision dismissing the April 23, 2009 petition under 37 CFR 1.181.

13. On July 17, 2009, patent owner filed the instant petition (i.e., the petition addressed by this decision) under 37 CFR 1.182 requesting entry of the claim amendments filed on October 20, 2008. The patent owner concurrently filed a petition under 37 CFR 1.183 requesting an extension of time to file the Appellant Brief until after a decision on the petition under 37 CFR 1.182. The petition under 37 CFR 1.183 is being addressed in a separate decision mailed concurrently herewith.

14. On July 24, 2009, the patent owner filed an Appellant Brief.

15. On August 10, 2009, the third party requester filed written comments in response to patent owner's July 17, 2009 petition under 37 CFR 1.182.

RELEVANT REGULATORY PROVISION

37 CFR 1.182 provides:

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

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after an action closing prosecution) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the action closing prosecution. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In this instance, the § 1.182 petition includes a submission directed towards the entry of claim amendments and accompanying remarks, as discussed in patent owner's instant petition. The petition is accompanied by a proposed amendment to the claims in Appendix A and accompanying remarks in Appendix B. The proposed amendment is the same as the proposed amendment filed October 20, 2008, except for the markings and parenthetical expressions.[2] These amendments were denied entry in the RAN of March 24, 2009. The examiner provided a detailed explanation in the RAN of the reasons for not entering the proposed amendment. For example, the examiner stated that there was no showing of good and sufficient reasons why the amendment was necessary and was not earlier presented. Furthermore, the examiner stated that the proposed amendment to claims 1, 12, 30, and 57 raises issues of indefiniteness under 35 U.S.C. 112, second paragraph, scope of enablement under 35 U.S.C. 112, first paragraph, and new matter under 35 U.SC. 112, first paragraph. Thus, the proposed amendment did not present

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

[2] Patent owner has attempted to correct the non-compliance with 37 CFR 1.530 noted by the examiner in the RAN, however the proposed amendment has not been reviewed for compliance with 37 CFR 1.530.

the rejected claims in better form for appeal. The examiner also noted that the proposed amendment raised new issues because the claims as amended were not shown in the drawings. Furthermore, a decision dismissing the petition to enter the amendment after ACP under 37 CFR 1.181 was mailed June 17, 2009, in which the examiner's refusal to enter the proposed amendment was reviewed, but no basis was found to overturn the examiner's non-entry of the amendment.

Patent owner argues that: (1) the claim amendments are necessary and were not earlier presented as the examiner did not provide any opportunities for the patent owner to do so; (2) the claim amendments presented the rejected claims in better form for consideration on appeal; and (3) the claim amendments cancelled claims and complied with a requirement of form expressly set forth in the ACP.

First, patent owner argues that the claim amendments are necessary and could not have been presented earlier. Specifically, patent owner argues that the proposed claim amendments of claims 1, 12, 40, 44, 46, 50, 54, 56, 57, 66, 68, 69, 73 and 75 were to clarify the pending claims in response to the rejections under 35 U.S.C. 112, first and second paragraph, in the ACP, that the claims amendments were necessary to overcome the rejections in the ACP, and the claim amendments were not earlier presented because the examiner did not give the patent owner any opportunity to file such amendments following the response filed on October 16, 2007.

However, claims 1-36 were rejected on the same grounds of rejection in both the first Office action and the ACP. Patent owner *did not amend any of claims 1-36* in response to the first Office action, and added new claims 37-76. Furthermore, claims 1-36 were not rejected under 35 U.S.C. 112, first paragraph, or 35 U.S.C. 112, second paragraph, and thus there does not appear to be any need to "clarify" these claims. Thus, at least the proposed amendments to claims 1, 12, and 30 could have been presented earlier, in response to the first Office action. The proposed amendments are not in response to issues newly raised in the ACP, since there were no new issues raised with respect to claims 1-36.

A grant of continued reexamination is not for the purpose of simply providing an additional opportunity to address a previously raised issue, after the examiner refuses to accept an argument as to the issue in an ACP, but, rather, patent owner must show that the examiner, in the ACP, is providing some new reason for the position taken that would not have been reasonably anticipated.

Second, patent owner argues that the proposed claim amendments present the rejected claims in better form for consideration on appeal. Proposed amendments which raise new issues do not present the rejected claims in better form for consideration on appeal. As discussed above, the examiner has already stated in the RAN that the proposed amendments raise new issues under 35 U.S.C. 112, first and second paragraphs. While patent owner presents a number of arguments in the instant petition attempting to rebut the examiner's determination that the proposed amendment raises new issues, such arguments are properly addressed through 37 CFR 1.181, not through 37 CFR 1.182. The patent owner filed a petition under 37 CFR 1.181 that appears to make these same arguments. However, as discussed above, the patent owner's petition under 37 CFR 1.181 was dismissed in a decision mailed June 17, 2009. If patent owner is seeking relief

on the basis that a previous Office decision on the 37 CFR 1.181 petition is incorrect, then the proper avenue for relief would be a petition for review of the decision dismissing the patent owner's petition under 37 CFR 1.181. 37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is, according to the terms of the regulation, not the appropriate mechanism for relief.

Finally, patent owner argues that the claim amendments cancelled claims and complied with a requirement of form set forth in the ACP. While the proposed amendment does include the cancellation of some claims, the proposed amendment includes other claim amendments which, as discussed above, would not further prosecution by better defining the issues for appeal, or by placing the claims in condition for the issuance of a reexamination certificate. A proposed amendment is considered in its entirety in determining whether the proposed amendment will be entered or not.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. 314 to conduct *inter partes* reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.182 is dismissed.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit.

3. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

8-25-09
Kenpet7/RCR/IP

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AUG 26 2009

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In re Kalley et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,261
Filed: May 7, 2007
For: U.S. Patent No.: 6,590,220

DECISION
DISMISSING PETITION
UNDER 37 CFR 1.183

This is a decision on the July 17, 2009 patent owner petition entitled "Petition Under 37 C.F.R. § 1.183 to Request a Waiver of Prohibition of an Extension of Time for Filing an Appeal Brief."

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is dismissed as moot.

The requisite petition fee of $400.00 for a petition under 37 CFR 1.183 is being charged to petitioner's deposit account as authorized in the petition.

RELEVANT BACKGROUND

1. U.S Patent number 6,590,220 (the '220 patent) issued on July 8, 2003.
2. On May 7, 2007, a request for *inter partes* reexamination of the '220 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,261 (the '261 reexamination proceeding).
3. On July 20, 2007, the Office issued an order, in the '261 reexamination proceeding, granting *inter partes* reexamination of the '220 patent.
4. The '261 reexamination proceeding progressed to the point where, on September 19, 2008, the Office mailed an Action Closing Prosecution (ACP).

5. On October 20, 2008, the patent owner filed a response to the ACP including a proposed amendment to the claims.

6. On November 19, 2008, the third party requester filed written comments in response to patent owner's response.

7. On March 24, 2009, the Office mailed a Right of Appeal Notice (RAN). The RAN stated that the proposed amendment to the claims filed October 20, 2008 has not been entered.

8. On April 23, 2009, the patent owner filed a petition under 37 CFR 1.181 requesting entry of the amendment filed October 20, 2008. The patent owner concurrently filed a petition under 37 CFR 1.183 requesting an extension of time to file the appeal brief.

9. On April 24, 2009, the patent owner filed a notice of appeal.

10. On May 21, 2009, the third party requester filed written comments regarding the petition under 37 CFR 1.181.

11. On June 15, 2009, the Office mailed a decision granting-in-part the April 23, 2009 petition under 37 CFR 1.183. Patent owner was given a ONE MONTH extension of time to file an Appellant Brief, and thus, patent owner's Appellant Brief was due no later than July 24, 2009.

12. On June 17, 2009, the Office mailed a decision dismissing the April 23, 2009 petition under 37 CFR 1.181.

13. On July 17, 2009, patent owner filed a petition under 37 CFR 1.182 requesting entry of the claim amendments filed on October 20, 2008. The patent owner concurrently filed the instant petition (i.e., the petition addressed by this decision) under 37 CFR 1.183 requesting an extension of time to file the Appellant Brief until after a decision on the petition under 37 CFR 1.182.

14. On July 24, 2009, the patent owner filed an Appellant Brief.

15. On August 10, 2009, the third party requester filed written comments in response to patent owner's July 17, 2009 petition under 37 CFR 1.182.

RELEVANT REGULATORY PROVISION

37 CFR 1.183 states:

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

DECISION

The present July 17, 2009 petition under 37 CFR 1.183 was filed concurrently with a petition under 37 CFR 1.182 requesting entry of the amendment filed on October 20, 2008. In the 37 CFR 1.183 petition, the patent owner requests (1) a waiver of the prohibition of an extension of time for filing an Appellant Brief, and (2) an extension of the time period to file the Appellant Brief until after a decision on the 37 CFR 1.182 petition.

After filing of the present petition under 37 CFR 1.183, patent owner timely filed its Appellant Brief on July 24, 2009. Since the Appellant Brief has already been filed, the petition under 37 CFR 1.183 for extension of time to file that brief is moot.

A decision on the July 17, 2009 petition under 37 CFR 1.182 is being mailed concurrently herewith.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.183 is dismissed as moot.

2. After mailing of this decision, the $400.00 petition fee will be charged to petitioner's deposit account No. 19-4293 as authorized in the petition.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit.

4. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

8-25-09

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NOV 27 2007

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In re Reexamination Proceeding	:
C. Bryant	:
Control No. 95/000,265	: DECISION GRANTING PETITION
Filed: May 29, 2007	:
U.S. Patent No. 7,222,614	:
Attorney Docket No. E025 7010	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 6, 2007, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration (OPLA) for 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 ...."

On November 6, 2007, the present petition was filed. The present petition under 37 CFR 1.137(b) includes, inter alia, an authorization to charge counsel's deposit account for the $770.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

On November 6, 2007, in a separate submission, the requisite response (Patent Owner's Response To Office Action - item 1) was filed by EFS-Web.

The petition for entry of the late papers is granted.

$770.00 has been charged to counsel's deposit account no. 09-0528 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) for consideration of Patent Owner's Response To Office Action filed November 6, 2007, in due course.

The Third Party Requestor has **THIRTY (30) days from the mailing date of this decision** to file comments pursuant to 37 CFR1.947, responsive to Patent Owner's Response To Office Action.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, David Reip, in CRU Art Unit 3993, who can be reached at 571-272-4702.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

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MAILED

NOV 28 2007

CENTRAL REEXAMINATION UNIT

In re UTStarcom, Inc.
Reissue Application
Application No. 11/636,350
Filed: December 7, 2006
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

In re UTStarcom, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,269
Filed: June 26, 2007
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

: DECISION DISMISSING
: PETITIONS, AND
: *SUA SPONTE* MERGING
: REISSUE AND
: *INTER PARTES*
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's "PETITION OPPOSING MERGER OF CONCURRENT PROCEEDINGS AND FOR SUSPENSION OF *INTER PARTES* REEXAMINATION UNDER 37 C.F.R. § 1.182 OR IF DENIED, FOR SUSPENSION OF THE RULES UNDER 37 C.F.R. § 1.183" that was filed on September 11, 2007.

This is also a decision on the third party requester's "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) FOR SUSPENSION OF THE REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,829,473, AND UNDER 37 CFR § 1.183 FOR SUSPENSION OF 37 C.F.R. 1.939(b)" filed on October 30, 2007, and on patent owner's November 1, 2007 opposition to the October 30, 2007 third party requester's petition.

The respective party papers and reissue application number 11/636,350 and *inter partes* reexamination control number 95/000,269 are before the Office of Patent Legal Administration for consideration and such action as may be appropriate.

Summary:
The respective patent owner and third party requester petitions are dismissed with respect to granting the substantive relief requested therein.

Reissue application number 11/636,350 and *inter partes* reexamination control number 95/000,269 are merged, *sua sponte* into a single proceeding in accordance with the conditions and procedures discussed below.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 22-0261 for both the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition, and for the $400.00 fee for filing the filing of the paper under 37 CFR 1.182 opposing the third party requester petition. A total of $800.00 will be charged to Deposit Account No. 22-0261.

Third party requester has remitted the $400.00 petition fee under 37 CFR 1.182 for filing its petition. The payment was received by credit card.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,829,473 B2 (the '473 patent) issued to Sundar Raman *et al*, on December 7, 2004, and is assigned to UTStarcom, Incorporated (patent owner).

2. On December 7, 2006, the patent owner filed a reissue application based on the '473 patent, which was assigned application number 11/636,350 (the '350 reissue application). The application as filed did not contain an oath or declaration, and did not contain a statement under 37 CFR 3.73(b) in support of the consent by patent owner to the filing of the reissue application.

3. Concurrently with the filing of the '350 reissue application, patent owner filed a preliminary amendment that amended two or the four independent claims and various dependent claims of the '350 reissue application.

4. On May 30, 2007, a statement under 37 CFR 3.73(b) and a declaration under 37 CFR 1.63 (that was not a reissue declaration 37 CFR 1.175) was filed by patent owner in the '350 reissue application.

5. A request for *inter partes* reexamination of the '473 patent was filed by a third party requester on June 26, 2007, and the resulting reexamination proceeding was assigned Control Number 95/000,269 (the '269 reexamination proceeding). Starent Networks Corporation is identified as the real party in interest for the requester.

6. On July 17, 2007, a reissue declaration under 37 CFR 1.175 was filed by patent owner in the '350 reissue application.

7. A first Office action on the merits of patentability has been not been issued by the Office in the '350 reissue application.

8. On August 16, 2007, an order granting *inter partes* reexamination of claims 1-64, (*i.e.*, all of the claims) of the '473 patent was mailed for the '269 *inter partes* proceeding. The order was

not accompanied by an Office action on the patentability of the claims, and no action on the patentability of claims 1-64 has been taken.

9. The '473 patent is the subject of litigation. [1] The litigation is stayed due to the copending reissue application. [2]

10. On September 11, 2007, patent owner filed a petition opposing merger of the '269 *inter partes* reexamination proceeding and the '350 reissue application, and requesting suspension of the '269 *inter partes* reexamination proceeding. [3]

11. On October 30, 2007, third party requester filed a petition to suspend the '350 reissue application during the pendency of the '269 *inter partes* reexamination proceeding.

12. On November 5, 2007, patent owner filed a paper opposing the October 30, 2007 third party requester petition.

DECISION

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> 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) provides:

> 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

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[1] *UTStarcom v. Starent Networks Corp.* No. 05-00710 JSW (N.D. Cal.), February 16, 2005 See: Request for *Inter Partes* Reexamination, 95/000,269, June 21, 2007, page 8; See also: Notice of Concurrent Proceedings filed in reissue application 11/636,350 on December 7, 2006.

[2] *Id.*

[3] It appears that the record copy of this paper lacks page 22 of the petition; however, page 22 of the petition is in the record as part of Exhibit B of the third party requester's October 30, 2007 petition.

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.

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.

35 U.S.C. § 314 provides:

(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.

(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.

35 U.S.C. § 315(a)and (b) provide:

(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 1.906 provides:

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.
(b) Claims in an inter partes reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.
(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

37 CFR 1.937 provides, in part:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the 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 1.939 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.
(b)Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

37 CFR 1.955 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 § 2686.03 provides, in 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).
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> 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 underlying added.]
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> Where a reissue patent will not be granted prior to the expiration of the 3-month period for making the determination on the reexamination request, a decision will be made after an order to reexamine is issued 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. In this situation, no first Office action will have accompanied the order for reexamination.
>
> 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. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed.

II. BACKGROUND

The '350 reissue application and the '269 *inter partes* reexamination proceeding are currently pending. Each of the two proceedings is at an early stage of prosecution, *i.e.*, neither individual proceeding has received a first Office action on patentability. Since reexamination has been ordered pursuant to § 1.931 in the '269 *inter partes* reexamination proceeding, a decision under § 1.991 is timely as to whether the '350 reissue application and the '269 *inter partes*

reexamination proceeding should be merged. In connection with this decision, patent owner filed a petition on September 11, 2007, proactively opposing merger of the '350 reissue application and the '269 *inter partes* reexamination proceeding, and requesting suspension of the '269 *inter partes* reexamination proceeding. Third party requester has filed, on October 30, 2007, a petition requesting suspension of the '350 reissue application. Patent owner filed a paper on November 5, 2007, opposing the third party requester's petition.

III. DISCUSSION REGARDING PATENT OWNER'S PETITION [4]

It is to be noted that no action on the merits of patentability has been promulgated in the '269 *inter partes* reexamination proceeding. Thus, the patent owner petition paper and opposition paper are improper papers under 37 CFR 1.939(b), because they were both filed prior to the first Office action on the merits. Those papers would also not be entitled to entry under 37 CFR 1.939(a), and would be returned on the grounds that the rules do not provide for filing those papers. However, patent owner has requested consideration of its petition and opposition papers pursuant to both 37 CFR 1.182 (relief for which the rules otherwise do not provide) and 37 CFR 1.183 (suspension of the rules). Patent owner's petition is granted to the extent that the provisions of 37 CFR 1.939 are waived to permit consideration of the paper, and such consideration will be undertaken under 37 CFR 1.182 given that the rules do not provide for the requested relief.

In the petition paper, patent owner opines that if the '269 *inter partes* reexamination proceeding is merged with the '350 reissue application, then patent owner will be deprived of its statutory right to correct the specification and drawings of the '473 patent through reissue. This argument is not persuasive, because patent owner has not established any basis for concluding that the drawings and the specification of a patent in a merged reissue/*inter partes* reexamination proceeding may not be corrected in like manner to correction of such matters in a separate reissue application.

Further, 37 CFR 1.991 clearly provides for the possibility of merging copending reissue and *inter partes* reexamination proceedings. Moreover, as noted in MPEP § 2686.03, the general policy of the Office is 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. [5] 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. It should be noted that

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[4] Each and every argument made in patent owner's petition has been carefully considered. This decision will summarize patent owner's position. The failure to specifically state each point raised by patent owner should not be taken to mean that such point was not considered or was overlooked.

[5] In this instance, it is further noted that, 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 the *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 the level field intent of the *inter partes* reexamination statute.

MPEP § 2686.03(B) (which addresses copending reexamination proceedings that have not received actions on the merits) states that merger is possible even where one of the proceedings raises matters that would not be proper for consideration in the other proceeding. That is, merger can, and generally should be accomplished, where doing so will protect the rights of both patent owner and the third party requester, and the merged proceeding can be structured to preclude issues that are improper in the controlling reissue proceeding from being raised in the merged proceeding where a party would be precluded from raising such issues. It should also be noted that the Office has recently merged a broadening reissue application with an *inter partes* reexamination proceeding, where the proceedings were at appropriate early stages of prosecution. [6] The merger was accomplished so as to preclude, for example, the *inter partes* reexamination requester from commenting in the merged proceeding regarding the merits of the broadened claims presented in the merged proceeding that was conducted based upon a modified reissue practice, so that the patent owner could pursue broadened reissue claims as it had a right to do under 35 U.S.C. § 251. However, in an *inter partes* reexamination proceeding, a third party requester has the right to comment on proposed amendments to the specification and drawings of a patent, which do not result in a broadening of the scope of the entirety of the patent claims.

Patent owner also opines that it will be deprived of its statutory rights to broaden patent claims in a reissue application. First, it is not at all clear that as filed, the '350 reissue application is a broadening reissue application, because it does not facially appear that patent owner expressed any intent to broaden the protection afforded by the '473 patent claims within two years of the issue date of the '473 patent. [7] However, it is unnecessary, and inappropriate, to decide that issue in the present decision. Attention is again invited to the discussion in footnote 6 for an example of merger of a broadening reissue application with an *inter partes* reexamination

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[6] See: Merged 11/703,606 reissue application - 95/000,270 *Inter Partes* Reexamination proceeding, "Decision, *Sua Sponte*, Merging Reissue and *Inter Partes* Reexamination Proceedings, and Waiving Rules," October 24, 2007. Compare: *In re Allan*, 71 USPQ2d 1751 (2004), a reported, but unpublished, decision that is designated as nonprecedential. In the *Allan* 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 10/430,71 as paper PETDEC dated December 22, 2003). Note should be taken of the manner in which *Allan* was distinguished by the Decision in the merged '606 reissue/'270 *inter partes* reexamination proceeding by fashioning appropriate protection for the reissue rights of the patent owner and the third party requester of the *inter partes* reexamination proceeding.

[7] The '473 patent issued on December 7, 2004. The '350 reissue application was filed on December 7, 2006. As filed, no paper in the '350 reissue application expressed an intent to broaden. Claims 1, 12, 37 and 61 of the '473 patent are the only independent claims, and all are open-ended comprising type claims. Only claim 12 and claim 61 were amended, and the single amendment changing the word "the" to "a" can be read as being directed to providing antecedent basis in the claims. (See: page 2, item 4 of the patent owner petition wherein it is stated that "[M]any of the amendments were to repair syntactical errors-such as lack of antecedent basis.") As to any amendment made to the dependent claims: Unless a dependent claim has been improperly amended to be broader than its parent claim, (see the discussion at MPEP § 608.01(n)(III)), a dependent claim must narrow the independent claim upon which it depends. The amendments to the dependent claims may broaden a dependent claim with respect to the scope of THAT original independent claim; however, such amendments must not broaden to increase the coverage afforded beyond that of the open-ended independent parent claims. The first, (and currently only) reissue declaration filed in the '350 reissue application was filed on July 17, 2007, and does not state that the '473 patent is wholly or partly inoperative by claiming less than it had a right to claim. In general, see MPEP 1412.03(IV) and *In re Graff*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) and *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) on the issue of broadening in a reissue application within two years of the issue date of the original patent.

proceeding, in which the merger was accomplished so as to protect the patent owner's statutory right to broaden patent claims through 35 U.S.C. § 251 reissue of the patent, such that the reexamination requester must not comment on the broadened materials.

Patent owner next relies upon the decision in *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985) as mandating suspension of the present '269 *inter partes* reexamination proceeding. It is noted, however, that *Onda* is clearly inapposite the facts with respect to merger of the present '350 reissue application and '269 *inter partes* reexamination proceedings. In *Onda*, the reissue application was filed after a decision by the (then) Board of Appeals had been rendered affirming the examiner's determination in an *ex parte* reexamination proceeding that the patent claims were not patentable. The Office declined to merge the two proceedings because of the advanced stage of the *ex parte* reexamination proceeding as compared to the recently filed reissue application, and instead suspended the reexamination proceeding so that the patent claims would not be cancelled by publication of the reexamination certificate, and patent owner could thus seek to obtain narrower, patentable claims in the reissue application. Unlike the facts in *Onda*, the '350 reissue application and the '269 *inter partes* reexamination proceeding are both in a very early stage of prosecution; no first action on the merits has issued in either proceeding. Merger now will afford patent owner the right to appeal any rejection made in the merged proceeding, and to present in the merged proceeding narrower claims as a hedge against an adverse result with respect to any claims that may be rejected and appealed.

Finally, patent owner argues that the proceedings will be expedited by suspension of the *inter partes* reexamination proceeding, and that third party requester will not be prejudiced by non-merger. However, the reexamination requester will be prejudiced. It is important to note that the public, as well as the third party requester and the court in which there is currently stayed litigation, are entitled to disposition of the '269 *inter partes* reexamination proceeding with the special dispatch required by statute. By merging the '350 reissue application and '269 *inter partes* reexamination proceeding, all issues that can be raised in the '269 *inter partes* reexamination proceeding can be addressed, and the Office will not have to conduct two separate proceedings on two potentially differing records. On the other hand, merger of the '350 reissue application and the '269 *inter partes* reexamination proceeding will not unduly slow the reissue proceeding down, although (as discussed below) the *inter partes* reexamination rights of third party requester to participate will be preserved. Attention is invited to the portion of this decision that explains the manner in which the merged proceeding will be conducted.

For all of the above reasons, patent owner has not established a convincing basis for either maintaining the '350 reissue application and the '269 *inter partes* reexamination proceeding as separate, concurrently conducted proceedings, or for suspending the latter while conducting prosecution on the former. Accordingly, the patent owner's petition for such relief is dismissed.

IV. DISCUSSION OF THIRD PARTY REQUESTER'S PETITION AND PATENT OWNER'S OPPOSITION THERETO [8]

In its October 31, 2007 petition, third party requester requests that the '350 reissue application be suspended during the pendency of the '269 *inter partes* reexamination proceeding. Patent owner's November 5, 2007 opposition paper requests that the third party requester petition be struck or denied.

As discussed with respect to the September 11, 2007 patent owner petition, no action on the merits of patentability has been promulgated in the '269 *inter partes* reexamination proceeding. Thus, to the extent that the third party requester's petition is directed to the '269 *inter partes* reexamination proceeding, it is an improper paper under 37 CFR 1.939(b) because it was filed prior to the first Office action on the merits. The third party petition paper would also not be entitled to entry under 37 CFR 1.939(a), and would be returned on the grounds that the rules do not provide for filing those papers. However, third party requester has requested consideration of its petition paper pursuant to both 37 CFR 1.182 (relief for which the rules otherwise do not provided) and 37 CFR 1.183 (suspension of the rules). The third party petition is granted to the extent that the provisions of 37 CFR 1.939 are waived to permit consideration of the paper, and such consideration will be undertaken under 37 CFR 1.182 given that the rules do not provide for the requested relief.

A review of the third party requester's petition shows that third party requester takes the position that patent owner cannot pursue a broadening reissue application, because patent owner is barred by the limitation in 35 U.S.C. § 251 that precludes the filing of a broadening reissue application more than two years after the issue date of the original patent (for which reissue is sought). However, as noted in Section III, *supra*, this decision does not reach that issue. Any broadening issue that might be present would be an issue that can be addressed by the examiner during the examination of the reissue application (whether or not it is merged), and may be appealed should the examiner's decision be adverse to patent owner. Requester, on the other hand, has no statutory right to comment on any broadening issue with respect to the reissue application. It is to be noted that this matter should not have an effect on the merger. Even if claim revision is ultimately carried out to address a broadening issue, the reissue can continue as long as an appropriate 35 U.S.C. § 251 "error" in the patent remains of record. If that ceases to be the case, the merger can be dissolved.

Third party requester also argues that patent owner's reissue application is an "attempt to 'moot'" statutory rights and is contrary to the reexamination statute. It is, however, difficult to see how the filing of a reissue application more than six months prior to the filing of an *inter partes* reexamination request filed for the same patent is an "attempt" to do anything with respect to the subsequently filed (i.e., then non-existent) request for *inter partes* reexamination.

It is noted that third party requester does not oppose patent owner's attempt to reissue the '473 patent, because third party requester opines that the reissue application is not for broadening

[8] Each and every argument made in third party requester's petition and patent owner's opposition thereto has been carefully considered. This decision will summarize those positions. The failure to specifically state each point raised by the parties should not be taken to mean that such point was not considered or was overlooked.

purposes. Yet third party requester cites an Office decision [9] for the proposition that the '350 reissue application should be stayed during the pendency of the '269 *inter partes* reexamination proceeding. That cited Office decision is directed to the situation that third party requester states does not presently exist, namely the existence of a copending *inter partes* reexamination proceeding and a broadening reissue application for the same patent. If third party requester is correct that the '350 reissue application is not a broadening reissue application, [10] it is difficult to understand third party requester's objection to merger of the '350 reissue application and the '269 *inter partes* reexamination proceeding, because the conduct of such a merged proceeding will afford third party requester with comment rights essentially equivalent to the comment rights that exist in an unmerged *inter partes* reexamination proceeding. 37 CFR 1.991 expressly provides that "[I]n 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."

It is also to be noted that, as pointed out by both parties, the litigation proceedings involving the '473 patent have been stayed to permit the reissue application proceedings. As noted by patent owner, suspension of the reissue application would unduly delay the litigation proceedings.

Third party requester has not established any basis for suspending the '350 reissue application and conducting the '269 *inter partes* reexamination proceeding, thereby requiring the Office to expend additional resources, and delay the reissue application to the possible prejudice of the patent owner. Accordingly, the requester's petition for such relief is dismissed. Any concerns that third party requester has regarding timely prosecution of the reissue application, and/or preservation of the comment rights of the third party requester, will be addressed by the terms of the Order merging the two proceedings. [11]

V. Decision Merging The '350 Reissue Application And The '269 *Inter Partes* Reexamination Proceeding

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the '350 reissue application and the '269 *inter partes* reexamination proceeding 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 reissue application and the *inter partes* reexamination file 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.

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[9] Exhibit F attached to the October 30, 2007 third party requester decision.

[10] Again, this decision need not, and does not decide the correctness of third party requester's allegation that the '350 reissue application is not properly a broadening reissue application.

[11] See Section V below.

2. Presently, the claims in the '350 reissue application are not the same in as the claims in the '269 *inter partes* reexamination proceeding. Specifically, patent claims 2, 4, 7, 10, 11, 12, 15-17, 19, 20, 22, 25-27, 29, 35, 42-46, 49, 52, 54-56, 59 and 61 have been amended. Further, it appears that patent drawing Figures 5-7 and 11-14 have been amended, and that extensive amendments to the specification have been made in the reissue application. **Therefore, an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases,** specifically, reissue Application No. 11/636,350, and *inter partes* reexamination Control No. 95/000,269.

The response to this 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). The paper should be strictly limited to the bare presentation of the amendments. The patent owner must not address any issues otherwise present in either of the proceedings in the housekeeping amendment. Any discussion of the merits or issues of the proceeding by patent owner would be improper and would result in non-entry of the paper into the record, as it would result in the paper being an improper submission under 37 CFR 1.939. The housekeeping amendment must comply with the provisions of 37 CFR 1.173 (the rule governing amendments filed in reissue applications). [12] See MPEP § 1453 for a complete discussion of amendment practice in reissue applications.

3. In the event that the required housekeeping amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

4. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) will not create a comment right for third party requester. Any comments paper filed by third party requester in response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. The regulatory provisions governing the examination of reissue applications include, *inter alia*, provisions equivalent to the regulations relating to the conduct of *inter partes* reexamination proceedings, including that examination of a reissue application be examined expeditiously. Therefore, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination practice, to the extent it is practical to do so. In

[12] Note that a "clean copy" of the amendment is not required by 37 CFR 1.173, and is not to be provided.

addition, the third party requester in the '269 *inter partes* reexamination proceeding may participate in the merged proceeding to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be strictly limited to issues within the scope of *inter partes* reexamination as directed in paragraph 15 below. The examiner will apply the reissue statute, rules, and case law to the examination of the merged proceeding except as directed in paragraph 15 below.

2. Each Office action issued by the examiner will take the form of a single action which jointly applies to the '350 reissue application and the '269 *inter partes* reexamination proceeding. Time periods for response will be set pursuant to MPEP § 1442.01. [13] Each action will contain identifying data for both of the proceedings, *i.e.*, the reissue application and the *inter partes* reexamination proceeding. 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 response by the reissue applicant/patent owner must consist of a single response, with **a copy being filed for entry in 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 reissue application number and the *inter partes* reexamination proceeding control number).

4. All amendments that are submitted during the prosecution of the merged proceeding must be submitted in accordance with the practice under 37 CFR 1.173 and 37 CFR 1.121(h) governing reissue applications. See MPEP § 1453 for a complete discussion of amendment practice in a reissue application. It is to be noted that, except for subsection (h), 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

5. Any paper (*e.g.*, comments, brief) filed by third party requester must consist of a single response, with **a copy being filed for entry in 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 reissue application number and the *inter partes* reexamination proceeding control number).

6. There will be no interviews in the merged proceeding, as the rules provide that *inter partes* reexamination will be conducted on the written record. [14]

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[13] MPEP § 1442.01 provides, in pertinent part: "Applicants will normally be given 1 month to reply to Office actions in all reissue applications which are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This 1-month period may be extended only upon a showing of clear justification pursuant to 37 CFR 1.136(b). The Office action will inform applicant that the provisions of 37 CFR 1.136(a) are not available. Of course, up to 3 months may be set for reply if the examiner determines such a period is clearly justified." [Emphasis added.]

[14] 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

7. 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).

8. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. Thereafter, with respect to the '269 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal rights have been exhausted. See 37 CFR 1.957(c).

9. If the applicant/patent owner files an express abandonment of the '350 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 '269 *inter partes* reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

10. Where the merged proceeding is dissolved based on abandonment of the reissue application and the '269 *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 (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant practice to 37 CFR 1.906(c).

11. If the merged proceeding is dissolved based on abandonment of the '350 reissue application and the '269 *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application of the '350 reissue application will be merged with the '269 *inter partes* reexamination proceeding (thus, the continuation reissue application might be stayed pending conclusion of the '269 *inter partes* reexamination).

12. If applicant/patent owner files a Request for Continued Examination (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 is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it is filed with respect to a reissue application or a non-reissue application.

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permitting interviews, which is the intent of the *inter partes* reexamination statute. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of paramount importance. A petition under 37 CFR 1.183 may be submitted to request an interview in the rare circumstances that an interview is deemed to be indispensable.

13. 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.

14. The examiner in the merged proceeding will consult with OPLA (*i.e.*, the OPLA reexamination legal advisor (RLA) assigned to the '269 *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner, as he/she would consult in an *inter partes* reexamination proceeding that is not merged.

15. Scope Of Third Party Requester's Participation In The Merged Proceeding:

37 CFR 1.991 provides that "[I]n 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. The following provides for preservation of that right:

a. Copies of all Office actions will be provided by the Office to the third party requester. Further, any paper filed by the applicant/patent owner in the merged proceeding must be served on the third party requester. Third party requester will be given an opportunity to comment after all patent owner replies (responses) to Office actions (to the extent pointed out below). As permitted by the reexamination statute and regulations, the third party requester may comment on the patentability of amended patent claims or newly proposed claims based upon patentability issues that are not limited to patentability over prior patents and printed publications (as per 37 CFR 1.906 and MPEP § 2258). However, third party requester participation in the merged proceeding must be strictly limited to issues within the scope of *inter partes* reexamination. No third party comments can be advanced on issues appropriate for reissue, but not appropriate for reexamination. For example requester must not provide:

(1) Comments regarding the acceptability of any reissue declaration;
(2) Comments regarding assignee assent;
(3) Comments regarding the recapture doctrine;
(4) Comments on patentability issues not based on patents or printed publications, unless permitted by 37 CFR 1.906 and MPEP § 2658 for new or amendatory text or drawing revision; and
(5) Comments that any existing or amended claim of the '473 patent, or any claim proposed in the merged proceeding, is unpatentable under 35 U.S.C. § 314(a) as impermissibly broadening the scope of coverage of the patent claims, whether by reason of claim interpretation resulting from amendments to the specification or otherwise. [15]

[15] It is again to be noted that third party requester and patent owner have taken conflicting positions regarding whether the '350 reissue application is a broadening reissue application. See, for example pages 2 and 3 of the September 11, 2007 patent owner petition and pages 3-4 of the November 5, 2007 patent owner opposition paper, and compare with pages 2-4 of the October 30, 207 third party requester petition. The question of whether the '350 reissue application is a broadening reissue application (see MPEP § 11412.03) that was timely filed will not be decided in this petition. That issue will be decided by the examiner during the merged proceeding based on the

Third party comments on any patentability or procedural issue that is solely authorized for reissue application practice and procedure (as opposed to such for reexamination), will result in a holding that the paper containing such comments is an improper paper that will not be entered into the record. [16] Any such improper paper will be returned to the requester as an improper submission under 37 CFR 1.939, or expunged (sealed), if the paper is entered prior to discovery of the defect.

b. In the same manner that patent owner/applicant in the merged proceeding must serve the third party requester with correspondence filed in the Office, the third party requester must serve the patent owner/applicant with correspondence that requester files in the Office.

c. Prior to the issuance of any Notice of Allowability (Form PTOL-37), the procedure for issuing Office actions, the forms used for such Office actions, the procedure governing any response by the patent owner/applicant, and the procedure governing any requester comments, 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 37 CFR 41.81 will govern appeals by 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. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to so advise the parties, and to inform patent owner of the steps that must be taken (*e.g.*, payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out above, the present *inter partes* reexamination proceeding would be concluded by the grant of such a reissue patent, and the reissue patent would serve as the reexamination certificate under 37 CFR 1.997.

d. 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, but requester may not appeal on the issue of whether a claim has been impermissibly broadened in the merged proceeding, or on any other non-reexamination issue.

e. Requester's comments in all appeal papers must be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no appeal can be advanced by third party requester with respect to issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed

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record as it exists at the time of this decision, and no further third party requester comments on the issue will be permitted.

[16] Thus, for example, where a question 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 question. Similarly, 35 U.S.C. § 251 permits broadening of the scope of coverage afforded by the patent claims subject to the requirement of timely notice that such broadening is sought via reissue. Therefore, comments by the third party requester that a given newly presented claim or amended patent claim has been impermissibly broadened, or that a claim interpretation resulting from an amendment to the specification would impermissibly broaden the scope of coverage of the '473 patent claims, would be impermissible in the merged proceeding. Impermissible third party requester comments will result in return of the third party paper, or in expungement (sealing) Image File of the paper in the Image File Wrapper (IFW) so that the improper paper would not be part of the IFW record.

above).

f. In view of the provisions 37 CFR 1.953(c), any filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to an Action Closing Prosecution under 37 CFR 1.949.

VI. 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...."

Above it is directed that:

> "Prior to the issuance of any Notice of Allowability (Form PTOL-37), the procedure for issuing Office actions, the forms used for such Office actions, the procedure governing any response by the patent owner/applicant, and the procedure governing any requester comments, 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.

CONCLUSION

1. The September 11, 2007 patent owner petition and the October 30, 2007 third party requester petition have each been considered, but are each dismissed.

2. The '350 reissue application and the '269 *inter partes* reexamination proceeding **are merged**, *sua sponte*, into a single consolidated proceeding, that will be conducted in accordance with the guidelines set forth in this decision.

3. Patent owner is required to file an appropriate housekeeping amendment within **ONE (1) MONTH** of this decision placing the same amendments reissue Application No. 11/636,350, and *inter partes* reexamination Control No. 95/000,269.

4. Once the housekeeping amendment is received, or the time for filing such housekeeping amendment has expired, jurisdiction of the merged reissue and *inter partes* reexamination

proceeding will be forwarded via the Technology Center 2600 Technology Center Director to an examiner for the preparation of an Office action in the merged proceeding. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '473 patent (*e.g.*, by preparing/signing an action). See MPEP § 2636. All further examination should be conducted in accordance with Sections V(B) and V(C) of this decision.

5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** that places the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

6. A copy of this decision will be placed in the IFW of the '350 reissue application and in the IFW file of the '269 *inter partes* reexamination proceeding.

7. Jurisdiction of the '350 reissue application file and the '269 *inter partes* reexamination file will reside with the Central Reexamination Unit (CRU) to await the filing of a housekeeping amendment in accordance with Section V(B) of this Decision.

8. Telephone inquiries related to this decision and questions regarding procedural matters 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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November 20, 2007

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CENTRAL REEXAMINATION UNIT

In re UTStarcom, Inc.
Reissue Application
Application No. 11/636,350
Filed: December 7, 2006
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

In re UTStarcom, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,269
Filed: June 26, 2007
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

DECISION DISMISSING PETITIONS, AND *SUA SPONTE* MERGING REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDINGS

This is a decision on patent owner's "PETITION OPPOSING MERGER OF CONCURRENT PROCEEDINGS AND FOR SUSPENSION OF *INTER PARTES* REEXAMINATION UNDER 37 C.F.R. § 1.182 OR IF DENIED, FOR SUSPENSION OF THE RULES UNDER 37 C.F.R. § 1.183" that was filed on September 11, 2007.

This is also a decision on the third party requester's "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) FOR SUSPENSION OF THE REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,829,473, AND UNDER 37 CFR § 1.183 FOR SUSPENSION OF 37 C.F.R. 1.939(b)" filed on October 30, 2007, and on patent owner's November 1, 2007 opposition to the October 30, 2007 third party requester's petition.

The respective party papers and reissue application number 11/636,350 and *inter partes* reexamination control number 95/000,269 are before the Office of Patent Legal Administration for consideration and such action as may be appropriate.

Summary:
The respective patent owner and third party requester petitions are dismissed with respect to granting the substantive relief requested therein.

Reissue application number 11/636,350 and *inter partes* reexamination control number 95/000,269 are merged, *sua sponte* into a single proceeding in accordance with the conditions and procedures discussed below.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 22-0261 for both the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition, and for the $400.00 fee for filing the filing of the paper under 37 CFR 1.182 opposing the third party requester petition. A total of $800.00 will be charged to Deposit Account No. 22-0261.

Third party requester has remitted the $400.00 petition fee under 37 CFR 1.182 for filing its petition. The payment was received by credit card.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,829,473 B2 (the '473 patent) issued to Sundar Raman *et al*, on December 7, 2004, and is assigned to UTStarcom, Incorporated (patent owner).

2. On December 7, 2006, the patent owner filed a reissue application based on the '473 patent, which was assigned application number 11/636,350 (the '350 reissue application). The application as filed did not contain an oath or declaration, and did not contain a statement under 37 CFR 3.73(b) in support of the consent by patent owner to the filing of the reissue application.

3. Concurrently with the filing of the '350 reissue application, patent owner filed a preliminary amendment that amended two or the four independent claims and various dependent claims of the '350 reissue application.

4. On May 30, 2007, a statement under 37 CFR 3.73(b) and a declaration under 37 CFR 1.63 (that was not a reissue declaration 37 CFR 1.175) was filed by patent owner in the '350 reissue application.

5. A request for ***inter partes*** reexamination of the '473 patent was filed by a third party requester on June 26, 2007, and the resulting reexamination proceeding was assigned Control Number 95/000,269 (the '269 reexamination proceeding). Starent Networks Corporation is identified as the real party in interest for the requester.

6. On July 17, 2007, a reissue declaration under 37 CFR 1.175 was filed by patent owner in the '350 reissue application.

7. A first Office action on the merits of patentability has been not been issued by the Office in the '350 reissue application.

8. On August 16, 2007, an order granting *inter partes* reexamination of claims 1-64, (*i.e.*, all of the claims) of the '473 patent was mailed for the '269 *inter partes* proceeding. The order was

not accompanied by an Office action on the patentability of the claims, and no action on the patentability of claims 1-64 has been taken.

9. The '473 patent is the subject of litigation. [1] The litigation is stayed due to the copending reissue application. [2]

10. On September 11, 2007, patent owner filed a petition opposing merger of the '269 *inter partes* reexamination proceeding and the '350 reissue application, and requesting suspension of the '269 *inter partes* reexamination proceeding. [3]

11. On October 30, 2007, third party requester filed a petition to suspend the '350 reissue application during the pendency of the '269 *inter partes* reexamination proceeding.

12. On November 5, 2007, patent owner filed a paper opposing the October 30, 2007 third party requester petition.

DECISION

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> 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) provides:

> 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

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[1] *UTStarcom v. Starent Networks Corp.* No. 05-00710 JSW (N.D. Cal.), February 16, 2005 See: Request for *Inter Partes* Reexamination, 95/000,269, June 21, 2007, page 8; See also: Notice of Concurrent Proceedings filed in reissue application 11/636,350 on December 7, 2006.

[2] *Id.*

[3] It appears that the record copy of this paper lacks page 22 of the petition; however, page 22 of the petition is in the record as part of Exhibit B of the third party requester's October 30, 2007 petition.

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.

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.

35 U.S.C. § 314 provides:

(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.

(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.

35 U.S.C. § 315(a)and (b) provide:

(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 1.906 provides:

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.
(b) Claims in an inter partes reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.
(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

37 CFR 1.937 provides, in part:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the 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 1.939 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.
(b)Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

37 CFR 1.955 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 § 2686.03 provides, in 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 underlying added.]
>
> Where a reissue patent will not be granted prior to the expiration of the 3-month period for making the determination on the reexamination request, a decision will be made after an order to reexamine is issued 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. In this situation, no first Office action will have accompanied the order for reexamination.
>
> 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. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed.

II. BACKGROUND

The '350 reissue application and the '269 *inter partes* reexamination proceeding are currently pending. Each of the two proceedings is at an early stage of prosecution, *i.e.*, neither individual proceeding has received a first Office action on patentability. Since reexamination has been ordered pursuant to § 1.931 in the '269 *inter partes* reexamination proceeding, a decision under § 1.991 is timely as to whether the '350 reissue application and the '269 *inter partes*

reexamination proceeding should be merged. In connection with this decision, patent owner filed a petition on September 11, 2007, proactively opposing merger of the '350 reissue application and the '269 *inter partes* reexamination proceeding, and requesting suspension of the '269 *inter partes* reexamination proceeding. Third party requester has filed, on October 30, 2007, a petition requesting suspension of the '350 reissue application. Patent owner filed a paper on November 5, 2007, opposing the third party requester's petition.

III. DISCUSSION REGARDING PATENT OWNER'S PETITION [4]

It is to be noted that no action on the merits of patentability has been promulgated in the '269 *inter partes* reexamination proceeding. Thus, the patent owner petition paper and opposition paper are improper papers under 37 CFR 1.939(b), because they were both filed prior to the first Office action on the merits. Those papers would also not be entitled to entry under 37 CFR 1.939(a), and would be returned on the grounds that the rules do not provide for filing those papers. However, patent owner has requested consideration of its petition and opposition papers pursuant to both 37 CFR 1.182 (relief for which the rules otherwise do not provide) and 37 CFR 1.183 (suspension of the rules). Patent owner's petition is granted to the extent that the provisions of 37 CFR 1.939 are waived to permit consideration of the paper, and such consideration will be undertaken under 37 CFR 1.182 given that the rules do not provide for the requested relief.

In the petition paper, patent owner opines that if the '269 *inter partes* reexamination proceeding is merged with the '350 reissue application, then patent owner will be deprived of its statutory right to correct the specification and drawings of the '473 patent through reissue. This argument is not persuasive, because patent owner has not established any basis for concluding that the drawings and the specification of a patent in a merged reissue/*inter partes* reexamination proceeding may not be corrected in like manner to correction of such matters in a separate reissue application.

Further, 37 CFR 1.991 clearly provides for the possibility of merging copending reissue and *inter partes* reexamination proceedings. Moreover, as noted in MPEP § 2686.03, the general policy of the Office is 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. [5] 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. It should be noted that

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[4] Each and every argument made in patent owner's petition has been carefully considered. This decision will summarize patent owner's position. The failure to specifically state each point raised by patent owner should not be taken to mean that such point was not considered or was overlooked.

[5] In this instance, it is further noted that, 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 the *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 the level field intent of the *inter partes* reexamination statute.

MPEP § 2686.03(B) (which addresses copending reexamination proceedings that have not received actions on the merits) states that merger is possible even where one of the proceedings raises matters that would not be proper for consideration in the other proceeding. That is, merger can, and generally should be accomplished, where doing so will protect the rights of both patent owner and the third party requester, and the merged proceeding can be structured to preclude issues that are improper in the controlling reissue proceeding from being raised in the merged proceeding where a party would be precluded from raising such issues. It should also be noted that the Office has recently merged a broadening reissue application with an *inter partes* reexamination proceeding, where the proceedings were at appropriate early stages of prosecution. [6] The merger was accomplished so as to preclude, for example, the *inter partes* reexamination requester from commenting in the merged proceeding regarding the merits of the broadened claims presented in the merged proceeding that was conducted based upon a modified reissue practice, so that the patent owner could pursue broadened reissue claims as it had a right to do under 35 U.S.C. § 251. However, in an *inter partes* reexamination proceeding, a third party requester has the right to comment on proposed amendments to the specification and drawings of a patent, which do not result in a broadening of the scope of the entirety of the patent claims.

Patent owner also opines that it will be deprived of its statutory rights to broaden patent claims in a reissue application. First, it is not at all clear that as filed, the '350 reissue application is a broadening reissue application, because it does not facially appear that patent owner expressed any intent to broaden the protection afforded by the '473 patent claims within two years of the issue date of the '473 patent. [7] However, it is unnecessary, and inappropriate, to decide that issue in the present decision. Attention is again invited to the discussion in footnote 6 for an example of merger of a broadening reissue application with an *inter partes* reexamination

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[6] See: Merged 11/703,606 reissue application - 95/000,270 *Inter Partes* Reexamination proceeding, "Decision, *Sua Sponte*, Merging Reissue and *Inter Partes* Reexamination Proceedings, and Waiving Rules," October 24, 2007. Compare: *In re Allan*, 71 USPQ2d 1751 (2004), a reported, but unpublished, decision that is designated as nonprecedential. In the *Allan* 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 10/430,71 as paper PETDEC dated December 22, 2003). Note should be taken of the manner in which *Allan* was distinguished by the Decision in the merged '606 reissue/'270 *inter partes* reexamination proceeding by fashioning appropriate protection for the reissue rights of the patent owner and the third party requester of the *inter partes* reexamination proceeding.

[7] The '473 patent issued on December 7, 2004. The '350 reissue application was filed on December 7, 2006. As filed, no paper in the '350 reissue application expressed an intent to broaden. Claims 1, 12, 37 and 61 of the '473 patent are the only independent claims, and all are open-ended comprising type claims. Only claim 12 and claim 61 were amended, and the single amendment changing the word "the" to "a" can be read as being directed to providing antecedent basis in the claims. (See: page 2, item 4 of the patent owner petition wherein it is stated that "[M]any of the amendments were to repair syntactical errors-such as lack of antecedent basis.") As to any amendment made to the dependent claims: Unless a dependent claim has been improperly amended to be broader than its parent claim, (see the discussion at MPEP § 608.01(n)(III)), a dependent claim must narrow the independent claim upon which it depends. The amendments to the dependent claims may broaden a dependent claim with respect to the scope of THAT original independent claim; however, such amendments must not broaden to increase the coverage afforded beyond that of the open-ended independent parent claims. The first, (and currently only) reissue declaration filed in the '350 reissue application was filed on July 17, 2007, and does not state that the '473 patent is wholly or partly inoperative by claiming less than it had a right to claim. In general, see MPEP 1412.03(IV) and *In re Graff*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) and *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) on the issue of broadening in a reissue application within two years of the issue date of the original patent.

proceeding, in which the merger was accomplished so as to protect the patent owner's statutory right to broaden patent claims through 35 U.S.C. § 251 reissue of the patent, such that the reexamination requester must not comment on the broadened materials.

Patent owner next relies upon the decision in *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985) as mandating suspension of the present '269 *inter partes* reexamination proceeding. It is noted, however, that *Onda* is clearly inapposite the facts with respect to merger of the present '350 reissue application and '269 *inter partes* reexamination proceedings. In *Onda*, the reissue application was filed after a decision by the (then) Board of Appeals had been rendered affirming the examiner's determination in an *ex parte* reexamination proceeding that the patent claims were not patentable. The Office declined to merge the two proceedings because of the advanced stage of the *ex parte* reexamination proceeding as compared to the recently filed reissue application, and instead suspended the reexamination proceeding so that the patent claims would not be cancelled by publication of the reexamination certificate, and patent owner could thus seek to obtain narrower, patentable claims in the reissue application. Unlike the facts in *Onda*, the '350 reissue application and the '269 *inter partes* reexamination proceeding are both in a very early stage of prosecution; no first action on the merits has issued in either proceeding. Merger now will afford patent owner the right to appeal any rejection made in the merged proceeding, and to present in the merged proceeding narrower claims as a hedge against an adverse result with respect to any claims that may be rejected and appealed.

Finally, patent owner argues that the proceedings will be expedited by suspension of the *inter partes* reexamination proceeding, and that third party requester will not be prejudiced by non-merger. However, the reexamination requester will be prejudiced. It is important to note that the public, as well as the third party requester and the court in which there is currently stayed litigation, are entitled to disposition of the '269 *inter partes* reexamination proceeding with the special dispatch required by statute. By merging the '350 reissue application and '269 *inter partes* reexamination proceeding, all issues that can be raised in the '269 *inter partes* reexamination proceeding can be addressed, and the Office will not have to conduct two separate proceedings on two potentially differing records. On the other hand, merger of the '350 reissue application and the '269 *inter partes* reexamination proceeding will not unduly slow the reissue proceeding down, although (as discussed below) the *inter partes* reexamination rights of third party requester to participate will be preserved. Attention is invited to the portion of this decision that explains the manner in which the merged proceeding will be conducted.

For all of the above reasons, patent owner has not established a convincing basis for either maintaining the '350 reissue application and the '269 *inter partes* reexamination proceeding as separate, concurrently conducted proceedings, or for suspending the latter while conducting prosecution on the former. Accordingly, the patent owner's petition for such relief is dismissed.

IV. DISCUSSION OF THIRD PARTY REQUESTER'S PETITION AND PATENT OWNER'S OPPOSITION THERETO [8]

In its October 31, 2007 petition, third party requester requests that the '350 reissue application be suspended during the pendency of the '269 *inter partes* reexamination proceeding. Patent owner's November 5, 2007 opposition paper requests that the third party requester petition be struck or denied.

As discussed with respect to the September 11, 2007 patent owner petition, no action on the merits of patentability has been promulgated in the '269 *inter partes* reexamination proceeding. Thus, to the extent that the third party requester's petition is directed to the '269 *inter partes* reexamination proceeding, it is an improper paper under 37 CFR 1.939(b) because it was filed prior to the first Office action on the merits. The third party petition paper would also not be entitled to entry under 37 CFR 1.939(a), and would be returned on the grounds that the rules do not provide for filing those papers. However, third party requester has requested consideration of its petition paper pursuant to both 37 CFR 1.182 (relief for which the rules otherwise do not provided) and 37 CFR 1.183 (suspension of the rules). The third party petition is granted to the extent that the provisions of 37 CFR 1.939 are waived to permit consideration of the paper, and such consideration will be undertaken under 37 CFR 1.182 given that the rules do not provide for the requested relief.

A review of the third party requester's petition shows that third party requester takes the position that patent owner cannot pursue a broadening reissue application, because patent owner is barred by the limitation in 35 U.S.C. § 251 that precludes the filing of a broadening reissue application more than two years after the issue date of the original patent (for which reissue is sought). However, as noted in Section III, *supra*, this decision does not reach that issue. Any broadening issue that might be present would be an issue that can be addressed by the examiner during the examination of the reissue application (whether or not it is merged), and may be appealed should the examiner's decision be adverse to patent owner. Requester, on the other hand, has no statutory right to comment on any broadening issue with respect to the reissue application. It is to be noted that this matter should not have an effect on the merger. Even if claim revision is ultimately carried out to address a broadening issue, the reissue can continue as long as an appropriate 35 U.S.C. § 251 "error" in the patent remains of record. If that ceases to be the case, the merger can be dissolved.

Third party requester also argues that patent owner's reissue application is an "attempt to 'moot'" statutory rights and is contrary to the reexamination statute. It is, however, difficult to see how the filing of a reissue application more than six months prior to the filing of an *inter partes* reexamination request filed for the same patent is an "attempt" to do anything with respect to the subsequently filed (i.e., then non-existent) request for *inter partes* reexamination.

It is noted that third party requester does not oppose patent owner's attempt to reissue the '473 patent, because third party requester opines that the reissue application is not for broadening

[8] Each and every argument made in third party requester's petition and patent owner's opposition thereto has been carefully considered. This decision will summarize those positions. The failure to specifically state each point raised by the parties should not be taken to mean that such point was not considered or was overlooked.

purposes. Yet third party requester cites an Office decision [9] for the proposition that the '350 reissue application should be stayed during the pendency of the '269 *inter partes* reexamination proceeding. That cited Office decision is directed to the situation that third party requester states does not presently exist, namely the existence of a copending *inter partes* reexamination proceeding and a broadening reissue application for the same patent. If third party requester is correct that the '350 reissue application is not a broadening reissue application, [10] it is difficult to understand third party requester's objection to merger of the '350 reissue application and the '269 *inter partes* reexamination proceeding, because the conduct of such a merged proceeding will afford third party requester with comment rights essentially equivalent to the comment rights that exist in an unmerged *inter partes* reexamination proceeding. 37 CFR 1.991 expressly provides that "[I]n 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."

It is also to be noted that, as pointed out by both parties, the litigation proceedings involving the '473 patent have been stayed to permit the reissue application proceedings. As noted by patent owner, suspension of the reissue application would unduly delay the litigation proceedings.

Third party requester has not established any basis for suspending the '350 reissue application and conducting the '269 *inter partes* reexamination proceeding, thereby requiring the Office to expend additional resources, and delay the reissue application to the possible prejudice of the patent owner. Accordingly, the requester's petition for such relief is dismissed. Any concerns that third party requester has regarding timely prosecution of the reissue application, and/or preservation of the comment rights of the third party requester, will be addressed by the terms of the Order merging the two proceedings. [11]

V. Decision Merging The '350 Reissue Application And The '269 *Inter Partes* Reexamination Proceeding

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the '350 reissue application and the '269 *inter partes* reexamination proceeding 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 reissue application and the *inter partes* reexamination file 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.

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[9] Exhibit F attached to the October 30, 2007 third party requester decision.

[10] Again, this decision need not, and does not decide the correctness of third party requester's allegation that the '350 reissue application is not properly a broadening reissue application.

[11] See Section V below.

2. Presently, the claims in the '350 reissue application are not the same in as the claims in the '269 *inter partes* reexamination proceeding. Specifically, patent claims 2, 4, 7, 10, 11, 12, 15-17, 19, 20, 22, 25-27, 29, 35, 42-46, 49, 52, 54-56, 59 and 61 have been amended. Further, it appears that patent drawing Figures 5-7 and 11-14 have been amended, and that extensive amendments to the specification have been made in the reissue application. **Therefore, an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases,** specifically, reissue Application No. 11/636,350, and *inter partes* reexamination Control No. 95/000,269.

The response to this 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). The paper should be strictly limited to the bare presentation of the amendments. The patent owner must not address any issues otherwise present in either of the proceedings in the housekeeping amendment. Any discussion of the merits or issues of the proceeding by patent owner would be improper and would result in non-entry of the paper into the record, as it would result in the paper being an improper submission under 37 CFR 1.939. The housekeeping amendment must comply with the provisions of 37 CFR 1.173 (the rule governing amendments filed in reissue applications). [12] See MPEP § 1453 for a complete discussion of amendment practice in reissue applications.

3. In the event that the required housekeeping amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

4. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) will not create a comment right for third party requester. Any comments paper filed by third party requester in response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. The regulatory provisions governing the examination of reissue applications include, *inter alia*, provisions equivalent to the regulations relating to the conduct of *inter partes* reexamination proceedings, including that examination of a reissue application be examined expeditiously. Therefore, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination practice, to the extent it is practical to do so. In

[12] Note that a "clean copy" of the amendment is not required by 37 CFR 1.173, and is not to be provided.

addition, the third party requester in the '269 *inter partes* reexamination proceeding may participate in the merged proceeding to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be strictly limited to issues within the scope of *inter partes* reexamination as directed in paragraph 15 below. The examiner will apply the reissue statute, rules, and case law to the examination of the merged proceeding except as directed in paragraph 15 below.

2. Each Office action issued by the examiner will take the form of a single action which jointly applies to the '350 reissue application and the '269 *inter partes* reexamination proceeding. Time periods for response will be set pursuant to MPEP § 1442.01. [13] Each action will contain identifying data for both of the proceedings, *i.e.*, the reissue application and the *inter partes* reexamination proceeding. 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 response by the reissue applicant/patent owner must consist of a single response, with **a copy being filed for entry in 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 reissue application number and the *inter partes* reexamination proceeding control number).

4. All amendments that are submitted during the prosecution of the merged proceeding must be submitted in accordance with the practice under 37 CFR 1.173 and 37 CFR 1.121(h) governing reissue applications. See MPEP § 1453 for a complete discussion of amendment practice in a reissue application. It is to be noted that, except for subsection (h), 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

5. Any paper (*e.g.*, comments, brief) filed by third party requester must consist of a single response, with **a copy being filed for entry in 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 reissue application number and the *inter partes* reexamination proceeding control number).

6. There will be no interviews in the merged proceeding, as the rules provide that *inter partes* reexamination will be conducted on the written record. [14]

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[13] MPEP § 1442.01 provides, in pertinent part: "Applicants will normally be given 1 month to reply to Office actions in all reissue applications which are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This 1-month period may be extended only upon a showing of clear justification pursuant to 37 CFR 1.136(b). The Office action will inform applicant that the provisions of 37 CFR 1.136(a) are not available. Of course, up to 3 months may be set for reply if the examiner determines such a period is clearly justified." [Emphasis added.]

[14] 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

7. 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).

8. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. Thereafter, with respect to the '269 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b).. Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal rights have been exhausted. See 37 CFR 1.957(c).

9. If the applicant/patent owner files an express abandonment of the '350 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 '269 *inter partes* reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

10. Where the merged proceeding is dissolved based on abandonment of the reissue application and the '269 *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 (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant practice to 37 CFR 1.906(c).

11. If the merged proceeding is dissolved based on abandonment of the '350 reissue application and the '269 *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application of the '350 reissue application will be merged with the '269 *inter partes* reexamination proceeding (thus, the continuation reissue application might be stayed pending conclusion of the '269 *inter partes* reexamination).

12. If applicant/patent owner files a Request for Continued Examination (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 is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it is filed with respect to a reissue application or a non-reissue application.

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permitting interviews, which is the intent of the *inter partes* reexamination statute. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of paramount importance. A petition under 37 CFR 1.183 may be submitted to request an interview in the rare circumstances that an interview is deemed to be indispensable.

13. 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.

14. The examiner in the merged proceeding will consult with OPLA (*i.e.*, the OPLA reexamination legal advisor (RLA) assigned to the '269 *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner, as he/she would consult in an *inter partes* reexamination proceeding that is not merged.

15. Scope Of Third Party Requester's Participation In The Merged Proceeding:

37 CFR 1.991 provides that "[I]n 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. The following provides for preservation of that right:

a. Copies of all Office actions will be provided by the Office to the third party requester. Further, any paper filed by the applicant/patent owner in the merged proceeding must be served on the third party requester. Third party requester will be given an opportunity to comment after all patent owner replies (responses) to Office actions (to the extent pointed out below). As permitted by the reexamination statute and regulations, the third party requester may comment on the patentability of amended patent claims or newly proposed claims based upon patentability issues that are not limited to patentability over prior patents and printed publications (as per 37 CFR 1.906 and MPEP § 2258). However, third party requester participation in the merged proceeding must be strictly limited to issues within the scope of *inter partes* reexamination. No third party comments can be advanced on issues appropriate for reissue, but not appropriate for reexamination. For example requester must not provide:

(1) Comments regarding the acceptability of any reissue declaration;
(2) Comments regarding assignee assent;
(3) Comments regarding the recapture doctrine;
(4) Comments on patentability issues not based on patents or printed publications, unless permitted by 37 CFR 1.906 and MPEP § 2658 for new or amendatory text or drawing revision; and
(5) Comments that any existing or amended claim of the '473 patent, or any claim proposed in the merged proceeding, is unpatentable under 35 U.S.C. § 314(a) as impermissibly broadening the scope of coverage of the patent claims, whether by reason of claim interpretation resulting from amendments to the specification or otherwise. [15]

[15] It is again to be noted that third party requester and patent owner have taken conflicting positions regarding whether the '350 reissue application is a broadening reissue application. See, for example pages 2 and 3 of the September 11, 2007 patent owner petition and pages 3-4 of the November 5, 2007 patent owner opposition paper, and compare with pages 2-4 of the October 30, 207 third party requester petition. The question of whether the '350 reissue application is a broadening reissue application (see MPEP § 11412.03) that was timely filed will not be decided in this petition. That issue will be decided by the examiner during the merged proceeding based on the

Third party comments on any patentability or procedural issue that is solely authorized for reissue application practice and procedure (as opposed to such for reexamination), will result in a holding that the paper containing such comments is an improper paper that will not be entered into the record. [16] Any such improper paper will be returned to the requester as an improper submission under 37 CFR 1.939, or expunged (sealed), if the paper is entered prior to discovery of the defect.

b. In the same manner that patent owner/applicant in the merged proceeding must serve the third party requester with correspondence filed in the Office, the third party requester must serve the patent owner/applicant with correspondence that requester files in the Office.

c. Prior to the issuance of any Notice of Allowability (Form PTOL-37), the procedure for issuing Office actions, the forms used for such Office actions, the procedure governing any response by the patent owner/applicant, and the procedure governing any requester comments, 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 37 CFR 41.81 will govern appeals by 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. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to so advise the parties, and to inform patent owner of the steps that must be taken (*e.g.*, payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out above, the present *inter partes* reexamination proceeding would be concluded by the grant of such a reissue patent, and the reissue patent would serve as the reexamination certificate under 37 CFR 1.997.

d. 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, but requester may not appeal on the issue of whether a claim has been impermissibly broadened in the merged proceeding, or on any other non-reexamination issue.

e. Requester's comments in all appeal papers must be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no appeal can be advanced by third party requester with respect to issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed

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record as it exists at the time of this decision, and no further third party requester comments on the issue will be permitted.

[16] Thus, for example, where a question 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 question. Similarly, 35 U.S.C. § 251 permits broadening of the scope of coverage afforded by the patent claims subject to the requirement of timely notice that such broadening is sought via reissue. Therefore, comments by the third party requester that a given newly presented claim or amended patent claim has been impermissibly broadened, or that a claim interpretation resulting from an amendment to the specification would impermissibly broaden the scope of coverage of the '473 patent claims, would be impermissible in the merged proceeding. Impermissible third party requester comments will result in return of the third party paper, or in expungement (sealing) Image File of the paper in the Image File Wrapper (IFW) so that the improper paper would not be part of the IFW record.

above).

f. In view of the provisions 37 CFR 1.953(c), any filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to an Action Closing Prosecution under 37 CFR 1.949.

VI. 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...."

Above it is directed that:

> "Prior to the issuance of any Notice of Allowability (Form PTOL-37), the procedure for issuing Office actions, the forms used for such Office actions, the procedure governing any response by the patent owner/applicant, and the procedure governing any requester comments, 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.

CONCLUSION

1. The September 11, 2007 patent owner petition and the October 30, 2007 third party requester petition have each been considered, but are each dismissed.

2. The '350 reissue application and the '269 *inter partes* reexamination proceeding **are merged**, *sua sponte*, into a single consolidated proceeding, that will be conducted in accordance with the guidelines set forth in this decision.

3. Patent owner is required to file an appropriate housekeeping amendment within **ONE (1) MONTH** of this decision placing the same amendments reissue Application No. 11/636,350, and *inter partes* reexamination Control No. 95/000,269.

4. Once the housekeeping amendment is received, or the time for filing such housekeeping amendment has expired, jurisdiction of the merged reissue and *inter partes* reexamination

proceeding will be forwarded via the Technology Center 2600 Technology Center Director to an examiner for the preparation of an Office action in the merged proceeding. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '473 patent (*e.g.*, by preparing/signing an action). See MPEP § 2636. All further examination should be conducted in accordance with Sections V(B) and V(C) of this decision.

5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** that places the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

6. A copy of this decision will be placed in the IFW of the '350 reissue application and in the IFW file of the '269 *inter partes* reexamination proceeding.

7. Jurisdiction of the '350 reissue application file and the '269 *inter partes* reexamination file will reside with the Central Reexamination Unit (CRU) to await the filing of a housekeeping amendment in accordance with Section V(B) of this Decision.

8. Telephone inquiries related to this decision and questions regarding procedural matters 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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November 20, 2007

November 26, 2007
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95/000,269	06/21/2007	6829473	09005.8054-00000	8484

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

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MAILED

MAR 04 2008

CENTRAL REEXAMINATION UNIT

In re UTStarcom, Inc.
Reissue Application
Application No. 11/636,350
Filed: December 7, 2006
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

In re UTStarcom, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,269
Filed: June 21, 2007
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

DECISION DISMISSING PETITION

This is a decision on third party requester's paper filed on January 28, 2008 entitled "Petition Under 37 C.F.R. §§ 1.181, 1.182, & 1.183 for Further Consideration of Decision Dismissing Petitions, and *Sua Sponte* Merging Reissue and *Inter Partes* Reexamination Proceedings." The paper is being taken as a request for reconsideration of the merger decision.

The petition and the merged proceeding (in which the above-captioned reissue application and *inter partes* reexamination proceeding have been merged into a single combined proceeding) are before the Office of Patent Legal Administration for consideration.

Summary: The third party requester's petition is granted to the extent that the November 28, 2007 decision merging the above-captioned dated has been reconsidered as to the three aspects of that decision from which the third party requester (hereinafter "requester") has requested relief, but is dismissed with respect to granting the substantive relief requested. Further, the petition is being sealed, since it lacks an entry right in present merged proceeding.

FEES

Requester has remitted a single $400.00 petition fee under 37 CFR 1.17(f) for filing the present petition under 37 CFR 1.182 and 37 CFR 1.183. However, the petition is being considered under 37 CFR 1.181, and no fee is required. The $400.00 petition fee will be refunded as a credit to Deposit Account No. 06-0916.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,829,473 ("the '473 patent") issued to Sundar Raman *et al*, on December 7, 2004, and is assigned to UTStarcom, Incorporated (patent owner).

2. On December 7, 2006, the patent owner filed an application for reissue of the '473 patent, and the application was assigned application number 11/636,350 ("the '350 reissue application"). The application as filed did not contain an oath or declaration, and it did not contain a statement under 37 CFR 3.73(b) in support of the consent by patent owner to the filing of the reissue application.

3. Concurrently with the filing of the '350 reissue application, patent owner filed a preliminary amendment that amended two or the four independent claims and various dependent claims of the '350 reissue application.

4. On May 30, 2007, a statement under 37 CFR 3.73(b) and a declaration under 37 CFR 1.63 (that was not a reissue declaration 37 CFR 1.175) was filed by patent owner in the '350 reissue application.

5. A request for ***inter partes*** reexamination of the '473 patent was filed by a third party requester on June 21, 2007, and the resulting reexamination proceeding was assigned Control Number 95/000,269 ("the '269 reexamination proceeding"). Starent Networks Corporation is identified as the real party in interest for the requester.

6. On July 17, 2007, a reissue declaration under 37 CFR 1.175 was filed by patent owner in the '350 reissue application.

7. On August 16, 2007, an order granting *inter partes* reexamination of claims 1-64, (*i.e.*, all of the claims) of the '473 patent was mailed for the '269 *inter partes* proceeding. The order was not accompanied by an Office action on the patentability of the claims.

8. The '473 patent is the subject of litigation. [1] The litigation is stayed due to the copending reissue application. [2]

9. On September 11, 2007, patent owner filed a petition opposing merger of the '269 *inter partes* reexamination proceeding and the '350 reissue application, and requesting suspension of the '269 *inter partes* reexamination proceeding. [3]

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[1] *UTStarcom v. Starent Networks Corp.* No. 05-00710 JSW (N.D. Cal.), February 16, 2005. See: Request for *Inter Partes* Reexamination, 95/000,269, June 21, 2007, page 8. See also: Notice of Concurrent Proceedings filed in reissue application 11/636,350 on December 7, 2006.

[2] *Id.*

[3] It appears that the record copy of this paper lacks page 22 of the petition; however, page 22 of the petition is in the record as part of Exhibit B of the third party requester's October 30, 2007 petition.

10. On October 30, 2007, third party requester filed a petition to suspend the '350 reissue application during the pendency of the '269 *inter partes* reexamination proceeding.

11. On November 5, 2007, patent owner filed a paper opposing the October 30, 2007 third party requester petition.

12. On November 28, 2007, a *sua sponte* merger decision was mailed. The decision merged the '350 reissue application and the '269 *inter partes* reexamination proceedings into a single combined proceeding, and it also dismissed the patent owner and requester petitions.

13. At the time of the merger decision, no first action on patentability has been promulgated in either the '269 *inter partes* reexamination proceeding or in the '350 reissue application.

14. On December 27, 2007, patent owner filed a housekeeping amendment in the '269 *inter partes* reexamination Image File Wrapper (IFW) that was intended to place the identical specification, claims and drawings in both the '269 *inter partes* reexamination proceeding and the '350 reissue application. To date, neither that amendment nor the preliminary amendment filed in the '350 reissue application on December 7, 2007 has been reviewed for compliance with the regulations governing the format for amendments.

15. No first action on patentability has been promulgated in the merged proceeding.

DECISION

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> 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) provides:

> 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.

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 1.939 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.
(b)Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

37 CFR 1.947 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 1.991 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 § 2686.03 provides, in 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 underlying added.]

Where a reissue patent will not be granted prior to the expiration of the 3-month period for making the determination on the reexamination request, a decision will be made after an order to reexamine is issued 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. In this situation, no first Office action will have accompanied the order for reexamination.

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. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed.

37 CFR 41.61(a)(2) provides:

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).

II. BACKGROUND

In accordance with 37 CFR 1.991 and the practice set forth in MPEP § 2686.03, the '350 reissue application and the '269 *inter partes* reexamination were merged into a single combined proceeding by a merger decision dated November 28, 2007. MPEP § 2686.03 states that when a pending *inter partes* reexamination proceeding and a pending reissue application are each directed to the same patent, the decision to merge the two proceedings is made on a case-by-case basis. For that reason, the November 28, 2007 merger decision set forth extensive guidelines. In part, the guidelines required that the merged proceeding would be based on maintaining the '350 reissue application and the '269 *inter partes* reexamination proceeding in separate IFWs with identical specifications, claims and drawings. Accordingly, a period of time was set in which patent owner was required to file a housekeeping amendment to place identical specifications, claims and drawings in the IFW of each proceeding. No right of comment on the housekeeping amendment was provided for third party requester.

The November 28, 2007 merger decision also set forth the guidelines that would govern the manner in which the merged proceeding would be conducted. The guidelines provided that because reissue practice is broader than *inter partes* reexamination practice, the merged

proceeding would be conducted, to the extent practical, under the rules relating to examination of reissue applications. However, the merger decision also provided that participation rights essentially equivalent to the rights afforded the third party requester in the '269 *inter partes* reexamination proceeding, including appeal rights, would be provided to the third party requester in the merged proceeding. The third party requester's participation rights in the merged proceeding were limited only to the extent that such rights could not exceed in scope the participation rights of a third party requester in an *inter partes* reexamination proceeding. Stated differently, the third party requester would not be permitted to comment in the merged proceeding on matters that would be proper for consideration during the prosecution of a reissue application, but not proper for reexamination. [4]

III. SUMMARY OF ISSUES RAISED BY THIRD PARTY REQUESTER [5]

The present third party requester petition seeks review of three specific issues regarding the scope of participation in the merged proceeding afforded to requester by the November 27, 2007 merger decision. Specifically, third party requester takes issue with:

a. The provision in the merger decision that precludes third party requester from commenting on the patent owner housekeeping amendment required by the merger decision.

b. The provision in the merger decision that precludes third party requester from commenting on issues that are only "reissue practice" issues, such as impermissibly filing a broadening reissue application more than two years after the issue date of the original patent, or commenting that broadened claims are precluded in the merged proceeding pursuant to 35 U.S.C. § 314(a), whether by reason of claim interpretation resulting from amendments to the specification of otherwise

c. The provision in the merger decision that if third party requester files a paper that includes comments on an issue that the Office deems to be improper, then the paper in its entirety will be excluded from the record.

IV. ANALYSIS AND FINDINGS

a. Inability to Comment on the Patent Owner's Housekeeping Amendment

With respect to the housekeeping amendment, requester opines that it should be authorized to comment on whether such amendment complies with 35 U.S.C. § 112, or seeks to enter new matter in violation of 35 U.S.C. § 132. Third party requester argues in detail, by reference to the reexamination statute and regulations, why third party requester is entitled to so comment.

However, third party requester neglects to consider that the regulations governing the conduct of *inter partes* reexamination, which have been applied to create comment rights for the third party requester in the merged proceeding, do not permit "preemptive strikes" on housekeeping amendments. Although 37 CFR 1.991 states that a patent owner "will be required to place ... the same claims in the reissue application and the *inter partes* reexamination proceeding," *i.e.*, to

[4] Reference may be had to paragraph C. 15 of the November 27, 2007 decision, which bridges pages 15-17 of that decision, and which specifies the participation rights of third party requester and the limitation thereon.

[5] All issues raised by in the third party requester petition have been carefully considered, even if not specifically mentioned in this section of the decision.

file a "housekeeping amendment," the regulations governing *inter partes* reexamination proceedings do not provide for the filing of third party written comments directed to the patent owner's housekeeping amendment. Rather, the regulations governing the filing of requester written comments, 37 CFR 1.947 and 1.951(b) (which are grounded 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. [6] If the patent owner files a response to an Office action, the requester will then have an opportunity to comment on the claims, as amended by the housekeeping amendment, 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 an Office action indicates the patentability of some or all pending claims, the regulations provide third party requester with appeal rights for the third party requester on issues that the examiner decides in favor of the patent owner. [7] Further, it is to be noted that in the present merged proceeding, no first Office action on the merits of the *inter partes* reexamination has been mailed. [8] It is further to be noted that, even in the event that the patent owner does not file a response to the initial Office action on the merits of the proceeding (e.g., if the Office action were to confirm all claims), the third party requester would be able to appeal pursuant to 37 CFR 41.61, and at that point, comment on the claims, as amended by the housekeeping amendment, as to issues within the scope of reexamination. At present, there is nothing in the record that third party requester must comment on that cannot be commented on after the Office has taken a position, and after patent owner responded (if a response to the position taken by the Office deems such to be appropriate), or by way of appeal.

b. Comments by Third Party Requester on Enlargement of the Scope of the Patent Claims in the Merged Proceeding

Third party requester notes that 35 U.S.C. § 314(a) precludes the broadening of the scope of protection afforded by patent claims in an *inter partes* reexamination proceeding. Third party requester further notes that comments by the third party requester to the effect that claims have been impermissibly broadened in contravention to 35 U.S.C. § 314(a) in an *inter partes* reexamination proceeding have been permitted by the Office in at least two other *inter partes* reexamination proceedings, including *inter partes* reexamination proceeding 95/000,270, which has been merged with a reissue application. Third party requester argues that it should be permitted to comment on what it views as impermissible broadening in the present merged proceeding.

In addressing requester's argument, it is initially pointed out that the patent owner's amendment in the reissue application was beyond requester's reach as to comment on each patent owner response and appeal rights prior to merger, and merger does not now place it within reach. The requester did not file the present '269 reexamination proceeding until six and a half months after the '350 reissue application was filed. What requester is postulating is that a requester seeing that a patent owner has filed a broadening reissue can then file an *inter partes*

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[6] See: 37 CFR 1.947 ("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 ...")

[7] In general, see 37 CFR1.943 through 37 CFR 1.953 and the appeal provisions of 37 CFR 41.60 through 41.81, all of which were mentioned in paragraph C.15 of the November 27, 2007 merger decision.

[8] See: 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") and compare 37 CFR 1.935 ("The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.")

reexamination, obtain merger based on the "special dispatch" provision of 35 U.S.C. 314(c), and then be immediately permitted to address even the propriety of patent owner's broadening of the claims via reissue, despite requester being statutorily prohibited from an *inter partes* reexamination comment on such matters each time patent owner responds and prohibited from appeal as to such matters. To begin with, 35 U.S.C. 314(c) does not unequivocally require special dispatch. In order to prevent the requester from improperly commenting and appealing as to the propriety of patent owner's broadening of the claims via reissue, the Office had (and has) the statutory "good cause" to suspend the present later-filed *inter partes* reexamination pending conclusion of the reissue proceeding.[9] In an effort to further "special dispatch," however, the Office has permitted requester's proceeding to go forward, while barring the *inter* partes reexamination comment & appeal as to the propriety of any claim broadening, which requester would not be statutorily permitted to do on the reissue application in absence of the merger, and cannot now be permitted to do as a result of the merger. Accordingly, requester's position is not persuasive.

In clarification of requester's comment right:

1. As set forth in Section C.15 of the November 27, 2007 merger decision, requester is precluded from arguing that the presentation of broadened patent claims in the merged proceeding is impermissible because broadened claims are precluded in *inter partes* reexamination by 35 U.S.C. § 314(a), since such claims are permitted in the reissue application which would proceed, whether or not the reexamination proceeding is suspended.

2. Requester is precluded from arguing a lack of support, enablement, or description as to any broadening effected by patent owner with respect to the claim scope existing prior to reexamination. The same applied as to whether the broadening limitations are clear or indefinite (i.e, whether they particularly point out the invention). As pointed out, this was beyond requester's reach prior to merger, and merger does not change that statutory-based fact.

3. Requester would be permitted to comment as to a change, even in the broadened claims, that narrows the claim scope existing prior to reexamination, which requester believes not to be supported, enabled, or described via the original disclosure.

4. Requester would be permitted to comment as to the prior art applied to the broadened claims, as long as requester does not argue the broadening aspect of the claims to open the claims to the prior art.

These guidelines will permit the two proceedings to be merged, without contravening the reexamination and reissue statutes.

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[9] It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the 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 this instance, the claims of the reissue application and the claims of the reexamination proceeding are already not identical. It is further to be noted that, if the examination of the reissue and reexamination proceedings were conducted separately in this instance, 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 for requester participation.

As a final point on this matter, the above guidelines do not, in any way, preclude the requester from protesting under 37 CFR 1.291, pursuant to the guidelines set forth in MPEP 1900, with respect to the reissue-application merged in the present merged proceeding. The third party requester has not lost any rights which it would have, had the '350 reissue application and the '269 *inter partes* reexamination proceedings not been merged into a single combined proceeding. Rather, requester's rights have been retained as to both individual proceedings, while permitting concurrent examination and not contravening the reexamination and reissue statutes.

c. Third Party Comments On An Issue Deemed To Be Improper By The Office

Third party requester argues that it is severely prejudiced by the statement in the merger decision that if third party requester files a paper that includes comments on an issue that the Office deems to be improper, that the paper in its entirety will be excluded from the record. The argument is based upon the observation that the third party requester has no may of knowing whether it is commenting on prohibited subject matter when it submits a paper. Third party requester requests that the Office identify comments or other material in a third party paper, explain the basis for its position, and allow the third party requester to file a redacted paper.

First, it is noted that there is a large amount of published information, such as the Manual of Patent Examining Procedure, the reexamination statute, and the reexamination regulations, that is available to third party requester. This material provides guidance on the subject matter that is, and is not, deemed to be appropriate for consideration in an *inter partes* reexamination proceeding. In addition, the Office of Patent Legal Administration (OPLA) routinely answers telephone inquiries regarding reexamination practice and procedure, and it is appropriate for a party to an *inter partes* reexamination (or a merged reissue/*inter partes* reexamination proceeding), to contact for guidance on purely procedural matters.

It is further to be noted that the Office routinely returns or seals papers that have been filed in a reexamination proceeding that are deemed to contain material that is deemed to be improper for entry into an *inter partes* reexamination. See, for example, MPEP § 2667, subsection (B), regarding the return of "improper" paper to a third party requester. There is no other way to return or seal [10] a paper other than by returning or sealing the paper in its entirety. Also, absent an inquiry limited to the procedural issue of whether certain subject matter could properly be included in a paper to be filed, the Office is not in a position to foresee, in advance of the paper being filed, whether the paper will contain subject matter that would be "improper" for entry in a reexamination proceeding, and thus cannot provide an exhaustive listing of subject matter that would be deemed to be "improper" in advance of reviewing a paper filed by a party.

Further, it is generally the practice of the Office after a party files a paper to review the paper. If the paper contains "improper" material, the Office will then inform the party that the paper will not be entered into the record because it contains "improper" material, to identify the specific material deemed to be "improper," and to provide the party with an opportunity to submit a redacted paper. An example of such practice is provided in section V. "Return of Petition

[10] Papers that are entered into an Image File Wrapper (IFW) prior to discovery of their impropriety cannot physically be removed from the IFW. Therefore, such papers are effectively "returned" by being sealed. Papers are sealed by marking the papers "closed" and "non-public." Papers so marked in the IFW cannot be viewed in the PAIR system.

Paper, "*infra*. Even in the scenario after an Action Closing Prosecution described by MPEP 2672, part IV, relief is available via waiver of the rules under 37 CFR 1.183.

V. Return of Improper Petition Paper

The present petition paper contains material that is deemed to be improper for entry into a reissue proceeding (in which the requester has no comment right), improper for entry into a reexamination proceeding (in which the requester has no comment right at present), and certainly improper for entry into the present merged reissue/reexamination proceeding. That material is discussed on beginning at the bottom of page 4, and on pages 5-7. Specifically, the discussion relates to third party requester's belief that the housekeeping amendment filed by patent owner contains "new matter," and that patent owner did not timely broaden the reissue application.

It was specifically pointed out in the November 27, 2007 merger decision that the third party requester was not to address the issue of whether the '350 reissue application was a broadening reissue that was timely filed. Third party requester has, nevertheless, discussed this issue in the present petition.

At present, the January 28, 2008 third party requester petition is deemed to lack an entry right in the present merged proceeding and will be "returned" to third party requester by being "sealed." The petition will, therefore, form no part of the record of the merged proceeding. Third party requester may submit a redacted version of the present petition within **15 DAYS** of the date of the present decision in order to make its technical objections (not directed to the merits of the claims) part of the record. The redacted version of the petition may not include substantive comments on the reissue application, or the December 27, 2007 housekeeping amendment. In accordance with 37 CFR 1.903, the redacted version of the present petition must be served on patent owner by the requester.

For the foregoing reasons, it is not found that the November 27, 2007 merger decision requires modification, other than the clarification stated at Section IV.b., *supra.*; it is not found that the merger decision in any way prejudices the third party requester's rights. Therefore, there is no basis to grant the relief requested by requester. With respect to "broadening" in the merged proceeding, third party requester would have had the right to comment on broadening during the *inter partes* reexamination proceeding; indeed, patent owner need only have invoked 35 U.S.C. § 314(a) and explained how it applied to the alleged new matter. However, that right is in conflict with patent owner's right to properly broaden the '473 patent in a reissue application, which is joined with the present *inter partes* reexamination proceeding, rather than suspending the present later-filed *inter partes* reexamination proceeding. Third party requester will even have the right to comment on patent owner's housekeeping amendment, but such must be done in accordance with, and at the times mandated by, the *inter partes* reexamination regulations. Further, the requester (as well as the patent owner) must certainly avoid filing papers that contain material that is inappropriate for consideration in an *inter partes* reexamination proceeding, or that is not otherwise filed in the manner provided for by the *inter partes* regulations. Third party requester (and patent owner) have the ability to seek guidance with respect to whether a proposed filing contains inappropriate material, and will generally be given an opportunity to submit a redacted paper if an "improper" paper is returned or sealed in accordance with established Office practice.

CONCLUSION

1. In the interest of conducting the merged reissue/*inter partes* reexamination proceeding with special dispatch, the January 28, 2008 third party requester petition has been considered as to its objections to the November 27, 2007 merger decision, but is dismissed. A clarification of the merger guidelines is provided at Section IV.b., above.

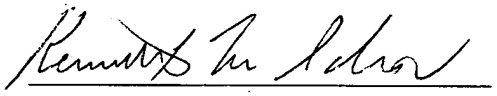
2. The January 28, 2008 third party requester petition is being "sealed," because it is a paper that lacks an entry right in the merged reissue/*inter partes* reexamination proceeding.

3. The present decision will be entered into the record of the merged reissue/*inter partes* reexamination proceeding.

4. A period of **15 DAYS** is set in which the third party requester may file a redacted version of the present petition in order to make its objections to the November 27, 2007 merger decision part of the record.

5. Jurisdiction of the merged reissue/*inter partes* reexamination proceeding is being returned to Technology Center 2600 for examination of the merged proceeding.

6. Telephone inquiries related to this decision and questions regarding procedural matters 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 4, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,269	06/21/2007	6829473	80615.249347	8484

71398 7590 12/29/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

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MAILED

DEC 29 2009

CENTRAL REEXAMINATION UNIT

In re UTStarcom, Inc.
Reissue Application
Application No. 11/636,350
Filed: December 7, 2006
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

In re UTStarcom, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,269
Filed: June 21, 2007
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

DECISION GRANTING REQUEST FOR NEW OFFICE ACTION

Jurisdiction over the present merged reissue/inter partes reexamination was forwarded to the Office of Patent Legal Administration by Technology Center 2600 Quality Assurance Specialist Michael Horabik, for consideration of all pending papers.

This is a decision vacating the Office action mailed December 22, 2008. The merged proceeding will be remanded to the Examiner for issuance of a new Office action.

This decision addresses the disposition of the February 20, 2009 third party comments under 35 USC 314 (b)(2) and 37 CFR 1.947, patent owner's paper filed February 27, 2009 titled "Petition to strike Starent's comments under 37 C.F.R. § 1.182 or, under 37 C.F.R. § 1.183 for Suspension of the Rules" ("the Petition"), and, a paper filed by third party requester on March 18, 2009 entitled "**THIRD** PARTY REQUESTER'S PETITION **UNDER 37 C.F.R.** §§ 1.181-183 TO DISMISS PATENT OWNER'S PETITION TO STRIKE REQUESTER'S COMMENTS" (the "Opposition").

Patent owner's submission of January 21, 2009, is not considered because the Office action that it responded to has been vacated. Also, for the reasons set forth below, the patent owner petition to strike third party's February 20, 2009 comments is granted.

The third party comments paper submitted February 20, 2009, in response to the Non-final Office action mailed December 22, 2008 and in response to patent owner's Amendment/Request for reconsideration filed January 21, 2009, is not in compliance with the limitations specified in the decision merging the reissue and reexamination proceedings dated November 28, 2007 at pages 15-17 and is therefore being expunged by closing the comments paper in the IFW record and marking it as "non-public" so that it is unavailable to the examiner and the public.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,829,473 ("the '473 patent") issued to Sundar Raman *et al*, on December 7, 2004, and is assigned to UTStarcom, Incorporated (patent owner).

2. On December 7, 2006, the patent owner filed an application for reissue of the '473 patent, and the application was assigned application number 11/636,350 ("the '350 reissue application"). The application as filed did not contain an oath or declaration, and it did not contain a statement under 37 CFR 3.73(b) in support of the consent by patent owner to the filing of the reissue application.

3. Concurrently with the filing of the '350 reissue application, patent owner filed a preliminary amendment that amended two or the four independent claims and various dependent claims of the '350 reissue application.

4. On May 30, 2007, a statement under 37 CFR 3.73(b) and a declaration under 37 CFR 1.63 (that was not a reissue declaration 37 CFR 1.175) was filed by patent owner in the '350 reissue application.

5. A request for ***inter partes*** reexamination of the '473 patent was filed by a third party requester on June 21, 2007, and the resulting reexamination proceeding was assigned Control Number 95/000,269 ("the '269 reexamination proceeding"). Starent Networks Corporation is identified as the real party in interest for the requester.

6. On July 17, 2007, a reissue declaration under 37 CFR 1.175 was filed by patent owner in the '350 reissue application.

7. On August 16, 2007, an order granting *inter partes* reexamination of claims 1-64, (*i.e.*, all of the claims) of the '473 patent was mailed for the '269 *inter partes* proceeding. The order was not accompanied by an Office action on the patentability of the claims.

8. The '473 patent is the subject of litigation. [1] The litigation is stayed due to the copending reissue application. [2]

9. On September 11, 2007, patent owner filed a petition opposing merger of the '269 *inter partes* reexamination proceeding and the '350 reissue application, and requesting

---

[1] *UTStarcom v. Starent Networks Corp.* No. 05-00710 JSW (N.D. Cal.), February 16, 2005. See: Request for *Inter Partes* Reexamination, 95/000,269, June 21, 2007, page 8. See also: Notice of Concurrent Proceedings filed in reissue application 11/636,350 on December 7, 2006.

[2] *Id.*

suspension of the '269 *inter partes* reexamination proceeding. [3]

10. On October 30, 2007, third party requester filed a petition to suspend the '350 reissue application during the pendency of the '269 *inter partes* reexamination proceeding.

11. On November 5, 2007, patent owner filed a paper opposing the October 30, 2007 third party requester petition.

12. On November 28, 2007, a *sua sponte* merger decision was mailed. The decision merged the '350 reissue application and the '269 *inter partes* reexamination proceedings into a single combined proceeding, and it also dismissed the patent owner and requester petitions.

13. At the time of the merger decision, no first action on patentability had been promulgated in either the '269 *inter partes* reexamination proceeding or in the '350 reissue application.

14. On December 27, 2007, patent owner filed a housekeeping amendment in the '269 *inter partes* reexamination Image File Wrapper (IFW) that was intended to place the identical specification, claims and drawings in both the '269 *inter partes* reexamination proceeding and the '350 reissue application.

15. On December 22, 2008 a non-final rejection was mailed in the merged proceeding which objected to claims 30 and 31 because of informalities; rejected claims 1-31, 37-56, 58, and 61-64 under 35 USC 102(e) as being anticipated by Barna et al (6,999,449); objected to claims 32-36, 57, 59, and 60 as being dependent upon a rejected base claim but claims 32-36 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; and confirmed claims 57, 59, and 60 as being dependent on an unamended patent claim.

16. On January 21, 2009 patent owner filed a response to non-final rejection amending each of the claims. Claims 1, 2, 4, 5, 7, 10-12, 15-17, 19, 20, 22, 25-28, 30, 31, 35, 37, 42-46, 49, 52, 54-56, 59, and 61 were amended. The text of claims 3, 6, 8, 9, 13, 14, 18, 21, 23, 24, 29, 32-34, 36, 38-41, 47, 48, 50, 51, 53, 57, 58, 60, and 62-64 were unamended, though they are dependent on amended claims, and are thus also amended by virtue of that dependency.

17. On February 20, 2009, third party filed comments under 35 U.S.C. 314(b)(2) and 37 CFR 1.947.

18. On February 27, 2009 patent owner filed a petition under 37 CFR 1.182 or 1.183 to strike third party's comments or suspend the rules ("the petition").

19. On March 18, 2009, third party filed a petition under 37 CFR 1.181-1.183 to dismiss the patent owner's petition to strike requester's comments ("the opposition").

[3] It appears that the record copy of this paper lacks page 22 of the petition; however, page 22 of the petition is in the record as part of Exhibit B of the third party requester's October 30, 2007 petition.

DECISION

I. RELEVANT AUTHORITY

35 U.S.C. § 314(b) provides:

> (b) RESPONSE.
>
> (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 1.947 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.

Parts V(C) 1 and 2 of the merger decision (mailed November 28, 2007) state in part:

> V(C)(1) .., the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination practice, to the extent it is practical to do so. In addition, the third party requester in the '269 *inter partes* reexamination proceeding may participate in the merged proceeding to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be strictly limited to issues within the scope of *inter partes* reexamination as directed in paragraph 15 below. The examiner will apply the reissue statute, rules, and case law to the examination of the merged proceeding except as directed in paragraph 15 below.
>
> V(C)(2) Each Office action issued by the examiner will take the form of a single action which jointly applies to the '350 reissue application and the '269 *inter partes* reexamination proceeding.

Parts V(C) 15 and 15(a)(4)-(5) of the merger decision (mailed November 28, 2007) state in part:

> V(C)(15) 37 CFR 1.991 provides that "[I]n 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'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 .

V(C) (15) (a) ...However, third party requester participation in the merged proceeding must be strictly limited to issues within the scope of *inter partes* reexamination. No third party comments can be advanced on issues appropriate for reissue, but not appropriate for reexamination. **For example requester must not provide:**

...

(4) Comments on patentability issues not based on patents or printed publications, unless permitted by 37 CFR 1.906 and MPEP § 2658 for new or amendatory text or drawing revision; and

(5) Comments that any existing or amended claim of the '473 patent, or any claim proposed in the merged proceeding, is unpatentable under 35 U.S.C. § 314(a) as impermissibly broadening the scope of coverage of the patent claims, whether by reason of claim interpretation resulting from amendments to the specification or otherwise.

II. DECEMBER 22, 2008 OFFICE ACTION

The patent owner's response of January 21, 2009 alleges that in the Office action of December 22, 2008, "the rejections were apparently based upon the original patent claims" as opposed to the claims as amended by the housekeeping amendment of December 27, 2007. [4] Patent owner requests that the Office action be withdrawn as the rejections of some claims were not based upon the claims of record.

A review of the file history reveals that the Office action in question rejects claims 1-31, 37-56, 58, and 61-64 as anticipated by U.S. patent 6,999,449 to Barna et al. and finds the remaining claims patentable over the prior art. No other art is specifically addressed on the record.

The order granting *inter partes* reexamination of claims 1-64 of the '473 patent found that 16 different prior art documents each individually raised a substantial new question of patentability with respect to some of the patent claims.

The decision merging the '350 reissue application and the '269 reexamination proceeding stated that "the third party'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." [5] To that end, the procedure was set up to carefully limit third party's comment rights to issues within the scope of reexamination.

The failure of the December 22, 2008 Office action on the merits to address the proposed rejections presented in the *inter partes* request deprives the requester of the ability to comment on any refusal to adopt such rejection. Accordingly, the action must be **vacated**.

Therefore, the January 21, 2009 patent owner's amendments to the claims will not be entered and the accompanying response to the now-vacated Office action will not be considered. Third-

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[4] Amendment/Request for Reconsideration at pages 12-13.

[5] Decision of November 28, 2007 , VC(15).

party requester's comments of February 20, 2009 are being expunged for the reasons set forth in the next section.

As explained below, third party requester may submit a protest under 37 CFR 1.291 in the merged proceeding within 15 DAYS of the date of the present decision. At the expiration of this period, the merged proceeding will be remanded to the examiner to prepare a new Office action

III. PETITION TO STRIKE THE FEBRUARY 20, 2009 THIRD PARTY COMMENTS

A review of the third party submission received February 20, 2009 reveals the submission discussed on pages 2-8 the entirety of part III DETAILED COMMENTS ON THE OFFICE ACTION directed to patent owner's housekeeping amendment filed December 27, 2007, contending that the additions to the specification and the replacement drawings (5-7) constitute the introduction of new matter.

The merger decision of November 28, 2007 section V.B.4., page 12, states in part:

> Any comments paper filed by third party requester in response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect.

The decision of March 4, 2008 section IV.b.2 (page 8) provides clarification of the scope of permitted third party comments, stating:

> Requester is precluded from arguing a lack of support, enablement, or description as to any broadening effected by patent owner ***with respect to the claim scope existing prior to reexamination.*** The same applied as to whether the broadening limitations are clear or indefinite (i.e, whether they particularly point out the invention). As pointed out, this was beyond requester's reach prior to merger, and merger does not change that statutory-based fact. [Emphasis added]

Furthermore, the statute and the rule limit the third party comment rights to issues raised in the action and patent owner response. Requester contends that the "the issue of new matter was in fact raised by the Office Action because the Examiner, in allowing certain claims, necessarily concluded that the specification complied with Section 112."[6] It is noted that the examiner's allowing some claims does not amount to the Office action "raising" the issue of any possible rejection that was not on the record. Thus, the discussion on the aforementioned pages of the February 20, 2009 third party submission is improper for entry into the present merged reissue/reexamination proceeding, since these issues were not raised by the Office action of December 22, 2008 nor by patent owner's response of January 21, 2009 as required by 37 CFR § 1.947.

The February 20, 2009 third party requester submission is deemed to lack an entry right in the present merged proceeding and will accordingly be expunged from the record. The February

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[6] Opposition at pages 4 and 6.

20, 2009 requester submission will, therefore, form no part of the record of the merged proceeding.

Accordingly, the petition to strike is **granted**.

IV. FURTHER DISCUSSION

The decision of March 4, 2008 section IV.b (page 9) provided guidance to requester as to an acceptable means for presenting otherwise excluded issues for consideration by the examiner in the merged proceeding. Specifically, the decision stated:

> As a final point on this matter, the above guidelines **do not, in any way, preclude the requester from protesting under 37 CFR 1.291, pursuant to the guidelines set forth in MPEP 1900, with respect to the reissue-application merged in the present merged proceeding.** The third party requester has not lost any rights which it would have, had the '350 reissue application and the '269 *inter partes* reexamination proceedings not been merged into a single combined proceeding. Rather, requester's rights have been retained as to both individual proceedings, while permitting concurrent examination and not contravening the reexamination and reissue statutes. [Emphasis added.]

Accordingly, third party requester has been advised of an acceptable procedure for presenting the arguments and proposed rejections that would result in full consideration of the requester's position.

Third party requester may submit a protest under 37 CFR 1.291 in the merged proceeding within 15 DAYS of the date of the present decision. If compliant, such protest will be entered into the record and the Examiner, in the next Office action on the merits, will address any proposed rejection presented in the protest. Requester's subsequent comment rights will extend to the Office action's addressing any proposed rejection presented in the protest.

V. RECOURSE

1. The February 20, 2009 third party requester submission is deemed to lack an entry right in the present merged proceeding and will be expunged.

2. The third party requester is again reminded, the Reissue/Reexamination merger guidelines do not, in any way, preclude the requester from protesting under 37 CFR 1.291, pursuant to the guidelines set forth in MPEP 1900, with respect to the reissue-application merged in the present merged proceeding. The third party requester has not lost any rights which it would have, had the '350 reissue application and the '269 *inter partes* reexamination proceedings not been merged into a single combined proceeding. Rather, requester's rights have been retained as to both individual proceedings, while permitting concurrent examination and not contravening the reexamination and reissue statutes.

Note that a protest, consistent with 37 CFR 1.291, may take the form of proposed rejections. If a proper protest is filed within 15 days of this decision, the examiner will comment on it in the next action. Note also that if a protest, consistent with 37 CFR 1.291 is not filed within 15 days

of this decision, it will not be considered timely, and as such, will not be considered, absent a showing of extraordinary circumstances as to delay in submission.

3. Should examiner not accept the third party's view presented in any properly filed protest, then that non-acceptance will be part of the Office action and will be available to be commented on by third party requester in the next round of response and comment to the Office action.

4. Also note, 35 U.S.C. 315(b) expressly provides that the requester may appeal to the Board of Patent Appeals and Interferences with respect to any final decision favorable to the patentability of an original or proposed amended or new claim of the patent.

Insofar as any waiver of the rules, 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.

CONCLUSION

1. The Office action mailed December 22, 2008 is hereby **vacated**.

2. Patent owner's response of January 21, 2009 will remain part of the record but will not be considered.

3. Patent owner's petition to strike the third party requester's February 20, 2009 submission is granted.

4. The February 20, 2009 third party requester comments submission is deemed to lack an entry right in the present merged proceeding and will be "returned" to third party requester by being "sealed." The submission will, therefore, form no part of the record of the merged proceeding

5. A period of **15 DAYS** from the date of this decision is set in which the third party requester may submit a protest that complies with 37 CFR 1.291.

6. Any protest that complies with 37 CFR 1.291 filed within this **15 DAY** period will be considered by the examiner in next Office action. If a protest, consistent with 37 CFR 1.291 is not filed within 15 days of this decision, it will not be considered timely, and as such, will not be considered, absent a showing of extraordinary circumstances as to delay in submission.

7. Patent owner's petition filed February 27, 2009 and third party requesters opposition filed March 18, 2009 will remain part of the record.

8. Jurisdiction of the merged reissue/*inter partes* reexamination proceeding is being returned to Technology Center 2600 for examination of the merged proceeding after the 15 Day period for protest set forth in this decision expires, or the protest is filed, whichever is earlier.

9. Telephone inquiries related to this decision and questions regarding procedural matters should be directed to Pinchus M. Laufer, Legal Advisor at (571) 272-7726, or in his absence,

to the undersigned, at (571) 272-7710.

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

December 28, 2009
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95/000,269	06/21/2007	6829473	80615.249347	8484

71398 7590 06/23/2010

EXAMINER	
ART UNIT	PAPER NUMBER

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DATE MAILED: 06/23/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/636,350	12/07/2006	Sundar Raman	80615-242201	8357

7590 06/24/2010

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000269
PATENT NO. : 6829473
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

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(For Reissue Applicant/Patent Owner)

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

Kia L. Freeman
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Washington, DC 20001

(For Third Party Requester)

In re UTStarcom, Inc.
Reissue Application
Application No. 11/636,350
Filed: December 7, 2006
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

In re UTStarcom, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/000,269
Filed: June 21, 2007
For: U.S. Patent No. 6,829,473 B2
Issued: December 7, 2004

DECISION DISMISSING PETITION

This is a decision dismissing patent owner's petition entitled "PETITION TO UNMERGE THE MERGED PROCEEDINGS; AND TERMINATE/DISMISS/STAY THE INTER PARTES REEXAM UNDER 37 C.F.R. § 1.182 OR, UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF THE RULES," filed on March 18, 2010.

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

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to patent owner's deposit account on March 19, 2010.

The petition is dismissed for the reasons set forth herein.

BACKGROUND

1. U.S. Patent No. 6,829,473 ("the '473 patent") issued to Sundar Raman *et al.*, on December 7, 2004, and is assigned to UTStarcom, Inc. (patent owner/reissue applicant/petitioner).

2. On December 7, 2006, the patent owner filed an application for reissue of the '473 patent, and the application was assigned application number 11/636,350 ("the '350 reissue application").

3. A request for *inter partes* reexamination of the '473 patent was filed by a third party requester on June 21, 2007, and the resulting reexamination proceeding was assigned Control Number 95/000,269 ("the '269 reexamination proceeding"). Starent Networks Corporation is identified as the real party in interest for the reexamination requester (requester).

4. On August 16, 2007, an order granting *inter partes* reexamination of claims 1-64, (*i.e.*, all of the claims) of the '473 patent was mailed for the '269 *inter partes* proceeding.

5. On November 28, 2007, a merger decision was mailed. The decision *sua sponte* merged the '350 reissue application and the '269 *inter partes* reexamination proceedings into a single combined proceeding ("the merged proceeding").

6. On December 22, 2008, a non-final rejection was mailed in the merged proceeding.

7. On January 21, 2009, patent owner filed a response to the non-final rejection.

8. On February 20, 2009, requester filed comments under 35 U.S.C. 314(b)(2) and 37 CFR 1.947.

9. On December 29, 2009, the Office mailed a decision in the merged proceeding vacating the December 22, 2008 non-final Office action and remanding the merged proceeding to the examiner for issuance of a new Office action.

10. On March 18, 2010, patent owner filed the instant petition entitled "PETITION TO UNMERGE THE MERGED PROCEEDINGS; AND TERMINATE/DISMISS/STAY THE INTER PARTES REEXAM UNDER 37 C.F.R. § 1.182 OR, UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF THE RULES" ("the petition under 37 CFR 1.182/1.183").

11. On May 27, 2010, the Office issued a non-final Office action in the merged proceeding.

12. The '473 patent is the subject of litigation ("the litigation") between patent owner and

requester.[1] The litigation had been stayed pending resolution of the merged proceeding.[2]

DECISION

I. Relevant Authority

35 U.S.C. § 314 provides in-part:

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

35 U.S.C. § 317 provides in-part:

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

II. Patent Owner's March 18, 2010 Petition under 37 CFR 1.182/1.183

In the March 18, 2010 petition under 37 CFR 1.182/1.183, petitioner requests:
(1) that the merged proceeding be severed;
(2) that the '269 reexamination proceeding be terminated or, in the alternative, stayed pending resolution of the '350 reissue application proceeding; and
(3) that any further examination in the merged proceeding be stayed until the Office issues a decision on the instant petition.

In support of the request for termination or, in the alternative, suspension of the '269 reexamination proceeding, petitioner asserts:

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[1] *UTStarcom v. Starent Networks Corp.* No. 05-00710 JSW (N.D. Cal.), February 16, 2005. *See* Request for *Inter Partes* Reexamination, 95/000,269, filed on June 21, 2007, page 8. *See also* Notice of Concurrent Proceedings, filed in reissue application 11/636,350 on December 7, 2006.

[2] Petition under 37 CFR 1.182/1.183 at page 2, paragraph 2.

> [T]he *inter partes* reexamination should be terminated/dismissed due to the estoppel provisions of 35 U.S.C. 317(b) in view of Starent having settled the Litigation and taken a license of the '473 patent, indicating Starent's acceptance of the validity and enforceability of all claims of the '473 patent, establishing all the requisites for the estoppel provisions of 35 U.S.C. 317(b) to apply to each claim of the '473 patent.[3]

Petitioner further asserts that "all claims of the '473 patent qualify as 'claims in suit' for purposes of applying 35 U.S.C. 317(b)" and that "[a]ccordingly, based on 35 U.S.C. 317(b), proceeding further with the present *inter partes* reexamination is barred as to all claims of the '473 patent." [4]

In support of the request to sever/unmerge the merged proceeding, petitioner asserts that:

> Without any further participation by Starent in the merged proceedings, with the references from the Request for *inter partes* reexamination already of record in the reissue proceeding, with the Examiner already having determined the presence of allowable subject matter in the claims of the reissue application, and with the Examiner and UTStarcom being the only parties remaining in the merged proceedings, there is no longer any need to continue the *inter partes* reexamination aspect of the merged proceedings. The interests of all the remaining parties can be completely served through the reissue proceeding alone.[5]

Petitioner further asserts, as a basis to sever/unmerge the merged proceeding, that "[t]he restrictions associated with the *inter partes* reexamination proceeding are overly burdensome on the Examiner and serve only to impede examination." [6]

III. Analysis and Findings

A. Request to Terminate the '269 *Inter Partes* Reexamination Proceeding

A copy of an October 21, 2009 court document issued by the U.S. District Court for the Northern District of Illinois Eastern Division entitled "STIPULATION OF DISMISSAL WITH PREJUDICE" accompanied the instant petition (Exhibit 1). This document is not relevant to the merged proceeding as the corresponding litigation in which the document was issued does not pertain to the '473 patent. Thus, this document does not evidence "a final decision ... entered

---

[3] Petition under 37 CFR 1.182/1.183 at pages 11-12.

[4] Petition under 37 CFR 1.182/1.183 at page 12 (stating that "[t]he Litigation involved all claims of the '473 patent. The Complaint stated that Starent infringed the '473 patent (see Exhibit 5), implicitly asserting all claims of the '473 patent against Starent. Starent challenged the validity of the asserted claims ("asserted claims" referring to all claims of the '473 patent) and the enforceability of all claims of the '473 patent.")

[5] Petition under 37 CFR 1.182/1.183 at page 11.

[6] Petition under 37 CFR 1.182/1.183 at page 11. *See also* pages 3-4, paragraphs 10-13 (asserting that under the rules of the merged proceeding, communication between the petitioner (reissue applicant/patent owner) is impeded, and that resources are wasted in sending copies of communications to requester even though requester "no longer has any interest in the proceedings.")

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..." as required in 35 U.S.C. 317(b). Accordingly, the March 18, 2010 petition is **dismissed**.

With regard to petitioner's request to sever/unmerge the merged reissue/*inter partes* reexamination proceeding on the basis that requester is no longer participating in the merged proceeding, it is noted that there is no paper filed by the requester in the record of the merged proceeding stating that requester will not further participate in the merged proceeding. Moreover, regarding the alleged burdens of the procedures governing the merged proceeding, should requester state on the record that it will not further participate in the merged proceeding, petitioner may petition under 37 CFR 1.183 for waiver of the prohibition of interviews on the merits on an interview-by-interview basis, provided that petitioner, in each such instance, establishes an extraordinary situation in which justice requires waiver of the regulation. In regard to this, it is to be understood that, even if requester no longer participates, the public has its own interest in the Office's resolution of the substantial new question of patentability with special dispatch pursuant to the requirement of 35 U.S.C. 314(c). Where an interview can be shown in advance, on an interview-by-interview basis, to resolve issues to thereby facilitate special dispatch, justice can require waiver of the regulation in order to carry out the statutorily mandated special dispatch.

With regard to petitioner's alternative request to stay the '269 *inter partes* reexamination proceeding, such would run counter to the statutory requirement for "special dispatch" in *inter partes* reexamination proceedings (which remains, even if requester does not participate – see immediately above paragraph). 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 not be set aside in favor of the examination of the reissue application. Thus, suspension of the '269 *inter partes* reexamination proceeding pending completion of the examination of the '350 reissue application would not be appropriate.

For all of the foregoing reasons, the March 18, 2010 petition is **dismissed** with respect to the request that the merged proceeding be severed/unmerged, and with respect to the request that the '269 *inter partes* reexamination proceeding be terminated or, in the alternative, stayed pending resolution of the '350 reissue application proceeding.

Moreover, with respect to petitioner's request that any further examination in the merged proceeding be stayed until the Office issues a decision on the instant petition, it is noted that an Office action has been issued in the merged proceeding on May 27, 2010. However, in view of this decision, no impropriety could have resulted as a consequence of the May 27, 2010 Office action. In addition, this requested relief had not been granted prior to the issuance of the May 27, 2010 Office action.

B. Additional Discussion

Even if the court document submitted with the instant petition had pertained to the litigation of the '473 patent, it would not have been adequate to trigger the estoppel provision of 35 U.S.C.

317(b). The October 21, 2009 "STIPULATION OF DISMISSAL WITH PREJUDICE" (Exhibit 1) merely states:

> The parties have settled all remaining claims in the action. Accordingly, pursuant to Federal Rule of Procedure 41(a)(1), all parties in this action, by their respective counsel, jointly stipulate and agree to dismiss this action, including all claims asserted at any time, with prejudice. The parties shall bear their own costs and fees.

The stipulation of dismissal document does not state, for example, that the requester (Starent) was unable to sustain its burden of proving invalidity of the '473 patent claims or that the requester has not sustained its burden of proving invalidity of the '473 patent claims. It also does not state that the parties agreed that the requester had not sustained or could not sustain its burden of proving invalidity of the '473 patent claims. Thus, the stipulation of dismissal document entered in the civil action would not establish a final decision against the requester that the requester has not sustained its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b) for termination of the prosecution and conclusion of the reexamination proceeding.

CONCLUSION

1. The March 18, 2010 petition entitled "PETITION TO UNMERGE THE MERGED PROCEEDINGS; AND TERMINATE/DISMISS/STAY THE INTER PARTES REEXAM UNDER 37 C.F.R. § 1.182 OR, UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF THE RULES" is **dismissed**.

2. Telephone inquiries related to this decision and questions regarding procedural matters should be directed to Pinchus M. Laufer, Legal Advisor at (571) 272-7726, or in his absence, to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

6-22-10
Kenpet8/IP/suspend

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(For Third Party Requester)

In re Hunter Fan Company
Reissue Application
Application No. 11/703,606
Filed: February 7, 2007
For: U.S. Patent No. 7,131,819 B2

In re Hunter Fan Company
Inter Partes Reexamination Proceeding
Control No. 95/000,270
Filed: June 26, 2007
For: U.S. Patent No. 7,131,819 B2

DECISION, *SUA SPONTE*, MERGING REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDINGS AND WAIVING RULES

Reissue application number 11/703,606 and *inter partes* reexamination control number 95/000,270 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.

Summary: Reissue application number 11/703,606 and *inter partes* reexamination control number 95/000,270 are merged into a single proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 7,131,819 B2 (the '819 patent) issued to Gregory Michael Bird, on November 7, 2006, and is assigned to Hunter Fan Company.

2. On February 7, 2007, the patent owner filed a "broadening" reissue application based on the '819 patent, which was assigned application number 11/703,606 (the '606 reissue application).

3. Concurrently with the filing of the '606 reissue application, new claims 5-9 were added by preliminary amendment. None of the original patent claims were canceled or amended.

4. A first Office action was mailed in the '606 reissue application on June 8, 2007, in which all of the pending claims were rejected.

5. A request for ***inter partes*** reexamination of the '819 patent was filed by a third party requester on June 26, 2007, and the resulting reexamination proceeding was assigned Control Number 95/000,270 (the '270 reexamination proceeding). Minka Lighting, Inc. is identified as the real party in interest for the requester.

6. On August 17, 2007, an order granting reexamination of claims 1-4, (i.e. all of the claims) of the '819 patent was mailed for the '270 *inter partes* proceeding. The order was not accompanied by an Office action on the patentability of the claims, and no action on the patentability of claims 1-4 has been taken.

7. On September 9, 2007, a Sunday, a paper was timely filed in the '606 reissue application in response to the June 8, 2007 Office action.

8. No further action has been taken by the Office in the '606 reissue application.

9. The '819 patent is the subject of litigation filed on February 7, 2006. The case is *Hunter Fan Company v. Minka Lighting, Inc.*, No. 2:06-CV-02108, Western District of Tennessee, Memphis Division. The litigation does not appear to be stayed.

DECISION MERGING THE '606 REISSUE APPLICATION AND THE '270 *INTER PARTES* REEXAMINATION PROCEEDINGS

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> 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.

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.

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 1.906(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 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 § 2686.03 provides, in 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 underlying added.]

II. DISCUSSION REGARDING MERGER

As evidenced by the above review of facts, the '606 reissue application and the '270 *inter partes* reexamination proceeding are currently pending. The two proceedings are in their early stages of prosecution. Since reexamination has been ordered pursuant to § 1.931 in the '270 *inter partes* reexamination proceeding, a decision under § 1.991 is timely as to whether the '606 reissue application and the '270 *inter partes* reexamination proceeding 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. [1] Normally, the proceedings will be merged when it is desirable to

[1] In this instance, it is further noted that, 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 the *inter partes*

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 10/430,71 as paper PETDEC dated December 22, 2003).

In the *Allan* fact-situation, the *inter partes* reexamination proceeding was the first filed proceeding. 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. Patent owner then filed a petition requesting that the copending reissue application and *inter partes* reexamination not be merged and that the *inter partes* reexamination proceeding be suspended pending completion of the reissue application. Alternatively, patent owner requested that the reissue application be suspended pending completion of the *inter partes* reexamination proceeding.

It was explained in the *Allan* December 22, 2003 decision on petition that the effect of granting the requested relief by patent owner to suspend the *inter partes* reexamination proceeding would have potentially precluded the reexamination requester from obtaining a final resolution in the *inter partes* reexamination proceeding, because patent owner could have theoretically filed a string of continuation applications based on the reissue application, and the *inter partes* reexamination proceeding would remain suspended while each continuation was sequentially prosecuted. Further, it was found that there was no good cause (which is required by 35 U.S.C. § 314(c)) for suspending the *inter partes* reexamination proceeding, because the alternative options of suspending the reissue proceeding and merging the copending proceedings were both available. It was deemed, in the *Allan* December 22, 2003 decision, to be appropriate to merge the copending reissue and *inter partes* reexamination proceedings, since suspension of the reissue application would unduly delay the ability of 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 broader claims that were obtained. Also, Office practice was (and is) to treat reissue applications as special, and suspension of the reissue application would have run counter to that policy.

On reconsideration in *Allan* to address patent owner's reconsideration petition, it was 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 22, 2003 merger decision provided that the

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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 the level field intent of the *inter partes* reexamination statute.

"third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings."[2] Such would have erroneously permitted the *inter partes* reexamination requester to comment on broadened patent claims and to participate in the appeal process with respect to broadened patent claims in the merged proceeding, which runs counter to the ex parte nature of a reissue proceeding mandated by 35 U.S.C. 251.

37 CFR 1.991 provides that "[I]n 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." In *Allan,* this provision of the rules was construed too broadly so as to only preclude the third party requester from commenting on issues that were "reissue issues" such as recapture, the content of the reissue declaration and assignee consent. [3] The December 22, 2003 merger decision failed to preclude the third party requester from commenting in any way on the patentability of broadened claims presented in the reissue application. However, the reexamination requester of the *Allan inter partes* reexamination proceeding should have been precluded from commenting, in any fashion on the merits of the broadened claims present in the merged proceeding, [4] since the presence of such broadened claims is statutorily precluded in *inter partes* reexamination. 35 U.S.C. 314(a). Accordingly the *Allan* decision reversed the December 22, 2003 decision, and instead of merging the copending reissue application and *inter partes* reexamination proceedings, the reissue application was suspended.

The suspension of the reissue application was the appropriate remedy in *Allan,* since the reissue application was filed after the reexamination request, [5] patent owner had requested suspension of the reissue as one alternative means of relief, [6] and patent owner's stated objective[7] 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) was achieved. The facts presented in the present instance with respect to the present '606 reissue application and the present '270 *inter partes* reexamination proceeding are, however, distinguishable from those in Allan. Initially, the '606 reissue application was the first filed proceeding. The '270 *inter partes* reexamination proceeding was

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[2] *In re Allan*, 71 USPQ2d at 1753.

[3] Page 4 of the December 22, 2003 decision merging the copending broadening reissue application and *inter partes* reexamination proceeding stated: "The third party requester does not gain any rights to participate with respect to issues that are not within the scope of *inter partes* reexamination. Specifically, with regard to petitioner's example of the issue of broadening the claims, note that the addition of broadened claims is not permitted in *inter partes* reexamination. Therefore, broadening issues would not be an issue within the scope of *inter partes* reexamination, and the third party requester would not be permitted to raise these issues in the merged proceeding. In other words, third party requester would have the right to reply to any rejections/reasons for patentability with regard to the newly added broadened claims, since they are added to both proceedings. However, third party requester would NOT have the right to address broadening reissues, *e.g.*, the 2 yr. time limit, recapture, declaration, assignee consent, *etc.*, as these would not be patentability issues within the scope of *inter partes* reexamination."

[4] Beyond merely noting that such claims were in fact broader than the patent claims and therefore improper in the reexamination proceeding

[5] 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.

[6] *In re Allan*, 71 USPQ2d at 1754.

[7] See *Id.*

filed more than four months after the filing of the '606 reissue application, and after a first Office action on the merits had been mailed in the '606 reissue application. Further, patent owner has not expressed a willingness to have the reissue application suspended, as was the case in *Allan*. Accordingly, and based on the present fact situation, the reissue application will not be suspended.

As to the reexamination proceeding, 35 U.S.C. 314(c) statutorily requires "special dispatch," unless the Director determines there is good cause for suspension. In this instance, if at all possible, it is desirable to prevent the delay in resolving the raised statutory new question of patentability while patent owner prosecutes the reissue application, and any continuation reissue applications that may be filed. Accordingly, a merger decision will be fashioned to be more specific than was the December 22, 2003 decision in *Allan*, whereby third party requester will be permitted to comment in the merged proceeding only on matters that could have been commented on in the '270 *inter partes* reexamination proceeding. By fashioning the merger decision more precisely, both the patent owner and the *inter partes* reexamination requester will be able to participate in the merged proceeding with respect to the same matters that they could have addressed in the '270 *inter partes* reexamination, if that proceeding were to have proceeded without having been merged, while the third party requester will be precluded from participating and commenting on issues that are unique to examination of a reissue application, including any issue of patentability of the broadened reissue claims.

It is to be noted that it is equitable that the third party requester not be permitted to comment on a broadened claim, since a reexamination filing cannot be used to give the third party requester access to those broadened claims. The present merger permits both proceedings to go forward at the same time, while preserving the rights of both parties. Also, if a reissue patent is subsequently granted on one or more of the broadened claims, the third party requester would have the right to file a request for reexamination of those claims of the reissue patent.

III. Decision Merging The '606 Reissue Application And The '270 *Inter Partes* Reexamination Proceeding

A. Merger of Proceedings

In accordance with 37 CFR 1.991, the '606 reissue application and the '270 *inter partes* reexamination proceeding 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 reissue application and the *inter partes* reexamination file 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 '606 reissue application are not the same in as the claims in the '270 *inter partes* reexamination proceeding. Specifically, patent claim 3 has been amended and new, broadened claims 5-9 have been added in the '606 reissue application. **Therefore, an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases,** specifically, reissue Application No. 11/703,606, and *inter partes* reexamination Control No. 95/000,270. 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). The patent owner must not address any issues otherwise present in either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for both files (*i.e.*, the reissue application No. and the *inter partes* reexamination proceeding Control No.) and a signature. The housekeeping amendment must be filed in duplicate for entry into each of the reissue application file and the *inter partes* reexamination file. The housekeeping amendment must comply with the provisions of 37 CFR 1.173 (the rule governing amendments filed in reissue applications). [8] 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 amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

4. It should be noted that submission of such an appropriate housekeeping amendment (*i.e.*, limited to the bare presentation of claims) will not create a comment right for third party requester. Any comments paper filed by third party requester in response to any such housekeeping amendment would be improper, and would result in the return of the paper as an improper submission under 37 CFR 1.939, or expungement of the paper, if it is entered prior to discovery of the defect. Note that 37 CFR 1.991 states (in part):

> ...In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 to 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files.

C. Conduct of the Merged Reissue and *Inter Partes* Reexamination Proceedings

1. The regulatory provisions governing the examination of reissue applications include, *inter alia*, provisions equivalent the regulations relating to the conduct of *inter partes* reexamination proceedings, including that examination of a reissue application be examined expeditiously.

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[8] Note that a "clean copy" of the amendment is not required by 37 CFR 1.173, and is not to be provided.

Therefore, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, to the extent it is practical to do so. In addition, the third party requester in the '270 *inter partes* reexamination proceeding may participate in the merged proceeding to the extent provided under 37 CFR 1.902 to 1.997, except that such participation shall be strictly limited to issues within the scope of *inter partes* reexamination. The examiner will apply the reissue statute, rules, and case law to the examination of the merged proceeding except as directed in paragraph 15 below.

2. Each Office action issued by the examiner will take the form of a single action which jointly applies to the '606 reissue application and the '270 *inter partes* reexamination proceeding. Each action will contain identifying data for both of the proceedings, *i.e.*, the reissue application and the *inter partes* reexamination proceeding. 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 response by the reissue applicant/patent owner must consist of a single response, with **a copy being filed for entry in 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 reissue Application Number and the *inter partes* reexamination proceeding Control 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 and 37 CFR 1.121(h) governing reissue applications. See MPEP § 1453 for a complete discussion of amendment practice in a reissue application. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

5. Any paper (e.g., comments, brief) filed by third party requester must consist of a single response, with **a copy being filed for entry in 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 reissue Application Number and the *inter partes* reexamination proceeding Control Number).

6. There will be no interviews in the merged proceeding, as the rules provide that *inter partes* reexamination will be conducted on the written record. [9]

[9] 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. Note that the right to an interview in a reissue application is not a statutory right, and in this instance, carrying out the legislative intent is of

7. 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).

8. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. Thereafter, with respect to the '270 *inter partes* reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal rights have been exhausted. See 37 CFR 1.957(c).

9. If the applicant/patent owner files an express abandonment of the '606 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 '270 *inter partes* reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

10. Where the merged proceeding is dissolved based on abandonment of the reissue application and the '270 *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 (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under *inter partes* reexamination following the dissolution would be noted by the examiner as not being proper under *inter partes* reexamination pursuant practice to 37 CFR 1.906(c).

11. If the merged proceeding is dissolved based on abandonment of the '606 reissue application and the '270 *inter partes* reexamination proceeding continues, there is no guarantee that any continuation reissue application of the '606 reissue application will be merged with the '270 *inter partes* reexamination proceeding (the continuation reissue application might be stayed pending conclusion of the '270 *inter partes* reexamination).

12. If applicant/patent owner files a Request for Continued Examination (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 is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

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paramount importance. A petition under 37 CFR 1.183 may be submitted to request an interview in the rare circumstances that an interview is deemed to be indispensable.

13. 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.

14. The examiner in the merged proceeding will consult with OPLA (*i.e.*, the OPLA legal advisor assigned to the '270 *inter partes* reexamination) prior to issuing an Office action in the present merged proceeding, in the same manner, as he/she would consult in an *inter partes* reexamination proceeding that is not merged.

15. Scope Of Third Party Requester's Participation In The Merged Proceeding:

37 CFR 1.991 provides that "[I]n 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. The following provides for preservation of that right:

a. Copies of all Office actions will be provided by the Office to the third party requester. Further, any paper filed by the applicant/patent owner in the merged proceeding must be served on the third party requester. Third party requester will be given an opportunity to comment on all patent owner replies (responses) to Office actions (as pointed out below). However, third party requester participation in the merged proceeding must be strictly limited to issues within the scope of *inter partes* reexamination. No third party comments can be advanced on issues appropriate for reissue, but not appropriate for reexamination, as, for example:

(1) Comments on any aspect of the patentability of broadened claims presented under the authority of the reissue statute (including but not limited to issues of whether broadening reissue was sought within two years of the issue date of the patent);
(2) Comments regarding the acceptability of any reissue declaration;
(3) Comments regarding assignee assent; and
(4) Comments regarding the recapture doctrine.

Third party comments 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. [10] Any such improper paper will be returned to the requester as an improper submission under 37 CFR 1.939, or expunged, if the paper is entered prior to discovery of the defect.

[10] Thus, for example, where a question 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 question.

b. In the same manner that patent owner/applicant in the merged proceeding must serve the third party requester with correspondence filed in the Office, the third party requester must serve the patent owner/applicant with correspondence that requester files in the Office.

c. Prior to the issuance of any Notice of Allowability (Form PTOL-37) - (1) the procedure for issuing Office actions, (2) the forms used for actions, (3) any response by the patent owner/applicant, and (3) procedure, including requester comments, will 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 37 CFR 41.81 will govern appeals by the patent owner and requester to the Board of Patent Appeals and Interferences (Board), and to the Court of Appeals for the Federal Circuit. When the case is in condition for the issuance of a Notice of Allowability, Form PTOL-37 will be used to advise parties of same, and inform patent owner of the steps that must be taken (*e.g.*, payment of the issue fee) to mature the reissue application into a reissue patent. As pointed out in Section (C)(7) above, the present *inter partes* reexamination proceeding would be concluded by the grant of such a reissue patent, and the reissue patent would serve as the certificate under 37 CFR 1.997.

d. Inherent in the 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 37 CFR 41.60 through 37 CFR 41.81 will govern, but only with respect to claims that are not broadened claims in the merged proceeding.

e. Requester's comments in all appeal papers must be limited to matters appropriate to *inter partes* reexamination (*i.e.*, no appeal can be advanced by third party requester with respect to issues appropriate for reissue and not appropriate for *inter partes* reexamination, as discussed above).

f. In view of the provisions 37 CFR 1.953(c), any filing of a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 must be accompanied by a petition under 37 CFR 1.182/1.183, requesting acceptance of same as a proper response to the final action, that is taken as being an equivalent to the Right of Appeal Notice under 37 CFR 1.953.

IV. 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...."

Above it is directed that:

> "(1)the procedure for issuing Office actions, (2) the forms used for actions, (3) any response by the patent owner/applicant, and (3) procedure, including requester comments, 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.

CONCLUSION

1. The '606 reissue application and the '270 *inter partes* reexamination proceeding **are merged** into a single consolidated proceeding.

2. A copy of this decision will be placed in the IFW of the '606 reissue application and the '270 *inter partes* reexamination proceeding.

3. Jurisdiction of the '606 reissue application file and the '270 *inter partes* reexamination file will reside with the Central Reexamination Unit (CRU) to await the filing of a housekeeping amendment in accordance with Section III(B) of this Decision.

4. Once the housekeeping amendment is received, or the time for filing such housekeeping amendment has expired, jurisdiction of the merged reissue and *inter partes* reexamination proceeding will be forwarded via the Technology Center 3700 Group Director to an examiner for the preparation of an Office action in the merged proceeding. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '819 patent (e.g., by preparing/signing an action). See MPEP 2636. All further examination should be conducted in accordance with Sections III(B) and III(C) of this Decision.

5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within <u>one month</u> of this Decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

6. Telephone inquiries related to this decision and questions regarding procedural matters 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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October 9, 2007

October 23, 2007
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,274	07/11/2007	6707264	10598.0004-00	7040

41066 7590 03/21/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,175	08/18/2006	6707264	4421.75753	9460

32047 7590 03/21/2008

GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC
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Ex parte Reexamination Proceeding :
Control No. 90/008,175 :
Filed: August 18, 2006 :
For: U.S. Patent No. 6,707,264 : **DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**

Inter Partes Reexamination Proceeding :
Control No. 95/000,274 :
Filed: July 11, 2007 :
For: U.S. Patent No. 6,707,264 :

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. U.S. Patent No. 6,707,264 (the '264 patent) issued to Yung-Lin Lin *et al.* on March 16, 2004, and was assigned to O2Micro International Limited.

2. A request for *ex parte* reexamination of claims 1-22 of the '264 patent was filed on August 18, 2006, by third party requester Patrick G. Burns, and the request was assigned control number 90/008,175 (the '8175 *ex parte* reexamination proceeding).

3. On October 26, 2006, *ex parte* reexamination was ordered for claims 1-22 of the '264 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability as to those claims.

4. A request for *inter partes* reexamination of claims 1-22 of the '264 patent was filed on July 11, 2007, by third party requester Rohm Co., Ltd., who is also the real party in interest. The request was assigned control number 95/000,274 (the '0274 *inter partes* reexamination proceeding).

5. On August 8, 2007, *inter partes* reexamination was ordered for claims 1-22 of the '264 patent, based on the examiner's determination that the request for *inter partes* reexamination raised a substantial new question of patentability as to those claims.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '8175 *ex parte* reexamination expired after December 26, 2006.[1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '0274 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

[1] There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from parties.

In accordance with 37 CFR 1.989(a), the 90/008,175 and 95/000,274 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 in this instance.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

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

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,274 and *ex parte* Reexamination Control No. 90/008,175 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor

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

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OCT 06 2008

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In re Lin et al.,
Ex parte Reexamination Proceeding
Control No. 90/008,175
Filed: August 18, 2006
For: U.S. Patent No. 6,707,264

In re Lin et al.,
Inter partes Reexamination Proceeding
Control No. 95/000,274
Filed: July 11, 2007
For: U.S. Patent No. 6,707,264

DECISION DISMISSING PETITION TO SEVER PROCEEDINGS AND GRANTING PARTIAL WAIVER OF 37 CFR 1.955

This is a decision on the August 16, 2008 patent owner petition titled "PETITION UNDER 37 C.F.R. § 1.183 SEEKING DE-MERGER OF REEXAMINATION CONTROL NOS. 90/008,175 AND 95/000,274 AND SUSPENSION OF REEXAMINATION CONTROL NO. 95/000,274" (the "Petition"). As the rules do not provide for a petition for severance (de-merger) of merged reexamination proceedings and suspension of a reexamination proceeding, the petition paper is being treated as a petition under 37 CFR 1.182.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to petitioner's credit card on August 18, 2008.

The petition and merged reexamination proceeding for 95/000,274 and 90/008,175 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition for severance and suspension is dismissed as premature.

Patent owner's petition is, however, granted to the extent that the rules of practice (37 CFR 1.955) are waived to afford patent owner a **single opportunity** to hold an interview with the examiner in this proceeding if, and only if, patent owner proceeds as provided in Section V below.

BACKGROUND

1. On March 16, 2004, United States Patent Number 6,707,264 (the '264 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '264 patent, assigned Reexamination Control No. 90/008,175 (the '8175 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8175 proceeding.

4. On July 11, 2007, a request for *inter partes* reexamination of the '264 patent, assigned Reexamination Control No. 95/000,274 (the '274 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. Patent owner and third party requester in the '274 proceeding are adversarial parties in concurrent litigation regarding the '264 patent in the United States District Court for the Eastern District of Texas (concurrent litigation).[1]

6. On August 8, 2007, the Office issued an order granting *inter partes* reexamination in the '274 proceeding, without an accompanying action on the merits.

7. On March 21, 2008, the Office issued a decision *sua sponte* merging the '8175 *ex parte* proceeding and the '274 *inter partes* proceeding (the merged proceeding).

8. On April 23, 2008, the third party requester submitted a Notice of Concurrent Proceedings under 37 CFR 1.985(b). In paragraph 2 of the submission, the requester states that it "will no longer actively participate in the proceeding in any way" and waives its right to file any comment otherwise allowed under 35 U.S.C. § 314(b)(2) and/or 37 C.F.R. § 1.947." The notification included a court document from the concurrent litigation entitled "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008.

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[1] *O2 Micro Int'l, Ltd. v. Rohm Co. Ltd.*, Case No. 2:05-CV-0211 (E.D. Tex. 2005).

9. On June 5, 2008, the Office issued a non-final Office action on the merits in the merged proceeding.

10. On August 16, 2008, patent owner filed a petition under 37 CFR 1.183 requesting de-merger of the merged proceeding and suspension of the '274 proceeding.

PRELIMINARY MATTER: PATENT OWNER'S ADDRESS

37 CFR 1.33(c) states:

> (c) All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '274 proceeding and (3) the '8175 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. Additionally, the petition that is addressed by this decision is from a third counsel alleging that they are now counsel for patent owner in the merged proceeding. **The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c)** and it is that of Grossman, Tucker, Perreault & Pfleger, PLLC, and 55 South Commercial Street, Manchester NH 03101. [2]

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

(a) Designate the correspondence address and attorneys of record in both proceedings, to provide one address and party for the merged proceeding, which is the same as that in the patent file, and

(b) If there is a newly designated attorney, supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

Patent owner is reminded to serve both reexamination requesters with copies of all papers filed in these proceedings, including said correspondence address communications.

As a courtesy, this decision is being mailed to all addresses. Pending clarification, the address of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101, will be used **in all future correspondence**.

---

[2] On September 18, 2007 a revocation of power of attorney and new power of attorney and change of address was submitted in the '274 proceeding, however no such transaction has ever occurred in the '264 patent.

RELEVANT STATUTES, REGULATIONS AND GUIDANCE

35 U.S.C. 314(c) states:

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

35 U.S.C. 317(b) 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 that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907(b) states:

> 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 2686.04 II B provides (Emphasis added):

> The Third Party Requester Was a Party to the Litigation.
>
> Final Holding of validity: The provisions of 37 CFR 1.907(b) apply. Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may **not** 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 the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office, i.e., the proceeding will be concluded.
>
> ...
>
> In view of the above, when the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

(1) Was the Federal Court's decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court's decision a final decision, after all appeals?

(3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in the Federal Court during the civil action?

- If the answer to each of questions (1)-(3) is "yes" for all claims for which reexamination was requested in the proceeding, then the *inter partes* reexamination prosecution must be terminated. In such a case, the Central Reexamination Unit (CRU) Director will prepare a decision discussing the above considerations (1)-(3) and vacate the reexamination proceeding at that time.

- If the answer to all of questions (1)-(3) is "yes" for one or more (but not all) of the claims for which reexamination was requested in the proceeding; those claims will not be treated. The examiner's action will point out the claims not treated and the reason why, i.e., a discussion of the above considerations (1)-(3). The guidelines set forth above in subsection II. (A) will be used for the claims remaining.

- If the answer to question (1) or to question (3) is "no" for all claims for which reexamination was requested, then the examination of the reexamination proceeding will proceed without any discussion on the record of considerations (1)-(3), using the guidelines set forth above in subsection II.(A).

- If, for any claim for which reexamination was requested, the answer to both of questions (1) and (3) is "yes", but the answer to question (2) is "no", then examination of the reexamination proceeding will proceed using the guidelines set forth above in subsection II.(A). The examiner's action will contain a discussion of considerations (1)-(3). If the examiner subsequently becomes aware that the Federal Court decision has become final, reexamination of the affected claims must be discontinued. If all claims being examined are affected, the reexamination will be vacated by the CRU Director as discussed above. See also subsection V. below.

Final Holding of invalidity: A final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). **Where all claims for which reexamination was requested are affected, the reexamination will be vacated by the CRU Director.** A non-final holding of claim invalidity or unenforceability, however, will not be controlling on the question of whether a substantial new question of patentability is present.

DECISION

I. Patent Owner's Position

Patent owner's petition filed August 16, 2008, requests that the merged reexamination proceeding should be severed ("de-merged"), that the '274 *inter partes* reexamination proceeding should be suspended while the '8175 *ex parte* proceeding continues, and that at the conclusion of the *ex parte* prosecution the *inter partes* proceeding be harmonized with the results of the '8175 *ex parte* reexamination proceeding by means of a housekeeping

amendment. The basis for patent owner's position is that - because the third party requester in the '274 *inter partes* reexamination proceeding has agreed to no longer exercise its right to file comments in the '274 proceeding, in light of a Consent Judgment/settlement agreement in concurrent litigation between the parties on the same patent, the presence of the procedural rules of *inter partes* reexamination will actually thwart special dispatch.

II. Analysis and Findings

Initially, it is to be noted that, regardless of any merit to patent owner's position, the statutory issue of the attachment of estoppel must first be addressed before any determination can be made on the merits of patent owner's petition (whether the petition is taken under 37 CFR 1.182 or 37 CFR 1.183). Patent owner's petition is silent regarding the estoppel provisions of 35 U.S.C. § 317(b) which attach to an *inter partes* reexamination proceeding when a final decision has been entered. Yet, if the estoppel provisions of 35 U.S.C. § 317(b) have attached to all claims of the '274 *inter partes* reexamination proceeding, the '274 *inter partes* reexamination would be terminated. If so, the relief requested by patent owner would then follow in due course, and there would be no need for resort to 37 CFR 1.182 and 37 CFR 1.183.

A review of the record reveals that neither party has disclosed and/or submitted court records to establish which claims of the '264 patent were being asserted in the concurrent litigation. The initial request only lists the litigation proceedings and includes a court memorandum opinion and order that appears to be the result of a Markman claim construction hearing from a companion case in the District Court. [3] The memorandum does not state which claims from the '264 patent were being asserted or being challenged with the defense of invalidity. The third party requester's submission of court papers in the "Notice of Concurrent Proceedings under 37 CFR 1.985(b)," filed on April 23, 2008, is silent regarding both as to which claims from the '264 patent were being asserted or being challenged with the defense of invalidity, as well as to the finality of the court's decision.

The '264 patent issued with 22 claims, of which claims 1, 9, and 16, are independent. The request for reexamination filed on behalf of Rohm Co. Ltd., (as the real party in interest) established a substantial new question of patentability with respect to all the claims of the '264 patent.

Based on the above, it cannot be determined if the claims in suit are or are not ***identical*** to the claims under reexamination in the '274 proceeding, because such has not been made of record in the '274 *inter partes* reexamination proceeding, but all the patent claims, i.e., claims 1-22, are subject to reexamination in the '274 proceeding. Furthermore, it cannot be determined from the record if the concurrent litigation resulted in a final decision.

35 U.S.C. § 317(b) attaches the estoppel on a claim-by-claim basis. Thus, if the present *inter partes* reexamination of claims 1-22 contained evidence of a final decision, the *inter* partes reexamination proceeding could not continue as to any claims subject to the "final decision."

Therefore, if evidence on the record shows that a final decision was rendered on all the claims subject to *inter partes* reexamination that the third party requester "has not sustained its burden of proving the invalidity of any patent claim in suit" then the statute would

[3] Memorandum Opinion and Order, *O2 Micro Int'l, Ltd. v. Samsung Elecs. Co. Ltd.*, Case No. 2:04-CV-323, (E.D. Tex. 2004)

require the Office to terminate the '274 *inter partes* proceeding. As a result of such a termination, the '8175 *ex parte* proceeding would be severed (from the terminated *inter partes* proceeding) to continue prosecution, thus obviating the need for the three step relief requested by petitioner. In such a circumstance the Office would not have to consider granting petitioner relief not specifically provided for in the rules, but instead would grant petitioner, in effect, relief as provided for under the rules, *i.e.* termination which will result in severance. See 35 U.S.C. 317(b) and 37 CFR 1.907(b).

However, it has not been established that the consent judgment entered in the civil proceeding constitutes "a final decision ... against a party in a civil action ... that the party has not sustained its burden of proving the invalidity" of the claims in suit. Accordingly, the petition to sever and suspend the '274 proceeding is dismissed as premature.

III. Guidance for Petition to Terminate

In order to resolve the need for relief in this instance, patent owner is called upon to present the following, with supporting documentation from the concurrent litigation, to complete the petition, and resolve the issue under 35 U.S.C. 317(b) and 37 CFR 907(b) as to termination of the '274 *inter partes* reexamination proceeding:

1) An explanation, with supporting court documentation, as to whether or not the action taken in the concurrent litigation, i.e. the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008, is a "Final Decision" within the statutory meaning of 35 U.S.C. 317(b).

2) If the action taken in the concurrent litigation is a "Final Decision," then identify, with supporting documentation from the record of the litigation, which claims from the '264 patent were subject to adjudication in the concurrent litigation.

3) For all claims identified as being subject to adjudication by the court in the concurrent litigation, disclose, with supporting court documentation, how they were challenged and treated in resolution or affirmance of the challenge in regard to their patentability.

Patent owner's showing must establish, based on specifically pointed out part(s) of the record of the litigation, whether the estoppel provisions of 35 U.S.C. 317(b) should apply to all the claims of the patent and/or issues for which patent owner requests the Office to no longer maintain. Specifically, the showing must be adequate to establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit."

IV. Interim Prosecution of the merged proceeding

Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding, except that, in light of requester's express waiver of its right to

file comments, the proceeding will be forwarded to the examiner for action immediately upon entry of patent owner responses, or the expiration of time for same.[4]

If an Action Closing Prosecution (ACP) is generated for the merged proceeding and the *inter partes* reexamination proceeding is subsequently terminated and/or severed, that will result in the treating of such ACP as a final Office action in the remaining *ex parte* proceeding, governed by the rules of *ex parte* reexamination.

V. Interview

37 CFR 1.955 states:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent owner has also requested an interview in the merged proceeding. Patent owner's rationale requesting a waiver of the rule precluding interviews in an *inter partes* reexamination is that, in light of assertions on the record by third party requester, from the '274 *inter partes* reexamination proceeding, the third party would not be prejudiced and conduct of the interview will facilitate the statutory mandate of "special dispatch."

There is substantial evidence on the record that the third party requester from the '274 *inter partes* reexamination proceeding will not participate, nor be prejudiced by the conduct of an interview, as evidenced by the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008. Accordingly, **a single interview** will be permitted. This waiver of the rules is solely to conduct a single interview. There is no further waiver of the rules at this time. Any requests for further interviews can be considered in the future, after the matters discussed above in this decision are resolved.

Patent owner is give fifteen (15) days with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

CONCLUSION

1. The patent owner petition to sever the '274 and '8175 proceedings and suspend the '274 proceeding is dismissed.

2. Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding.

3. The patent owner may file a petition to terminate or limit the '274 proceeding in accordance with the guidance provided above in Section III.

4. Patent owner's petition is granted in part such that 37 CFR 1.955 is waived to the extent that Patent owner is being afforded a **single opportunity** to hold an interview with the

[4] If third party requester objects to this procedure, and wishes to preserve its right to comment, then requester is called upon to immediately inform the Office of that decision and explain the circumstances for withdrawing an assertion made in the record of this proceeding. Note further, that the language of the third party's submission does not make it entirely clear whether they intend to prospectively waive any participation in the appeal process.

examiner in this proceeding if, and only if, patent owner proceeds as provided above in Section V. Patent owner is given **fifteen (15) days** from the mail date of this decision with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

5. Jurisdiction of the merged proceeding is returned to the Central Reexamination unit (CRU) for examination consistent with this decision.

6. Telephone inquires related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in their 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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CENTRAL REEXAMINATION UNIT

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Houston, TX 77002

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DECISION DISMISSING PETITION TO SEVER PROCEEDINGS AND GRANTING PARTIAL WAIVER OF 37 CFR 1.955

This is a decision on the August 16, 2008 patent owner petition titled "PETITION UNDER 37 C.F.R. § 1.183 SEEKING DE-MERGER OF REEXAMINATION CONTROL NOS. 90/008,175 AND 95/000,274 AND SUSPENSION OF REEXAMINATION CONTROL NO. 95/000,274" (the "Petition"). As the rules do not provide for a petition for severance (de-merger) of merged reexamination proceedings and suspension of a reexamination proceeding, the petition paper is being treated as a petition under 37 CFR 1.182.

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Patent owner's petition is, however, granted to the extent that the rules of practice (37 CFR 1.955) are waived to afford patent owner a **single opportunity** to hold an interview with the examiner in this proceeding if, and only if, patent owner proceeds as provided in Section V below.

BACKGROUND

1. On March 16, 2004, United States Patent Number 6,707,264 (the '264 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '264 patent, assigned Reexamination Control No. 90/008,175 (the '8175 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8175 proceeding.

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5. Patent owner and third party requester in the '274 proceeding are adversarial parties in concurrent litigation regarding the '264 patent in the United States District Court for the Eastern District of Texas (concurrent litigation).[1]

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The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '274 proceeding and (3) the '8175 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. Additionally, the petition that is addressed by this decision is from a third counsel alleging that they are now counsel for patent owner in the merged proceeding. **The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c)**, and it is that of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101. [2]

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

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

35 U.S.C. 317(b) 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 that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907(b) states:

> 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 2686.04 II B provides (Emphasis added):

> The Third Party Requester Was a Party to the Litigation.
>
> Final Holding of validity: The provisions of 37 CFR 1.907(b) apply. Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may **not** 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 the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office, i.e., the proceeding will be concluded.
>
> ...
>
> In view of the above, when the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

(1) Was the Federal Court's decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court's decision a final decision, after all appeals?

(3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in the Federal Court during the civil action?

- If the answer to each of questions (1)-(3) is "yes" for all claims for which reexamination was requested in the proceeding, then the *inter partes* reexamination prosecution must be terminated. In such a case, the Central Reexamination Unit (CRU) Director will prepare a decision discussing the above considerations (1)-(3) and vacate the reexamination proceeding at that time.

- If the answer to all of questions (1)-(3) is "yes" for one or more (but not all) of the claims for which reexamination was requested in the proceeding, those claims will not be treated. The examiner's action will point out the claims not treated and the reason why, i.e., a discussion of the above considerations (1)-(3). The guidelines set forth above in subsection II.(A) will be used for the claims remaining.

- If the answer to question (1) or to question (3) is "no" for all claims for which reexamination was requested, then the examination of the reexamination proceeding will proceed without any discussion on the record of considerations (1)-(3), using the guidelines set forth above in subsection II.(A).

- If, for any claim for which reexamination was requested, the answer to both of questions (1) and (3) is "yes", but the answer to question (2) is "no", then examination of the reexamination proceeding will proceed using the guidelines set forth above in subsection II.(A). The examiner's action will contain a discussion of considerations (1)-(3). If the examiner subsequently becomes aware that the Federal Court decision has become final, reexamination of the affected claims must be discontinued. If all claims being examined are affected, the reexamination will be vacated by the CRU Director as discussed above. See also subsection V. below.

Final Holding of invalidity: A final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). **Where all claims for which reexamination was requested are affected, the reexamination will be vacated by the CRU Director.** A non-final holding of claim invalidity or unenforceability, however, will not be controlling on the question of whether a substantial new question of patentability is present.

DECISION

I. Patent Owner's Position

Patent owner's petition filed August 16, 2008, requests that the merged reexamination proceeding should be severed ("de-merged"), that the '274 *inter partes* reexamination proceeding should be suspended while the '8175 *ex parte* proceeding continues, and that at the conclusion of the *ex parte* prosecution the *inter partes* proceeding be harmonized with the results of the '8175 *ex parte* reexamination proceeding by means of a housekeeping

amendment. The basis for patent owner's position is that - because the third party requester in the '274 *inter partes* reexamination proceeding has agreed to no longer exercise its right to file comments in the '274 proceeding, in light of a Consent Judgment/settlement agreement in concurrent litigation between the parties on the same patent, the presence of the procedural rules of *inter partes* reexamination will actually thwart special dispatch.

II. Analysis and Findings

Initially, it is to be noted that, regardless of any merit to patent owner's position, the statutory issue of the attachment of estoppel must first be addressed before any determination can be made on the merits of patent owner's petition (whether the petition is taken under 37 CFR 1.182 or 37 CFR 1.183). Patent owner's petition is silent regarding the estoppel provisions of 35 U.S.C. § 317(b) which attach to an *inter partes* reexamination proceeding when a final decision has been entered. Yet, if the estoppel provisions of 35 U.S.C. § 317(b) have attached to all claims of the '274 *inter partes* reexamination proceeding, the '274 *inter partes* reexamination would be terminated. If so, the relief requested by patent owner would then follow in due course, and there would be no need for resort to 37 CFR 1.182 and 37 CFR 1.183.

A review of the record reveals that neither party has disclosed and/or submitted court records to establish which claims of the '264 patent were being asserted in the concurrent litigation. The initial request only lists the litigation proceedings and includes a court memorandum opinion and order that appears to be the result of a Markman claim construction hearing from a companion case in the District Court. [3] The memorandum does not state which claims from the '264 patent were being asserted or being challenged with the defense of invalidity. The third party requester's submission of court papers in the "Notice of Concurrent Proceedings under 37 CFR 1.985(b)," filed on April 23, 2008, is silent regarding both as to which claims from the '264 patent were being asserted or being challenged with the defense of invalidity, as well as to the finality of the court's decision.

The '264 patent issued with 22 claims, of which claims 1, 9, and 16, are independent. The request for reexamination filed on behalf of Rohm Co. Ltd., (as the real party in interest) established a substantial new question of patentability with respect to all the claims of the '264 patent.

Based on the above, it cannot be determined if the claims in suit are or are not ***identical*** to the claims under reexamination in the '274 proceeding, because such has not been made of record in the '274 *inter partes* reexamination proceeding, but all the patent claims, i.e., claims 1-22, are subject to reexamination in the '274 proceeding. Furthermore, it cannot be determined from the record if the concurrent litigation resulted in a final decision.

35 U.S.C. § 317(b) attaches the estoppel on a claim-by-claim basis. Thus, if the present *inter partes* reexamination of claims 1-22 contained evidence of a final decision, the *inter* partes reexamination proceeding could not continue as to any claims subject to the "final decision."

Therefore, if evidence on the record shows that a final decision was rendered on all the claims subject to *inter partes* reexamination that the third party requester "has not sustained its burden of proving the invalidity of any patent claim in suit" then the statute would

[3] Memorandum Opinion and Order, *O2 Micro Int'l, Ltd. v. Samsung Elecs. Co. Ltd.*, Case No. 2:04-CV-323, (E.D. Tex. 2004)

require the Office to terminate the '274 *inter partes* proceeding. As a result of such a termination, the '8175 *ex parte* proceeding would be severed (from the terminated *inter partes* proceeding) to continue prosecution, thus obviating the need for the three step relief requested by petitioner. In such a circumstance the Office would not have to consider granting petitioner relief not specifically provided for in the rules, but instead would grant petitioner, in effect, relief as provided for under the rules, *i.e.* termination which will result in severance. See 35 U.S.C. 317(b) and 37 CFR 1.907(b).

However, it has not been established that the consent judgment entered in the civil proceeding constitutes "a final decision ... against a party in a civil action ... that the party has not sustained its burden of proving the invalidity" of the claims in suit. Accordingly, the petition to sever and suspend the '274 proceeding is dismissed as premature.

III. Guidance for Petition to Terminate

In order to resolve the need for relief in this instance, patent owner is called upon to present the following, with supporting documentation from the concurrent litigation, to complete the petition, and resolve the issue under 35 U.S.C. 317(b) and 37 CFR 907(b) as to termination of the '274 *inter partes* reexamination proceeding:

1) An explanation, with supporting court documentation, as to whether or not the action taken in the concurrent litigation, i.e. the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008, is a "Final Decision" within the statutory meaning of 35 U.S.C. 317(b).

2) If the action taken in the concurrent litigation is a "Final Decision," then identify, with supporting documentation from the record of the litigation, which claims from the '264 patent were subject to adjudication in the concurrent litigation.

3) For all claims identified as being subject to adjudication by the court in the concurrent litigation, disclose, with supporting court documentation, how they were challenged and treated in resolution or affirmance of the challenge in regard to their patentability.

Patent owner's showing must establish, based on specifically pointed out part(s) of the record of the litigation, whether the estoppel provisions of 35 U.S.C. 317(b) should apply to all the claims of the patent and/or issues for which patent owner requests the Office to no longer maintain. Specifically, the showing must be adequate to establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit."

IV. Interim Prosecution of the merged proceeding

Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding, except that, in light of requester's express waiver of its right to

file comments, the proceeding will be forwarded to the examiner for action immediately upon entry of patent owner responses, or the expiration of time for same.[4]

If an Action Closing Prosecution (ACP) is generated for the merged proceeding and the *inter partes* reexamination proceeding is subsequently terminated and/or severed, that will result in the treating of such ACP as a final Office action in the remaining *ex parte* proceeding, governed by the rules of *ex parte* reexamination.

V. Interview

37 CFR 1.955 states:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent owner has also requested an interview in the merged proceeding. Patent owner's rationale requesting a waiver of the rule precluding interviews in an *inter partes* reexamination is that, in light of assertions on the record by third party requester, from the '274 *inter partes* reexamination proceeding, the third party would not be prejudiced and conduct of the interview will facilitate the statutory mandate of "special dispatch."

There is substantial evidence on the record that the third party requester from the '274 *inter partes* reexamination proceeding will not participate, nor be prejudiced by the conduct of an interview, as evidenced by the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008. Accordingly, **a single interview** will be permitted. This waiver of the rules is solely to conduct a single interview. There is no further waiver of the rules at this time. Any requests for further interviews can be considered in the future, after the matters discussed above in this decision are resolved.

Patent owner is give fifteen (15) days with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

CONCLUSION

1. The patent owner petition to sever the '274 and '8175 proceedings and suspend the '274 proceeding is dismissed.

2. Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding.

3. The patent owner may file a petition to terminate or limit the '274 proceeding in accordance with the guidance provided above in Section III.

4. Patent owner's petition is granted in part such that 37 CFR 1.955 is waived to the extent that Patent owner is being afforded a **single opportunity** to hold an interview with the

[4] If third party requester objects to this procedure, and wishes to preserve its right to comment, then requester is called upon to immediately inform the Office of that decision and explain the circumstances for withdrawing an assertion made in the record of this proceeding. Note further, that the language of the third party's submission does not make it entirely clear whether they intend to prospectively waive any participation in the appeal process.

examiner in this proceeding if, and only if, patent owner proceeds as provided above in Section V. Patent owner is given **fifteen (15) days** from the mail date of this decision with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

5. Jurisdiction of the merged proceeding is returned to the Central Reexamination unit (CRU) for examination consistent with this decision.

6. Telephone inquires related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in their 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

MAILED

OCT 20 2008

CENTRAL REEXAMINATION UNIT

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Ex parte Reexamination Proceeding :
Control No. 90/008,175 :
Filed: August 18, 2006 :
For: U.S. Patent No. 6,707,264 : **DECISION**
: **GRANTING**
: **PETITION**

Inter Partes Reexamination Proceeding :
Control No. 95/000,274 :
Filed: July 11, 2007 :
For: U.S. Patent No. 6,707,264 :

This is a decision on the patent owner paper entitled "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)," filed on August 5, 2008.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to patent owner's Deposit Account No. 50-4160, as authorized on page two of the transmittal letter, which accompanied the petition on August 5, 2008.

REVIEW OF THE RELEVANT FACTS

1. On March 16, 2004, United States Patent Number 6,707,264 (the '264 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '264 patent, assigned Reexamination Control No. 90/008,175 (the '8175 proceeding), was filed by third party requester Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8175 proceeding.

4. On July 11, 2007, a request for *inter partes* reexamination of the '264 patent, assigned Reexamination Control No. 95/000,274 (the '274 proceeding), was filed by third party requester Lionel Lavenue on behalf of real party in interest Rohm Co., Ltd.

5. On August 8, 2007, the Office issued an order granting *inter partes* reexamination in the '274 proceeding, without an accompanying action on the merits.

6. On March 21, 2008, the Office issued a decision *sua sponte* merging the '8175 *ex parte* proceeding and the '274 *inter partes* proceeding (the merged proceeding).

7. On June 5, 2008, the Office issued a non-final Office action on the merits in the merged proceeding.

8. On August 5, 2008, patent owner filed, in the '8175 proceeding, the instant petition paper entitled, "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)."

9. Concurrently on August 5, 2008, patent owner filed, in the '8175 proceeding, a response to the June 5, 2008 Office action, which exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 12 pages.

DECISION

37 CFR 1.183 provides:

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

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

In the instant petition, patent owner requests waiver of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, with respect to patent owner's response to the June 5, 2008 Office action filed concurrently with the instant petition on August 5, 2008. As pointed out above, patent owner's August 5, 2008 response exceeds the 50-page limit by 12 pages. In support of waiver of the rule, patent owner points out that the June 5, 2008 Office action is an Office action in a merged proceeding, and is itself 112 pages in length, and the action cites numerous references, each of which raises an issue corresponding to some or all of the 22 claims of the '264 patent. In order to effectively address the issues raised in the Office action, patent owner deems it necessary to exceed the page limit set forth in 37 CFR 1.943(b).

Upon consideration of the instant petition, it is noted that the June 5, 2008 Office action applies or discusses 29 references, and analyzes 100 proposed grounds of rejection raised by the third party requesters, in addition to raising several new grounds of rejection. Based upon the extensive incorporation by reference of the requesters' proposed rejections, the new rejections made by the examiner in the June 5, 2008 Office action, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit for the patent owner's response to the extent that the patent owner's August 5, 2008 response exceeds the 50-page limit by 12 pages.

It is noted, however, that the August 5, 2008 patent owner petition paper and concurrently filed response do not comply with the requirements set forth in the March 21, 2008 "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS" (the merger decision). In particular, section III(B) of the merger decision indicates (emphasis added):

> 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 requester(s) must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.**
>
> ****
>
> Patent owner and requesters are reminded that **every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties** (including papers filed *via* facsimile transmission), **and every paper filed must reflect that such paper**

> **was served on the other parties, pursuant to 37 CFR 1.903.** All papers are to be addressed to the Central Reexamination Unit as provided above.

In this instance, the August 5, 2008 patent owner petition paper and response were not filed in accordance with the March 21, 2008 merger decision because the patent owner petition paper and response (1) were not filed in duplicate (the petition paper and response were only filed in the '8175 proceeding), (2) do not contain identifying data for both files (the petition paper and response only contain identifying data for the '8175 proceeding), and (3) do not reflect that the petition paper and response were served on all of the other parties (the certificate of service accompanying the petition paper and response reflects only that the *ex parte* third party requester was served, but not the *inter partes* third party requester).

Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is provisionally waived as to the 12 pages of the patent owner's August 5, 2008 response that exceed the 50-page limit, **contingent** upon the patent owner timely re-filing the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision as set forth below.

The patent owner is hereby given a **non-extendible period of 15 days from the mailing date of this decision** to re-file the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision.

If patent owner does so, then the *inter partes* third party requester may once file written comments on the patent owner's response within a **non-extendible period of 30 days from the date of service of patent owner's re-filed response**.

In the event the patent owner fails to re-file the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision within the time period set forth above, the 50-page limit of 37 CFR 1.943(b) will not be waived, and the patent owner's August 5, 2008 response will be deemed improper (i.e., because the length of the patent owner submission exceeds that permitted by 37 CFR 1.943) and will not be considered, i.e., there would be no response to the Office action, and the Office would take action accordingly. [1]

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is provisionally waived as to the 12 pages of the patent owner's August 5, 2008 response that exceed the 50-page limit, **contingent** upon the patent owner timely re-filing the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision.

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[1] *See Manual of Patent Examining Procedure* § 2667(I)(2) (8th ed. 2001) (Rev. 7, July 2008).

2. A **non-extendible period of 15 days from the mailing date of this decision** is hereby set for patent owner to re-file the August 5, 2008 petition paper and response to the outstanding Office action in accordance with the March 21, 2008 merger decision.

3. If patent owner does re-file, then the *inter partes* third party requester may once file written comments within a non-extendible period of 30 days from the date of service of the re-filed patent owner's response.

4. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor

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

10/20/08
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CENTRAL REEXAMINATION UNIT

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Ex parte Reexamination Proceeding :
Control No. 90/008,175 :
Filed: August 18, 2006 :
For: U.S. Patent No. 6,707,264 : **DECISION**
: **GRANTING**
: **PETITION**

Inter Partes Reexamination Proceeding :
Control No. 95/000,274 :
Filed: July 11, 2007 :
For: U.S. Patent No. 6,707,264 :

This is a decision on the October 29, 2008 patent owner paper entitled "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)" (the re-filed petition), which has been filed concurrently with a response to the June 5, 2008 Office Action (the re-filed response).

The re-filed petition is before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to patent owner's Deposit Account No. 50-4160, as authorized on page two of the re-filed petition.

DECISION

On August 5, 2008, patent owner filed a petition paper in the 90/008,175 reexamination proceeding entitled "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)," concurrently with a response to the June 5, 2008 Office Action. Patent owner's August 5, 2008 response exceeds the 50-page limit of 37 CFR 1.943(b) by 12 pages.

On October 20, 2008, the Office issued a decision provisionally granting patent owner's August 5, 2008 petition under 37 CFR 1.183. Specifically, the October 20, 2008 decision provisionally waived the page limit of 37 CFR 1.943(b) as to the 12 pages of patent owner's August 5, 2008 response that exceed the 50-page limit, contingent upon patent owner timely re-filing the August 5, 2008 petition paper and response in accordance with the Office's March 21, 2008 "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS" (the merger decision).

Because it appears patent owner has timely re-filed the August 5, 2008 petition paper and response in accordance with the merger decision, the re-filed petition is **granted** to the extent that the 50-page limit of 37 CFR 1.943(b) is waived as to the 12 pages of patent owner's August 5, 2008 response that exceed the 50-page limit.

It is noted that the pagination of patent owner's re-filed response (71 pages) differs from that of patent owner's August 5, 2008 response (62 pages). However, it appears the content of the re-filed response is identical to that of the August 5, 2008 response, except that the re-filed response includes identifying data for both the 90/008,175 and 95/000,274 reexamination proceedings and the certificate of service appended thereto reflects that both the *ex parte* and *inter partes* third party requesters were served.

The October 20, 2008 decision provided *inter partes* third party requester with an opportunity to once file written comments on patent owner's re-filed response within a non-extendible period of 30 days from the date of service of patent owner's re-filed response. That 30-day time period (from the service of the October 29, 2008 patent owner re-filed response) for *inter partes* third party requester to have submitted written comments has expired.

CONCLUSION

1. Patent owner's re-filed petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the 12 pages of patent owner's August 5, 2008 response that exceed the 50-page limit.

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 Nicole D. Dretar, Legal Advisor, at 571-272-7717.

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