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MAR 12 2008

CENTRAL REEXAMINATION UNIT

Stanley Z. Cole
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1875 Eye Street, N.W. Suite 1100
Washington, DC 20036

(For Patent Owner)

Adriane M. Antler
222 East 41st Street
New York, New York 10017

(For Requester)

In re Prickett et al.
Reexamination Proceeding
Control No.: 95/000,276
Filed: July 9, 2007
For: U.S. Patent No. 6,924,264

: DECISION DISMISSING
: 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 August 8, 2007, titled "PETITION FOR ADDITONAL PAGES UNDER 37 C.F.R. § 1.183," 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. Specifically, the third party requester requests an additional fifty pages (100 total pages), or one hundred pages (150 total pages) for the third party requester's comments on the patent owner's expected response to the Office action mailed on January 17, 2008, if the Office permits the patent owner to file a response that contains an additional fifty pages or one hundred pages, respectively. The third party requester also requests that any declarations filed by the third party requester be excluded as part of the 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 dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,924,264 (the '264 patent) issued on August 2, 2005.

2. A request for reexamination of the '264 patent was filed on July 9, 2007. The request was assigned control No. 95/000,276 (the '276 reexamination proceeding).

3. Reexamination was ordered for the '276 proceeding on October 3, 2007.

4. On January 17, 2008, a first Office action rejecting claims 1-8, 10, and 12-23 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 February 1, 2008, the patent owner filed a petition under 37 CFR 1.183 requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.

6. On February 8, 2008, the third party 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.

7. In a separate decision being mailed concurrently with the present decision, the USPTO is granting the petition under 37 CFR 1.183 filed by the patent owner, to the extent that the patent owner is permitted to file a response that does not exceed one hundred pages in length (an additional 50 pages) to the Office action mailed on January 17, 2008.

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 patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds fifty (50) pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

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 requester, and is subject to the page limit requirement under 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 counts.

Likewise, if a 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.

In the instant petition, the third party requester requests relief from the fifty-page limit under 37 CFR 1.943(b), requesting an additional fifty pages (100 total pages) or one hundred pages (150 total pages) for the third party requester's comments on the patent owner's expected response to the Office action mailed on January 17, 2008. The third party requester alleges that since 37 CFR 1.943(b) does not distinguish between responses by a patent owner and written comments by a third party requester in setting the page limit, should the USPTO grant the patent owner an additional fifty pages or one hundred pages for response, the USPTO should also grant the third party requester an equal amount of additional pages for written comments. The third party requester also requests that any declarations filed by the third party requester be excluded as part of the page limit.

The record reveals that the Office action mailed on January 17, 2008, exceeds fifty pages and the examiner incorporated from the request, into the Office action, some of the rejections proposed by the requester. The Office action sets forth fifty-one grounds of rejection and relies on numerous references. The request for *inter partes* reexamination contains one hundred sixty-nine pages in length and it includes three declarations that contain nearly one hundred total pages. The order granting the request contains sixty-two pages, which incorporates by reference some of argument from the request. Based upon the above facts, a response by the patent owner that does not exceed one hundred pages (an additional 50 pages) to respond to the Office action mailed on January 17, 2008 has been deemed equitable in addressing the Office action in the separate decision granting the patent owner petition under 37 CFR 1.183 being mailed concurrently with the present decision.

However, the third party requester has not provided any specific facts as to why the third party requester would need to file written comments that exceed the 50-page limit. The patent owner's response to the Office action is required under 37 CFR 1.111(b) to distinctly and specifically point out the supposed errors in the Office action and must reply to every ground of objection and rejection in the Office action. This requirement does not apply to the third party requester's written comments. The mere fact that the USPTO grants the

patent owner an additional fifty pages for responding to the Office action is not *per se* sufficient to justify an additional fifty pages for the third party requester's written comments.

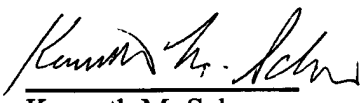
Accordingly, the petition is dismissed. Any comments filed by the third party requester on the patent owner's response to the Office action mailed on January 17, 2008, shall not exceed fifty (50) pages in length. Any declarations or affidavits filed by the third party requester will be counted or excluded as part of the page limit to the extent set forth in this decision.

CONCLUSION

1. The petition under 37 CFR 1.183 filed by the third party requester on February 8, 2008 for waiver of the requirements of 37 CFR 1.943(b) is dismissed.

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

3. Telephone inquiries with regard to this decision should be directed to 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

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In re Prickett et al.
Reexamination Proceeding
Control No.: 95/000,276
Filed: July 9, 2007
For: U.S. Patent No. 6,924,264

: DECISION GRANTING
: PETITION UNDER
: 37 CFR 1.183

This is a decision on the petition under 37 CFR 1.183 filed by the patent owner on August 1, 2007, titled "PETITION FOR ADDITONAL PAGES PURSUANT TO 37 C.F.R. § 1.183," requesting waiver of 37 CFR 1.943(b) that requires responses by the patent owner not to exceed fifty (50) pages in length. Specifically, the patent owner requests an additional fifty pages (100 total pages) to respond to the Office action mailed on January 17, 2008. The patent owner also requests that declarations be excluded as part of the page limit under 37 CFR 1.943(b), and, if declarations do count as part of the page limit, the patent owner requests one hundred additional pages (150 total pages) to respond to the Office action.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent that the response by the patent owner may contain an additional fifty pages (100 total pages) to respond the Office action mailed on January 17, 2008.

REVIEW OF FACTS

1. U.S. Patent No. 6,924,264 (the '264 patent) issued on August 2, 2005.

2. A request for reexamination of the '264 patent was filed on July 9, 2007. The request was assigned control No. 95/000,276 (the '276 reexamination proceeding).

3. Reexamination was ordered for the '276 proceeding on October 3, 2007.

4. On January 17, 2008, a first Office action rejecting claims 1-8, 10, and 12-23 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 February 1, 2008, the patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.

6. On February 8, 2008, the third party requester filed a 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 50 pages in length.

7. In a separate decision being mailed concurrently with the present decision, the USPTO is dismissing the petition under 37 CFR 1.183 filed by the third party requester.

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 patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds fifty (50) pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

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 requester, and is subject to the page limit requirement under 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 counts.

Likewise, if a 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.

In the instant petition, the patent owner requests that declarations not be counted as part of the page limit under 37 CFR 1.943(b). If declarations do not count as part of the page limit, the patent owner requests an additional fifty pages (100 total pages) to respond to the Office action mailed on January 17, 2008. If declarations do count as part of the page limit, the patent owner requests one hundred additional pages (150 total pages) to respond to the Office action.

The record reveals that the Office action mailed on January 17, 2008, exceeds fifty pages, and the examiner incorporated from the request, into the Office action, some of the rejections proposed by the requester. The Office action sets forth fifty-one grounds of rejection and relies on numerous references. The request for *inter partes* reexamination contains one hundred sixty-nine pages in length, and it includes three declarations that contain nearly one hundred total pages. The order granting the request contains sixty-two pages, which incorporates by reference some of argument from the request.

Based upon the above facts and the individual facts and circumstances of this proceeding, a response by the patent owner that does not exceed one hundred pages in length (an additional 50 pages) to respond to the Office action mailed on January 17, 2008 is deemed equitable to address the Office action. However, the request for additional one hundred pages (150 total pages) to respond to the Office action is not granted, because certain affidavits or declarations that do not contain opinions or arguments are excluded from the page limit requirements as previously stated (*e.g.*, 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).

Accordingly, the petition is granted:

(A) For only the next immediate response filed by the patent owner, in response to the Office action mailed on January 17, 2008; and

(B) To permit patent owner to provide as much as one hundred (100) pages for patent owner's response to the Office action mailed on January 17, 2008. Any declarations and affidavits filed by the patent owner will be counted or excluded as part of the page

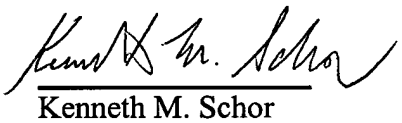
limit in accordance with this decision. The Office will enforce compliance with this new page limit of 100 pages, and a strict review of the length of patent owner's response will be made upon its receipt.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to permit a response by the patent owner to the Office action mailed on January 17, 2008, not to exceed one hundred (100) pages in length.

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

3. Telephone inquiries with regard to this decision should be directed to 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

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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.
95/000,276	07/09/2007	6924264	11767-104-999	2035

30678 7590 06/04/2008

CONNOLLY BOVE LODGE & HUTZ LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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JONES DAY
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New York, NY 10017

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JUN 04 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,276*.

PATENT NUMBER *6,924,264*.

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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Adriane M. Antler
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(For Requester)

In re Prickett et al.
Reexamination Proceeding
Control No.: 95/000,276
Filed: July 9, 2007
For: U.S. Patent No. 6,924,264

: DECISION DISMISSING
: PETITION TO
: STRIKE DECLARATION

This is a decision on (1) the petition under 37 CFR 1.181 and 1.182 filed by the patent owner on February 1, 2008, titled "PETITION TO STRIKE THE DECLARATION OF MARK J. POZNANSKY PURSUANT TO 37 C.F.R. §§ 1.181 AND 1.182," requesting to strike the declaration of Mark J. Poznansky in its entirety (hereafter Petition to Strike), and (2) the petition under 37 CFR 1.182 filed by the third party requester on February 8, 2007, titled "PETITION UNDER 37 C.F.R. § 1.182," requesting denial of the patent owner's Petition to Strike (hereafter Opposition Petition). Specifically, the patent owner is seeking to strike only the first declaration of Mark J. Poznansky entitled, "Declaration of Mark J. Poznansky," filed on July 9, 2007, and not the second declaration entitled "Second Declaration of Mark J. Poznansky."

The petitions are before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The Petition to Strike filed by the patent owner on February 1, 2008, is dismissed.
The Opposition Petition filed by the third party requester on February 8, 2008, is granted.

FEES

A petition under 37 CFR 1.182 requires the fee set forth in 37 CFR 1.17(f).

The Petition to Strike filed by the patent owner on February 1, 2007 (in the last paragraph on page 7) provides an authorization to charge the Deposit Account No. 22-0185. Therefore, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the Deposit Account No. 22-0185, as authorized in the patent owner's Petition to Strike filed on February 1, 2008.

The Opposition Petition filed by the third party requester on February 8, 2007 (in the last paragraph on page 7) provides an authorization to charge the Deposit Account No. 50-3013. Therefore, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the Deposit Account No. 50-3013 as authorized in the third party requester's Opposition Petition filed on February 8, 2008.

REVIEW OF FACTS

1. U.S. Patent No. 6,924,264 (the '264 patent) issued on August 2, 2005.

2. A request for reexamination of the '264 patent was filed on July 9, 2007. The request was assigned control No. 95/000,276 (the '276 reexamination proceeding). The request was accompanied by two declarations of Mark J. Poznansky and one declaration of Omar Quraishi.

3. Reexamination was ordered for the '276 proceeding on October 3, 2007.

4. On January 17, 2008, a first Office action rejecting claims 1-8, 10, and 12-23 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 February 1, 2008, the patent owner filed the Petition to Strike under 37 CFR 1.181 and 1.182, requesting the Declaration of Mark J. Poznansky be removed from the file records.

6. On February 8, 2008, the third party requester filed the Opposition Petition under 37 CFR 1.182 requesting a denial of the patent owner's petition to strike the Declaration of Mark J. Poznansky.

DECISION

35 U.S.C. 301 states:

> 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. (Emphasis added.)

35 U.S.C. 311 states in pertinent part:

> The request shall set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. 314 states in pertinent part:

> [R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

35 U.S.C. 132 states in pertinent part:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, **together with such information and references as may be useful** in judging of the propriety of continuing the prosecution of his application... (emphasis added).

37 CFR 1.906(a) states:

> (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.

37 CFR 1.915(b)(3) states:

> 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.

Manual of Patent Examining Procedure, 8th Edition, Rev. 6, August 2007 (MPEP) § 2205 states in pertinent part:

> Affidavits or declarations or other written evidence relating to the prior art documents submitted may accompany the citation to explain the contents or pertinent dates in more detail.

MPEP § 2617 states in pertinent part:

> 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 § 2258 states in pertinent part:

> 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 reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

In the Petition to Strike, the patent owner requests that the first declaration of Mark J. Poznansky entitled, "Declaration of Mark J. Poznansky," filed on July 9, 2007 (hereinafter, the Declaration of Mark J. Poznansky) be stricken, because the patent owner alleges that the declaration is improper for exceeding the scope permitted in *inter partes* reexamination proceedings. The patent owner further asserts that the declaration offers "expert opinion on issues bearing directly on the alleged invalidity of the '264 patent (*e.g.*, obviousness)," "extends well beyond an explanation of the references" and "focuses on improper legal conclusions and opinions." These arguments from the patent owner have been considered, but are found to be not persuasive.

The Declaration of Mark J. Poznansky was filed with the request for reexamination of the '264 patent on July 9, 2007 by the third party requester. 35 USC 311(b)(2) and 37 CFR 1.915(b) sets forth the requirements for a request for *inter partes* reexamination. Such a request must contain a detailed explanation of the pertinency and manner of applying the cited patents and printed publications to every claim for which reexamination is requested. *See* 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). The request may include affidavits or declarations or other written evidence which explain the contents of the cited patents or printed publication in more detail. *See* MPEP §§ 2205, 2258, and 2617. Other matters, such as public use or sale, inventorship, 35 USC 101, 35 USC 112, fraud, etc., will not be considered when making the determination on the request and should not be presented in the request. *See* MPEP § 2617.

Furthermore, for proposed obviousness rejections, requester must provide a rationale (a basis) to combine the cited prior art and a statement of why the claims would have been obvious over the proposed reference combination. *See* MPEP § 2617. As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ459 (1966), and obviousness is a legal determination based on several underlying factual inquiries including resolving the level of ordinary skill in the pertinent art. *See* MPEP § 2141 (8th Ed., Rev. 6, September 2007). Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art, and in an obviousness rejection, why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art must be explained. *See* MPEP § 2141 (8th Ed., Rev. 6, September 2007).

The declaration states that Dr. Poznansky considers the twenty-six references listed in the declaration. In the declaration, Dr. Poznansky provides detailed explanation of the prior art

references and explanations of how the prior art references provide suggestions and reasons to make certain improvements. Dr. Poznansky also provides his factual findings on what one of ordinary skill in the art would recognize from the prior art references and how one of ordinary skill in the art would have a rationale to combine certain references. The declaration does not contain matters such as public use or sale, inventorship, 35 U.S.C. 101, 35 U.S.C. 112, fraud, etc. The declaration mainly contains detailed explanations of the prior art and manner of applying the cited patents and printed publication to the claims of the patent in the context of obviousness rejections. If there are any statements on an ultimate legal conclusion in the declaration, such statements will be considered by the Office only as an opinion as to the obviousness of the rejections; clearly, the ultimate legal conclusion lies with the Office, and any legal tribune later appropriately considering the matter.

In regard to the patent owner's argument on the issue that the examiner may not rely on an affidavit or declaration for the purpose of determining validity of patent claims, the examiner is permitted to make a rejection based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. *See* MPEP §§ 2258 and 2617. 35 U.S.C. 314 provides that reexamination will be "conducted according to the procedures established for initial examination under the provisions of sections 132 and 133" and 35 U.S.C. 132 provides that "[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, **together with such information and references as may be useful"** (emphasis added). A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. However, the examiner is not precluded from considering other "information" (*e.g.*, affidavits, declarations and transcripts) to help define the scope and content of the prior art, or to establish that a claimed invention is unpatentable under 35 U.S.C. 102 or 103. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991); *In re Chambers*, 20 U.S.P.Q.2d 1470, 1474 (Com'r Pat. & Trademarks, 1991); *Heinl v. Godici*, 143 F.Supp.2d 593 (E.D. Va. 2001). Furthermore, if the examiner were to improperly made a rejection in an Office action that is not based upon patents and/or printed publications, such as a rejection under 35 U.S.C. 101, the patent owner should raise this issue in the response to any such Office action, rather than seeking to strike the Declaration of Mark Poznansky that was filed with the request for reexamination for appropriate reasons - to explain the pertinency and manner of applying the cited patents and printed publications to the patent claims.

Based upon the above facts and the individual facts and circumstances of this proceeding, the Declaration of Mark J. Poznansky filed with the request for *inter partes* reexamination is not deemed improper, and it will not be removed from the file records.

Accordingly, the Petition to Strike filed by the patent owner on February 1, 2008, is dismissed, and the Opposition Petition filed by the third party requester on February 8, 2008, is granted.

CONCLUSION

1. The Petition to Strike under 37 CFR 1.181 and 37 CFR 1.82 filed by the patent owner on February 1, 2008, is dismissed.

2. The Opposition Petition filed by the third party requester on February 8, 2007, is granted.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to process the patent owner's response filed on April 16, 2008, and the third party requester's comments filed on May 15, 2008. After the Central Reexamination Unit has processed all party papers, 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 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

6-02-08

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(For Patent Owner)

MAILED

JUN 04 2008

CENTRAL REEXAMINATION UNIT

Adriane M. Antler
222 East 41st Street
New York, New York 10017

(For Requester)

In re Prickett et al.
Reexamination Proceeding
Control No.: 95/000,276
Filed: July 9, 2007
For: U.S. Patent No. 6,924,264

: DECISION DISMISSING
: PETITION TO
: STRIKE DECLARATION

This is a decision on (1) the petition under 37 CFR 1.181 and 1.182 filed by the patent owner on February 1, 2008, titled "PETITION TO STRIKE THE DECLARATION OF MARK J. POZNANSKY PURSUANT TO 37 C.F.R. §§ 1.181 AND 1.182," requesting to strike the declaration of Mark J. Poznansky in its entirety (hereafter Petition to Strike), and (2) the petition under 37 CFR 1.182 filed by the third party requester on February 8, 2007, titled "PETITION UNDER 37 C.F.R. § 1.182," requesting denial of the patent owner's Petition to Strike (hereafter Opposition Petition). Specifically, the patent owner is seeking to strike only the first declaration of Mark J. Poznansky entitled, "Declaration of Mark J. Poznansky," filed on July 9, 2007, and not the second declaration entitled "Second Declaration of Mark J. Poznansky."

The petitions are before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The Petition to Strike filed by the patent owner on February 1, 2008, is dismissed.
The Opposition Petition filed by the third party requester on February 8, 2008, is granted.

FEES

A petition under 37 CFR 1.182 requires the fee set forth in 37 CFR 1.17(f).

The Petition to Strike filed by the patent owner on February 1, 2007 (in the last paragraph on page 7) provides an authorization to charge the Deposit Account No. 22-0185. Therefore, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the Deposit Account No. 22-0185, as authorized in the patent owner's Petition to Strike filed on February 1, 2008.

The Opposition Petition filed by the third party requester on February 8, 2007 (in the last paragraph on page 7) provides an authorization to charge the Deposit Account No. 50-3013. Therefore, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the Deposit Account No. 50-3013 as authorized in the third party requester's Opposition Petition filed on February 8, 2008.

REVIEW OF FACTS

1. U.S. Patent No. 6,924,264 (the '264 patent) issued on August 2, 2005.

2. A request for reexamination of the '264 patent was filed on July 9, 2007. The request was assigned control No. 95/000,276 (the '276 reexamination proceeding). The request was accompanied by two declarations of Mark J. Poznansky and one declaration of Omar Quraishi.

3. Reexamination was ordered for the '276 proceeding on October 3, 2007.

4. On January 17, 2008, a first Office action rejecting claims 1-8, 10, and 12-23 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 February 1, 2008, the patent owner filed the Petition to Strike under 37 CFR 1.181 and 1.182, requesting the Declaration of Mark J. Poznansky be removed from the file records.

6. On February 8, 2008, the third party requester filed the Opposition Petition under 37 CFR 1.182 requesting a denial of the patent owner's petition to strike the Declaration of Mark J. Poznansky.

DECISION

35 U.S.C. 301 states:

> 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. (Emphasis added.)

35 U.S.C. 311 states in pertinent part:

> The request shall set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. 314 states in pertinent part:

> [R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

35 U.S.C. 132 states in pertinent part:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, **together with such information and references as may be useful** in judging of the propriety of continuing the prosecution of his application... (emphasis added).

37 CFR 1.906(a) states:

> (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.

37 CFR 1.915(b)(3) states:

> 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.

Manual of Patent Examining Procedure, 8th Edition, Rev. 6, August 2007 (MPEP) § 2205 states in pertinent part:

> Affidavits or declarations or other written evidence relating to the prior art documents submitted may accompany the citation to explain the contents or pertinent dates in more detail.

MPEP § 2617 states in pertinent part:

> 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 § 2258 states in pertinent part:

> 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 reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

In the Petition to Strike, the patent owner requests that the first declaration of Mark J. Poznansky entitled, "Declaration of Mark J. Poznansky," filed on July 9, 2007 (hereinafter, the Declaration of Mark J. Poznansky) be stricken, because the patent owner alleges that the declaration is improper for exceeding the scope permitted in *inter partes* reexamination proceedings. The patent owner further asserts that the declaration offers "expert opinion on issues bearing directly on the alleged invalidity of the '264 patent (*e.g.*, obviousness)," "extends well beyond an explanation of the references" and "focuses on improper legal conclusions and opinions." These arguments from the patent owner have been considered, but are found to be not persuasive.

The Declaration of Mark J. Poznansky was filed with the request for reexamination of the '264 patent on July 9, 2007 by the third party requester. 35 USC 311(b)(2) and 37 CFR 1.915(b) sets forth the requirements for a request for *inter partes* reexamination. Such a request must contain a detailed explanation of the pertinency and manner of applying the cited patents and printed publications to every claim for which reexamination is requested. *See* 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). The request may include affidavits or declarations or other written evidence which explain the contents of the cited patents or printed publication in more detail. *See* MPEP §§ 2205, 2258, and 2617. Other matters, such as public use or sale, inventorship, 35 USC 101, 35 USC 112, fraud, etc., will not be considered when making the determination on the request and should not be presented in the request. *See* MPEP § 2617.

Furthermore, for proposed obviousness rejections, requester must provide a rationale (a basis) to combine the cited prior art and a statement of why the claims would have been obvious over the proposed reference combination. *See* MPEP § 2617. As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ459 (1966), and obviousness is a legal determination based on several underlying factual inquiries including resolving the level of ordinary skill in the pertinent art. *See* MPEP § 2141 (8th Ed., Rev. 6, September 2007). Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art, and in an obviousness rejection, why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art must be explained. *See* MPEP § 2141 (8th Ed., Rev. 6, September 2007).

The declaration states that Dr. Poznansky considers the twenty-six references listed in the declaration. In the declaration, Dr. Poznansky provides detailed explanation of the prior art

references and explanations of how the prior art references provide suggestions and reasons to make certain improvements. Dr. Poznansky also provides his factual findings on what one of ordinary skill in the art would recognize from the prior art references and how one of ordinary skill in the art would have a rationale to combine certain references. The declaration does not contain matters such as public use or sale, inventorship, 35 U.S.C. 101, 35 U.S.C. 112, fraud, etc. The declaration mainly contains detailed explanations of the prior art and manner of applying the cited patents and printed publication to the claims of the patent in the context of obviousness rejections. If there are any statements on an ultimate legal conclusion in the declaration, such statements will be considered by the Office only as an opinion as to the obviousness of the rejections; clearly, the ultimate legal conclusion lies with the Office, and any legal tribune later appropriately considering the matter.

In regard to the patent owner's argument on the issue that the examiner may not rely on an affidavit or declaration for the purpose of determining validity of patent claims, the examiner is permitted to make a rejection based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. *See* MPEP §§ 2258 and 2617. 35 U.S.C. 314 provides that reexamination will be "conducted according to the procedures established for initial examination under the provisions of sections 132 and 133" and 35 U.S.C. 132 provides that "[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, **together with such information and references as may be useful"** (emphasis added). A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. However, the examiner is not precluded from considering other "information" (*e.g.*, affidavits, declarations and transcripts) to help define the scope and content of the prior art, or to establish that a claimed invention is unpatentable under 35 U.S.C. 102 or 103. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991); *In re Chambers*, 20 U.S.P.Q.2d 1470, 1474 (Com'r Pat. & Trademarks, 1991); *Heinl v. Godici*, 143 F.Supp.2d 593 (E.D. Va. 2001). Furthermore, if the examiner were to improperly made a rejection in an Office action that is not based upon patents and/or printed publications, such as a rejection under 35 U.S.C. 101, the patent owner should raise this issue in the response to any such Office action, rather than seeking to strike the Declaration of Mark Poznansky that was filed with the request for reexamination for appropriate reasons - to explain the pertinency and manner of applying the cited patents and printed publications to the patent claims.

Based upon the above facts and the individual facts and circumstances of this proceeding, the Declaration of Mark J. Poznansky filed with the request for *inter partes* reexamination is not deemed improper, and it will not be removed from the file records.

Accordingly, the Petition to Strike filed by the patent owner on February 1, 2008, is dismissed, and the Opposition Petition filed by the third party requester on February 8, 2008, is granted.

CONCLUSION

1. The Petition to Strike under 37 CFR 1.181 and 37 CFR 1.82 filed by the patent owner on February 1, 2008, is dismissed.

2. The Opposition Petition filed by the third party requester on February 8, 2007, is granted.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to process the patent owner's response filed on April 16, 2008, and the third party requester's comments filed on May 15, 2008. After the Central Reexamination Unit has processed all party papers, 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 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

6-02-08

RAM Fee History Query

Revenue Accounting and Management

Name/Number: 95000276 Total Records Found: 7

Start Date: Any Date End Date: Any Date

Accounting Date	Sequence Num.	Fee Type	Fee Code	Fee Amount	Mailroom Date	Payment Method
02/11/2008	00005586	4	1462	$400.00	02/08/2008	DA 503013
02/11/2008	00005436	4	1462	$400.00	02/08/2008	DA 503013
02/11/2008	00005511	4	1462	$400.00	02/08/2008	DA 503013
02/04/2008	00002276	4	1462	$400.00	02/01/2008	DA 220185
02/04/2008	00002277	4	1463	$200.00	02/01/2008	DA 220185
02/04/2008	00002455	4	1462	$400.00	02/01/2008	DA 220185
07/18/2007	00000005	1	1813	$8,800.00	07/09/2007	DA 503013

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(For Patent Owner)

MAILED

SEP 24 2008

CENTRAL REEXAMINATION UNIT

Jones Day
222 East 41st Street
New York, NY 10017

(For Third Party Requester)

In re Amylin Pharmaceuticals, Inc.
Inter Partes Reexamination Proceeding
Control No.: 95/000,276
Filed: July 9, 2007
For: U.S. Patent No.: 6,924,264 B1

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

This is a decision on the June 25, 2008 patent owner paper entitled "PETITION TO STRIKE THE THIRD PARTY REQUESTOR'S SUPPLEMENTAL PAPERS PURSUANT TO 37 CFR §§ 1.181 AND 1.182," (hereinafter "petition"). This decision also treats the July 11, 2008 third party requester paper entitled "PETITION UNDER 37 CFR §1.182, (hereinafter "opposition petition").

The petition, the opposition paper, and the 95/000,276 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

FEES

A petition fee of $ 400.00 (37 CFR 1.17(f)) will be charged to Deposit Account No. 22-0185 and a petition fee of $ 400.00 will be charged to Deposit Account No. 50-3013 as authorized in the patent owner petition and the third party requester opposition, respectively.

BACKGROUND

1. Patent number 6,924,264 ("the '264 patent") issued on August 2, 2005.

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2. A request for *inter partes* reexamination of the '264 patent was filed on July 9, 2007, and was assigned control No. 95/000,276 (the '276 *inter partes* reexamination proceeding).

3. An Order Granting *Inter Partes* Reexamination in the '276 *inter partes* reexamination proceeding was mailed on October 3, 2007.

4. On January 17, 2008, a non-final Office action on the patentability of the claims for which reexamination was ordered was mailed in the '276 *inter partes* reexamination proceeding.

5. On April 16, 2008, patent owner filed a response to the January 17, 2008 Office action as provided for by 37 CFR 1.945. The response was timely filed by reason of a previously secured extension of time.

6. On May 15, 2008, 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 June 25, 2008, patent owner filed the present petition.

8. On July 11, 2008, third party requester filed the present opposition petition opposing the June 25, 2008 patent owner petition.

9. Also on July 11, 2008, third party requester filed a petition to substitute a legible copy of a paper that was not completely legibly scanned into the Image File Wrapper (IFW).

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. [Emphasis added.]

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.
> (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 1.947 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. [Emphasis added.]

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. Relief Requested by Patent Owner and Third Party Requester

A review of the record shows that the Office mailed a first action on claim patentability on January 17, 2008. On April 16, 2008, patent owner paper filed a timely response to the January 17, 2008 non-final Office action, after securing an extension of time to do so. On May 15, 2008, third party requester then exercised its right under 37 CFR 1.947 [1] to file written comments after the Office action and patent owner's response thereto. Requester's written comments include, *inter alia*, a paper styled as "Second Declaration of Omar Quraishi" (hereinafter "Quraishi declaration") and a paper styled as "Third Declaration of Mark J. Poznansky" (hereinafter "Poznansky declaration"). The relief requested in the present patent owner petition is to strike the Poznansky and Quraishi declarations in their entirety "as being supplemental" to the third party requester's comments. [2] Alternatively, the present petition requests that the Quraishi declaration be stricken in its entirety "for extending beyond issues raised" by the January 17, 2008 Office action. [3]

Third party requester's opposition petition opposes each aspect of the relief requested by patent owner. Requester takes the position that the declarations in question were filed with requester's written comments to explain the scope and content of prior art patents and printed publications that were properly relied on by requester as being directed to issues raised by the January 17,

---

[1] 37 CFR 1.947 implements the provisions of 35 U.S.C. § 314(b)(2), the section of the reexamination statute that permits a third party requester to participate during the patentability determination stage of an *inter partes* reexamination proceeding by filing comments directed to both the Office action and the patent owner's response to the Office action.

[2] "Petition to Strike ... ," June 25, 2008 at page 1.

[3] Id.

2008 Office action and patent owner's response thereto. [4] Requester also asserts that the Quraishi declaration does not address any issues beyond those raised by patent owner's response to the January 17, 2008 Office action.

III. Analysis and Findings

It is stated in MPEP § 2666 that 37 CFR 1.111 applies in *inter partes* reexamination practice, and that a supplemental amendment paper, *i.e.*, a second or additional amendment paper, cannot be filed as a matter of right. In similar fashion, 37 CFR 1.947 permits a third party requester to "once" file written comments directed to an Office action or the patent owner's response to that Office action. [5] The regulation would, therefore, preclude the filing of more than one set of written comments directed to the same Office action and/or the same patent owner response to that Office action, in the same manner that 37 CFR 1.111(a)(2) precludes the filing of more than one amendment paper directed to the same Office action as a matter of right. It is found, however, that neither the Poznansky declaration nor the Quraishi declaration is a "supplemental" paper with respect to the written comments filed by requester on May 15, 2008. Rather, those declarations are part of the filing of the written requester comments, just as the filing of the two declarations submitted by patent owner as part of the April 16, 2008 response to the January 17, 2008 Office action are not "supplemental" to that response. Therefore, patent owner's characterization of the Poznansky declaration and the Quraishi declaration as being "supplemental papers" is without merit.

Further, the Quraishi declaration is plainly directed to the patent owner's January 17, 2008 response. [6] That the Quraishi declaration may be based on "entirely new experiments" [7] in no way establishes otherwise. Patent owner has not cited any authority for its position that a requester is precluded from addressing a patent owner's response to an Office action via a declaration directed to rebutting some part of the response, where the declaration is based on "new experimentation and theories not previously presented" [8] The Quraishi declaration directed to rebutting arguments in the April 16, 2008 patent response [9] may be submitted. Requester having initially presented certain evidence to demonstrate claim unpatentability cannot reasonably have been expected to have anticipated all arguments that might be advanced by patent owner to thereby rebut such evidence *ab initio*. There is nothing in the regulations that would preclude requester from conducting new tests that produce evidence

---

[4] "Petition Under 3 C.F.R. § 1.182," filed July 11, 2008, at pages 2-3.

[5] It should be noted that if the Office action in question is an Action Closing Prosecution (37 CFR 1.949), then the third party requester's written comments to the patent owner's response must address only the response, and not the Action Closing Prosecution (37 CFR 1.951(b). However, the January 17, 2008 Office action is not an Action Closing Prosecution.

[6] It is noted that the copy of the Quraishi declaration filed on May 15, 2008 that is of record in the Image File Wrapper contains a distortion on page 13 of the declaration that renders the page partially illegible. That matter is the subject of the above-identified separate requester petition of July 11, 2008 (*i.e.*, filed concurrently with the present third party requester petition) to substitute a completely legible copy of the Quraishi declaration. That petition will be provisionally granted. Accordingly, all references in this decision to the substance contained in the Quraishi declaration should be understood as referring to the July 11, 2008 completely legible copy of that declaration.

[7] "Petition to Strike ... ," June 25, 2008 at page 4.

[8] Id.

[9] For example, at page 15 of patent owner's remarks accompanying the April 16, 2008 response to the January 17, 2008 Office action, it is argued that the rejection is improper because "**Göke 1993** (23) does not inherently disclose an albumin-exendin-4 conjugate." at page 9 of the Quraishi declaration, declarant argues based on new experiments that **Göke 1993** in fact demonstrates the existence of albumin-exendin-4 conjugates. This argument is clearly responsive to the argument advanced by patent owner in response to the January 17, 2008 Office action.

addressing a patent owner's argument against evidence initially relied on by requester that was produced by tests that had been conducted earlier. Such is within the language of 37 CFR 1.947 as being "limited to issues raised by the Office action or the patent owner's response." Accordingly, patent owner has not persuasively established an alternative basis for striking the Quraishi declaration.

CONCLUSION

1. The patent owner petition filed on June 25, 2008 is dismissed.

2. Jurisdiction of the '276 *inter partes* reexamination proceeding will be returned to the Central Reexamination Unit for appropriate action on the patent owner response filed on April 16, 2008, and the third party requester written comments filed on May 15, 2008.

3. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

/Kenneth M. Schor/

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

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September 17, 2008

Sept. 22, 2008
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222 East 41st Street
New York, NY 10017

In re Amylin Pharmaceuticals, Inc.	: **DECISION**
Inter Partes Reexamination Proceeding	: **GRANTING**
Control No.: 95/000,276	: **PETITION**
Filed: July 9, 2007	:
For: U.S. Patent No.: 6,924,264 B1	:

This is a decision on the July 11, 2008 third party requester petition styled "PETITION UNDER 37 CFR §1.182, (hereinafter "petition"). [1]

The petition and the 95/000,276 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

FEES

A petition fee of $ 400.00 (37 CFR 1.17(f)) will be charged to Deposit Account No. 50-3013 as authorized at page 2 of the petition.

BACKGROUND

1. Patent number 6,924,264 ("the '264 patent") issued on August 2, 2005.

2. A request for *inter partes* reexamination of the '264 patent was filed on July 9, 2007, and was assigned control No. 95/000,276 (the '276 *inter partes* reexamination proceeding).

3. An Order Granting *Inter Partes* Reexamination in the '276 *inter partes* reexamination proceeding was mailed on October 3, 2007.

[1] Requester filed two identically styled petitions invoking 37 CFR 1.182 on July 11, 2008. The present petition is a principal petition seeking relief, and is not the requester 37 CFR 1.182 petition opposing patent owner's June 25, 2008 petition.

4. On January 17, 2008, a non-final Office action on the patentability of the claims for which reexamination was ordered was mailed in the '276 *inter partes* reexamination proceeding.

5. On April 16, 2008, patent owner filed a response to the January 17, 2008 Office action as provided for by 37 CFR 1.945. The response was timely filed by reason of a previously secured extension of time.

6. On May 15, 2008, third party requester timely filed written comments directed to the August 6, 2007 patent owner response. The written comments include a number of attached papers, one of which is entitled "Second Declaration of Omar Quraishi" (hereinafter "Quraishi declaration").

7. On June 25, 2008, patent owner filed a petition to strike requester comments..

8. On July 11, 2008, third party requester filed an opposition petition opposing the June 25, 2008 patent owner petition.

9. Also on July 11, 2008, third party requester filed the present petition.

DECISION

I. Relevant Authority

37 CFR 1.182 provides:

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

37 CFR 10.18 provides, in part:

> (a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of § 1.4(d), § 1.4(e), or § 2.193(c)(1) of this chapter.
> (b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that–
> (1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom

II. Relief Requested by Third Party Requester

A review of the record shows that the Office mailed a first action on claim patentability on January 17, 2008. On April 16, 2008, patent owner filed a timely response to the January 17, 2008 non-final Office action, after securing an extension of time to do so. On May 15, 2008, third party requester then exercised its right under 37 CFR 1.947 [2] to file written comments after the Office action and patent owner's response thereto. Requester's written comments included, *inter alia,* the Quraishi declaration.

Third party requester has now attached Appendix A and Appendix B to the present petition to support the requested relief. Appendix A contains a copy of the Quraishi declaration "as filed" on May 15, 2008, as part of the papers attached to requester's May 15, 2008 written comments. Appendix B contains a copy of the Quraishi declaration as it appears in the Image File Wrapper among the requester May 15, 2008 written comment papers. The relief requested by third party requester in the present petition is to correct the record in the Image File Wrapper (IFW) of the '276 *inter partes* reexamination proceeding by substituting "a clean copy" of the Quraishi declaration, as it appears in Appendix A, for the copy of the Quraishi declaration dated May 15, 2008 that presently appears in the IFW of the '276 *inter partes* reexamination proceeding.

III. Analysis and Findings

Appendix B has been compared with the image of the Quraishi declaration that appears in the IFW as part of requester's May 15, 2008 written comments. It is agreed that Appendix B and the image of the Quraishi declaration of record on May 15, 2008 appear to be essentially identical. Both contain distortions at pages 12, 17 and 18. [3] Also, Appendix A has been compared with Appendix B and lacks those distortions.

Requester states in the present petition that the Quraishi declaration as filed on May 15, 2008 did not contain the distorted text that appears on pages 12, 17 and 18 of the May 15, 2008 image of the Quraishi declaration of record in the IFW. In light of the provisions of 37 CFR 10.18, the Office accepts this statement, in absence of information to the contrary. Accordingly, the Office accepts Appendix A as attached to the present petition as being the image of the document that was filed as part of requester's May 15, 2008 written comments, subject to patent owner's right to comment as follows:

Patent owner is provided with a non-extendable period of fifteen (15) days from the mailing date of this decision to contest the acceptance of the Appendix A as being a correct copy of the document that was actually filed by requester on May 15, 2008. If patent owner files such comments, requester may not file comments thereon unless invited to do by the Office. Absent a persuasive showing by patent owner, the examiner in the present '276 *inter partes*

[2] 37 CFR 1.947 implements the provisions of 35 U.S.C. § 314(b)(2), the section of the reexamination statute that permits a third party requester to participate during the patentability determination stage of an *inter partes* reexamination proceeding by filing comments directed to both the Office action and the patent owner's response to the Office action.

[3] These page numbers refer to the page numbers appearing on the July 11, 2008 documents filed as Appendix A and Appendix B to the present petition, and not to the pages numbers of the images of those documents. The image of each of Appendix A and Appendix B includes a cover sheet; hence page 1 of each image is not page 1 of the Quraishi declaration and page 24 of each image is page 23 (the last page) of the Quraishi declaration.

reexamination proceeding will be instructed to treat Appendix A as being a correct copy of the document that was actually filed by requester on May 15, 2008.

CONCLUSION

1. The third party requester petition is granted.

2. Within fifteen (15) days of the date of this decision, patent owner may make a showing why the Quraishi declaration that has been attached to the present petition as Appendix A should not be considered to be a correct copy of the document as filed by requester on May 15, 2008.

3. Jurisdiction of the '276 *inter partes* reexamination proceeding will remain with the Office of Patent Legal Administration pending a response by patent owner.

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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September 18, 2008

United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

RAHUL PATHAK
JONES DAY
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(For Requester)

In re Prickett et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,276
Filed: July 9, 2007
For: U.S. Patent No. 6,924,264

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the May 5, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On July 9, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,276 ("the '276 proceeding").

- Prosecution progressed until, on March 5, 2009, an Action Closing Prosecution (ACP) was issued.

- On March 31, 2009, the Office issued a decision granting a patent owner request for extension of time under 37 CFR 1.956(c) filed on March 18, 2009, extending the period for response set forth in 37 CFR 1.951(a) until May 5, 2009.

- On May 5, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of an amendment, evidence, and remarks filed with the petition.

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 1.951(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.

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.

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

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

relief. 37 CFR 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP.

The May 5, 2009, patent owner petition is filed under 37 CFR 1.182 requesting entry of amendments, evidence, and remarks submitted on May 5, 2009. 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 submission. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

Furthermore, the May 5, 2009 patent owner petition, although filed under 37 CFR 1.182 requesting entry of amendments, evidence, and remarks submitted on May 5, 2009, has been filed within the time period set forth for response in the ACP. For this reason, 37 CFR 1.951(a) specifically provides for the consideration of the comments and amendments. The submission will be addressed by the Central Reexamination Unit as a response under 37 CFR 1.951(a).

Since the situation is currently in the process of being addressed through 37 CFR 1.951, consideration of the situation under 37 CFR 1.182 would be premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date, relief has not been granted under 37 CFR 1.951 or through another section. Until such time, the issue is not ripe for consideration by the Office.

Accordingly, the petition is **dismissed** as being premature.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Prosecution is not being reopened by this decision

3. Jurisdiction is being forwarded to the Central Reexamination Unit to process the May 5, 2009 patent owner amendment, evidence, and remarks (filed with the petition) as a submission under 37 CFR 1.951(a), and for the examiner to treat it as such.

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 Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

June 5, 2009
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United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Prickett *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,276
Filed: July 9, 2007
For: U.S. Patent No. 6,924,264

DECISION ON PETITION TO CONTINUE *INTER PARTES* REEXAMINATION PROCEEDINGS

This is a decision on the January 6, 2010 patent owner renewed petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition is **granted**.

FEES

The fee set forth in 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.182 is $400, and it was charged to Patent Owner's credit card on January 6, 2010 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

BACKGROUND

1. On August 2, 2005 the Office issued U.S. Patent No. 6,924,264 (the '264 patent) to Prickett *et al.* The '264 patent issued with a total of twenty-three claims.

2. On July 9, 2007, a request for *inter partes* reexamination was filed by the third party requester, and assigned control number 95/000,276 ("the '276 proceeding"). The request asserted that a substantial new question of patentability existed regarding claims 1-8, 10, and 12-23 of the '264 patent.

3. On October 3, 2007, the Office issued an order granting the request for reexamination in the '276 proceeding, concluding that a substantial new question of patentability was raised by the request regarding claims 1-8, 10, and 12-23. An Office action on the merits

was not concurrently issued with the order, but the order stated it would be issued in due course.

4. On January 17, 2008, the Office issued a first Office action on the merits rejecting claims 1-8, 10, 12-23.

5. On April 16, 2008, patent owner timely filed a response that included an amendment canceling all the originally issued twenty-three claims and adding new claims 24-38.[1]

6. On May 15, 2008, third party requester timely submitted comments and declarations.[2]

7. The proceeding progressed until, on March 5, 2009, an Action Closing Prosecution (ACP) was issued.

8. On May 5, 2009, patent owner timely filed a response after ACP including an amendment, three affidavits and remarks.[3] Concurrently patent owner filed a petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of an amendment, remarks and affidavits filed with the petition.

9. On June 3, 2009, third party requester timely submitted comments.

10. On June 8, 2009, the Office issued a decision dismissing the May 5, 2009 patent owner petition as premature.

11. On December 17, 2009, the Office issued a Right of Appeal Notice (RAN) denying entry of patent owner's May 5, 2009 amendments, remarks and affidavits filed in response to the March 5, 2009 ACP.

12. On January 6, 2010, patent owner field a renewed petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of an amendment, remarks and affidavits. Concurrently, patent owner filed a petition entitled, "PETITION UNDER 37 CFR § 1.183 REQUESTING WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF AND FOR AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF."

13. On February 4, 2010, the third party requester filed an opposition to patent owner's January 6, 2010 petition requesting continued reexamination, which is being addressed by a decision mailed concurrently with this decision.

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[1] Patent owner was granted an extension of time to file a response to the January 17, 2008 Office action until 17 April 2008.

[2] A third declaration executed by Mark J. Poznansky and a second declaration executed by Omar Quraishi.

[3] Patent owner was granted an extension of time to file a red for response to the March 5, 2009 ACP until May 5, 2009.

14. On February 22, 2010, the Office issued a decision granting patent owner's request for waiver of 37 CFR 41.46 and granted patent owner an extension of time to file an appeal brief.

15. This decision addresses patent owner request for continued reexamination under 37 CFR 1.182 and entry of amendment, remarks and affidavits concurrently filed with the petition.

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 1.951(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.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the Amendment after ACP received in the Office on May 5, 2009 along with other after-final communications submitted in response to the March 5, 2009 ACP.

In March of 2005, the Office issued a Notice titled[4] "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." Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an

[4] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

inter partes reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an inter partes reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Based on the facts and circumstances of the present case, petitioner patent owner's response in the form of a request to enter an amendment, remarks and evidence after final rejection, i.e., the May 9, 2009 response to ACP, constitutes a *bona fide* effort to advance prosecution and as such, the granting of the present petition is consistent with the requirement of 35 USC 314(c) to conduct an *inter partes* reexamination proceeding "with special dispatch within the Office."

On March 5, 2009, the examiner issued an ACP with eight different new grounds of rejection. The first ground of rejection was a statutory non-art rejection of all the claims under 35 U.S.C. 305. The second to the eight grounds of rejection, all utilized newly submitted declarations filed by the third party requester on May 15, 2008 to evidence or support the rationale of the grounds of rejection. The sixth through eighth grounds of rejection improvidently used the third Poznansky declaration as part of the combination of references that serve as a basis of the rejection. Patent owner has never had a fair opportunity to respond to the grounds of rejection that either utilize newly cited declarations to support the rationale of the new grounds of rejection or improvidently serve as part of the basis for the new grounds of rejection, nor could patent owner have reasonably foreseen that third party requester's newly submitted declarations would be used in this manner.

Furthermore, patent owner's amendment is a reasonable advancement of prosecution on the merits. On page 13 of the March 5, 2009 ACP, the examiner addressed claim 28, a dependent claim that included the limitations of originally issued independent claim 23, plus the limitations of claim 13 with the limitation drawn to the exendin-4 "linked to the one or more polymers at the N or C terminal residue, or the N or C termini of a side chain of one or more amino acids of the exendin-4 or agonist analog of exendin-4, wherein the amino acid is selected from the group consisting of lysine, aspartic acid, glutamic acid and cysteine." The examiner stated the second grounds of rejection that claim 28 was rejected under 35 USC 102(a) as anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Edwards, relying on Poznansky I,

Harlow & Lane declaration and a newly submitted third declaration of Mark Poznansky for evidence of inherency or in the alternative evidence of obviousness. The examiner stated that Edwards discloses exendin-4 cross-linked with glutaraldehyde to bovine serum albumin and that Poznansky I evidenced the inherent property of glutaraldehyde as a cross-linking agent that cross links peptides at the epsilon amino group of a lysine side chain or free amino group of the amino terminus. The examiner further stated that Poznansky I evidences the form of the exendin-4-BSA molecules cross-linked with glutaraldehyde as polymers linked through an epsilon amino group on a lysine amino acid, at an amino, carboxyl or thiol group, at the N or C terminal residue, or the N or C termini of a side chain, of lysine, aspartic acid, glutamic acid or cysteine, at one or more amino acid side chain moieties, or one or more amine or carboxylic groups as particularly recited in claims 26-29. The examiner went on to cite as support for a rationale of inherency or obviousness for the first time in prosecution the third Poznansky declaration, which was submitted by with third party requester's responsive comments to the January 17, 2008 Office action.

The post ACP amendment submitted by patent owner presents new claims 24-39, and specifically new claim 24 in reliance upon the examiner's statements regarding the inherency arguments as evidenced by Poznansky I and now claims exendin-4 "linked through the C-terminal amino acid to one polymer selected from the group consisting of polyethylene glycol, a polyamino acid, albumin, gelatin, succinyl-gelatin and (hydroxypropyl)-methacrylamide." Therefore, the amendment by patent owner is advancing prosecution by further amending claim 24 to include a specific location of chemical bond linkage between exendin-4 and one polymer. This further amending of claim 24 is also submitted for the purpose of obviating all other rejections of record.

Finally, patent owner submitted three affidavits to provide additional evidence in respond to the new grounds of rejection. Patent owner has good and sufficient reason for not being able to submit the affidavits early. Specifically because it was not reasonably foreseeable that they would be necessary to respond to the grounds of rejection asserted in the ACP all utilized newly submitted declarations filed by the third party requester, wherein three of the newly asserted grounds of rejection improvidently used the third Poznansky declaration as part of the combination of references to serve as a basis of the rejection. The RAN dated December 17, 2009 stated that entry of the May 9, 2009 response after ACP was denied, because the proposed amendment introduces new claim limitations not previously considered during the reexamination proceeding; the changes were not limited to cancelling claims, adopting examiner's suggestions, and the changes do not remove issues for appeal; and the proposed amendment required more than a cursory review by the examiner and it's entry would require consideration of the new grounds for rejection.

Based upon the facts and circumstances of the present case, the post ACP amendment, remarks and declarations presented by Petitioner/patent owner, consistent with and limited by patent owner to a response to the reasonably unforeseeable new asserted grounds of rejection and based upon the reasonable reliance of the actions taken by the examiner in the ACP, is deemed a *bona fide* attempt to advance the prosecution toward the issuance of a reexamination certificate. As such, the granting of the present petition is consistent with the requirements of 35 USC 314(c) to conduct an *inter partes* reexamination proceeding "with special dispatch within the Office."

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the amendment, affidavits and remarks submitted after ACP on May 5, 2009. The May 5, 2009 response to ACP will be entered in the reexamination proceeding, and the proceeding will be forwarded to the CRU to await submission of any third party comments under 37 CFR 1.947 after the May 5, 2009 patent owner response. Following the submission of third party requester comments or the lapse of the time period for third party comment, the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the May 5, 2009 patent owner response and any third party comments. The Examiner will then issue an Office action treating the May 5, 2009 patent owner papers as a response and third party comments received after a first Office action.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the '276 *inter-partes* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a showing of **extraordinary** circumstances.

3. The closing of prosecution rendered via the Office action mailed March 5, 2009 is withdrawn, and prosecution of the proceeding is reopened. The amendment will be treated as a response by patent owner received **after** a first Office action.

4. Third party requester has thirty (30) days from the date of mailing of this decision to submit comments pursuant to 37 CFR 1.947.

5. The Amendment After ACP received May 5, 2009[5] will be entered by the Central Examination Unit, await submission of third party comments and then be forwarded to the examiner for consideration of both the amendment and any third party comments.

6. Jurisdiction for the '276 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

7. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

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

Kenpet8/RCR/IP 3-11-10

[5] This decision takes no position on the propriety of the amendment or whether it introduces new matter. Any issues raised by the amendment will be addressed by the Examiner in the next Office action.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,278	07/12/2007	7065417		3408

32376 7590 01/04/2008

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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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG LLP
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,278*.

PATENT NUMBER *7,065,417*.

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

Tolar, Schaffer, LLP
8500 Bluffstone Cove
Suite A201
Austin, TX 78759

(For Patent Owner)

MAILED

JAN 0 4 2008

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 1000 West Tower
Washington, DC 20005

(For Requester)

In re: Moon *et alia*
Reexamination Proceeding
Control No. 95/000,278
Request Deposited: July 12, 2007
For: U.S. Patent No. 7,065,417

DECISION ON PETITION

The *Inter Partes* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed December 11, 2007 to stay the reexamination pending conclusion of district court litigation, or alternatively, to extend the time to respond to office action by four months.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,065,417 (hereinafter, the '417 patent), issued to Moon *et alia* on June 20, 2006.

2. On July 12, 2007, a third party deposited a Request for *Inter Partes* Reexamination of the '417 patent. The reexamination proceeding was assigned Control No. 95/000,278 (hereinafter, the '278 proceeding).

3. The reexamination order was granted in the '278 proceeding on September 28, 2007.

4. On November 8, 2007, a non-final office action was mailed setting a two-month shortened statutory period for response.

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.

The petition raises two separate and distinct issues which are addressed by different branches of the office. The petition to stay the reexamination proceeding in its entirety is decided by a different branch than the request for an extension of time.

Accordingly, the petition as it requests the reexamination proceeding be stayed in its entirety is dismissed under 37 CFR 1.4(c). Patent Owner may file such a petition as a separate paper. It should be noted that the merits of such a petition are not addressed in the present decision.

The petition alternatively requests a four-month extension of time to respond to the office action of November 8, 2007. The alternative request is decided below.

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 in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch ....

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

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

Patent Owner states that they are in the process of obtaining information that may result in the filing of secondary considerations of non-obviousness. Patent Owner also states that the office action with a mailing date of November 8, 2007 was not posted on the PAIR website until November 13, 2007. Reference is made to the petition for details of these and other issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a complete response. Although Patent Owner requests a four-month extension of time, Patent Owner also urges "the PTO to take a 'wait and see' approach" (see page 19 of the instant petition). Patent Owner argues that extending the time for response "would give the PTO insight on the pace of discovery and certain critical District Court decisions, upon which the PTO could decide whether the time for response should be further extended, or whether the reexamination should be stayed in its entirety" (see page 20 of the instant petition). An extension of time of one month is considered sufficient at the present time. 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.

Accordingly, the time for filing a response is extended for one month is due on or before February 9, 2008 (February 8, 2008 being a Sunday).

CONCLUSION

1. Petitioner's request to suspend (or stay) the reexamination proceeding in its entirety is dismissed under 37 CFR 1.4(c).

2. Petitioner's request to extend the period for response by four months is granted-in-part. A one-month extension is granted with the present decision.

3. The non-final office action mailed November 8, 2007 is before Patent Owner for response. The response is due on or before February 9, 2008 (February 8, 2008 being a Sunday).

4. 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

5. 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

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.
95/000,278	07/12/2007	7065417		3408

32376 7590 02/19/2008

LAWRENCE R. YOUST
2001 Ross Avenue
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Lawrence R. Youst (For Patent Owner)
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Suite 3000
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1300 Eye Street NW
Suite 1000 West Tower
Washington, DC 20005

In re: Moon *et alia*
Reexamination Proceeding
Control No. 95/000,278
Request Deposited: July 12, 2007
For: U.S. Patent No. 7,065,417

DECISION GRANTING IN PART PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.956

The *Inter Partes* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed February 1, 2008 to extend the time to respond to office action by one month.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,065,417 (hereinafter, the '417 patent), issued to Moon *et alia* on June 20, 2006.

2. On July 12, 2007, a third party deposited a Request for *Inter Partes* Reexamination of the '417 patent. The reexamination proceeding was assigned Control No. 95/000,278 (hereinafter, the '278 proceeding).

3. The reexamination order was granted in the '278 proceeding on September 28, 2007.

4. On November 8, 2007, a non-final office action was mailed setting a two-month shortened statutory period for response.

5. On December 11, 2007, PO filed a petition to stay the reexamination or to extend the time to respond by four months.

6. On January 4, 2008, the period for response was extended by one month.

7. On February 1, 2008, PO filed a second petition requesting an extension of time to respond to the Office action issued on November 8, 2007.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed November 8, 2007. The request for extension is the second request for an extension of time. The present petition for extension of time was timely filed on February 1, 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.

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

Patent Owner states that they are in the process of obtaining information that may result in the filing of evidence of secondary considerations of non-obviousness. Specifically, petitioner states that they "will receive all Defendants' documents (Apple and Co-Defendants) beginning February 4, 2008." Reference is made to the petition for details of these and other issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for the additional extension of time. It is clear Patent Owner requires some additional time to prepare a complete response. Although Patent Owner requests a one-month extension of time, balancing the desire to provide the patent owner with additional time to respond must be weighed against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch. An extension of time of **15 days** is considered sufficient at the present time. 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.

Accordingly, the time for filing a response is extended for two weeks. The response to the office action mailed November 8, 2007 and is due on or before Monday February 25, 2008 (February 23 being a Saturday).

Other Issues

The petition references a "co-filed Petition to Stay the Reexamination Pending Conclusion of District Court Litigation". Examination cannot be suspended when there is an outstanding Office action necessitating a reply (as is presently the case in the '278 proceeding). Therefore, a decision on the Petition to Stay the Reexamination proceeding will not be rendered at this time, but will be deferred until such time as it can be treated on the merits.

The petition references a proposed Protective Order that could render some information "confidential" that may be presented as evidence of secondary considerations of non-obviousness. If any such information is presented at a later time and the information is found to be material to patentability, the information may be made of record (and therefore will be made public). Material which supports patentability will almost always be entered in the record. If the information is found not to be material to patentability, then the examiner will be able to discuss on the record why it is not material to patentability.

In order to comply with the statutory requirement that the proceeding be conducted with special dispatch, yet still permit Patent Owner to present evidence which could support patentability, the office will consider entry of evidence to support nonobviousness after the Action Closing Prosecution. Such a submission of evidence should be accompanied, if necessary, with a petition under 37 CFR 1.183 to waive the requirement in 37 CFR 1.951 that comments be "limited to issues raised in the Office action closing prosecution".

The current correspondence address of record for Patent Owner is

Lawrence R. Youst
2001 Ross Avenue
Suite 3000
Dallas, TX 75201

This change of address was made with the revocation of power of attorney and new power of attorney filed August 1, 2007. Toler, Schaffer, LLP (the previous correspondence address of record) is being sent a courtesy copy of the present decision. No future correspondence will be sent to Toler, Schaffer, LLP.

CONCLUSION

1. Petitioner's request to extend the period for response by one month is granted-in-part. A fifteen-day extension is granted with the present decision.

2. The non-final office action mailed November 8, 2007 is before Patent Owner for response. The response is due on or before February 25, 2008 (February 23 being a Saturday).

3. 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

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

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

CC: Toler, Schaffer, LLP
8500 Bluffstone Cove
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CENTRAL REEXAMINATION UNIT

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In re Moon et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,278
Filed: July 12, 2007
For: U.S. Patent No. 7,065,417

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

This is a decision on the February 1, 2008 patent owner petition, taken under 37 CFR 1.182, which is titled "PETITION TO STAY THE REEXAMINATION PENDING CONCLUSION OF DISTRICT COURT LITIGATION" (the "Petition").

37 CFR 1.987 provides that "[I]f a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the inter partes reexamination proceeding." Thus, 37 CFR 1.987 provides authority for suspension of an *inter partes* reexamination proceeding where the patent being reexamined "is or becomes involved in litigation." The mechanism for requesting such a suspension, however, is not provided by the rules. Accordingly, the present petition is taken as a petition under 37 CFR 1.182. It is noted that the requisite petition fee of $400 has been paid by patent owner.

The petition and *inter partes* reexamination control number 95/000,278 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 considered, but is dismissed with respect to granting the underlying relief requested.

SUMMARY

Patent owner's petition requests suspension/stay "pending entry of a final judgment or dismissal of all parties to the District Court proceeding"; i.e., that the Office should refrain from taking any action in the '278 proceeding and first consider acting on the proceeding after termination of litigation in the District Court.

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 proceed forward in *inter partes* reexamination proceedings with special dispatch *absent good cause for suspension.*

In *Sony,* two *inter partes* reexamination requests were filed after the District Court 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. In the instant proceeding, the reexamination request was filed 5 months after the filing of the civil suit, prior to the commencement of discovery and almost 2 years before the scheduled trial date.

Petitioner's proposal amounts to a request for a pre-emptive termination of *the inter partes* reexamination in anticipation of the possibility of estoppel by a final decision of the courts some years in the future. While the statute may allow for suspension for "good cause," it does not allow for effectively terminating the proceeding in favor of an eventual decision (i.e., pre-estoppel). Furthermore, suspension for an indefinite lengthy period is inconsistent with the statutory mandate of special dispatch.

The statutory scheme contemplates a situation where both reexamination and court proceedings may take place at the same time. Granting petitioner's request would eviscerate the statutory scheme by refraining from carrying out reexamination, in deference to the possibility of resolution of court proceedings favorable to a party.

Furthermore, the types of evidence patent owner seeks in discovery, while speculative, are relevant to each and every determination of obviousness. The logical extension of patent owner's argument is for the Office to set aside all *inter partes* reexamination in any patent involved in litigation where the requester is party to the litigation and a question of obviousness has been raised.

Accordingly, the petition to suspend *inter partes* reexamination, until the entry of a final judgment in the concurrent district court litigation, is **dismissed.**

BACKGROUND

1. U.S. patent No. 7,065,417 ("the '417 patent") issued to Kwang-Su Moon and Jung-Ha Hwang on June 20, 2006, and is currently assigned to Texas MP3 Technologies, Ltd. ("Texas MP3").

2. On February 16, 2007, patent owner Texas MP3 filed suit against Apple Computer ("Apple ") for infringement of the '417 patent in the United States District Court for the Eastern District of Texas. [1]

3. On July 12, 2007, a request for *inter partes* reexamination of the '417 patent, assigned control No. 95/000,278 (the '0278 proceeding"), was filed by a third party requester on behalf of Apple Computer (the "requester"). Apple will be referred to as the "requester" of the '0278 proceeding.

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

5. On September 28, 2007, the Office issued an order granting the request for *inter partes* reexamination of claims 1-30, i.e., all of the claims, of the '417 patent.

6. On November 8, 2007, the Office issued an Office action rejecting claims 1-30.

7. On December 11, 2007, patent owner Texas MP3 filed a petition entitled "PETITION TO STAY THE REEXAMINATION PENDING OF DISTRICT COURT LITIGATION, OR ALTERNATIVELY, TO EXTEND THE TIME TO RESPOND TO OFFICE ACTION BY FOUR MONTHS."

8. On January 4, 2008, the Office mailed a decision on the December 11, 2007 patent owner petition extending the period to respond to the November 8, 2007 Office action to February 9, 2008.

9. On February 1, 2008, patent owner Texas MP3 filed a petition entitled "PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.956" and a separate petition entitled "PETITION TO STAY THE REEXAMINATION PENDING OF DISTRICT COURT LITIGATION."

10. On February 19, 2008, the Office mailed a decision on the December 11, 2007 patent owner petition extending the period to respond to the November 8, 2007 Office action to February 25, 2008.

11. On February 25, 2007, patent owner filed a timely response to the November 8, 2007 Office action.

The petition to stay the proceeding filed February 1, 2008 is the subject of this decision. [2]

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."

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[1] *Texas MP3 Techs., Ltd. v. Samsung Elecs. Co. Ltd.*, No. 2:07cv052 (E.D. Texas Feb. 16, 2007)

[2] See item 9 in the BACKGROUND

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."

II. Patent Owner's Position

The November 8, 2007 Office action (see "Background" item #6 above) sets forth rejections of claims 1-30 under 35 U.S.C. 103 as being obvious over various prior art references. Patent owner contends that critical evidence of non-obviousness (often referred to as "secondary considerations") will be developed through discovery in the related litigation, and thus the examination in the Office should await final judgment in the District Court proceedings.

Patent owner argues that the identity of the claims [3] at issue, the need for deposition testimony and other discovery in order to obtain information on various issues [4] bearing on obviousness, the need for court procedures to insure confidentiality, as well as the ability of the court to have preclusive effect for all defendants [5] in resolving the issue of obviousness constitutes "good cause" for suspending the reexamination proceeding. In support of this position, patent owner emphasizes [6] the MPEP 2686.04 III statement that:

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[3] Patent Owner relies on a statutory disclaimer filed December 11, 2007 as the basis of this assertion. However, a review of the file indicates that the disclaimer was not approved because it was not executed by an attorney of record. Thus, the claims at issue in the reexamination are not identical to the claims at issue in the district court litigation.

[4] E.g., commercial success of mp3 players, copying, and industry recognition. Patent owner's contentions that evidence of copying, accolades, and commercial success are relevant to obviousness are predicated on the assumption that the devices in question appropriate significant features of the claims.

[5] Since Apple is the only one of the defendants in the District Court proceeding who is a party to this reexamination, any conclusion of validity in this proceeding would have no estoppel effect on the remaining parties to the District Court litigation.

[6] Petition at page 14.

> 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).*** [Emphasis supplied by petitioner]

In light of these arguments, patent owner requests suspension of the present *inter partes* reexamination at least until a final judgment in the litigation between patent owner and requester is entered by the United States District Court for the Eastern District of Texas.

III. Analysis and Findings

Part 1:

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.

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 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, where the District Court had already rendered judgment against the *inter partes* reexamination requester. 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, in which the District Court had already rendered judgment against the *inter partes* reexamination requester. *Id.* [7]

Unlike the circumstances that existed in *Sony*, [8] the litigation between patent owner and the third party requesting reexamination of the instant '417 patent is in a relatively preliminary stage. The parties have just commenced discovery [9] in the District Court, and the trial date has been set for July 6, 2009. If a trial is necessary, or even if summary judgment were to be granted for all of the claims of the '417 patent that remain in the '278 *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. It is also speculative as to what the District Court may find/hold, and what, if any, relevant information might be generated.

Thus, it is clear that there is presently no "good cause" to stay the '278 *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 '417 patent claims will be forthcoming in the near future, nor what that decision might be. [10] Therefore, it is premature to suspend the '278 *inter partes* reexamination proceeding, because it is unlikely that the estoppel provisions of the reexamination statute will apply to all of the '417 patent claims in the near future, *if at all*. As pointed out, 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 the same issues with respect to the involved claims [11] are being raised in

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[7] 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. *Sony*, at *21-*37.

[8] 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.

[9] Document production by defendants was scheduled to begin on February 4, 2008 and to end on May 5, 2008; the deadline for fact discovery is May 22, 2009..

[10] 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 '417 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 '278 *inter partes* reexamination proceeding.

[11] Currently, there are more claims involved in the reexamination than in the litigation.

reexamination and litigation, and no *ex parte* reexamination exists, [12] there is simply no good cause, at present, to suspend the '278 *inter partes* reexamination proceeding.

Part 2:

An additional consideration is that petitioner's proposal amounts to a request for a pre-emptive indefinite termination of *the inter partes* reexamination, in anticipation of the possibility of estoppel by a final decision of the courts some years in the future, or the possibility of generating relevant information. While the statute may allow for suspension for "good cause," it does not permit effectively terminating any litigated proceeding indefinitely in favor of a possibility of generating information or a finding via an eventual court decision. It is to be noted that, pursuant to 35 U.S.C. § 317(b), *inter partes* reexamination of a patent and litigation as to that patent may continue side-by-side until "a final decision has been entered against a party in a civil action ... that the party has not sustained its burden of proving the invalidity of any patent claim in suit" or until "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." Petitioner's proposal, however, would provide for a pre-emptive termination of *the inter partes* reexamination in anticipation of the possibility of generated information or estoppel by a final decision of the courts some years in the future. While the statute may allow for suspending a proceeding for "good cause," it does not permit effectively terminating any litigated proceeding in favor of a possibility of generating information or a finding via an eventual court decision. If an *inter partes* reexamination of a patent were to be suspended any time there was litigation as to that patent (effectively terminating the proceeding until the resolution of the litigation), Congress would have simply said so in the statute. It clearly did not.

The type of evidence patent owner seeks in discovery, while speculative, is relevant to each and every determination of obviousness. The logical extension of patent owner's argument would be for the Office to set aside all *inter partes* reexamination in any patent involved in litigation where the requester is party to the litigation and a question of obviousness has been raised. This runs contrary to the statutory scheme which contemplates both reexamination and court proceedings taking place at the same time. Granting petitioner's request would eviscerate the statutory scheme by refraining from carrying out reexamination, in deference to the possibility of resolution of court proceedings favorable to a party or generating information.

Part 3:

Patent owner remains free to renew its request via a future petition for an appropriate (*i.e.*, partial or complete) suspension of the '278 *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 '278 *inter partes* reexamination proceeding substantially in advance of the termination of prosecution in the present '278 *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.

---

[12] If an *ex parte* reexamination proceeding was ongoing as to the '417 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.

IV. Further Discussion

The grounds patent owner puts forth suspension of action will be briefly addressed in this section.

a) Identity of claims: As of the date of this decision, the claims under reexamination are not identical to the claims asserted in the suit. Therefore, even if the civil proceedings are allowed to progress to the point that estoppel attaches, it would not result in termination of the entire reexamination proceeding. This factor weighs heavily against suspension.

b) Need for Discovery: Patent owner contends that discovery is needed on the issues of (i) commercial success, (ii) copying and (iii) standards applied in the awarding of "public recognition" and "product awards".

As a preliminary matter, the need for discovery to obtain information on secondary considerations may be raised in any reexamination proceeding where there is (or potentially may be) a proposed rejection based upon obviousness. Thus, this alone without a specific and substantive showing of need would not be enough to warrant stay of the reexamination. As to copying, petitioner states "published literature suggests that agents or employees of Apple's design and development team consulted Diamond Rio (Texas MP3's predecessor in interest to the patented technology) regarding their commercial embodiment of the patented invention. (Exhibit 15) "[13]. A review of Exhibit 15 provides no indication whatever that Apple engineers consulted with Diamond Rio in designing the iPOD®.

Furthermore, the types of evidence patent owner seeks in discovery are relevant to each and every determination of obviousness. The logical extension of patent owner's argument is for the Office to set aside all *inter partes* reexamination in any patent involved in litigation where the requester is party to the litigation and a question of obviousness has been raised.

c) Protective Orders: Patent owner's argument that the district court is the appropriate venue for conducting the test of validity of the patent due to the availability of protective orders underscores the fact that what is truly being requested is a pre-emptive termination of the proceeding. The possibility of a protective order has no bearing on the request for a stay, because if the order (as proposed by defendants) prevents any disclosure to the Office, then there is no point in the Office awaiting the close of proceedings, since the information will never be available to the examiner. On the other hand, if (as proposed by Patent owner) the information is freely available for submission in the Office proceeding then there is no need for suspension, and it may be submitted to the Office.

As a final point, the petition seeks suspension of the *inter partes* reexamination at least until a final judgment in the litigation between patent owner and requester is entered by the United States District Court for the Eastern District of Texas. The litigation between patent owner and third party requester involving the instant '417 patent is in a relatively preliminary stage. The parties are still conducting discovery (which is scheduled to be completed by May 22, 2009) in the District Court, with the trial date set for July 6, 2009. **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,

[13] Petition at pages 8-9, "FACT" number 13.

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.

The petition accordingly is dismissed.

CONCLUSION

1. The patent owner petition is dismissed.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit for further processing and examination.

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

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

4-2-08
C:\kiva\kenpet6\IP\UV\95_0278 Suspend-for-discovery_dismissed.doc

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

Date:
MAILED
JAN 29 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000278
PATENT NO. : 7065417
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,278	07/12/2007	7065417	026115.0101 X1US	3408

32376 7590 01/29/2009

LAWRENCE R. YOUST
2001 Ross Avenue
Suite 3000
DALLAS, TX 75201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/29/2009

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

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2001 ROSS AVENUE, SUITE 3000
DALLAS, TX 75201

(For Patent Owner) MAILED

JAN 29 2009

CENTRAL REEXAMINATION UNIT

TRACY DRUCE
NOVAK, DRUCE & QUIGG, LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re Moon *et al.*	:	
Inter Partes Reexamination Proceeding	:	DECISION
Control No.: 95/000,278	:	GRANTING
Request Deposited: July 12, 2007	:	PETITION
For: U.S. Patent No. 7,065,417	:	

This is a decision on the January 9, 2009, petition entitled "JOINT PETITION UNDER 37 C.F.R. §§ 1.182 AND/OR 1.183 TO RETURN ERRONEOUS IDS WITHOUT ENTRY INTO THE RECORD AND RELEASE TO THE THIRD PARTY REQUESTER" (the petition), requesting non-entry and return of highly confidential, protected documents, which were inadvertently submitted by patent owner to the Office in an information disclosure statement (IDS) on December 31, 2008.

Because the rules do not specifically provide for the non-entry and return of the inadvertently submitted documents, the petition will be treated as a petition under 37 CFR 1.182. The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to third party requester's credit card, as authorized on page three of the petition.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,065,417 (the '417 patent) issued to Moon *et al.* on June 20, 2006.

2. On July 12, 2007, a third party requester filed a request for *inter partes* reexamination, which proceeding was assigned Control No. 95/000,278 (the '278 proceeding).

3. On September 28, 2007, the Office mailed an Order granting the request for *inter partes* reexamination.

4. The '417 patent is the subject of litigation styled *Texas MP3 Technologies, Ltd. v. Samsung Electronics Co., Ltd*, Civil Action No. 2:07-CV-052-TJW (E.D. Tex.) (hereinafter "Texas MP3 Technologies-Samsung litigation.")

5. On July 23, 2008, a "PROTECTIVE ORDER REGARDING THE DISCLOSURE AND USE OF DISCOVERY MATERIALS" (the protective order) was issued in the Texas MP3 Technologies-Samsung litigation.

6. On December 31, 2008, patent owner submitted for the '278 proceeding an IDS containing documents clearly marked highly confidential and subject to the protective order in the Texas MP3 Technologies-Samsung litigation.

7. On January 9, 2009, patent owner and third party requester filed the instant petition entitled "JOINT PETITION UNDER 37 C.F.R. §§ 1.182 AND/OR 1.183 TO RETURN ERRONEOUS IDS WITHOUT ENTRY INTO THE RECORD AND RELEASE TO THE THIRD PARTY REQUESTER," requesting non-entry and return/release to third party requester of the protected materials submitted in the December 31, 2008 IDS.

DECISION

In the petition, patent owner and third party requester (the parties) assert that patent owner inadvertently submitted to the Office the December 31, 2008 IDS, which includes documents clearly marked highly confidential,[1] such documents having been submitted contrary to the protective order issued by the District Court for the Eastern District of Texas in the Texas MP3 Technologies-Samsung litigation. The parties further assert that public disclosure of these documents would result in irreparable harm to the third party requester.[2] Accordingly, the parties have agreed to file a joint petition requesting that these documents not be entered into the record of the '278 proceeding to avoid public disclosure thereof. The parties have further agreed to have third party requester's courier retrieve the protected materials from the Office.[3]

A review of the record of the '278 proceeding reveals that the December 31, 2008 IDS and accompanying protected documents have not been scanned into the image file wrapper (IFW) of the '278 proceeding. In view of the irreparable harm to third party requester that would be caused by public disclosure of these protected documents, and in view of the facts and circumstances pertaining to the instant petition for non-entry of the December 31, 2008 IDS and accompanying documents into the IFW of the '278 proceeding, the petition is granted, and third party requester is required to retrieve the December 31, 2008 IDS and accompanying documents from the Office.

---

[1] *See* petition at page 2 (indicating the documents are marked "Highly Confidential – Outside Attorney's Eyes Only").

[2] *See* petition at page 1.

[3] *See* petition at page 2.

ADDITIONAL DISCUSSION

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order.[4] MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose.

CONCLUSION

1. Patent owner's and third party requester's joint petition under 37 CFR 1.182 is granted. The December 31, 2008 IDS and accompanying documents will not be entered into the IFW of the '278 proceeding.

2. Third party requester is required to retrieve the December 31, 2008 IDS and accompanying documents from the Office by contacting Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710, or in his absence, Nicole Dretar, Legal Advisor, at 571-272-7717, to arrange a date and time for pick-up by third party requester's courier.

3. Jurisdiction over the '278 proceeding is being returned to the Central Reexamination Unit (CRU).

4. Any questions concerning this communication should be directed to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

Robert A Clarke

Robert A. Clarke
Director
Office of Patent Legal Administration

[4] *See* MPEP § 724

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,283	08/07/2007	6501234	10598.0003-00	6659

41066 7590 04/16/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Lionel M. Lavenue

FINNEGAN HENDERSON FARABOW, ET. AL. LLP

Two Freedom Square; 11955 Freedom Drive

Reston, VA 20190-5675

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

REEXAMINATION CONTROL NUMBER *95/000,283*.

PATENT NUMBER *6,501,234*.

TECHNOLOGY CENTER *3990*.

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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MURABITO, HAO & BARNES, LLP (For Patent Owner)
Two North Market Street
Third Floor
San Jose, CA 95113

MAILED

APR 16 2008

CENTRAL REEXAMINATION UNIT

Patrick G. Burns (For *ex parte* Requester)
Greer, Burns & Crain Ltd.
300 South Wacker Drive
Suite 2500
Chicago, IL 60606

Finnegan, Henderson, et al., LLP (For *inter partes* Requester)
901 New York Avenue, NW
Washington, DC 20001-4413

In re Lin et al.,
Ex parte Reexamination Proceeding
Control No. 90/008,170
Filed: August 18, 2006
For: U.S. Patent No. 6,501,234

In re Lin et al.,
Inter partes Reexamination Proceeding
Control No. 95/000,283
Filed: August 7, 2007
For: U.S. Patent No. 6,501,234

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. On December 31, 2002, United States Patent Number 6,501,234 (the '234 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '234 patent, assigned Reexamination Control No. 90/008,170 (the '8170 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination of claims 1-56 of the '234 patent in the '8170 proceeding.

4. On August 7, 2007, a request for *inter partes* reexamination of the '234 patent, assigned Reexamination Control No. 95/000,283 (the '283 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. On October 26, 2007, the Office issued an order granting *inter partes* reexamination of claims 1-56 of the '234 patent in the '283 proceeding, without an accompanying action on the merits.

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 '283 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 95/000,283 and 90/008,170 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*. As 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.

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(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as 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. 95/000,283 and *ex parte* Reexamination Control No. 90/008,170 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 his absence, to the undersigned, at 571-272-7710.

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

April 16, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,283	08/07/2007	6501234	10598.0003-00	6659

41066 7590 09/17/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/17/2008

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RESTON, VA 20190-5675

Date:
MAILED

SEP 17 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000283
PATENT NO. : 6501234
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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SEP 17 2008

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In re Lin et al.,
Ex parte Reexamination Proceeding
Control No. 90/008,170
Filed: August 18, 2006
For: U.S. Patent No. 6,501,234

In re Lin et al.,
Inter partes Reexamination Proceeding
Control No. 95/000,283
Filed: August 7, 2007
For: U.S. Patent No. 6,501,234

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. 90/008,170 AND 95/000,283 AND SUSPENSION OF REEXAMINATION CONTROL NO. 95/000,283" (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 95/000,283 and 90/008,170 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 December 31, 2002, United States Patent Number 6,501,234 (the '234 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '234 patent, assigned Reexamination Control No. 90/008,170 (the '8170 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8170 proceeding.

4. On August 7, 2007, a request for *inter partes* reexamination of the '234 patent, assigned Reexamination Control No. 95/000,283 (the '283 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. Patent owner and third party requester in the '283 proceeding are adversarial parties in concurrent litigation regarding the '234 patent in the United States District Court for the Eastern District of Texas (concurrent litigation).[1]

6. On October 26, 2007, the Office issued an order granting *inter partes* reexamination in the '283 proceeding, without an accompanying action on the merits.

7. On April 16, 2008, the Office issued a decision *sua sponte* merging the '8170 *ex parte* proceeding and the '283 *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 24, 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 '283 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 '283 proceeding and (3) the '8170 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 '283 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:

(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**.

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[2] On September 18, 2007 a revocation of power of attorney and new power of attorney and change of address was submitted in the '283 proceeding, however no such transaction has ever occurred in the '234 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 '283 *inter partes* reexamination proceeding should be suspended while the '8170 *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 '8170 *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 '283 *inter partes* reexamination proceeding has agreed to no longer exercise its right to file comments in the '283 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 '283 *inter partes* reexamination proceeding, the '283 *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 '234 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 '234 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 '234 patent were being asserted or being challenged with the defense of invalidity, as well as to the finality of the court's decision.

The '234 patent issued with 56 claims, of which claims 1, 27, and 31, 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 '234 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 '283 proceeding, because such has not been made of record in the '283 *inter partes* reexamination proceeding, but all the patent claims, i.e., claims 1-56, are subject to reexamination in the '283 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 1-56 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 '283 *inter partes* proceeding. As a result of such a termination, the '8170 *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 grant 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 '283 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 '283 *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 '234 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 '283 *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 '283 *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 '283 and '8170 proceedings and suspend the '283 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 '283 proceeding in accordance with the guidance provided above in Section III.

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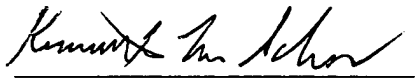
[4] If third party requester objects to this procedure, and wishes to preserve its right to comment, then requester is called upon to immediately inform the Office of that decision and explain the circumstances for withdrawing an assertion made in the record of this proceeding. Note further, that the 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.

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 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

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CENTRAL REEXAMINATION UNIT

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(For first *Inter Partes* Requester)

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ATLANTA, GA 30357-0037

(For second *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,285
Filed: September 21, 2007
For: U.S. Patent No. 7,097,719

Inter Partes Reexamination Proceeding
Control No. 95/001,085
Filed: October 2, 2008
For: U.S. Patent No. 7,097,719

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,097,719 (the '719 patent) issued to Bray *et al.* on August 29, 2006.

2. A first request for *inter partes* reexamination of the '719 patent was filed on September 21, 2007, by third party requester Jennifer P. Yancey. The request was assigned control number 95/000,285 (the '0285 proceeding).

3. On December 19, 2007, *inter partes* reexamination was ordered for the '0285 proceeding based on the examiner's determination that the September 21, 2007 request raised a substantial new question of patentability.

4. Concurrently on December 19, 2007, a non-final Office action was mailed in the '0285 proceeding, rejecting claims 1-7 of the '719 patent.

5. On March 19, 2008, patent owner timely filed in the '0285 proceeding an amendment and response to the December 19, 2007 Office action, amending claims 1, 3 and 7 and presenting new claims 8-17.

6. On April 17, 2008, third party requester timely filed in the '0285 proceeding written comments on patent owner's March 19, 2008 amendment and response.

7. A second request for *inter partes* reexamination of the '719 patent was filed on October 2, 2008, by third party requester Alcan Rhenalu, in which Alcan Rhenalu and Alcan Rolled Products - Ravenswood, LLC were identified as the real parties in interest. The request was assigned control number 95/001,085 (the '1085 proceeding).

8. On December 12, 2008, *inter partes* reexamination was ordered for the '1085 proceeding, based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.

9. To date, there has been no Office action in the '1085 proceeding, and there has been no further Office action in the '0285 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. Both proceedings are *inter partes* proceedings, are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989(a) provides:

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/000,285 and 95/001,085 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since claims 1, 3 and 7 have been amended in the '0285 proceeding and claims 8-17 have been newly presented in the '0285 proceeding, the claims are not currently the same in both files and an amendment is needed to place the same claim amendments in both proceedings.

2. Claims 1, 3 and 7-17 are **rejected under 35 U.S.C. 112, paragraph 2**, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention. Since the same claims read differently in the two proceedings (claims 8-17 are not even in the second proceeding), the intended scope of the claims in each proceeding is not clear.

3. Patent owner is required to submit an appropriate amendment within one month of this decision, such amendment placing the same amendment in both files.

4. This merger decision provides **an Office action on the merits** pursuant to 35 U.S.C. 314(b)(2), and patent owner's amendment response goes to the merits of the proceeding, to address the above rejection under 35 U.S.C. 112. In order that the response be considered to be a complete response pursuant to 35 U.S.C. 314(b)(2), patent owner must include the remarks that set forth the basis for having presented the amendments to claims 1, 3 and 7 and having presented new claims 8-17 in the '0285 proceeding. Failure to include the basis for having made the amendment to claims 1, 3 and 7 and having presented new claims 8-17 in patent owner's response will result in a holding that the amendment is non-responsive and non-enterable, leading to cancellation of claims 1, 3 and 7-17 from the merged reexamination proceeding.

5. After patent owner files a response to this decision, the third party requesters may once file written comments within a period of 30 days from the date of service of patent owner's response. Any such comments must be limited to patentability issues directed to patent owner's amendment of the claims made in the *inter partes* reexamination or claims newly presented in the *inter partes* reexamination. Such issues may include the issue of claim patentability based on prior patents and printed publications applicable to any amended claims and any newly presented claims in patent owner's response. The time for submitting comments by the third party requesters is statutory, and it may not be extended.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers filed by patent owner and the third party requesters should be directed as follows:

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

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

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

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

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

C. Amendments:

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

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

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

D. Fees:

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

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.

IV. SUPPLEMENT TO THE DECEMBER 12, 2008 ORDER

As noted above, on March 19, 2008, patent owner filed in the '0285 proceeding an amendment and response to the December 19, 2007 Office action, amending claims 1, 3 and 7 of the '719 patent and presenting new claims 8-17. Subsequently, on December 12, 2008, *inter partes* reexamination was ordered in the '1085 proceeding for claims 1-17 of the '719 patent, as amended during the '0285 proceeding, based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability affecting these claims.

As pointed out by third party requester in the '1085 proceeding, MPEP 2642(I) provides that "[w]here a second or subsequent request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending (ongoing) for that patent, the second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the ongoing pending reexamination proceeding." However, as noted in MPEP 2643, amendments and/or new claims present in any copending reexamination or reissue proceeding for the patent to be reexamined will not be considered nor commented upon when deciding a request for reexamination.[1] Rather, where a request for reexamination is granted and reexamination is ordered, the first Office action and any subsequent reexamination prosecution should be on the basis of the claims as amended by any copending reexamination or reissue proceeding.

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[1] *See also* MPEP 2642(I) (providing that "The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.923)")(emphasis added).

Thus, while substantial new questions of patentability were properly raised by the third party requester in the '1085 proceeding, the December 12, 2008 order granting reexamination in the '1085 proceeding should have been limited to claims 1-7 of the '719 patent, the claims in effect at the time the determination was made. This merger decision is supplemental to the December 12, 2008 order, and modifies it to the extent that the order granting reexamination in the '1085 proceeding grants reexamination as to claims 1-7 of the '719 patent, the claims in effect at the time the December 12, 2008 determination was made.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,285 and *Inter Partes* Reexamination Control No. 95/001,085 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. An amendment must be filed, pursuant to Part II of this decision, within ONE MONTH of the mail date of this decision, placing the same claims in both files of the present merged proceeding, together with an explanation of the basis for any amendment or new claims included in the response.

3. After patent owner files a response to this decision, the third party requesters may once file written comments within a period of 30 DAYS from the date of service of patent owner's response. Any such comments must be limited to patentability issues directed to patent owner's amendment of the claims or newly presented claims. Such issues may include the issue of claim patentability based on prior patents/printed publications applicable to any amended claims and any newly presented claims in patent owner's response. The time for submitting comments by the third party requesters is statutory and may not be extended.

4. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.

5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to place the same amendment in both proceedings and requesters' comments on that response, or (b) the expiration of the time for filing the required response and any comments requesters elect to file.

6. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

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

March 23, 2009
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,285	09/21/2007	7097719	07-1747	9522

8840 7590 05/10/2010

INTELLECTUAL PROPERTY
ALCOA TECHNICAL CENTER, BUILDING C
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ALCOA CENTER, PA 15069-0001

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JENNIFER P. YANCY
JONES, TULLAR & COOPER, P.C.
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

Date:
MAILED
MAY 10 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000285
PATENT NO. : 7097719
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.

Best Available Copy

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100 Technical Drive
Alcoa Center, PA 15069-0001

For Patent Owner

MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

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For Requester

Susan E. Shaw McBee
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For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,285
Filed: September 21, 2007

Control No. 95/001,085
Filed: October 2, 2008

For: US Patent No. 7,097,719

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

This is a decision on the petition filed April 26, 2010 to request a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed April 1, 2010.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated April 1, 2010, 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 Patent Owner anticipates the need for additional time to obtain and prepare evidence for submission with its response to the Office action. An extension of time for one month is requested to provide Patent Owner with a fair opportunity to respond to the outstanding Office action.

Analysis and Findings

Patent Owner has failed to 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. Any request for an extension of time must

include a statement of what action the Patent Owner has taken to provide a response, to date as of the date the request for extension is submitted and why, in spite of the action taken thus far, the requested additional time is needed. The present request does not include such documentation. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is insufficient to justify the grant of an extension of time in which to file a response to the outstanding Office action.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of April 1, 2010 is **dismissed**.

2. The Patent Owner's response is due June 01, 2010.

3. Response may be submitted as follows:

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

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

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

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

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

/Deborah Jones/
SPE, Art Unit 3991
Central Reexamination Unit

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JUN 30 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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(For first *Inter Partes* Requester)

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ATLANTA, GA 30357-0037

(For second *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,285
Filed: September 21, 2007
For: U.S. Patent No. 7,097,719

Inter Partes Reexamination Proceeding
Control No. 95/001,085
Filed: October 2, 2008
For: U.S. Patent No. 7,097,719

DECISION, DISMISSING PETITION TO WAIVE PAGE LENGTH LIMIT FOR PATENT OWNER'S RESPONSE TO THE OFFICE ACTION

This is a decision on an April 26, 2010 patent owner's petition entitled "PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION." The petition requests waiver of the 37 CFR 1.943(b) requirement that patent owner's response to an office action in an *inter partes* reexamination proceeding not exceed 50 pages in length.

Patent owner's petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

Patent owner's petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

The period for reply to an April 1, 2010 Office action previously extended to July 1, 2010 in a May 28, 2010 decision, is extended for an additional month until August 2, 2010.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the April 26, 2010 petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 01-1000 on May 3, 2010 pursuant to the authorization on page 3 of the petition.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,097,719 (the '719 patent) issued to Bray *et al.* on August 29, 2006.

2. A first request for *inter partes* reexamination of the '719 patent was filed on September 21, 2007, by third party requester Jennifer P. Yancey (the first requester). The request was assigned control number 95/000,285 (the '0285 proceeding).

3. On December 19, 2007, *inter partes* reexamination was ordered for the '0285 proceeding.

4. A second request for *inter partes* reexamination of the '719 patent was filed on October 2, 2008, by third party requester Alcan Rhenalu (the second requester). The request was assigned control number 95/001,085 (the '1085 proceeding).

5. On December 12, 2008, *inter partes* reexamination was ordered for the '1085 proceeding.

6. On March 24, 2009, the Office mailed a decision in the '0285 and '1085 proceedings (the merger decision), *sua sponte* merging the '0285 and '1085 proceedings into a single proceeding (the merged proceeding).

7. On April 20, 2009, patent owner filed an amendment and response, responsive to the March 24, 2009 merger decision.

8. On May 11, 2009, second requester filed comments responsive to the March 24, 2009 merger decision and the April 20, 2009 patent owner amendment and response.

9. On May 19, 2009, first requester filed comments responsive to the March 24, 2009 merger decision and the April 20, 2009 patent owner amendment and response.

10. On October 9, 2009 the Office issued a "Notice Re Defective Paper in Inter Partes Reexamination" (the Notice of Defective Paper), stating that the patent owner's April 20, 2009 amendment and response is improper because it exceeds the page limit permitted under 37 CFR 1.943.

11. On October 23, 2009, patent owner submitted a re-drafted amendment and response, responsive to the October 9, 2009 Notice of Defective Paper.

12. On November 18, 2009, second requester filed comments responsive to the October 23, 2009 re-drafted patent owner amendment and response.

13. On April 1, 2010, the Office issued a non-final Office action in the merged proceeding, rejecting claims 1-17.

14. On April 26, 2010 patent owner filed the instant petition entitled "PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION" (the petition under 37 CFR 1.183) to waive the page limit requirements of 37 CFR 1.943(b).

15. On May 28, 2010 the Office granted a May 24, 2010 (renewed) petition for extension of time permitting a reply to the April 1, 2010 Office action to be timely submitted on July 1, 2010.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

Patent Owner's Petition under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(b) as it applies to patent owner's response to the April 1, 2010 Office action.[1] In particular, patent owner states that "[d]ue to the numerous factual allegations, legal arguments and references that must be addressed in response to that Office Action, this is an extraordinary situation in which justice requires the suspension of the page limit rule of 1.943(b)."[2]

In support of its request for waiver of the rule, patent owner asserts that the Office action sets forth eighteen different grounds of rejection and states:

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[1] Petition under 37 CFR 1.183 at pages 1 and 3.
[2] Petition under 37 CFR 1.183 at pages 1-2

> The first seventeen grounds of rejection essentially incorporate by reference the ['1,085 request (grounds I.-VIII), the '285 request (grounds XIV. - XVIII.), the comments filed Nov. 19, 2009 (grounds IX.-X and XII), and the comments filed May 19, 2009 (ground XIX). Grounds XX is the Examiner's own rejection. Furthermore, the Office Action also includes eight additional pages (15-22) responding to Patent Owner's previous arguments.[3]

Further in support of its request for waiver of the rule, patent owner asserts that the eighteen grounds of rejection are based on several different legal theories and thirteen different references (plus twenty additional references are cited in the "Response to Arguments" section of the Office action), and states:

> Patent Owner's previous response of April 20, 2009, had to be revised to comply with the page limit due to the numerous references and arguments made by the first reexamination requestor. Patent Owner now has twelve additional grounds of rejection to address as set forth by the second reexamination requestor, and its additional comments of November 11, 2009. Patent Owner also has to address at least thirteen references, and potentially up to thirty-three references, in its response. Patent owner also has four new legal grounds of rejection (§§ 112 and 314(a)) to address that have not previously been raised.[4]

Finally, patent owner asserts that "[t]o fairly address the Office Action, Patent Owner anticipates that up to (90) pages will be required in its response."[5]

Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

As indicated above, patent owner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to the outstanding Office action to a maximum length of 90 pages, to address 18 grounds of rejection and at least 13 references. It is to be noted, however, that the number of rejections and the length of the Examiner's treatment of issues is not a *per se* indication of how many pages patent owner will need.[6] In some instances, a long examiner

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[3] Petition under 37 CFR 1.183 at pages 2-3.
[4] *Id.* at page 3.
[5] *Id.*.
[6] It is noted that the substantive portion of the April 1, 2010 Office action spans 22 pages and incorporates by reference approximately 54 pages from the '1085 request for *inter partes* reexamination, the second requester's comments filed on November 18, 2009, the '0285 request for *inter partes* reexamination, and the first requester's comments filed on May 19, 2009, for a total of 76 pages.

discussion can be rebutted by simply showing a flaw in one or more points of the discussion, using a few sentences or paragraphs to do so. For example, while patent owner suggests, as indicated above, that 50 pages in which to respond to the rejections would be inadequate, it is not clear exactly how many pages patent owner would need to develop a response to each of the 18 rejections, or that a maximum of 90 pages would be sufficient to develop a response to all of the rejections. Thus, in this instance, patent owner has provided arguments in support of why more pages are deemed necessary to complete the response, but patent owner has failed to provide a concrete basis for an accurate determination of how many additional pages are needed to complete the response.

A concrete showing which petitioner could have made in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) would be an attempt to draft a response in compliance with the 50-page limit followed by submission of the resulting drafted response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Such a submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner could have relied on the proposed response for justification that more pages (than are permitted by rule) are needed to complete the response and to set forth an accurate determination of how many additional pages are needed to complete the response.

Patent owner may file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), accompanied by a drafted response, as described immediately above. If the Office does not grant such a petition under 37 CFR 1.183 to the full extent of the suggested proposed response, patent owner would be given a period of 15 days within which to submit a compliant response in accordance with the page limit set forth in the decision on that petition. The third party requesters would then have 30 days from the date of service of any patent owner's rule-compliant response that is filed, to file a comments paper pursuant to 37 CFR 1.947.[7] If the Office does grant such a petition under 37 CFR 1.183, the third party requesters would have 30 days from the mailing date of a decision granting patent owner's petition under 37 CFR 1.183 and accepting the proposed response as page-length compliant, in which to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

For all of the reasons set forth above, patent owner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b), and the April 26, 2010 petition under 37 CFR 1.183 is dismissed.

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[7] *See* MPEP 2667(I)(A)(2), which provides, in-part: "Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options: (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. ... If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice."

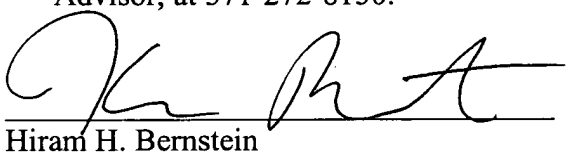
CONCLUSION

1. The patent owner April 26, 2010 petition under 37 CFR 1.183 is **dismissed**.

2. The period for reply to an April 1, 2010 Office action previously extended to July 1, 2010 in a May 28, 2010 decision, is extended for an additional month until August 2, 2010

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

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.



Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,288	01/15/2008	6547764	22452-3100/US	3867

7590 02/19/2009

EXAMINER	

Marc A. Began, Esq.
Novo Nordisk Pharmaceuticals, Inc.
100 College Road West
Princeton, NJ 08540

ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BARBARA A. WIGLEY
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH 7TH STREET
SUITE 3300
MINNEAPOLIS, MN 55402-3901

MAILED

FEB 19 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,288*.

PATENT NUMBER *6,547,764*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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(For Patent Owner)

MARC A. BEGAN, ESQ.
NOVO NORDISK PHARMACEUTICALS, INC.
100 COLLEGE ROAD WEST
PRINCETON, NJ 08540

MAILED

FEB 19 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

BARBARA A. WIGLEY
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH 7 TM STREET
SUITE 3300
MINNEAPOLIS, MN 55402-3901

In re Larsen et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,288	:	FOR REOPENING
Filed: January 15, 2008	:	PROSECUTION
For: U.S. Patent No.: 6,547,764	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on December 29, 2008. The petition is entitled "PETITION UNDER 37 CFR § 1.181" [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 August 22, 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 December 29, 2008 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,288.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,547,764 (hereinafter, the '764 patent) issued on April 15, 2003.

2. A corrected request for *inter partes* reexamination, assigned control No. 95/000,288, was filed by a third party requester on January 15, 2008, which was compliant with the filing date requirements.

3. *Inter partes* reexamination was ordered for the '288 reexamination proceeding on February 29, 2008. On the same day, a non-final Office action was mailed in the '288 reexamination proceeding.

4. The patent owner filed a response to the non-final Office action on May 2, 2008. The response included proposed amendments to claims 1, 2, 4, and 12 and added proposed new claims 18-32.

5. The third party filed comments on May 29, 2008 to the patent owner's response, which included proposed rejections for the new proposed claims 18-32.

6. On June 16, 2008, the patent owner filed an information disclosure statement.

7. On August 22, 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 February 29, 2008 Office action, and adopted the new proposed rejections based upon prior art as proposed by the third party requester.

8. On September 24, 2008, Patent Owner filed remarks and a proposed amendment to claims 12, 18, 19, 20, and 25, and cancelling claims 24, 29, and 32.

9. On October 22, 2008, the third party requester filed comments.

10. On November 3, 2008, the patent owner filed another information disclosure statement.

11. On November 20, 2008, the Office mailed a Right to Appeal Notice (RAN) in which it is stated that the proposed amendment of September 24, 2008 will not be entered. The RAN states that the patent owner's remarks and the third party requester's comments were considered and addressed to the extent the remarks and comments are applicable to the claims prior to the September 24, 2008 proposed amendment.

12. On December 29, 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.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed amendment of September 24, 2008 because the proposed amendment "...(a) would have reduced the number of claims on appeal; (b) would not have altered the substance of the remaining claims; and (c) would have corrected certain minor Section 112 issues in the claims." See page 2 of the petition. The petitioner also states that "... the grounds upon which the Examiner refused to enter the proposed amendment do not appear to be sufficiently clear to allow appellate review, and thus would properly result in a remand by the Board of Patent Appeals and Interferences for clarification." See page 2 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed amendment of September 24, 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 February 29, 2008, and adopted the proposed rejections for the new proposed claims 18-32. The ACP did make new rejections under 35 U.S.C. 112 on proposed new claims 19-25 and amended claim 12. These new rejections were caused by the amendment to claim 12 and the addition of proposed new claims in the paper of May 2, 2008. Therefore, the examiner could not have made the rejections under 35 U.S.C. 112 prior to the ACP. In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed amendment of September 24, 2008 because the proposed amendment would have reduced the number of claims on appeal, would not have altered the substance of the remaining claims, and would have corrected certain minor Section 112 issues in the claims.

In support of this allegation, the patent owner states that no showing of why the amendment was not presented earlier is not required because the amendment addresses issues raised in the new rejections under 35 U.S.C. 112, and that the amendment only corrects minor deficiencies in the claims and places them in better condition for appeal. The amendment of September 24, 2008 does more than simply addresses and corrects minor issues presented by the new rejections under 35 U.S.C. 112. As the patent owner admits, the amendment of September 24, 2008 incorporated the subject matter of claim 24 into claim 18, the subject matter of claim 29 into claim 25; and the subject matter of claim 32 into claim 12. As stated above, the amendment does not have a right of entry after an ACP, and a showing under 37 CFR 1.116(b) is required in order for the examiner to evaluate whether or not to enter the amendment. Neither the amendment of September 24, 2008 nor the petition addresses why these amendments to claims 12, 18, and 25 were not presented earlier. Furthermore, as explained by the examiner in the RAN, entry of the amendment of September 24, 2008 would have caused withdrawal of rejections to certain claims and required introducing a new rejection to those claims. See pages 8-9 in the RAN, which states:

> "The proposed amendment would require modifications of the rejections set forth in the ACP. For example, the first ground of rejection would have to be withdrawn as to claims 12-14, 18, 19, and 25, the second ground of rejection would have to be withdrawn as to claims 15, 16, 20, and 21, and the third ground of rejection would have to be modified to include claims 12-16, 18-21, and 25."

The patent owner states it appears that the RAN did "reorder" the grounds of rejection so that the reason given by the examiner for not entering the amendment is without merit or unclear. See

page 5 of the petition. In reviewing the RAN, there is no evidence that the examiner changed or "reordered" the rejections. Specifically, Ground 1 still includes claims 12-14, 18, 19, and 25 (see page 12 of the RAN); Ground 2 still includes claims 15, 16, 20, and 21 (see page 13 of the RAN); and Ground 3 does not include claims 12-16, 18-21, and 25 (see page 13 of the RAN).

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the amendment of September 24, 2008 should not be entered, 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 her discretion in deciding to not enter the amendment of September 24, 2008.

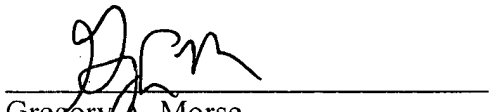
Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the amendment dated September 24, 2008 and reopening of prosecution of the '288 reexamination proceeding is denied.

2. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

3. Telephone inquiries related to this decision should be directed to 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

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.
95/000,288	01/15/2008	6547764	22452-3100/US	3867

7590 03/31/2009

EXAMINER	

Marc A. Began, Esq.
Novo Nordisk Pharmaceuticals, Inc.
100 College Road West
Princeton, NJ 08540

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BARBARA A. WIGLEY
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH 7TH STREET
SUITE 3300
MINNEAPOLIS, MN 55402-3901

MAILED

MAR 3 1 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,288*.

PATENT NUMBER *6,547,764*.

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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MAR 3 1 2009

CENTRAL REEXAMINATION UNIT

MARC A. BEGAN, ESQ.
NOVO NORDISK PHARMACEUTICALS, INC.
100 COLLEGE ROAD WEST
PRINCETON, NJ 08540

(For Patent Owner)

BARBARA A. WIGLEY
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH 7th STREET
SUITE 3300
MINNEAPOLIS, MN 55402-3901

(For Third Party Requester)

In re Larsen et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,288
Filed: January 15, 2008
For: U.S. Patent No.: 6,547,764

: DECISION ON PETITION
: TO CONTINUE
: *INTER PARTES*
: REEXAMINATION
: PROCEEDING

This is a decision on the February 26, 2009 patent owner petition under 37 CFR 1.182 requesting continuing reexamination of the instant *inter partes* reexamination proceeding.

The petition under 37 CFR 1.182 and the 95/000,288 *inter partes* 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 petition under 37 CFR 1.182 was charged to Deposit account No. 19-2385 on February 27, 2009.

For the reasons set forth below, the present petition under 37 CFR 1.182 is dismissed.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,547,764 (hereinafter, the '764 patent) issued to Larsen et al. on April 15, 2003 with 17 claims.

2. A corrected request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,288 (the '288 proceeding), was deposited by a third party requester on January 15, 2008, and a filing date of January 15, 2008 was assigned to the request, as corrected.

3. On February 29, 2008, the Office issued an Order granting reexamination in the '288 reexamination proceeding.

4. The proceeding progressed to the point that, on August 22, 2008, the Office issued an Action Closing Prosecution (ACP), in which claims 1-32, of record in the proceeding, were

all rejected.

5. On September 24, 2008, patent owner filed, under 37 CFR 1.951(a), a comments submission including an amendment. The amendment proposed cancelling claims 24, 29, and 32, and amending claims 12, 18-20, and 25.

6. On November 20, 2008, the Office issued a Right of Appeal Notice (RAN). The RAN stated that the amendment filed September 24, 2008 was denied entry in accordance with the guidelines set forth in MPEP 2673, subpart III.

7. On December 22, 2008, patent owner filed a Notice of Appeal.

8. On December 22, 2008, patent owner filed a petition under 37 CFR 1.181 for reconsideration of the refusal to enter the amendment dated September 24, 2008.

9. On January 5, 2009, third party requester filed a Notice of Cross Appeal.

10. A decision dismissing the December 22, 2008 patent owner petition under 37 CFR 1.181 was mailed by the Office on February 19, 2009.

11. On February 26, 2009, patent owner filed the instant petition under 37 CFR 1.182, for continued reexamination of the instant *inter partes* reexamination proceeding

12. On March 5, 2009, third party requester filed an Appeal Brief.

13. On March 9, 2009, patent owner filed an Appeal Brief.

DECISION ON PETITION UNDER 37 CFR 1.182

I. RELEVANT REGULATIONS

37 CFR 41.63(b) provides:

> (b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

37 CFR 1.116(b) provides:

> (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.

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).

II. CONTINUATION OF PROSECUTION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding for the purpose of amending the claims to overcome the 35 U.S.C. 112 (§ 112) rejections raised for the first time in the August 22, 2008 Office action and thereby place the claims in proper form for appeal (see page 3 of the present petition). The petitioner proposes to submit a modified version of the September 24, 2008 amendment containing only those claim amendments submitted in its September 24, 2008 amendment that seek to overcome the § 112 rejections (see Attachment A included in the present petition).[1]

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[2] Notice was provided therein that a 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 formal 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 for the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a formal submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

---

[1] In Attachment A to the present petition, it is noted that the proposed amendments to claim 12 to overcome the Section 112 rejections in the ACP are not identical to the proposed amendments for claim 12 in the amendment submitted on September 24, 2008.

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

In this instance, Petitioner patent owner's response includes a newly proposed amendment attached to the present petition to overcome the § 112 rejections of record, thereby reducing the number of issues for appeal, which could provide a *bona fide* effort to advance the prosecution towards appeal. However, the proposed amendment attached to the present petition is neither in the proper form that is enterable as a separate paper, nor is it compliant with respect to 37 CFR 1.530. Therefore, the present petition is dismissed, since the proposed claim amendment in the current format cannot be entered into the file.

Furthermore, in the interest of special dispatch, granting a request for continued reexamination at this stage does not justify the amount of rework that would be involved... This includes mailing a new ACP and RAN solely to consider the amendments to overcome the § 112 rejections in the ACP. Petitioner could have addressed only the § 112 rejections prior to RAN, within the same time frame that the earlier petition under 37 CFR 1.181 was filed on December 22, 2008, and avoided such rework, but petitioner chose not to do so. On page 3 of the February 19, 2009 Decision on the 1.181 petition, the Director stated that good and sufficient reasons to enter the proposed September 24, 2008 amendment were not found. The proposed amendment filed on September 24, 2008 incorporated the subject matter of claim 24 into claim 18, the subject matter of claim 29 into claim 25, and the subject matter of claim 32 into claim 12, and the amendment did not address why the amendment to these claims were not presented earlier (see page 4 of the February 19, 2009 Decision). The incorporation of claims 24, 29, and 32 into claims 18, 25, and 12, respectively, did not address the § 112 rejections in the ACP. As pointed out on page 4 of the February 19, 2009 Decision, the examiner explained on pages 8-9 of the RAN that entry of the September 24, 2008 amendment would have caused withdrawal of rejections of certain claims and required introducing a new rejection to those claims.

Based on the facts and circumstances of the present case, to permit continued reexamination solely for the purpose of amending the claims to overcome the § 112 rejections as urged on page 3 of the present petition would only serve to prolong prosecution by the amount of rework required and hence will not be granted. It is noted that prior to the filing of the present petition, petitioner has never attempted, under 37 CFR 1.116(b) or otherwise, to have the amendment limited to addressing the § 112 rejections entered. If it is entered, the presently proposed amendment (Attachment A) to overcome the § 112 rejections to reduce the number of issues for appeal may be considered under 37 CFR 1.116(b) and there will be no need for continued examination relief under 37 CFR 1.182. If petitioner desires reconsideration of the present proposed amendment (Attachment A) under 37 CFR 1.116(b) after the filing of petitioner's Notice of Appeal on December 22, 2008 and Appeal Brief on March 9, 2009, the following must be provided: (1) a proposed amendment in a separate amendment paper that is in compliance with 37 CFR 1.530 for consideration of entry, and (2) a petition under 37 CFR 1.183 to request waiver of 37 CFR 41.63(b), which prohibits filing of an amendment after the date of filing an appeal pursuant to § 41.61.

CONCLUSION

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

2. Jurisdiction for the '288 reexamination proceeding is being transferred to the Central Reexamination Unit (CRU) for further handling of the Third Party Requester Appeal Brief filed on March 5, 2009 and the Patent Owner Appeal Brief filed on March 9, 2009.

3. The patent owner and third party requester are reminded that every paper filed in the present *inter partes* reexamination proceeding must be served on the other party, including papers filed *via* facsimile transmission, pursuant to 37 CFR 1.903.

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 U.S. Postal Service 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
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, or in her absence, to the undersigned at (571) 272-7710.

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

March 30, 2009
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,288	01/15/2008	6547764	22452-3100/US	3867

7590 06/30/2009

EXAMINER	

Marc A. Began, Esq.
Novo Nordisk Pharmaceuticals, Inc.
100 College Road West
Princeton, NJ 08540

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BARBARA A. WIGLEY
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH 7TH STREET
SUITE 3300
MINNEAPOLIS, MN 55402-3901

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,288*.

PATENT NUMBER *6,547,764*.

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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Marc A. Began (For Patent Owner)
NOVO NORDISK PHARMACEUTICALS, INC.
100 College Road West
Princeton, NJ 08540

Barbara A. Wigley (For Third Party Requester)
OPPENHEIMER WOLFF & DONNELLY LLP
45 South 7th Street
Suite 3300
Minneapolis, MN 55402-

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JUN 3 0 2009

CENTRAL REEXAMINATION UNIT

In re Larsen *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,288
Filed: Jan. 15, 2008
For: U.S. Patent No. 6,547,764

DECISION GRANTING PETITION

This is a decision on the patent owner's "PETITION UNDER 37 CFR 1.183" filed on May 22, 2009, requesting waiver of the rule to permit consideration of an Amendment under 37 CFR 1.116.

The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to deposit account No. 01-0035.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,547,764 (hereinafter, the '764 patent) issued to Larsen et al. on April 15, 2003 with 17 claims.

2. A corrected request for inter partes reexamination, assigned Reexamination Control No. 95/000,288 (the '288 proceeding), was deposited by a third party requester on January 15, 2008, and a filing date of January 15, 2008 was assigned to the request, as corrected.

3. On February 29, 2008, the Office issued an Order granting reexamination in the '288 reexamination proceeding.

4. The proceeding progressed to the point that, on August 22, 2008, the Office issued an Action Closing Prosecution (ACP), in which claims 1-32 of record in the proceeding were all rejected.

5. On September 24, 2008, patent owner filed, under 37 CFR 1.951 (a), a comments submission including an amendment. The amendment proposed canceling claims 24, 29, and 32, and amending claims 12, 18-20, and 25.

6. On November 20, 2008, the Office issued a Right of Appeal Notice (RAN). The RAN stated that the amendment filed September 24, 2008 was denied entry in accordance with the guidelines set forth in MPEP 2673, subpart III.

7. On December 22, 2008, patent owner filed a Notice of Appeal.

8. On December 22, 2008, patent owner filed a petition under 37 CFR 1.181 for reconsideration of the refusal to enter the amendment dated September 24, 2008.

9. On January 5, 2009, third party requester filed a Notice of Cross Appeal.

10. A decision dismissing the December 22, 2008 patent owner petition under 37 CFR 1.181 was mailed by the Office on February 19, 2009.

11. On February 26, 2009, patent owner filed a petition under 37 CFR 1.182, for continued reexamination of the instant inter partes reexamination proceeding.

12. On March 5, 2009, third party requester filed an Appeal Brief.

13. On March 9, 2009, patent owner filed an Appeal Brief.

14. On March 31, 2009, the Office issued a decision dismissing the petition filed on February 26, 2009, for continued reexamination.

15. On April 10, 2009, Respondent briefs were filed by patent owner and the third party requester.

16. On May 22, 2009, patent owner filed the subject petition under 37 CFR 1.183 to permit consideration of an amendment under 37 CFR 1.116 filed concurrently therewith. This decision addresses the subject petition and entry of the amendment.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

I. Pertinent Regulations

37 CFR 1.183 provides:

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

37 CFR 41.63(b) provides (in part):

> (b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

37 CFR 1.116(b) provides (in part):

> (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, 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.

II. Findings and Analysis

Petitioner patent owner requests that rule 37 CFR 41.63(b) be waived in order to permit consideration for entry of the Amendment filed May 22, 2009, after the filing of an appeal. The May 22 Amendment is presented to address and resolve rejections of the claims based on 35 U.S.C. § 112, second paragraph. Presently, at issue on appeal, there are numerous prior art rejections under 35 U.S.C. § § 102 and 103 and rejections under 35 U.S.C. § 112, first and second paragraphs. Resolving issues of indefiniteness under § 112, second paragraph, would reduce the number of issues on appeal.

In an effort to simplify issues on appeal and expedite prosecution, the request to waive rule 37 CFR 41.63(b) is granted. This waiver is not to be construed as granting entry of the May 22 Amendment. Rather, this waiver will permit the examiner to consider whether the May 22 Amendment should be entered. No decision as to the propriety of the May 22 Amendment is made herein.

Based on the facts and circumstances of this case, patent owner has demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, waiver of the rule is appropriate, and the petition is granted.

PATENT OWNER ADDRESS

It is noted that the attorney of record and patent owner address of record in the patent file are not the same as the attorney acting in a representative capacity for patent owner and his

address being used in correspondence in the re-examination proceeding. As no new power of attorney, supported by a statement under 37 CFR 3.73(b) showing that the signer of such new power of attorney has the authority to act on behalf of the patent owner, has been filed, correspondence will continue to be maintained with the attorney and address of record in the patent file. The Office will not engage in double correspondence.

CONCLUSION

1. For the reasons set forth above, the instant petition is granted.

2. The amendment filed May 22, 2009, will be entered into the record of the '288 proceeding.

3. Jurisdiction of the '288 proceeding is being returned to the Central Reexamination Unit for further handling consistent with this decision in which the examiner will consider entry of the May 22 Amendment.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

6/29/09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,288	01/15/2008	6547764	22452-3100/US	3867

7590 06/02/2010

EXAMINER	

Marc A. Began, Esq.
Novo Nordisk Pharmaceuticals, Inc.
100 College Road West
Princeton, NJ 08540

ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BARBARA A. WIGLEY
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45 SOUTH 7TH STREET
SUITE 3300
MINNEAPOLIS, MN 55402-3901

MAILED

JUN 02 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,288*.

PATENT NUMBER *6,547,764*.

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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JUN 02 2010

CENTRAL REEXAMINATION UNIT

In re Larsen *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,288
Filed: Jan. 15, 2008
For: U.S. Patent No. 6,547,764

DECISION DISMISSING PETITION

This is a decision on the patent owner's "PETITION UNDER 37 CFR 1.183 TO WAIVE 37 CFR 41.63(B)" filed on December 18, 2009, requesting waiver of the rule to permit consideration of an Amendment under 37 CFR 1.116.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to deposit account No. 01-0035.

The petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,547,764 (hereinafter, the '764 patent) issued to Larsen et al. on April 15, 2003 with 17 claims.

2. A corrected request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,288 (the '288 proceeding), was deposited by a third party requester on January 15, 2008, and a filing date of January 15, 2008 was assigned to the request, as corrected.

3. On February 29, 2008, the Office issued an Order granting reexamination in the '288 reexamination proceeding.

4. The proceeding progressed to the point that, on August 22, 2008, the Office issued an Action Closing Prosecution (ACP), in which claims 1-32 of record in the proceeding were all rejected.

5. On September 24, 2008, patent owner filed, under 37 CFR 1.951 (a), a comments submission including an amendment. The amendment proposed canceling claims 24, 29, and 32, and amending claims 12, 18-20, and 25.

6. On November 20, 2008, the Office issued a Right of Appeal Notice (RAN). The RAN stated that the amendment filed September 24, 2008 was denied entry in accordance with the guidelines set forth in MPEP 2673, subpart III.

7. On December 22, 2008, patent owner filed a Notice of Appeal.

8. On December 22, 2008, patent owner filed a petition under 37 CFR 1.181 for reconsideration of the refusal to enter the amendment dated September 24, 2008.

9. On January 5, 2009, third party requester filed a Notice of Cross Appeal.

10. A decision dismissing the December 22, 2008 patent owner petition under 37 CFR 1.181 was mailed by the Office on February 19, 2009.

11. On February 26, 2009, patent owner filed a petition under 37 CFR 1.182, for continued reexamination of the instant *inter partes* reexamination proceeding.

12. On March 5, 2009, third party requester filed an Appellant Brief.

13. On March 9, 2009, patent owner filed an Appellant Brief.

14. On March 31, 2009, the Office issued a decision dismissing the petition filed on February 26, 2009, for continued reexamination.

15. On April 10, 2009, Respondent briefs were filed by patent owner and the third party requester.

16. On May 22, 2009, patent owner filed a petition under 37 CFR 1.183 to permit consideration of an amendment under 37 CFR 1.116 filed concurrently therewith. The petition was granted on June 30, 2009.

17. On Sept. 15, 2009, both respondent briefs filed April 10, 2009 were held defective. A compliant respondent brief was filed by third party requester on October 9, 2009, and a compliant respondent brief was filed by patent owner on October 19, 2009.

18. On November 17, 2009, an Examiner's Answer was mailed, including an indication that the May 22, 2009 amendment was considered and was not entered.

19. On December 18, 2009, patent owner filed a petition under 37 CFR 1.183 to permit consideration of a second amendment under 37 CFR 1.116 filed concurrently therewith.

20. On December 22, 2009, a rebuttal brief was filed by patent owner.

21. Oral hearings were requested respectively by third party requester on January 15, 2010, and by patent owner on January 20, 2010.

22. On May 20, 2010, an Order returning an undocketed appeal to the examiner was issued for consideration of the subject petition, payment of the oral hearing fee by patent owner, and identification of the rejections cross appealed by the third party requester.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

I. Pertinent Regulations

37 CFR 1.183 provides:

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

37 CFR 41.63(b) provides (in part):

> (b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

37 CFR 1.116(b) provides (in part):

> (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, 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.

II. Findings and Analysis

Petitioner patent owner requests that rule 37 CFR 41.63(b) be waived in order to permit consideration for entry of the amendment filed December 18, 2009, after the filing of an appeal. The December 18 amendment is presented to address and resolve rejections of the claims based on 35 U.S.C. § 112, first and second paragraphs. Presently, at issue on appeal,

there are numerous prior art rejections under 35 U.S.C. § § 102 and 103 and rejections under 35 U.S.C. § 112, first and second paragraphs.

Patent owner requests that the petition be granted on the following grounds (in summary):

(a) The December 18 amendment includes the same substantive changes in the claims as in the May 22 amendment;

(b) The May 22 petition was granted permitting the examiner to consider the May 22 amendment;

(c) No Office action was issued in response to the May 22 amendment; thus, patent owner was not afforded an opportunity to make further claim changes;

(d) The Examiner's Answer does not assert that the May 22 amendment failed to overcome each and every ground of rejection under § 112;

(e) The December 18 proposed amendment requests the same claim amendments as the May 22 amendment without a clerical error; and

(f) The December 18 proposed amendment would reduce the number of issues on appeal.

As to points (a), (b), and (e) above, the proposed amendment is *not* the same as the May 22 amendment, which was considered by the examiner, since the prior submission included new language that caused it to be denied entry. As to points (c) and (d) above, there is no requirement that a new Office action be issued ôr that every point raised in an amendment after the right of appeal notice be addressed when considering whether the submission is proper for entry. As for point (f), it is not clear that entry of the December 18 amendment would in fact resolve all of the outstanding issues under § 112. As one example, the proposed changes to claim 12 do not clearly resolve the antecedent issues with respect to the needle cannula since the additional language does not make each recitation of that element consistent within the claim or with the dependent claims.

After careful consideration of the grounds raised in the petition, and after consulting with the examiner, the facts of the petition have not shown that an extraordinary situation exists that, in the interest of justice, would require consideration of the amendment at this stage in the proceeding. The mandate for special dispatch controls the facts presented in this petition because it is not clear that consideration of the amendment would significantly advance prosecution and warrant delay of the appeal process.

As a final point, extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, patent owner can file a reissue application in an effort to correct the patent by narrowing the claims to read as proposed in the amendment at issue which has not been entered. The filing of a reissue application is the appropriate vehicle for

correction of an error in a patent, and such a filing of a reissue application would still permit the reexamination to proceed (with the appeal) with special dispatch in resolving the substantial new question of patentability in the reexamination, while obtaining the relief desired by patent owner. See also MPEP 1449.01 which explains the handling of a reissue application where it is filed prior to the issue of a reexamination certificate. It is also pointed out that any reexamination certificate that is issued for this proceeding would contain a notification that such a reissue application was still outstanding

Based on the facts and circumstances of this case, patent owner has not demonstrated that an extraordinary situation exists such that justice requires relief under 37 CFR 1.183. Accordingly, waiver of the rule is not appropriate, and the petition is dismissed.

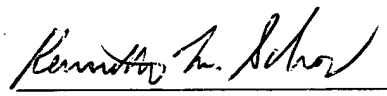
CONCLUSION

1. For the reasons set forth above, the instant petition is dismissed.

2. The amendment filed December 18, 2009, will not be entered into the record of the '288 proceeding.

3. Jurisdiction of the '288 proceeding is being returned to the Central Reexamination Unit for further handling consistent with the May 20, 2010 Order.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.



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

6/1/10
KenFinal+ACP - after it/Amdt-Decl enter

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MURABITO, HAO & BARNES, LLP
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For Patent Owner

MAILED
JAN 03 2008
CENTRAL REEXAMINATION UNIT

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For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
EX PARTE & INTER PARTES
REEXAMINATION
PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/007,929
Deposited on: 12 February 2006
For: US Patent No. 6,804,129

In re: Lin :
Ex Parte Reexamination Proceeding :
Control No. 90/008,378 :
Deposited on: 15 December 2006 :
For: US Patent No. 6,804,129 :

In re: Lin :
Inter Partes Reexamination Proceeding :
Control No. 95/000,291 :
Deposited on: 16 August 2007 :
For: US Patent No. 6,804,129 :

The above-identified reexamination files are before the Director of the Central Reexam Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.989

DISCUSSION

As noted under 37 CFR 1.989. Merger of concurrent reexamination proceedings.

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.

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

As noted in the above noted facts, the *inter partes* reexamination proceeding and the *ex parte* reexamination proceedings are currently pending Since reexamination has been ordered in all the proceedings and the time period for filing the appropriate subsequent patent owner's response has expired, a decision under 37 CFR § 1.989 (a) is timely.

The general policy of the Office is that the examination of the *inter partes* reexamination proceeding and the *ex parte* reexamination proceedings will not be conducted separately but will be conducted at the same for a single patent resulting in a single reexamination certificate. The reason for this policy is to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting prosecution of all 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.

In review of the prosecution history of the inter partes reexamination control number 95/000,291 there have been no amendments to the claims since the order has only just been granted. There is no first Office action on the merits at this time.

In review of the prosecution history of the ex parte proceedings 90/007,929 and 90/008,378 there are no amendments at this time to the claims or specification in these previously merged proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.989(a), the 90/95/000,291; 90/007,929 and 90/008,378 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files throughout the prosecution of the merged proceedings.

III. Conduct of Merged Proceeding.

A. Governing regulations for the merged proceedings:

The present decision merges the ex parte proceedings and the inter partes proceeding. Pursuant to 37 CFR 1.989 (b), the merges proceeding is to be governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed.

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

CONCLUSION

1. Reexamination Control Nos. 95/000,291; 90/007,979 and 90/008,378 are **MERGED**.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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

By Mail 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

MARK J. REINHART
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,291	10/01/2007	6804129	10598.0002-00	6022

41066 7590 06/27/2008

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TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2008

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JUN 27 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,291* + 90\008378 + 90\007989

PATENT NUMBER *6,804,129*.

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 27 2008

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Roger Fulghum
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Kenneth H. Ohriner (For 90/007,929 Requester)
Perkins Coie LLP
P.O. Box 1208
Seattle, WA 98111

In re Lin
Inter partes Reexamination Proceeding
Control No.: 95/000,291
Filed: October 1, 2007
For: U.S. Patent No. 6,804,129

In re Lin
Ex parte Reexamination Proceeding
Control No.: 90/008,378
Filed: December 15, 2006
For: U.S. Patent No. 6,804,129

In re Lin
Ex parte Reexamination Proceeding
Control No.: 90/007,929
Filed: February 12, 2006
For: U.S. Patent No. 6,804,129

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the June 13, 2008 patent owner petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,804,129 (the '129 patent) issued on October 12, 2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,929 ('929), was filed on February 12, 2006, by the '929 third party requester. An order granting reexamination of the '129 patent was mailed for the '929 reexamination proceeding on April 11, 2006.

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/008,378 ('378), was filed on December 15, 2006, by the '378 third party requester. An order granting reexamination of the '129 patent was mailed for the '378 reexamination proceeding on January 26, 2007.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,291 ('291), was filed on October 1, 2007, by the '291 third party requester. An order granting reexamination of the '129 patent was mailed for the '291 reexamination proceeding on November 9, 2007.

5. A decision merging the '929, '378, and '291 reexamination proceedings was mailed on January 3, 2008.

6. A non-final Office action regarding the merged proceeding was mailed on March 26, 2008.

7. On April 28, 2006, patent owner filed a response that was 168 pages in length to the March 26, 2008 Office Action.

8. On June 13, 2008, the patent owner filed the instant petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length.

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 on filing its response to the Office action of March 26, 2008. The April 28, 2006 response to the March 26th Office action is 168 pages in length. Based upon the need to address the patentability issues raised in the three merged reexamination proceedings, the requested page limit of 168 pages is deemed equitable in addressing the Office action. Accordingly, the petition is granted:

(A) For only the April 28, 2006 response supplied by the patent owner in response to the March 26, 2008 Office action, and thus

(B) To permit patent owner to provide one-hundred and sixty-eight (168) pages for patent owner's response to the March 26, 2008 Office action, as patent owner has done.

CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the length requirement of 37 CFR 1.943(b) is granted to permit patent owner's April 28, 2006 response to the March 26, 2008 first Office action, which response is one-hundred and sixty-eight (168) pages in length.

2. The date for filing of any third party requester comments under 37 CFR 1.947 runs thirty (30) days from the date of this decision waiving the length requirement of 37 CFR 1.943(b), to now complete the response *as to the length requirement.*

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

4. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Office of Patent Legal Administration, at (571) 272-7710.

for

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

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MAY 05 2009

CENTRAL REEXAMINATION UNIT

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BAKER BOTTS LLP
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Houston, TX 77002

Inter Partes Reexamination Proceeding :
Control No. 95/000,291 :
Filed: October 1, 2007 :
For: U.S. Patent No. 6,804,129 :
:
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/007,929 : **GRANTING**
Filed: February 12, 2006 : **PETITION**
For: US Patent No. 6,804,129 :
:
Ex Parte Reexamination Proceeding :
Control No. 90/008,378 :
Filed: December 15, 2006 :
For: US Patent No. 6,804,129 :

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 March 3, 2009.

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

The patent owner petition under 37 CFR 1.183 is granted for the concurrently submitted (March 3, 2009) patent owner 37 CFR 1.951(a) submission. The page limit of 37 CFR 1.943(b) submission is waived as to the 8 pages of the arguments portion of the patent owner's March 3, 2009 response that are found to exceed the 50-page limit.

Because the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 did not accompany the March 3, 2009 petition, the petition fee of $400.00 will charged to patent owner's Deposit Account (50-4160), as authorized on page 2 of the petition.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,804,129 (the '129 patent) issued on October 12, 2004.

2. On February 12, 2006, a first request for *ex parte* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 90/007,929 (the '7929 proceeding).

3. On April 11, 2006, the Office issued an order granting *ex parte* reexamination in the '7929 proceeding.

4. On December 15, 2006, a second request for *ex parte* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 90/008,378 (the '8378 proceeding).

5. On January 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8378 proceeding.

6. On August 9, 2007, the Office issued a "DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS," merging the '7929 and '8378 *ex parte* proceedings.

7. On October 1, 2007, a request for *inter partes* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 95/000,291 (the '291 proceeding).

8. On November 9, 2007, the Office issued an order granting *inter partes* reexamination in the '291 proceeding.

9. On January 3, 2008, the Office issued a "DECISION, *SUA SPONTE* MERGING *EX PARTE* & *INTER PARTES* REEXAMINATION PROCEEDINGS," merging the '7929, '8378, and '291 proceedings into a single, merged proceeding ("the merged proceeding").

10. On February 2, 2009, the Office mailed an Action Closing Prosecution in the merged proceeding.

11. On March 3, 2009, patent owner filed 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)."

12. Concurrently on March 3, 2009, patent owner filed a 37 CFR 1.951(a) submission, after the February 2, 2009 Action Closing Prosecution.

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.

On March 3, 2009, patent owner concurrently filed with the instant petition a 37 CFR 1.951(a) submission, titled as a response to the February 2, 2009 Action Closing Prosecution. The response exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 8 pages (the response is a total of 66 pages - 1 page of identification information and introductory remarks, 7 pages of claim amendments, and 58 pages of arguments).[1] In the instant petition, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the March 3, 2009 response.

In support of waiver of the rule, patent owner indicates that the February 2, 2009 Action Closing Prosecution "numbered 137 pages in length and recites eighteen issues."[2] Patent owner asserts that "[i]n order effectively address the patentability of the three merged proceedings, and rebut the eighteen issues raised in the Office Action, the Patent Owner feels it will be necessary to exceed the 50 page limit set forth in 37 C.F.R. § 1.943."[3]

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner's response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the March 3, 2009 petition for waiver of 37 CFR 1.943(b) with respect to the submitted response. Upon review of the submitted response for economizing, extraneous

[1] Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2).
[2] Petition at page 1.
[3] Petition at pages 1-2.

material, and arrangement, without repetition of information already of record, it is found that the 8 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances.

Based on the February 2, 2009 Action Closing Prosecution, which sets forth 50 grounds of rejection of the claims in approximately 120 pages, and the review of the submitted response thereto, as well as on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the arguments portion of patent owner's March 3, 2009 response exceeds the 50-page limit by 8 pages.

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 waived as to the **8 pages** of the arguments portion of the patent owner's March 3, 2009 response that exceed the 50-page limit.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) submission is waived as to the 8 pages of the arguments portion of the patent owner's March 3, 2009 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 Dretar, Legal Advisor, at 571-272-7717.

/Kenneth M. Schor/

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

04-28-09
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MAILED

AUG 12 2009

CENTRAL REEXAMINATION UNIT

Mark Levy
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(Courtesy Copy)

In re Thomas et al
Inter Partes Reexamination Proceeding
Control No. 95/000292
Filed: September 4, 2007
For: U.S. Patent No. 6,910,601

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

This decision is in response to the April 18, 2009 patent owner petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.951(a) that, after an action closing prosecution has been mailed by the Office, the patent owner may only once file comments limited to the issues raised in the Office action closing prosecution ("the April 18, 2009 patent owner petition").

This decision also addresses the certificate of service which accompanied the March 18, 2009 patent owner response ("the March 18, 2009 patent owner response").

In addition, this decision addresses the April 17, 2009 comments by the third party requester, to the extent that the comments discuss the service of the March 18, 2009 patent owner response ("the April 17, 2009 requester comments").

The April 18, 2009 patent owner petition, the March 18, 2009 patent owner response, the April 17, 2009 third party requester comments, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 has been received.

SUMMARY

1. The April 18, 2009 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.951(a) is **granted**. The April 18, 2009 patent owner petition, which includes patent owner's arguments regarding the correspondence address of the requester and the service on requester of the March 18, 2009 response, has been entered, will remain in the file, and has been addressed by this decision.

2. The March 18, 2009 patent owner response **has been entered** into the official file. The patent owner's service of the March 18, 2009 response on the requester is deemed to be **proper**.

BACKGROUND

- On June 28, 2005, U.S. Patent 6,910,601 (the '601 patent) issued to Thomas et al.

- On August 17, 2007, the requester deposited a request for *inter partes* reexamination, including a transmittal letter identifying the correspondence address of the third party requester as Mark Levy & Associates, PLLC, Press Building, Ste. 902, 19 Chenango Street, Binghamton, NY 13901 ("the Chenango street address"). The signature block of the representative of the third party requester, appearing on page 77 of the request, also identifies the Chenango street address. The reexamination proceeding was assigned control no. 95/000,292 ("the '0292 proceeding").

- On September 4, 2007, the requester deposited a supplemental request paper, i.e., a request for *inter partes* reexamination transmittal form PTO/SB/58, identifying, on page 2, the correspondence address of the third party requester as that of customer number 41245. Office records reveal that the address identified with customer number 41245 is Mark Levy, Hinman, Howard, & Kattell, LLP, 80 Exchange Street, P.O. Box 5250, Binghamton, NY 13901 ("the Exchange street address").

- On September 6, 2007, the Office mailed a notice of assignment of *inter partes* reexamination request, and a notice of *inter partes* reexamination request filing date to the third party requester at the Chenango street address, and to the patent owner. The '0292 proceeding was given a filing date of September 4, 2007.

- On November 14, 2007, the Office mailed an order granting reexamination in the '0292 proceeding to the third party requester at the Chenango street address, and to the patent owner.

- Also on November 14, 2007 the Office mailed a first Office action in the '0292 proceeding to the third party requester at the Chenango street address, and to the patent owner.

- On January 10, 2008, the patent owner filed a response to the November 14, 2007 Office action, and a certificate of service stating that a copy of the January 10, 2008 response was served on the third party requester at the Chenango street address.

- On February 11, 2008, the third party requester filed comments after the January 10, 2008 patent owner response. The February 11, 2008 comments are accompanied by a certificate of mailing dated February 8, 2008, and contain a signature block of the representative for the third party requester identifying the Chenango street address.

- On April 23, 2008, the Office mailed a notice of defective paper to the third party requester at the Chenango street address, and to the patent owner.

- On May 13, 2008, the patent owner filed a response to the April 23, 2008 notice of defective paper, accompanied by a certificate of service stating that a copy of the May 13, 2008 response was served on the third party requester at the Chenango street address.

- On February 23, 2009, the Office mailed an action closing prosecution to third party requester at the Chenango street address, and to the patent owner.

- On March 18, 2009, the patent owner filed a response to the February 23, 2009 action closing prosecution, accompanied by a certificate of service stating that a copy of the March 18, 2009 response was served on the third party requester at the Chenango street address ("the March 18, 2009 patent owner response").

- On April 17, 2009, the third party requester filed comments after the March 18, 2009 patent owner response. The April 17, 2009 comments contain, on page 14, a signature block of the representative of the third party requester identifying the Exchange street address ("the April 17, 2009 requester comments").

- On April 18, 2009, the patent owner filed the present petition under 37 CFR 1.183, which is taken as a petition to waive the requirement of 37 CFR 1.951(a) that, after an action closing prosecution has been mailed by the Office, the patent owner may only once file comments limited to the issues raised in the Office action closing prosecution ("the April 18, 2009 patent owner petition").

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314(b)(1) provides:

> 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.

37 CFR 1.33 provides, in pertinent part:

> Correspondence address and daytime telephone number . When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing . . .The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address.

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(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.

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

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

37 CFR 1.951(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 403 provides, in pertinent part:

37 CFR 1.33(a) provides that in a patent application the applicant must specify a correspondence address to which the Office will send notices, letters and other communications relating to the application. The correspondence address must appear either in an application data sheet (37 CFR 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with an application filing. Where more than one correspondence address is specified, the Office will select one of the correspondence addresses for use< as the correspondence address. This is intended to cover, for example, the situation where an application is submitted with multiple addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying 37 CFR 1.63 oath or declaration, or other similar situations. The Office will select which of the multiple correspondence addresses to use according to the following order: (A) application data sheet (ADS); (B) application transmittal; (C) oath or declaration (unless power of attorney is more current); and (D) power of attorney.< If more than one correspondence address is specified in a single document, the Office will select the address associated with a Customer Number over a typed correspondence address.

I. Customer Number Practice

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As the Office will not recognize more than one correspondence address (37 CFR 1.33(a)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application will generally be resolved in favor of the address of the Customer Number.

MPEP 601.03 provides, in pertinent part (emphasis added):

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. **Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.**

MPEP 2609 provides, in pertinent 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.

MPEP 2666.06 provides, in pertinent part:

. . . the service provision of the statute poses a problem, since, 35 U.S.C. 314(b)(2) mandates that, in order to be timely, a third party requester must file any written comments to the patent owner's response (to an Office action on the merits) within a period of 30 days from the date of service of such patent owner's response. Accordingly, if a patent owner's response to an Office action on the merits that is served on a third party requester is received by the third party requester more than 5 business days after the date of service set forth on the certificate of service, the third party requester may submit a verified statement, specifying the date of actual receipt, as an attachment to the third party requester's comments. The date of service will then be deemed by the Office to be the date of actual receipt by the third party requester of the patent owner's response.

MPEP 2613 provides, in pertinent part:

All correspondence for a third party requester is addressed to the representative of the requester, unless a specific indication is made to forward correspondence to another address.

MPEP 2622 provides, in pertinent part (emphasis added):

Address of Patent Owner: The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings. See 37 CFR 1.33(c).

MPEP 2624 provides, in pertinent part:

> Communications from the Office to the patent owner will be directed to the correspondence address for the patent being reexamined. See 37 CFR 1.33(c) . . . Where no correspondence address is otherwise specified, correspondence will be with the most recent attorney or agent made of record by the patent owner.

DECISION

The petitioner, who is the patent owner in the '0292 proceeding, points to arguments made by the third party requester in the April 17, 2009 requester comments, that the March 18, 2009 patent owner response should be treated as untimely, and should not be considered, because the third party requester argues that he was not served with a copy of the March 18, 2009 patent owner response.[1]

The petitioner argues that, if a copy of the March 18, 2009 patent owner response was never actually received by Mr. Levy, the representative of the requester, any lack of service was due to the fact that Mr. Levy did not file a change of correspondence address with the Office. The petitioner requests that the provisions of 37 CFR 1.951(a) be waived to permit the patent owner, by entry of the present April 18, 2009 patent owner petition, to inform the examiner "that any issue with receiving the March 18, 2009 response was due to Mr. Levy's change of address that was not of record in this file, and not due to some fault or failure of the patent owner."[2]

Office records reveal that, on August 17, 2007, the requester specified that the correspondence address of the requester is Mark Levy & Associates, PLLC, Press Building, Ste. 902, 19 Chenango Street, Binghamton, NY 13901 ("the Chenango street address"). On August 17, 2007, the third party requester deposited a request for reexamination, accompanied by a paper entitled "Request for Reexamination Transmittal Form". Box 13, which appears on page 2 of the "Request for Reexamination Transmittal Form" states (emphasis added):

> The requester's correspondence address (*if different from Number 2 above*):

Box 13 is unchecked, and is not completed, i.e., it is blank. Box 2 of the "Request for Reexamination Transmittal Form", which is checked, identifies the address of the requester as the Chenango street address. The "Request for Reexamination Transmittal Form", therefore, reveals that the requester expressly identified the Chenango street address as the correspondence address of the third party requester.[3]

The Office processes request papers as soon as possible upon receipt. This processing includes the assignment of a control number to the proceeding, and the entry of the requester's correspondence address into the computerized database of the Office. The request is then reviewed for compliance with filing date requirements. According to standard procedure, the

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[1] See the last paragraph of page 3 of the April 18, 2009 patent owner petition, as well as, for example, the paragraph bridging pages 1-2, and the third paragraph on page 5, of the April 17, 2009 requester comments.

[2] See the middle paragraph of page 4, as well as page 5, of the April 18, 2009 patent owner petition.

[3] In addition, the signature block of the representative of the requester, which appears on page 77 of the request, also designates the Chenango street address.

correspondence address of the requester in the new proceeding is entered into the Office's database soon after receipt of the request papers. In this case, the Chenango street address was the correspondence address of the requester entered in the '0292 proceeding, based on the standard procedure.

Several weeks after the Office's receipt of the request for the '0292 proceeding, including the "Request for Reexamination Transmittal Form", the requester filed, on September 4, 2007, a request for *inter partes* reexamination transmittal form PTO/SB/58, which indicates, on page 2, a correspondence address of the third party requester as that of customer number 41245. Office records reveal that the address identified with customer number 41245 is Mark Levy, Hinman, Howard, & Kattell, LLP, 80 Exchange Street, P.O. Box 5250, Binghamton, NY 13901 ("the Exchange street address").[4] No specific indication was provided, however, that the requester's originally designated correspondence address had been changed.

MPEP 601.03 provides, in pertinent part:

> The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

Because the requester failed to notify the Office that the September 4, 2007 transmittal contained a change of correspondence address, it was appropriate for the Office not to legally recognize a change in correspondence address.[5] While inconsistencies between a correspondence address resulting from a customer number and any other correspondence address provided in the

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[4] A review of the August 17, 2007 "Request for Reexamination Transmittal Form" reveals that the certification required by 37 CFR 1.915(b)(7), that the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination, was missing. This certification is required in order to obtain a filing date under 37 CFR 1.915(d) and under 37 CFR 1.919. In addition, the August 17, 2007 "Request for Reexamination Transmittal Form" submitted the required fee for an *inter partes* reexamination request, but referred to the rules for *ex parte* reexamination, rather than for *inter partes* reexamination. Once the September 4, 2007 transmittal form, containing the required certification and referring to the appropriate rules, was filed, a filing date was accorded.

[5] Office records reveal that, since the September 4, 2007 filing date of the '0292 proceeding, all Office communications in the '0292 proceeding, up to and including the February 23, 2009 action closing prosecution, were mailed to the third party requester at the Chenango street address. In addition, Office records reveal that the January 10, 2008 and the May 13, 2008 patent owner responses were each accompanied by a certificate of service indicating that a copy of these responses were served on the requester at the Chenango street address. See the "Background" section of this decision. Office records fail to reveal that the requester ever mentioned an intent to change the requester's correspondence address after receipt of any of these papers. In fact, the requester's representative, Mr. Levy, continued to identify the Chenango street address in his signature block appearing on page 30 of the February 11, 2008 comments. It is not until the April 17, 2009 comments that the requester mentions a failure to receive service of a copy of the March 18, 2009 patent owner response, and it is not until the April 17, 2009 comments that the requester's representative identifies the Exchange street address in his signature block, which appears on page 14. No mention, however, is made in the April 17, 2009 comments of the continued mailing of Office communications to the Chenango street address.

proceeding are generally resolved in favor of the customer number,[6] a correspondence address will generally not be changed where, as here, the customer number is included in a subsequent paper filed for another purpose, without mention of the fact that an address change is being made.

To date, the requester has failed to separately file, in this proceeding, a change of correspondence address, such as form PTO/SB/123B. For this reason, the official correspondence address for the requester in this proceeding remains the Chenango street address.

In addition, the Office notes that the requester became aware of the March 18, 2009 patent owner response on April 10, 2009, "as a result of its own routine check of the PTO's docket" [7] and apparently had obtained a copy of the response, given the April 17, 2009 requester comments, which were timely filed in response to the March 18, 2009 patent owner response. Even if the September 4, 2007 transmittal form were construed as a change of correspondence address, which it is not, service was effectively made on April 10, 2009, at the time that requester became aware of the March 18, 2009 patent owner response.[8]

The third party requester cannot argue that the requester was not served with the March 18, 2009 patent owner response, since 1) Office records fail to reveal that a separate paper, clearly requesting a change of correspondence address, was filed by the third party requester, 2) Office records for the '0292 proceeding are readily available to both parties by viewing Public PAIR using the Office's official website, www.uspto.gov, 3) the requester was on notice that the official correspondence address was deemed by the Office to be the Chenango street address, by virtue of the fact that all official correspondence, resulting in a total of six papers, were mailed to that address during a period of more than one and a half years, 4) the requester's representative continued to use the Chenango address himself,[9] 5) the requester's representative made no mention of a failure to receive a paper until the filing of the April 17, 2009 requester comments, when the Exchange street address appeared for the first time in his signature block, and 6) the requester actually received a copy of the March 18, 2009 response, by whatever means, and timely filed comments in response to the March 18, 2009 patent owner response.[10]

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[6] See MPEP 403, subsection I.

[7] See the paragraph bridging pages 1-2 of the April 17, 2009 requester comments.

[8] See also MPEP 2666.06, entitled "Service of Papers", which provides, in pertinent part:

> . . . the service provision of the statute poses a problem, since, 35 U.S.C. 314(b)(2) mandates that, in order to be timely, a third party requester must file any written comments to the patent owner's response (to an Office action on the merits) within a period of 30 days from the date of service of such patent owner's response. Accordingly, if a patent owner's response to an Office action on the merits that is served on a third party requester is received by the third party requester more than 5 business days after the date of service set forth on the certificate of service, the third party requester may submit a verified statement, specifying the date of actual receipt, as an attachment to the third party requester's comments. The date of service will then be deemed by the Office to be the date of actual receipt by the third party requester of the patent owner's response.

Office records fail to reveal that a verified statement pursuant to MPEP 2666.06 was filed. In addition, the Office notes that the patent owner appears to believe that the 30-day time period for filing requester's comments may be extended by the Office. This 30-day time period, however, is statutory, and cannot be waived or extended by the Office. See 35 U.S.C. 314(b)(2).

[9] See footnote 5.

[10] See the paragraph bridging pages 1-2 of the April 17, 2009 requester comments.

The parties are explicitly notified, via this decision, that the official correspondence address of the third party requester, which remains in this proceeding, is Mark Levy & Associates, PLLC, Press Building, Suite. 902, 19 Chenango Street, Binghamton, NY 13901.

Office records reveal that the March 18, 2009 patent owner response was served on the third party requester at the Chenango street address, which is the address of record for the third party requester. Accordingly, the patent owner's service of the March 18, 2009 response on the requester is deemed to be **proper**. The March 18, 2009 patent owner response **has been entered** into the official file.

For the reasons given above, the April 18, 2009 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.951(a) is **granted**. The April 18, 2009 patent owner petition, which includes patent owner's arguments regarding the correspondence address of the requester and the service on requester of the March 18, 2009 response, has been entered, will remain in the file, and has been addressed by this decision.

In addition, Office records further reveal that the address of the patent owner in this proceeding, which is the official correspondence address of the patent file, is linked to the address for customer number 30954. Office records reveal that the address for customer number 30954 was changed by the Office on multiple occasions, per "customer request".[11] The previous address linked to customer number 30954 was identical to the current address with the exception that "avenue" was changed to "boulevard", "LC" was changed to "LLP", and the suite number, suite 2800, was changed to suite 2400. These changes resulted in the current correspondence address of the patent owner, which is Lathrop and Gage, LLP, 2345 Grand Boulevard, Suite 2400, Kansas City, MO 64108.[12] Office records do not reveal, however, that the patent owner filed any notification **in the '0292 reexamination proceeding** that a change of address was filed with the Office for customer number 30954, which changed the correspondence address of the patent owner in the patent file (application no. 10/615503) of the patent under reexamination (the '601 patent). Such a notification would be accompanied by a copy of any paper filed with the Office to request the address change for customer number 30954. A certificate of service would be attached to the notification, certifying that the notification, and a copy of any paper that was filed with the Office to request the address change for customer number 30954, was served on the third party requester. The rules, at present, do not require the patent owner to serve a change of correspondence address on the third party requester, if the change of correspondence address is filed 1) directly into the patent file, using, for example, form PTO/SB/123, or 2) via a request for

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[11] At least some of the correspondence address changes were requested by the patent owner electronically via Private PAIR, using the Office's web site, www.uspto.gov.

[12] Currently, changes of correspondence address via customer number data change, which are processed by the Office's Electronic Business Center, do not necessarily appear in the Office's Image File Wrapper (IFW) database. While the Office is working to correct this issue, the patent owner is notified that both parties in the '0292 proceeding are called upon to serve the other party with any change of correspondence address, including a customer number data change, that is filed with the Office, and that the parties are called upon to file, in the '0292 proceeding, a notification of the correspondence address change, a copy of any paper filed with the Office to request the correspondence address change, including a customer number data change, and a certificate of service certifying that the notification and the copy of any papers accompanying the notification were served on the other party, as will be discussed *supra*.

customer number data change, which may be filed with the Office's Electronic Business Center (EBC), using, for example, i) form PTO/SB/124, entitled "Customer Number Data Change", ii) a spreadsheet loaded onto a diskette or a CD containing a customer number batch update, or iii) Private PAIR using the Office's web site, www.uspto.gov. The patent owner is reminded, however, that a failure to notify the requester of a change of address external to the reexamination proceeding, that is effective to change the patent owner address of the reexamination proceeding, delays the proceeding contrary to the special dispatch requirement of the reexamination statute. Also, a change in the patent owner address of the reexamination proceeding appears to be information that is material to requester's effective participation in this proceeding, thus providing a duty of notification. Accordingly, the patent owner is called upon, in the future, to file in the '0292 reexamination proceeding, a notification of any change of correspondence address of the patent owner that is filed with the Office,[13] including a copy of any paper that was filed with the Office to request an address change for customer number 30954 using any of the methods described above,[14] and to attach to the notification, a certificate of service certifying that the notification of change of correspondence address, and a copy of any paper that was filed with the Office to request a correspondence address change, including a request for an address change for customer number 30954, was served on the third party requester.

The third party requester is notified, via this decision, that the official correspondence address of the patent owner, that is now of record in this proceeding, is Lathrop and Gage, LLP, 2345 Grand Boulevard, Suite 2400, Kansas City, MO 64108.

In this instance, a courtesy copy of this decision is being mailed to the requester at the Exchange street address. If a clearly identified change of correspondence address, such as, for example, form PTO/SB/123B, is not separately filed in the '0292 reexamination proceeding by the requester in response to this decision, then all future Office correspondence will be mailed to the official correspondence address of record for the requester, at the Chenango street address. The Office also notes that the signature block of the April 17, 2009 comments identifies the zip code of the requester's Exchange street address as 13902, not 13901. The address associated with customer number 41245 includes a zip code of 13901. If this is incorrect, and if the requester files a change of correspondence address, such as form PTO/SB/123B, designating the address

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[13] The notification must state the current correspondence address. The notification should be, for example, a statement by the patent owner stating that a request to change the correspondence address of the patent file, 10/615503, and consequently, of the '0292 reexamination proceeding, has been filed on (specify date), by (specify the manner, such as by 1) filing form PTO/SB/123 in the patent file, or 2) requesting a customer number data change by filing, with the Office's EBC, i) form PTO/SB/124A, ii) an electronic request for an address change via Private PAIR, or iii) as part of a spreadsheet loaded onto a diskette or CD, containing a customer number batch update).

[14] If the correspondence address change of customer number 30954 is filed using the Office's form PTO/SB/124A, entitled "Request for Customer Number Data Change", the patent owner is called upon to file **in the '0292 proceeding**, with the notification, a copy of the completed form, and a copy of any cover letter that accompanies the form. If the correspondence address change is filed as part of a customer number batch update, using a spreadsheet loaded onto a diskette or CD, the patent owner is called upon to file **in the '0292 proceeding**, in addition to the notification, with a copy of the cover letter that accompanies the diskette or CD. If the change of address for a customer number is filed electronically via Private PAIR, using the Office's web site www.uspto.gov, the patent owner is called upon to file **in the '0292 proceeding**, with the notification, a copy of the web page containing the request for address change, and any confirmation page.

identified with this customer number, the requester must also file a data change for this customer number, such as, for example, form PTO/SB/124, to indicate the correct zip code.

Finally, see MPEP 2609, which provides, in pertinent 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.

Delays in the prosecution of any *inter partes* reexamination proceeding, caused by the parties in relation to the service of correspondence addresses in the proceeding, prevents the Office from conducting the *inter partes* reexamination proceeding with special dispatch, as required by 35 U.S.C. 314(c). For this reason, both parties are called upon, in the future, to serve the other party with a notification of any change of correspondence address in this '0292 *inter partes* reexamination proceeding, whether a separate change of correspondence address is filed by the patent owner directly in the patent file (application no. 10/615,503),[15] or whether the change in correspondence address is effected in the '0292 proceeding by the third party requester, or in the patent file by the patent owner, via a request for customer number data change, which may be filed with the Office's Electronic Business Center (EBC), using, for example, i) form PTO/SB/124, entitled "Customer Number Data Change", ii) a spreadsheet loaded onto a diskette or a CD containing a customer number batch update, or iii) Private PAIR using the Office's web site, www.uspto.gov. Specifically, the parties are called upon to file **in the '0292 reexamination proceeding**, a notification of any correspondence address change, [16] a copy of any paper filed with the Office to request the correspondence address change, including a customer number data change, [17] and a certificate of service attached to the notification,

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[15] The third party requester may separately file a change of correspondence address directly into the '0292 proceeding by filing, for example, form PTO/SB/123B. The patent owner may separately file a change of correspondence address directly into the patent file, application no. 10/615503, by filing form PTO/SB/123.

[16] The notification must state the current correspondence address. The notification should be, for example, a statement by the party requesting the address change, stating that a request to change the correspondence address has been filed on (specify date), by (specify the manner, such as by 1) filing form PTO/SB/123, if filed by the patent owner directly into the patent file, or 2) requesting a customer number data change by filing, with the Office's EBC, i) form PTO/SB/124A, ii) an electronic request for an address change via Private PAIR, or iii) as part of a spreadsheet loaded onto a diskette or CD, containing a customer number batch update). If, however, the third party requester requests a correspondence address change by filing the request (such as, for example, form PTO/SB/123B) **directly** into the '0292 reexamination proceeding, the third party requester is not called upon to additionally file a notification in the proceeding. The third party requester must, however, attach a certificate of service to the request, e.g., the completed form, certifying that a copy of the request, e.g., the completed form, and any paper that accompanied the request, such as a cover letter, were served on the patent owner.

[17] If the patent owner requests a correspondence address change by filing, for example, form PTO/SB/123 directly in the patent file, the patent owner is called upon to file **in the '0292 proceeding**, with the notification, a copy of the completed form, and a copy of any paper that accompanied the form, such as a cover letter. If the correspondence address change of a customer number is filed **by either party** using, for example, the Office's form PTO/SB/124A, entitled "Request for Customer Number Data Change", the party requesting the address change is called upon to file **in the '0292 proceeding**, with the notification, a copy of the completed form, and a copy of any paper, such as a cover letter, that accompanies the form. If the correspondence address change is filed **by either party** as part of a customer number batch update, using a spreadsheet loaded onto a diskette or CD, the party requesting the address change is called upon to file **in the '0292 proceeding**, with the notification, a copy of the cover letter that

certifying that the notification and the copy of any papers accompanying the notification were served on the other party. All papers served on the other party must include a copy of the certificate of service that was filed with the Office. If the third party requester requests a correspondence address change by filing the request (such as, for example, form PTO/SB/123B) **directly** into the '0292 reexamination proceeding, however, the third party requester is not called upon to additionally file a notification in the proceeding. The third party requester must, however, attach a certificate of service to the request, e.g., the completed form, certifying that a copy of the request, e.g., the completed form, and any paper that accompanied the request, such as a cover letter, were served on the patent owner, and must include a copy of the certificate of service with the papers served.

CONCLUSION

- The April 18, 2009 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.951(a) is **granted**. The April 18, 2009 patent owner petition, which includes patent owner's arguments regarding the correspondence address of the requester and the service on requester of the March 18, 2009 response, has been entered, will remain in the file, and has been addressed by this decision.

- The certificate of service of the March 18, 2009 patent owner response is found to be **proper**. The March 18, 2009 patent owner response **has been entered** into the official file.

- A courtesy copy of this decision is being mailed to the requester at Mark Levy, Hinman, Howard, & Kattell, LLP, 80 Exchange Street, P.O. Box 5250, Binghamton, NY 13901. If a clearly identified change of correspondence address, such as, for example, form PTO/SB/123B, is not filed by the requester in response to this decision, all future Office correspondence will be mailed to the official correspondence address of the requester, at Mark Levy & Associates, PLLC, Press Building, Ste. 902, 19 Chenango Street, Binghamton, NY 13901.

- If the requester, in response to this decision, files a separate change of correspondence address designating the address of customer number 41245, and if the requester wishes to designate zip code 13902 rather than 13901, which is the zip code of record for customer number 41245, the requester must also file a request for customer number data change, such as form PTO/SB/124, with the Office's Electronic Business Center (EBC), to correct the zip code of the official file to 13902.

- Any paper filed by either party in response to this decision must be served on the other party pursuant to 37 CFR 1.903.

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accompanies the diskette or CD. If the change of address for a customer number is filed electronically via Private PAIR, using the Office's web site www.uspto.gov, the party requesting the address change is called upon to file **in the '0292 proceeding**, with the notification, a copy of the web page containing the request for address change, and any confirmation page.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the March 18, 2009 patent owner response to the February 23, 2009 action closing prosecution and the April 17, 2009 third party requester comments on the March 18, 2009 patent owner response.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Beverly Flanagan, of CRU Art Unit 3993, at (571) 272-4766.

- Any further correspondence with respect to this matter should be addressed as follows:

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

  By Mail: Mail Stop Petition
  Commissioner for Patents
  Post Office Box 1450
  Alexandria, VA 22313-1450

  By Fax: (571) 273-9900

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

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

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

Kenpet7/IP
7-28-09

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.
95/000,292	09/04/2007	6,910,601	INN-000	4948

30954 7590 07/02/2010

LATHROP & GAGE LLP
2345 GRAND Boulevard
SUITE 2400
KANSAS CITY, MO 64108

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MARK LEVY
HINMAN, HOWARD & KATTELL, LLP
80 EXCHANGE STREET P.O. BOX 5250
BINGHAMTON, NY 13901

Date:

MAILED

JUL 02 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000292
PATENT NO. : 6910601
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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MARK LEVY & ASSOCIATES, PLLC
PRESS BUILDING, STE 902
19 CHENANGO STREET
BINGHAMTON, NY 13901

Date:

MAILED

JUL 02 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

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UNITED STATES PATENT AND TRADEMARK OFFICE

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LATHROP & GAGE LLP
2345 GRAND BOULEVARD
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KANSAS CITY, MO 64108

(For Patent Owner)

MARK LEVY & ASSOCIATES, PLLC
PRESS BUILDING, STE 902
19 CHENANGO STREET
BINGHAMTON, NY 13901

(For Requester)

MAILED

JUL 02 2010

CENTRAL REEXAMINATION UNIT

Mark Levy
Hinman, Howard, & Kattell, LLP
80 Exchange Street
P.O. Box 5250
Binghamton, NY 13901

(Courtesy Copy)

In re Thomas et al.
Reexamination Proceeding
Control No.: 95/000,292
Filed: September 4, 2007
For: U.S. Patent No.: 6,910,601

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on a petition filed by the third party requester on June 11, 2010. The petition is entitled "PETITION TO WITHDRAW DISMISSAL OF APPEAL" [hereinafter "the petition"], and treated as 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 May 12, 2010. This decision also addresses the patent owner's opposition to the petition, which was filed on June 25, 2010.

The petition and the opposition are before the Director of the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated June 11, 2010 is denied. The opposition to the petition is an improper paper and will be expunged from the record in accordance with MPEP 2667.

REVIEW OF RELEVANT FACTS

1. On June 28, 2005, U.S. Patent 6,910,601 (the '601 patent) issued to Thomas et al.

2. On August 17, 2007, the requester deposited a request for *inter partes* reexamination, including a transmittal letter identifying the correspondence address of the third party requester as Mark Levy & Associates, PLLC, Press Building, Ste. 902, 19 Chenango Street, Binghamton, NY 13901 ("the Chenango street address"). The signature block of the representative of the third party requester, appearing on page 77 of the request, also identifies the Chenango street address. The reexamination proceeding was assigned control no. 95/000,292 ("the '0292 proceeding").

3. On September 4, 2007, the requester deposited a supplemental request paper, i.e., a request for *inter partes* reexamination transmittal form PTO/SB/58, identifying, on page 2, the correspondence address of the third party requester as that of customer number 41245. Office records reveal that the address identified with customer number 41245 is Mark Levy, Hinman, Howard, & Kattell, LLP, 80 Exchange Street, P.O. Box 5250, Binghamton, NY 13901 ("the Exchange street address").

4. On September 6, 2007, the Office mailed a notice of assignment of *inter partes* reexamination request, and a notice of *inter partes* reexamination request filing date to the third party requester at the Chenango street address, and to the patent owner. The '0292 proceeding was given a filing date of September 4, 2007.

5. On November 14, 2007, the Office mailed an order granting reexamination in the '0292 proceeding to the third party requester at the Chenango street address, and to the patent owner.

6. Also on November 14, 2007 the Office mailed a first Office action in the '0292 proceeding to the third party requester at the Chenango street address, and to the patent owner.

7. On January 10, 2008, the patent owner filed a response to the November 14, 2007 Office action, and a certificate of service stating that a copy of the January 10, 2008 response was served on the third party requester at the Chenango street address.

8. On February 11, 2008, the third party requester filed comments after the January 10, 2008 patent owner response. The February 11, 2008 comments are accompanied by a certificate of mailing dated February 8, 2008, and contain a signature block of the representative for the third party requester identifying the Chenango street address.

9. On April 23, 2008, the Office mailed a notice of defective paper to the third party requester at the Chenango street address, and to the patent owner.

10. On May 13, 2008, the patent owner filed a response to the April 23, 2008 notice of defective paper, accompanied by a certificate of service stating that a copy of the May 13, 2008 response was served on the third party requester at the Chenango street address.

11. On February 23, 2009, the Office mailed an Action Closing Prosecution to third party requester at the Chenango street address, and to the patent owner.

12. On March 18, 2009, the patent owner filed a response to the February 23, 2009 Action Closing Prosecution, accompanied by a certificate of service stating that a copy of the March 18, 2009 response was served on the third party requester at the Chenango street address ("the March 18, 2009 patent owner response").

13. On April 17, 2009, the third party requester filed comments after the March 18, 2009 patent owner response. The April 17, 2009 comments contain, on page 14, a signature block of the representative of the third party requester identifying the Exchange street address ("the April 17, 2009 requester comments"). The comments stated that the patent owner failed to timely serve a copy of their response on the requester.

14. On April 18, 2009, the patent owner filed a petition under 37 CFR 1.183 ("the April 18, 2009 patent owner petition"), which was in response to the requester's statement that the patent owner failed to timely serve a copy of their March 18, 2009 response.

15. On August 12, 2009, a decision on the April 18, 2009 patent owner petition was mailed. The decision analyzed and determined that the requester's address correspondence of record is the Chenango Street address and that patent owner properly mailed a copy of their response to that address. See pages 6-9 and 12 of the decision, especially the bolded text at the beginning of page 9 of the decision.

16. On August 14, 2009, a Right of Appeal Notice was mailed to the patent owner and third party requester at the Chenango street address.

17. On September 16, 2009, the third party requester timely filed a Notice of Appeal.

18. On November 25, 2009, the third party requester filed an Appeal Brief.

19. On December 2, 2009, the patent owner filed a respondent brief and served the third party requester a copy at the Chenango street address with a courtesy copy being sent to the Exchange street address.

20. On April 6, 2010, the Office mailed an "*Inter Partes* Reexamination Notification re Brief," which stated that the third party requester's appeal brief of November 25, 2009 was defective and set a one month time period to file a corrected brief to avoid dismissal of the appeal. The notice was mailed to the Chenango street address.

21. On May 12, 2010, the Office mailed another "*Inter Partes* Reexamination Notification re Brief," which stated that appeal is dismissed because a corrected appeal brief was not timely received.

22. On June 9, 2010, the third party requester filed a paper regarding a change in correspondence address. No certificate of service accompanied the June 9, 2010 paper.

23. On June 11, 2010, the third party requester filed a replacement appeal brief and also the instant petition.

24. On June 25, 2010, the patent owner filed an opposition to the June 11, 2010 petition.

DECISION

The third party requester (petitioner) states that the requester is seeking review of the examiner's decision to withdraw the requester's appeal because the dismissal of the appeal would "... unduly and unfairly prejudice Third Party Requestor's rights." The petitioner fails to state the basis under which the petition is filed. As the petitioner did not pay a petition fee, which is required by 37 CFR 1.182 and 1.183, the instant petition is treated as a petition under 37 CFR 1.181 to request withdrawal of an improper dismissal of the appeal. Therefore, review of the petition is solely limited to whether the examiner followed Office rules and procedures in the determination that the appeal should be dismissed. Arguments pertaining to prejudice and unfairness are not applicable to whether the examiner followed proper procedures in the dismissal of the appeal. As such, these arguments will not be directly addressed in this decision.

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 41.68(c) states:

> (c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-

extendable time period within which to file an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

MPEP 2675.02 states, in pertinent part:

"Where an appellant or respondent brief does not comply with all the requirements of 37 CFR 41.67(a) and (c) or 37 CFR 41.68(a) and (b), respectively, such as missing fee or missing portion of the fee, a missing signature, inappropriate signature, less than three copies of the brief, no proof of service on a party; the appropriate party should be notified of the reasons for non-compliance and provided with a nonextendable period of one month within which to file an amended brief. The reasons for non-compliance and/or the defect(s) will be pointed out to the appropriate party in *one comprehensive action* (notification). Form PTOL-2067 will be used as the cover sheet for the notification action. A separate PTOL-2067 with notification action will be sent to each party, where the brief(s) of more than one party are non-compliant and/or defective. Where the same party's appellant and respondent briefs are both informal, the examiner may combine the notifications for both into one notification action with PTOL-2067.

If an appellant does not file an *amended* appellant brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance or does not correct all defects stated in the notification, the appeal will stand dismissed **as to that party**."

MPEP 2613 provides, in pertinent part:

All correspondence for a third party requester is addressed to the representative of the requester, unless a specific indication is made to forward correspondence to another address.

MPEP 601.03 provides, in pertinent part (emphasis added):

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. **Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.**

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 her decision to dismiss the third party requester's appeal.

In the petition, the petitioner states the April 6, 2009 Notification re Appeal was not received by the third party requester because the Office mailed the Notification to the Chenango street

address and not to the Exchange street address of the requester's attorney of record. The petitioner asserts that:

(1) the Office had previously acknowledged the Exchange street address as the "current address" and had improperly mailed the April 6, 2009 notice to the Chenango street address; and

(2) the third party requester did inform the Office of a change of address on or about March 1, 2008, and that the Exchange street address is "of record" in the USPTO.

See page 3 of the petition. The petitioner further explains that because the notice was mailed to the Chenango street address, the notice "... was inexplicably not conveyed to the undersigned for over one month, thus precluding any possibility for a timely response." See page 3 of the petition.

Upon review of the record, it is evident that the third party requester did not notify the Office of a change of address in March of 2008 in accordance with Office rules and policies. See MPEP 601.03 and 2613. See also pages 6-9 and 12 of the August 12, 2009 decision of record, which is incorporated by reference. In summary, this decision thoroughly analyzed the record up until August of 2009 and clearly determined that the third party requester's correspondence address is the Chenango street address. Specifically, the August 12, 2009 stated, in bold font, **"[t]he parties are explicitly notified, via this decision, that the official correspondence address of the third party requester, which remains in this proceeding, is Mark Levy & Associates, PLLC, Press Building, Suite. 902, 19 Chenango Street, Binghamton, NY 13901."** See page 9 of the August 12, 2009 decision. Therefore, the record is expressly clear and there is no doubt that the petitioner was so notified of the third party requester's correspondence address for the reexamination proceeding. As further evidence, throughout the entire record, the official correspondence address used for all Office communications is the Chenango street address and the official address for service used by the patent owner is the Chenango street address. The fact that both the Office and the patent owner mailed courtesy copies, at times, to the Exchange street address did not effect a correspondence address change in the reexamination proceeding. See MPEP 403, which states that dual correspondence is not undertaken by the Office. Accordingly, the petitioner's arguments that infer the Office mailed the April 6, 2010 notice in error to the Chenango street address is without merit.

Even after been clearly notified in August of 2009, the record shows that it was not until June 9, 2010 that the third party requester filed a paper in an effort to affect a change of correspondence address. The requester even admits that no notification of the change of the requester's correspondence address was made in this reexamination proceeding, but states that the "current address" has been associated with "... the undersigned's law firm's Customer Number 41245." See page 5 of the petition. However, the requester did not file an effective change of address for the Office to start using the Customer Number 41245 in the reexamination proceeding, and the petitioner was so notified by the August 12, 2009 decision. See pages 7-9 of the August 12, 2009 decision regarding use of the customer number for correspondence address. Furthermore, the petition makes no attempt to explain such a delay in filing a change of correspondence address. Accordingly, such a long delay to file a change in address is clearly counter to the

statutory requirement of "special dispatch." See 35 U.S.C. 314(c). Even the June 9, 2010 paper is ineffective to change the correspondence address for the third party requester because the June 9, 2010 paper did not include a certificate of service in accordance with Office rules and procedures. See 37 CFR 1.903. Therefore, the Chenango street address continues to be the correspondence address of record for the third party request in the reexamination proceeding.

Accordingly, the examiner correctly determined that the requester's appeal is dismissed for failure to file a corrected appeal brief within the one month time period set by the April 6, 2010 notice. 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 failed to file a replacement appeal brief. In accordance with Office policies set forth in MPEP 2675.02, the examiner dismissed the requester's appeal. The facts alone are controlling, and it is not relevant whether or not the error in not changing the correspondence address is "harmless," as discussed in the case law cited in the petition. For all these reasons, the petition is not persuasive that the examiner erred in her decision to dismiss 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 appeal is dismissed as to the third party requester. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and properly dismissed third party requester's appeal. Accordingly, the third party requester's petition is denied.

Patent Owner's Opposition to the Petition

Patent owner's paper filed on June 25, 2010, styled "Opposition to Petition Filed Circa 6/11/2010," is a paper that is not provided for in the rules. Accordingly, the paper could only be properly filed and considered if it were filed via a petition under 37 CFR 1.182 together with the petition fee set forth in 37 CFR 1.17(f), currently $400.00. The "Opposition to Petition Filed Circa 6/11/2010" was not filed as, or with, a petition under 37 CFR 1.182. Therefore, the substance of the paper has not been considered. The paper will be returned to the patent owner by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the examiner's decision to dismiss the appeal is denied.

2. Patent owner's paper filed on June 25, 2010, styled "Opposition to Petition Filed Circa 6/11/2010," is returned to the patent owner by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record.

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

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.
95/000,293	08/21/2007	6,947,702 B2	850-27	8349

23117 7590 03/25/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ECHOSTAR C/O MOFO LA
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013

Date:
MAILED
MAR 25 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000293
PATENT NO. : 6947702
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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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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MAILED

MAR 25 2009

CENTRAL REEXAMINATION UNIT

Robert W. Faris
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

(For Patent Owner)

Mehran Arjomand
ECHOSTAR C/O MOFO LA
555 WEST FIFTH STREET , SUITE 3500
LOS ANGELES, CA 90013

(For Third Party Requester)

DECISION
GRANTING
EXTENSION
OF TIME
[37 CFR § 1.956]

In re: Green, Sr. *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,293
Deposited on: 21 August 2007
For: US Patent No. 6,947,702

This is a decision on the 20 March 2009, patent owner petition titled "Reexamination-Request for Extension of Time Pursuant to 37 CFR Section 1.956," requesting that the time for responding to the Action Closing Prosecution Office action mailed 13 March 2009 to be extended by one (1) month.

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

The petition is granted for the reasons set forth below.

Statement of Relevant Facts

1. On 20 September 2005 US patent No. 6,947,702 was granted.

2. On 21 August 2007 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 26 October 2007 an Order Granting Request for *Inter Partes* Reexamination and a non-final Office action were mailed.

4. On 13 March 2009 an Action Closing Prosecution was mailed setting a time for response for one (1) month.

5. On 20 March 2009 the instant petition for a one (1) month extension of time was submitted by the patent owner.

Discussion

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution which was mailed on 13 March 2009. The Action Closing Prosecution provides for one (1) month period for response. The petition requesting a one (1) month extension of time was timely filed on 20 March 2009. Authorization to pay via credit card was provided in the petition dated 20 March 2009 to pay the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

Decision

The petition requests an extension of one (1) month time in which to reply to the outstanding Office action. The action is an Action Closing Prosecution. The petitioner notes that the Office action relies upon new prior art references that were not cited or applied in the previous Office action, the need to coordinate with the inventors and/or technical expert to properly respond to the requester's expert declaration, the large number of separate grounds of rejection and the illness/unavailability of one of the named inventors.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is "sufficient cause" to grant the petition for extension of time. A one (1) month extension of time is hereby granted.

The petition request is hereby granted.

A **one (1) month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Office action dated 13 March 2009 is hereby **granted**.

2. A **one (1) month** extension of time is hereby granted.

3. The office action mailed set a one (1) month response time for which to respond, with the granting of this extension of time, the period for response will end on **13 May 2009**.

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

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

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

By Hand: Customer Service Window
Randolph Building

401 Dulany Street
Alexandria, VA 22314

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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.
95/000,293	08/21/2007	6,947,702 B2	850-27	8349

23117 7590 10/14/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2009

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

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ECHOSTAR C/O MOFO LA
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013

Date:

MAILED

OCT 14 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000293
PATENT NO. : 6947702
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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Alexandria, VA 22313-1450
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Robert W. Faris
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

(For Patent Owner)

MAILED

OCT 14 2009

CENTRAL REEXAMINATION UNIT

Mehran Arjomand
ECHOSTAR C/O MOFO LA
555 WEST FIFTH STREET , SUITE 3500
LOS ANGELES, CA 90013

(For Third Party Requester)

DECISION
GRANTING-IN-PART
EXTENSION
OF TIME
[37 CFR § 1.956]

In re: Green, Sr. *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,293
Deposited on: 21 August 2007
For: US Patent No. 6,947,702

This is a decision on the 09 October 2009, patent owner petition titled "Reexamination-Request for Extension of Time Pursuant to 37 CFR Section 1.956," requesting that the time for responding to the Action Closing Prosecution Office action mailed 24 September 2009 to be extended by one (1) month.

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

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

Statement of Relevant Facts

1. On 20 September 2005 US patent No. 6,947,702 was granted.

2. On 21 August 2007 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 26 October 2007 an Order Granting Request for *Inter Partes* Reexamination and a non-final Office action were mailed.

4. On 24 September 2009 a second Action Closing Prosecution was mailed setting a time for response for one (1) month.

5. On 09 October 2009 the instant petition for a one (1) month extension of time was submitted by the patent owner.

Discussion

The Patent Owner requests an extension of time in which to file a response to the second Action Closing Prosecution which was mailed on 24 September 2009. The Action Closing Prosecution provides for one (1) month period for response. The petition requesting a one (1) month extension of time was timely filed on 20 March 2009. Authorization to pay via credit card was provided in the petition dated 20 March 2009 to pay the $200 petition fee pursuant to 37 CFR §1.17 (g).

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.

Decision

The petition requests an extension of one (1) month time in which to reply to the outstanding Office action. The action is the second Action Closing Prosecution. The petitioner notes that the Office action relies upon newly adopted grounds for rejection that were not cited or applied in the previous Office action, the need to analyze the new reasons for rejections, and the short period for response.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is "sufficient cause" to grant-in-part the petition for extension of time. A fourteen (14) day extension of time is hereby granted.

The petition request is hereby granted-in-part.

A **fourteen (14) day** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Office action dated 24 September 2009 is hereby **granted-in-part**.

2. A **fourteen (14) day** extension of time is hereby granted.

3. The office action mailed set a one (1) month response time for which to respond, with the granting of this extension of time, the period for response will end on **07 November 2009**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,295	08/03/2007	6687745	8163.003	6719

61834 7590 01/22/2008

DREIER LLP
499 PARK AVE
NEW YORK, NY 10022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Timothy J. Bechen, Esq. (For Patent Owner)
DREIER LLP
499 Park Ave.
New York City, NY 10022

Tracy Druce, Esq. (For Third Party Requester)
NOVAK, DRUCE & QUIGG, LPP
1000 Louisiana Avenue
Wells Fargo Plaza, 53rd Floor
Houston, TX 77002

MAILED

JAN 22 2008

CENTRAL REEXAMINATION UNIT

In re Franco et al. :
Reexamination Proceeding : DECISION
Control No. 95/000,295 : DISMISSING
Filed: August 3, 2007 : PETITION
For: U.S. Patent No. 6,687,745 :

This is a decision on the December 14, 2007 patent owner petition entitled "PETITION FOR STAY OF *INTER PARTES* REEXAMINATION UNDER 37 C.F.R. § 1.987."

The present petition is being taken as a petition under 37 CFR 1.182 for reasons set forth below. The fee set forth in 37 CFR 1.17(f) for a §1.182 petition is $400, and $400 is being charged to petitioner's Deposit Account 50-4026 pursuant to the authorization for same on page 9 of patent owner's December 14, 2007 petition.

The petition is before the Office of Patent Legal Administration for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,687,745 (the '745 patent), issued to Thomas D. Dickson, Jr., on February 3, 2004.

2. A request for *inter partes* reexamination of all the claims (claims 1-26) of the '745 patent was filed by third party requester (requester), Adobe Systems, Inc., on August 3, 2007. The request was assigned Control No. 95/000,295 (the '295 proceeding).

3. The '745 patent is subject to litigation in the United States District Court for the Eastern District of Texas, in *Droplets Inc. v. Adobe Systems, Inc.*, {Civil Action No. 2-06-CV-

307-TJW-CE}. The initial complaint was filed July 31, 2006. Based upon papers filed by the third party requester, claims 1-3, 8-19 and 21-26 appear to be the patent claims being asserted by the patent owner in the litigation. (See Exhibit OTH-B of the August 3, 2007 request for reexamination.)

4. On October 26, 2007, the Office issued an order granting the '295 request for reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '745 patent, claims 1-26, would be subject to reexamination.

5. On December 27, 2007, the patent owner filed the present petition, citing 35 U.S.C. § 314(c) and 37 CFR 1.987, and requesting suspension of the '295 *inter partes* reexamination proceeding.

6. As of the date of this decision, an Office action on the merits has not issued.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 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. § 1.933 states:

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

37 C.F.R. 1.985 states:

(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.

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 MATTERS:

Proper Legal Authority for the Petition

In regard to patent owner's attempts to stay the '295 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 *sua sponte* suspension of an *inter partes* reexamination proceeding by the Office 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 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.

The Patent Reexamination System

In 1980, Congress added a new administrative procedure known as *ex parte* reexamination. 35 U.S.C. §§ 301-307. *Ex parte* reexamination allows third parties to call to the Office's attention new prior art issues that might affect a patent's validity that the examiner did not consider during the patent's initial examination. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601 (Fed. Cir. 1985) (*Patlex I*). Congress contemplated three principal benefits of reexamination: (i) settle validity disputes more quickly and less expensively than protracted litigation; (ii) allow courts to refer patent validity questions to the expertise of the Office; and (iii) reinforce "investor confidence in the certainty of patent rights" by affording the Office an opportunity to review doubtful patents. *Patlex I*, 758 F.2d at 602. Thus, reexamination furthers the interests of both the public and patent owners in ensuring a strong, reliable patent system by allowing the Office a second look and testing the validity of patents in view of new evidence, thereby weeding out dubious patents. The Office's expertise in science and technology as well as patent law places the agency in a unique position to assess a patent's validity correctly and efficiently. Moreover, a paramount obligation mandated by Congress upon the Office is to conduct all reexaminations with "special dispatch." 35 U.S.C. § 305. In the only Federal Circuit case to consider the meaning of "special

dispatch," the court ruled that the Office incorrectly suspended a reexamination of a patent in view of a validity challenge in a concurrent litigation, because such a suspension ran contrary to the statutory "special dispatch" requirement for reexamination proceedings. *See Ethicon v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

Ex parte reexamination, however, does not provide a meaningful opportunity for the requester to participate once reexamination is ordered. 35 U.S.C. §§ 301-307. As a result, "such reexamination had been used infrequently" since it was enacted in 1980. 145 Cong. Rec. S14720 (Nov. 17, 1999). In order to encourage more third parties to use reexamination, Congress enacted in 1999 the *inter partes* reexamination procedure "as an option to the existing *ex parte* reexamination proceedings." *Id.* With this new option, third parties can now fully participate throughout the reexamination proceeding. Moreover, "[w]ith *inter partes* reexamination, it is believed that a better balance can be achieved toward the goal of improving patent quality and validity." H.R. Rep. 107-121 (June 28, 2001).

In creating the *inter partes* reexamination statutory framework, Congress borrowed heavily from the existing *ex parte* reexamination regime. For example, "[a]ny third party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of prior art cited under the provisions of section 301." 35 U.S.C. § 311. In addition, as is the case for *ex parte* reexamination, within 3 months from the filing of an *inter partes* reexamination request, the USPTO Director must determine whether a substantial new question of patentability has been raised by the request to justify initiating a reexamination proceeding. 35 U.S.C. § 312. Further, *inter partes* reexamination proceedings must likewise be conducted with "special dispatch." 35 U.S.C. § 314(c).

A key difference between *inter partes* and *ex parte* reexamination, is that Congress provided the requester with an opportunity to meaningfully participate throughout the proceeding. 35 U.S.C. § 314(b). Further, although Congress continued with its overarching mandate that *inter partes* reexaminations be conducted with "special dispatch," in contrast to *ex parte* reexamination, Congress provided the Office with discretion to suspend *inter partes* reexamination proceedings for "good cause." *See* 35 U.S.C. § 314(c). Another difference is that while Congress gave patent owners a specific right to file a statement in response to the order for an *ex parte* reexamination (35 U.S.C. § 304), Congress chose not to provide a similar provision in *inter partes* reexamination. In fact, Congress specifically gave the Office the authority to issue the first action on the merits on the same day as the order for reexamination is issued. 35 U.S.C. § 313. Additionally, with *inter partes* reexamination, Congress specifically provided estoppel provisions when a "final decision" upholding the validity of patent claims has been reached in a civil action or in a prior *inter partes* reexamination. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims. *Id.* Accordingly, while Congress desired that the

creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also contemplated in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other. Until that time, however, the Office is obligated to move forward in the *inter partes* reexamination with "special dispatch." Only "good cause" will permit the Office from deviating from that statutory mandate.

DECISION

Patent owner urges that, pursuant to 35 U.S.C. § 314 (c), there is good cause to suspend the '295 *inter partes* reexamination proceeding. Patent owner asserts the existence of matters to be raised in the concurrent litigation that are argued to affect the proper resolution of the '295 *inter partes* reexamination 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 '295 *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, because a broader spectrum of alleged prior art is currently before the District Court presiding over the concurrently pending patent litigation involving the '745 patent, the litigation will be more thorough relative to the '295 reexamination proceeding, which currently only has a subset of the alleged prior art in the litigation. 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 all patentability/invalidity arguments. Patent owner's position is based on its point that the courts can (a) consider prior art beyond patents and printed publications; (b) implement and enforce the exchange of discovery; (c) rely upon expert testimony; and (d) utilize subpoena powers to depose parties with relevant information.

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, which apply equally to *inter partes* reexamination. 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) (en 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.

It is clear that reexamination and litigation proceedings bring different benefits "to the table," and proceeding concurrently permits obtaining the benefits of both. 35 U.S.C. § 305 applies to *ex parte* reexamination and requires that both proceedings continue concurrently throughout, since§ 305 authorizes no exception to the mandate for special dispatch. In contrast, 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 the 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 that outweighs the benefits of conducting both proceedings concurrently. 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 proceeding 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 § 2686.04 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 that 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. These criteria establishes a benchmark and standard which the Office is using to test the facts and circumstances of record in *inter partes* reexamination proceedings, 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 initially 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 new question of patentability raised as to 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. After the claims were made congruent in the litigation and reexamination proceedings, 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 a significantly 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

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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.

of Appeals for the Federal Circuit ("the Federal Circuit"), and (c) the matter had already been briefed. Thus, there was a substantial likelihood that suspension of the reexamination proceedings would serve to conserve Office 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 reexamination 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 could very reasonably 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 at that point, based upon the change in circumstances. 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 present '295 *inter partes* reexamination proceeding differ significantly from those present in the Immersion-Sony *inter partes* reexamination proceeding. First and foremost, the court document submitted by the requester with the request for reexamination reveals an apparent lack of congruence between the claims at issue in the litigation and the claims at issue in the '295 *inter partes* reexamination. Exhibit OTH-B, submitted with the August 3, 2007 request for reexamination contains a patent claim chart in accordance with the Eastern District of Texas' Local Rules outlining the elements of the claims at issue relative to the allegedly infringing product. The claim chart lists only claims 1-3, 8-19 and 21-26 as being asserted as infringed by the patent owner. The requestor, in its August 3, 2007 reexamination request, requested that claims 1-26 be subject to a reexamination proceeding. The Office on October 26, 2007, issued an order granting the requester's August 3, 2007 request to initiate a reexamination proceeding of all the claims of the '745 patent, i.e. claims 1-26. Therefore, even if patent owner/petitioner's request for a stay of the '295 proceeding were granted to await judgment in the federal courts, it appears that not all the claims in the '295 proceeding would be disposed of by the litigation. (i.e. if the patent owner does not prevail in litigation, claims 4-7 and 20 may very well not be addressed by the court's decision). Therefore, suspension of the '295 proceeding would lead to piecemeal reexamination, and a delay in the reexamination of the new question of patentability raised as to the non-litigated claims.

Furthermore, in contrast to the Immersion-Sony *inter partes* reexamination proceedings, the litigation involving the present '745 patent is at a very early stage. For example, the issue of claim construction is still pending. Furthermore, the District court is currently engaged in resolving several jurisdictional issues and has not even begun to consider the merits of the case. 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 District Court is at a very early stage in regards to the merits of the case. 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 mandate to suspend the '295 *inter partes* proceeding. In this instance, not even a District Court finding is forthcoming in the immediate future. Accordingly, good cause to suspend the '295 *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. In the present instance, however, the requester filed the '295 *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. Also, if the Office's reexamination proceeding is not concluded by the time the District Court reaches the merits of the case are at hand, the court is free to stay the litigation to await the Office's decisions in the reexamination proceeding.

As to petitioner's District Court super set of prior art argument:

Petitioner patent owner's concern about an imbalance in prior art availability between the two forums (the Office and the Federal District Court) which may produce different results is unfounded. The two forums are not stove-piped to the point that prior art from the Federal District Court's proceedings cannot be brought into the Office's proceedings. To the contrary, the Office's rules place upon patent owner a duty of disclosure to the Office of all information "known to be material to patentability" as well as an obligation to apprise the Office of concurrent proceedings. See 37 CFR 1.933 and 1.985. As to apprising the Office of the litigation proceedings, MPEP 2686 explains the guidelines for doing so, pursuant to 37 CFR 1.985. Therefore, petitioner's assertion that a present imbalance of prior art currently before the

Federal District Court and the Office as sufficing as meeting the "good cause" exception to special dispatch to suspend a reexamination proceeding is not persuasive. If patent owner considers references currently before the court to be "material to patentability," then patent owner should discharge his or her duty of disclosure and submit the references in the '295 proceeding, so the Office can evaluate the prior art and render an official determination in regards to their materiality to patentability.

As to petitioner's District Court inherent powers argument:

Petitioner's assertions that the inherent powers of the Federal District Court establish a sufficient basis to justify a stay of the '295 *inter partes* reexamination proceeding under the "good cause" exception to special dispatch is not persuasive. First and foremost, if such an argument were sufficient to invoke a stay under the "good cause" exception to special dispatch, then all *inter partes* reexaminations with concurrent patent litigation would be automatically subject to a stay! Such a result would render the intent and mandate of Congress that reexamination and litigation proceeding continue together (until one reaches a point set forth in the statute) a nullity, because any party to an *inter partes* reexamination need merely file a complaint in a Federal District Court to stay the proceeding in favor of costly litigation. The balance struck by Congress between the Federal Courts and the Office was to actually favor reexamination and away from costly litigation to produce the benefits of: (i) settling validity disputes more quickly and less expensively than protracted litigation; (ii) allowing courts to refer patent validity questions to the expertise of the Office; and (iii) reinforcing investor confidence in the certainty of patent rights.

Secondly the inherent powers that petitioner listed are not without parallel and corollary power/force of law in a reexamination proceeding. As noted above in the argument-response section immediately preceding this one, the Office has rules in place for disclosure of all information known to the parties that is "material to patentability." This includes any such information generated in the litigation proceeding via the inherent powers of the Federal District Court. In regards to expert testimony, the Office under 37 CFR 1.132 permits the submission of expert opinion evidence in the form of affidavits and declarations. The *inter partes* reexamination rules in no way curtail or alter the use of declarations and affidavits to submit expert testimony in a reexamination proceeding.

In view of the above, petitioner's assertion that the inherent powers of the Federal District Court is sufficient to invoke the "good cause" exception to special dispatch to justify a suspension of the reexamination proceeding is not persuasive.

CONCLUSION

1. The December 27, 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

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

1-18-08
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Steven I. Weisburd
Dickstein Shapiro LLP
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(For Third Party Requester)

In re Nisani et al. :
Inter Parte Reexamination Proceeding :
Control No.: 95/000,297 :
Filed: September 12, 2007 :
For: U.S. Patent No.: 6,865,604 :

DECISION GRANTING REQUEST TO EXPEDITE AND DECISION DISMISSING REQUEST TO SUSPEND *INTER PARTES* REEXAMINATION

This is a decision on the patent owner papers filed on November 5, 2007, entitled "Petition to Expedite Under 37 CFR 1.182" and "Petition To Dismiss Request for Reexamination, or, Alternatively To Suspend *Inter Partes* Reexamination If Ordered."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition to expedite is granted, and the patent owner petition to suspend *inter partes* reexamination is dismissed. *Inter partes* reexamination in Control No. 95/000,297 will proceed with special dispatch.

FEES

The petition fees have been charged to patent owner's deposit account.

BACKGROUND

1. Patent number 6,865,604 (the '604 patent) issued on March 8, 2005, with claims 1-8.

2. The third party, Verint Systems Inc., filed a request for *inter partes* reexamination of claims 1-8 of the '604 patent that was assigned control no. 95/000,297 on September 12, 2007.

3. Patent owner filed a disclaimer, styled as a Terminal Disclaimer Under 37 CFR 1.321(a), on November 1, 2007, disclaiming claims 3-8 of the '604 patent. The Office will treat the disclaimer as a *statutory* disclaimer, rather than terminal, as it is directed to entire claims rather than a portion of the patent term. Claims 1 and 2 remain live in the '604 patent.

4. Patent owner filed a Notice of Recent Filings in Concurrent Patent Litigation Pursuant to 37 CFR 1.985 on November 5, 2007. While a search of litigation databases conducted by the Office found no litigations related to the '604 patent, patent owner's filing identifies the following concurrent proceeding: STS Software Systems Ltd. v. Witness Systems, Inc. et al., U.S. District Court, Northern District of Georgia, Atlanta Division, Case No. 1:04-CV-2111-RWS.

5. Patent owner filed these petitions on November 5, 2007. According to patent owner's statements in the petition and Exhibit F: July 23, 2007, Order, the litigation is presently in the discovery phase with trial set not later than March 15, 2008.

6. A decision granting the request for *inter partes* reexamination of claims 1 and 2 of the '604 patent was mailed November 19, 2007. A first office action has not been mailed.

DECISION

I. Pertinent Regulations

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(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 Appeal

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

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

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

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

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

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

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

35 U.S.C. 317 Inter partes reexamination prohibited

(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.

§ 1.913 Persons eligible to file request for *inter partes* reexamination.

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**.

§ 1.937 Conduct of *inter partes* reexamination.

(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.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(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.

§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

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.

II. Findings and Analysis

A. Request to Expedite - *Granted*

Patent owner requests that the petition requesting suspension of the *inter partes* reexamination be treated with special dispatch and that prompt action be taken. All *inter partes* proceedings are mandated to be handled with special dispatch. Prompt action on the request is hereby being taken in order to comply with the mandate.

B. Request to Dismiss the Request for Reexamination, or Alternatively, to Suspend Reexamination - *Dismissed*

Patent owner filed the petition to dismiss the request for reexamination almost two months after a filing date was accorded and well after consideration of the request for *inter partes* reexamination had commenced by the Office. The *inter partes* reexamination request has since been granted and reexamination has been ordered as to claims 1 and 2 of the '604 patent. Since the petition was offered in the alternative if the request was granted and reexamination was ordered, the Office considers patent owner's petition under the alternative, which requests suspension of the reexamination proceeding.

As required by 37 CFR 1.985, patent owner has advised the Office of concurrent proceedings in the District Court for the Northern District of Georgia. 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 under 37 CFR 1.987.

Suspension of the proceedings are based on a determination that there is good cause, otherwise the proceedings will be conducted with special dispatch within the Office under 35 USC 314(c). This Decision determines that good cause has not been sufficiently shown to support suspension of the proceedings. Deciding the sufficiency of good cause to suspend *inter partes* review is well within the bounds of the discretion of the Office, as emphasized in *Sony Computer Entertainment America Inc. v Jon W. Dudas*, 2006 WL 1472462 (E.D. Va.) The reexamination will proceed with special dispatch.

Parties challenging patent validity determinations are free to pursue *inter partes* review from the Office and litigation simultaneously, but the completion of either process will estop any parallel proceedings. 35 U.S.C. 317(b). In *Sony*, the Office determined that the *inter partes* proceeding and the litigation were at very different stages with the reexamination just beginning and the Federal Circuit appeal nearing its conclusion. It was determined that the Federal Circuit would likely issue a decision that would moot the Office's reexamination efforts. Taking the positions into account noting that the litigation was soon to be finally resolved, the Office determined that good cause existed to wait for the outcome of the Federal Circuit appeal and therefore favored suspension.

In this case, while the reexamination is just beginning, the litigation is not near final resolution. The litigation has an initial district court trial date set several months in the future. Moreover, regardless of the decision at the district court level, a **final** decision, after appeal, will not be rendered for a long period of time, probably well after the reexamination proceedings conclude. Given the mandate for the reexamination proceeding to be conducted with special dispatch, it would not be in the public's interest to suspend the reexamination proceeding for such a protracted period of time.

Patent owner asserts several reasons to support a showing of good cause to suspend *inter partes* reexamination. First, the patent owner argues that the third party requestor has made the reexamination request in the name of the parent company rather than its subsidiary, who according to the patent owner is a defendant in a copending litigation, to avoid the "estoppel provisions." The real party in interest identified by the third party requester is Verint Systems Inc. Patent owner avers that the defendant in the copending litigation is Witness Systems, Inc., which is now Verint Americas Inc., a subsidiary of Verint Systems, Inc.

Presumably, patent owner is referring to the estoppel provisions of 37 CFR 1.907 and the statute upon which those rules are based, 35 USC 317. In accordance with 37 CFR 1.915, the third party must make a certification that the requester is not precluded from filing the request for reexamination and make a statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy. The requester, Verint Systems, Inc., has complied with both of these requirements. Thus, this is not a reason to support a showing of good cause to suspend the proceeding.

Second, the patent owner asserts that the third party requester has timed the filing of the *inter partes* reexamination request to avoid the impact of the estoppel provisions of 35 USC 315(c) and at an advanced stage in the court proceedings. According to the patent owner, the patent litigation is nearly ready for trial.

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 does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings. The filing of this reexamination request at this time does not allow the third party requester to avoid future estoppel that would prevent asserting invalidity of a claim determined to be valid and patentable.

Further, patent owner states that the prior art references asserted by the third party requester are different than the prior art references relied upon in the copending litigation. Thus, it appears that the assertion of invalidity in this reexamination proceeding is different from the assertion in the litigation, which would moot the issue of estoppel. The patent owner also states that the prior art in the litigation should be limited to that which is cited in the reexamination request. There is no requirement in the statutes governing *inter partes* reexamination that a copending litigation must involve the same prior art references that are considered by the Office during the proceeding. The reexamination proceeding is conducted independently from any copending litigation.

The patent owner additionally argues that there is an undue burden on the patent owner to proceed with the reexamination proceeding in view of the presence of a protective order in the litigation that requires patent owner to retain different counsel for the Office proceeding. As such, according to the patent owner, there will be duplication of efforts, which doesn't advance the interests expressed by Congress of reducing litigation in district courts and make reexamination a viable, less costly alternative to patent litigation.

As noted by the patent owner, it appears that the prior art issues in the reexamination proceeding and the copending litigation are different, so duplication of effort is not relevant. Moreover, it is noted that the reexamination of a patent is not merely a duplication of a validity challenge in court as different standards of proof are used in determining validity and different conclusions, even based on the same evidence, could be correctly reached.

A third party has a statutory right to request reexamination proceeding at any time during the enforceability of a patent. One of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial question of patentability not previously considered by the Office. It is thus in the public interest of patent quality to reach a final decision regarding the validity of a patent claim and to continue the reexamination at this time. It is appropriate for both proceedings to continue until one of them reaches a final decision, which would then require the termination of the validity challenge to the same patent claims

in the other forum.

CONCLUSION

1. The patent owner petition filed on November 5, 2007, to expedite is granted and to suspend proceedings is dismissed.

2. The '297 *inter partes* reexamination proceeding will not be suspended and will proceed with special dispatch.

3. Jurisdiction over the '297 proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for appropriate action in due course.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Kenneth M. Schor
Senior Legal Advisor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,298	09/12/2007	6880004	03331/1201982-us6	1529

7278 7590 12/14/2007

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EXAMINER	
ART UNIT	PAPER NUMBER

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(For Patent Owner)

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DEC 14 2007

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Nisani et al. :
Inter Parte Reexamination Proceeding :
Control No.: 95/000,298 :
Filed: September 12, 2007 :
For: U.S. Patent No.: 6,880,004 :

DECISION GRANTING REQUEST TO EXPEDITE AND DECISION DISMISSING REQUEST TO SUSPEND *INTER PARTES* REEXAMINATION

This is a decision on the patent owner papers filed on November 5, 2007, entitled "Petition to Expedite Under 37 CFR 1.182" and "Petition To Dismiss Request for Reexamination, or, Alternatively To Suspend *Inter Partes* Reexamination If Ordered."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition to expedite is granted, and the patent owner petition to suspend *inter partes* reexamination is dismissed. *Inter partes* reexamination in Control No. 95/000,298 will proceed with special dispatch.

FEES

The petition fees have been charged to patent owner's deposit account.

BACKGROUND

1. Patent number 6,880,004 (the '004 patent) issued on April 12, 2005, with claims 1-11.

2. The third party, Verint Systems Inc., filed a request for *inter partes* reexamination of claims 1-11 of the '004 patent that was assigned control no. 95/000,298 on September 12, 2007.

3. Patent owner filed a disclaimer, styled as a Terminal Disclaimer Under 37 CFR 1.321(a), on November 1, 2007, disclaiming claims 1, 3, 4, 5, 6, 7, 9, 10, and 11 of the '004 patent. The Office will treat the disclaimer as a *statutory* disclaimer, rather than terminal, as it is directed to entire claims rather than a portion of the patent term. Claims 2 and 8 remain live in the '004 patent.

4. Patent owner filed a Notice of Recent Filings in Concurrent Patent Litigation Pursuant to 37 CFR 1.985 on November 5, 2007. While a search of litigation databases conducted by the Office found no litigations related to the '004 patent, patent owner's filing identifies the following concurrent proceeding: *STS Software Systems Ltd. v. Witness Systems, Inc. et al.*, U.S. District Court, Northern District of Georgia, Atlanta Division, Case No. 1:04-CV-2111-RWS.

5. Patent owner filed these petitions on November 5, 2007. According to patent owner's statements in the petition and Exhibit F: July 23, 2007, Order, the litigation is presently in the discovery phase with trial set not later than March 15, 2008.

6. A decision granting the request for *inter partes* reexamination of claims 2 and 8 of the '004 patent was mailed November 19, 2007. A first office action has not been mailed.

DECISION

I. Pertinent Regulations

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(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 Appeal

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

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

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

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

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

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

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

35 U.S.C. 317 Inter partes reexamination prohibited

(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.

§ 1.913 Persons eligible to file request for *inter partes* reexamination.

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**.

§ 1.937 Conduct of *inter partes* reexamination.

(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.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(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.

§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

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.

II. Findings and Analysis

A. Request to Expedite - *Granted*

Patent owner requests that the petition requesting suspension of the *inter partes* reexamination be treated with special dispatch and that prompt action be taken. All *inter partes* proceedings are mandated to be handled with special dispatch. Prompt action on the request is hereby being taken in order to comply with the mandate.

B. Request to Dismiss the Request for Reexamination, or Alternatively, to Suspend Reexamination - *Dismissed*

Patent owner filed the petition to dismiss the request for reexamination almost two months after a filing date was accorded and well after consideration of the request for *inter partes* reexamination had commenced by the Office. The *inter partes* reexamination request has since been granted and reexamination has been ordered as to claims 2 and 8 of the '004 patent. Since the petition was offered in the alternative if the request was granted and reexamination was ordered, the Office considers patent owner's petition under the alternative, which requests suspension of the reexamination proceeding.

As required by 37 CFR 1.985, patent owner has advised the Office of concurrent proceedings in the District Court for the Northern District of Georgia. 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 under 37 CFR 1.987.

Suspension of the proceeding is based on a determination that there is good cause, otherwise the proceeding will be conducted with special dispatch within the Office under 35 USC 314(c). This Decision determines that good cause has not been sufficiently shown to support suspension of the proceeding. Deciding the sufficiency of good cause to suspend *inter partes* review is well within the bounds of the discretion of the Office, as emphasized in *Sony Computer Entertainment America Inc. v Jon W. Dudas*, 2006 WL 1472462 (E.D. Va.) The reexamination will proceed with special dispatch.

Parties challenging patent validity determinations are free to pursue *inter partes* review from the Office and litigation simultaneously, but the completion of either process will estop any parallel proceedings. 35 U.S.C. 317(b). In *Sony*, the Office determined that the *inter partes* proceeding and the litigation were at very different stages with the reexamination just beginning and the Federal Circuit appeal nearing its conclusion. It was determined that the Federal Circuit would likely issue a decision that would moot the Office's reexamination efforts. Taking the positions into account noting that the litigation was soon to be finally resolved, the Office determined that good cause existed to wait for the outcome of the Federal Circuit appeal and therefore favored suspension.

In this case, while the reexamination is just beginning, the litigation is not near final resolution. The litigation has an initial district court trial date set several months in the future. Moreover, regardless of the decision at the district court level, a **final** decision, after appeal, will not be rendered for a long period of time, possibly well after the reexamination proceedings conclude. Given the mandate for the reexamination proceeding to be conducted with special dispatch, it would not be in the public's interest to suspend the reexamination proceeding for such a protracted period of time.

Patent owner asserts several reasons to support a showing of good cause to suspend *inter partes* reexamination. First, the patent owner argues that the third party requestor has made the reexamination request in the name of the parent company rather than its subsidiary, who according to the patent owner is a defendant in a copending litigation, to avoid the "estoppel provisions." The real party in interest identified by the third party requester is Verint Systems Inc. Patent owner avers that the defendant in the copending litigation is Witness Systems, Inc., which is now Verint Americas Inc., a subsidiary of Verint Systems, Inc.

Presumably, patent owner is referring to the estoppel provisions of 37 CFR 1.907 and the statute upon which those rules are based, 35 USC 317. In accordance with 37 CFR 1.915, the third party must make a certification that the requester is not precluded from filing the request for reexamination and make a statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy. The requester, Verint Systems, Inc., has complied with both of these requirements. Thus, this is not a reason to support a showing of good cause to suspend the proceeding.

Second, the patent owner asserts that the third party requester has timed the filing of the *inter partes* reexamination request to avoid the impact of the estoppel provisions of 35 USC 315(c) and at an advanced stage in the court proceedings. According to the patent owner, the patent litigation is nearly ready for trial.

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 proceeding. This 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 proceeding. The filing of this reexamination request at this time does not allow the third party requester to avoid future estoppel that would prevent asserting invalidity of a claim determined to be valid and patentable.

Further, patent owner states that the prior art references asserted by the third party requester are different than the prior art references relied upon in the copending litigation. Thus, it appears that the assertion of invalidity in this reexamination proceeding is different from the assertion in the litigation, which would moot the issue of estoppel. The patent owner also states that the prior art in the litigation should be limited to that which is cited in the reexamination request. There is no requirement in the statutes governing *inter partes* reexamination that a copending litigation must involve the same prior art references that are considered by the Office during the proceeding. The reexamination proceeding is conducted independently from any copending litigation.

The patent owner additionally argues that there is an undue burden on the patent owner to proceed with the reexamination proceeding in view of the presence of a protective order in the litigation that requires patent owner to retain different counsel for the Office proceeding. As such, according to the patent owner, there will be duplication of efforts, which doesn't advance the interests expressed by Congress of reducing litigation in district courts and make reexamination a viable, less costly alternative to patent litigation.

As noted by the patent owner, it appears that the prior art issues in the reexamination proceeding and the copending litigation are different, so duplication of effort is not relevant. Moreover, it is noted that the reexamination of a patent is not merely a duplication of a validity challenge in court as different standards of proof are used in determining validity and different conclusions, even based on the same evidence, could be correctly reached. Even if the issues were the same, patent owner's resort would be to the court to address the protective order.

A third party has a statutory right to request reexamination proceeding at any time during the enforceability of a patent. One of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial question of patentability not previously considered by the Office. It is thus in the public interest of patent quality to reach a final decision regarding the validity of a patent claim and to continue the reexamination at this time. It is

appropriate for both proceedings to continue until one of them reaches a final decision, which would then require the termination of the validity challenge to the same patent claims in the other forum.

CONCLUSION

1. The patent owner petition filed on November 5, 2007, to expedite is granted and to suspend the proceeding is dismissed.

2. The '298 *inter partes* reexamination proceeding will not be suspended and will proceed with special dispatch.

3. Jurisdiction over the '298 proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for appropriate action in due course.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Kenneth M. Schor
Senior Legal Advisor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,299	09/12/2007	6871229	03331/1201982-US8	1213

7278 7590 12/17/2007

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(For Patent Owner)

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(For Third Party Requester)

In re Nisani et al.	:	**DECISION GRANTING REQUEST**
Inter Parte Reexamination Proceeding	:	**TO EXPEDITE AND DECISION**
Control No.: 95/000,299	:	**DISMISSING REQUEST TO**
Filed: September 12, 2007	:	**SUSPEND *INTER PARTES***
For: U.S. Patent No.: 6,871,229	:	**REEXAMINATION**

This is a decision on the patent owner papers filed on November 5, 2007, entitled "Petition to Expedite Under 37 CFR 1.182" and "Petition To Dismiss Request for Reexamination, or, Alternatively To Suspend *Inter Partes* Reexamination If Ordered."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition to expedite is granted, and the patent owner petition to suspend *inter partes* reexamination is dismissed. *Inter partes* reexamination in Control No. 95/000,299 will proceed with special dispatch.

FEES

The petition fees have been charged to patent owner's deposit account.

BACKGROUND

1. Patent number 6,871,229 (the '229 patent) issued on March 22, 2005, with claims 1-25.

2. The third party, Verint Systems Inc., filed a request for *inter partes* reexamination of claims 3-25 of the '229 patent that was assigned control no. 95/000,299 on September 12, 2007.

3. Patent owner filed a disclaimer, styled as a Terminal Disclaimer Under 37 CFR 1.321(a), on November 1, 2007, disclaiming claims 1, 2, 3, 4, 5, 6, 9, 10, 13, 14, 16, 17, 18, 19, 20, 21, 23, 24, and 25 of the '229 patent. The Office will treat the disclaimer as a *statutory* disclaimer, rather than terminal, as it is directed to entire claims rather than a portion of the patent term. Claims 7, 8, 11, 12, 15, and 22 remain live in the '604 patent.

4. Patent owner filed a Notice of Recent Filings in Concurrent Patent Litigation Pursuant to 37 CFR 1.985 on November 5, 2007. While a search of litigation databases conducted by the Office found no litigations related to the '229 patent, patent owner's filing identifies the following concurrent proceeding: *STS Software Systems Ltd. v. Witness Systems, Inc. et al.*, U.S. District Court, Northern District of Georgia, Atlanta Division, Case No. 1:04-CV-2111-RWS.

5. Patent owner filed these petitions on November 5, 2007. According to patent owner's statements in the petition and Exhibit F: July 23, 2007, Order, the litigation is presently in the discovery phase with trial set not later than March 15, 2008.

6. A decision granting the request for *inter partes* reexamination of claims 7, 8, 11, 12, 15, and 22 of the '229 patent was mailed November 19, 2007. A first office action has not been mailed.

DECISION

I. Pertinent Regulations

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(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 Appeal

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

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

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

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

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

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

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

35 U.S.C. 317 Inter partes reexamination prohibited

(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.

§ 1.913 Persons eligible to file request for *inter partes* reexamination.

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**.

§ 1.937 Conduct of *inter partes* reexamination.

(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.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(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.

§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

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.

II. Findings and Analysis

A. Request to Expedite - *Granted*

Patent owner requests that the petition requesting suspension of the *inter partes* reexamination be treated with special dispatch and that prompt action be taken. All *inter partes* proceedings are mandated to be handled with special dispatch. Prompt action on the request is hereby being taken in order to comply with the mandate.

B. Request to Dismiss the Request for Reexamination, or Alternatively, to Suspend Reexamination - *Dismissed*

Patent owner filed the petition to dismiss the request for reexamination almost two months after a filing date was accorded and well after consideration of the request for *inter partes* reexamination had commenced by the Office. The *inter partes* reexamination request has since been granted and reexamination has been ordered as to claims 7, 8, 11, 12, 15, and 22 of the '229 patent. Since the petition was offered in the alternative if the request was granted and reexamination was ordered, the Office considers patent owner's petition under the alternative, which requests suspension of the reexamination proceeding.

As required by 37 CFR 1.985, patent owner has advised the Office of concurrent proceedings in the District Court for the Northern District of Georgia. 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 under 37 CFR 1.987.

Suspension of the proceeding is based on a determination that there is good cause, otherwise the proceeding will be conducted with special dispatch within the Office under 35 USC 314(c). This Decision determines that good cause has not been sufficiently shown to support suspension of the proceeding. Deciding the sufficiency of good cause to suspend *inter partes* review is well within the bounds of the discretion of the Office, as emphasized in *Sony Computer Entertainment America Inc. v Jon W. Dudas*, 2006 WL 1472462 (E.D. Va.) The reexamination will proceed with special dispatch.

Parties challenging patent validity determinations are free to pursue *inter partes* review from the Office and litigation simultaneously, but the completion of either process will estop any parallel proceedings. 35 U.S.C. 317(b). In *Sony*, the Office determined that the *inter partes* proceeding and the litigation were at very different stages with the reexamination just beginning and the Federal Circuit appeal nearing its conclusion. It was determined that the Federal Circuit would likely issue a decision that would moot the Office's reexamination efforts. Taking the positions into account noting that the litigation was soon to be finally resolved, the Office determined that good cause existed to wait for the outcome of the Federal Circuit appeal and therefore favored suspension.

In this case, while the reexamination is just beginning, the litigation is not near final resolution. The litigation has an initial district court trial date set several months in the future. Moreover, regardless of the decision at the district court level, a **final** decision, after appeal, will not be rendered for a long period of time, possibly well after the reexamination proceedings conclude. Given the mandate for the reexamination proceeding to be conducted with special dispatch, it would not be in the public's interest to suspend the reexamination proceeding for such a protracted period of time.

Patent owner asserts several reasons to support a showing of good cause to suspend *inter partes* reexamination. First, the patent owner argues that the third party requestor has made the reexamination request in the name of the parent company rather than its subsidiary, who according to the patent owner is a defendant in a copending litigation, to avoid the "estoppel provisions." The real party in interest identified by the third party requester is Verint Systems Inc. Patent owner avers that the defendant in the copending litigation is Witness Systems, Inc., which is now Verint Americas Inc., a subsidiary of Verint Systems, Inc.

Presumably, patent owner is referring to the estoppel provisions of 37 CFR 1.907 and the statute upon which those rules are based, 35 USC 317. In accordance with 37 CFR 1.915, the third party must make a certification that the requester is not precluded from filing the request for reexamination and make a statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy. The requester, Verint Systems, Inc., has complied with both of these requirements. Thus, this is not a reason to support a showing of good cause to suspend the proceeding.

Second, the patent owner asserts that the third party requester has timed the filing of the *inter partes* reexamination request to avoid the impact of the estoppel provisions of 35 USC 315(c) and at an advanced stage in the court proceedings. According to the patent owner, the patent litigation is nearly ready for trial.

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 proceeding. This 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 proceeding. The filing of this reexamination request at this time does not allow the third party requester to avoid future estoppel that would prevent asserting invalidity of a claim determined to be valid and patentable.

Further, patent owner states that the prior art references asserted by the third party requester are different than the prior art references relied upon in the copending litigation. Thus, it appears that the assertion of invalidity in this reexamination proceeding is different from the assertion in the litigation, which would moot the issue of estoppel. The patent owner also states that the prior art in the litigation should be limited to that which is cited in the reexamination request. There is no requirement in the statutes governing *inter partes* reexamination that a copending litigation must involve the same prior art references that are considered by the Office during the proceeding. The reexamination proceeding is conducted independently from any copending litigation.

The patent owner additionally argues that there is an undue burden on the patent owner to proceed with the reexamination proceeding in view of the presence of a protective order in the litigation that requires patent owner to retain different counsel for the Office proceeding. As such, according to the patent owner, there will be duplication of efforts, which doesn't advance the interests expressed by Congress of reducing litigation in district courts and make reexamination a viable, less costly alternative to patent litigation.

As noted by the patent owner, it appears that the prior art issues in the reexamination proceeding and the copending litigation are different, so duplication of effort is not relevant. Moreover, it is noted that the reexamination of a patent is not merely a duplication of a validity challenge in court as different standards of proof are used in determining validity and different conclusions, even based on the same evidence, could be correctly reached. Even if the issues were the same, patent owner's resort would be to the court to address the protective order.

A third party has a statutory right to request reexamination proceeding at any time during the enforceability of a patent. One of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial question of patentability not previously considered by the Office. It is thus in the public interest of patent quality to reach a final decision regarding the validity of a patent claim and to continue the reexamination at this time. It is

appropriate for both proceedings to continue until one of them reaches a final decision, which would then require the termination of the validity challenge to the same patent claims in the other forum.

CONCLUSION

1. The patent owner petition filed on November 5, 2007, to expedite is granted and to suspend the proceeding is dismissed.

2. The '299 *inter partes* reexamination proceeding will not be suspended and will proceed with special dispatch.

3. Jurisdiction over the '299 proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for appropriate action in due course.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

cdd

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,299	09/12/2007	6871229	03331/1201982-US8	1213

7590 05/11/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DICKSTEIN SHAPIRO LLP
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Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination

REEXAMINATION CONTROL NUMBER *95/000,299*.

PATENT NUMBER *6,871,229*.

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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MAY 11 2009

CENTRAL REEXAMINATION UNIT

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In re Nisani et al.	:	**DECISION DISMISSING**
Inter Parte Reexamination Proceeding	:	**REQUEST UNDER 37 CFR 1.182**
Control No.: 95/000,299	:	**TO ENTER INFORMATION**
Filed: September 12, 2007	:	**DISCLOSURE STATEMENT**
For: U.S. Patent No.: 6,871,229	:	

This is a decision on the patent owner papers filed on March 31, 2009, entitled "Petition Under 37 CFR 1.182 to Enter Information Disclosure Statement."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition is dismissed.

Thus, the IDS filed March 31, 2009, has not been entered for consideration by the examiner.

FEES

The petition fee of $400 has been received.

BACKGROUND

1. Patent number 6,871,229 (the '229 patent) issued on March 22, 2005, with claims 1-25.

2. The third party, Verint Systems Inc., filed a request for *inter partes* reexamination of claims 3-25 of the '229 patent that was assigned control no. 95/000,299 on September 12, 2007.

3. A decision granting the request for *inter partes* reexamination of claims 7, 8, 11, 12, 15, and 22 of the '229 patent was mailed November 19, 2007.

4. Prosecution progressed to the point where a notice of intent to issue a reexamination certificate was issued Jan. 16, 2009.

5. On March 31, 2009, the present petition was filed along with an Information Disclosure Statement, an PTO SB/08, and a copy of a prior art reference.

6. The reexamination proceeding is presently in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

DECISION

I. Pertinent Regulations

35 U.S.C. 314 Conduct of inter partes reexamination proceedings.

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

MPEP 2687.01 Examiner Consideration of Submissions After NIRC

.....any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after the NIRX (except as indicated immediately below) must be accompanied by a petition under 37 CFR 1.182. The petition must be granted, in order to have the amendment, information disclosure statement, or other paper related to the merits considered. Where an amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding is filed after the NIRC, and the accompanying petition under 37 CFR 1.182 is granted, the examiner will reconsider the case in view of the new information , and if appropriate, will reopen prosecution. See MPEP 2656 for a detailed discussion of the criteria for obtaining entry and consideration of information disclosure statement filed after the NIRC.

MPEP 2656 Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. Once the reexamination has entered the Reexamination Certificate printing cycle (452 status), pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
>
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

II. Findings and Analysis

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2656 noted above.

In the present instance, the fact situation fails to satisfy all grounds that would be analogous to those of 37 CFR 1.313(c). The petition fails to make an unequivocal statement as to why the art submitted makes at least one claim unpatentable and fails to provide an amendment to such claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. To the contrary, patent owner merely states that the Japan Patent Office (JPO) contends that claims directed to subject matter related to the claims in this reexamination proceeding lack inventive step under the Patent Law of Japan in view of the listed references. The patent owner makes a general statement that the claims subject to the JPO Official Action "correspond" to the claims as granted in the '299 patent. There is no discussion provided as to the specifics of the correspondence of the claims, nor how the references raised in the JPO Official Action are pertinent to the patentability of the claims in this proceeding under U.S. law. Moreover, Patent Owner does not provide a discussion of the substance of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding to show how at least one claim is made unpatentable.

Therefore, the present petition does not satisfy the requirements set out in the MPEP for a petition submitted for consideration of an IDS after the NIRC has been mailed, even before the proceeding has entered the publication process.

For *inter partes* reexamination, there is a statutory requirement pursuant to 35 U.S.C. 314 that all *inter partes* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory requirement for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch. This is explicitly set forth in the latest revision of the MPEP as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on Jan. 16, 2009, and the proceeding has now entered the final stages of the printing cycle. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the printing cycle, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 314 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request

for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not discussed in detail, it is proper that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

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

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

In view of the above, the petition is dismissed.

CONCLUSION

1. The patent owner petition filed on March 31, 2009, requesting consideration of an Information Disclosure Statement is dismissed.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS will however be placed in the electronic file.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

/Kenneth M. Schor/

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

cdd
5/7/09

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: FOR PATENT OWNER

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CENTRAL REEXAMINATION UNIT

Rothwell, Figg, Ernst, Manbeck PC
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Washington, DC 20005

: FOR THIRD PARTY
: REQUESTER

In re Bartels et al.

Inter partes Reexamination Proceeding
Control No. : 95/000,301
Filed : October 2, 2007
Patent No. 6,660,297

: DECISION ON PATENT
: OWNER'S PETITION UNDER
: 37 CFR 1.181

This is a decision addressing Patent Owner's submission, filed November 13, 2009 and entitled "PETITION UNDER 37 CFR § 1.181 FOR WITHDRAWAL OF PREMATURE ACTION CLOSING PROSECUTION."

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

SUMMARY

Patent Owner's petition is DENIED.

BACKGROUND

1. On October 2, 2007, a request for *inter partes* reexamination was filed by the third party requester for claims 1-6, 8-12 and 14-21 of U.S. Patent Number 6,660,297; the resulting reexamination proceeding was given a filing date and assigned control number 95/000,301.

2. On December 21, 2007, an order granting reexamination and a non-final Office action were mailed.

3. On February 19, 2008, Patent Owner submitted a timely response to the outstanding Office action, including amendments and new claims 22-32.

4. On March 19, 2008, Requester filed comments in response to Patent Owner's submission.

5. On September 14, 2009, an Action Closing Prosecution (ACP) was mailed, in which the examiner maintained all rejections and made additional rejections of new claims 22-32.

6. On November 13, 2009, the instant petition was filed by Patent Owner.

DECISION

The ACP of September 14, 2009 maintained rejections under 35 U.S.C. § 103 of claims 1, 2 and 4 over the Prevention's Healing Publication (PHP) and claims 1-4, 10 and 16-18 over PHP in combination with the 1999 AREDS Report. The petition alleges that certain issues have not been "clearly developed." Patent Owner cites MPEP 2671.02 in support of its position. MPEP 2671.02 states that "it is intended that the second Office action in the reexamination proceeding will ordinarily be an ACP. The criteria for issuing an ACP is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application."

MPEP 706.07(a) states, in part:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 706.07(e) refers the reader to MPEP 1207.03 for a discussion of what may constitute a new ground of rejection. MPEP 1207.03(III) states, in part:

> 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....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.

In this case, the statutory basis (35 U.S.C. § 103) and the evidence relied upon (PHP and AREDS) each remain the same. The rationale supporting the rejections is also unchanged; the examiner has done nothing more than reply to Patent Owner's response, explaining why Patent Owner's arguments are not persuasive. This is not a new ground

of rejection, but a fulfillment of the requirement in MPEP 2671.02(I) 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."

The petition (pp. 2-4) presents a laundry list of items which allegedly evidence significant positions taken for the first time in the ACP. Patent Owner apparently believes that any statement without *ipsis verbis* support in a previous Office action is a new position. This is incorrect and flies in the face of common sense. If a patent examiner were limited to repeating exactly what was stated in previous action(s), there would be no point in responding to Patent Owner's arguments at all.

The petition points out four main areas where the examiner's position is allegedly "incorrect" and therefore not "clearly developed." First, Patent Owner argues that the examiner has taken a new position by stating that the ingredients of the claimed composition were known to treat macular degeneration, it would have been obvious to combine them, and that there was a reasonable expectation of success. With regard to the ingredients being known, PHP states, "Some doctors recommend these nutrients to help prevent or slow the progress of macular degeneration" (p. 372). The appropriate portions of the PHP reference were cited in the Request, which was incorporated by reference in the first Office action. With regard to obviousness and reasonable expectation of success, this position is implicit whenever a rejection is made under § 103 because these are essential requirements of a prima facie case. See MPEP 2143, 2143.02. This is not a new ground of rejection. The examiner's statement that verification of what was previously reported in the prior art is not the correct standard for (non)obviousness is not a new ground of rejection, simply an explanation of why Patent Owner's argument was not found persuasive. Patent Owner's arguments regarding the Chew declaration, submitted with the petition, have not been considered because they appear to be directed to the merits of the rejections. The propriety of a rejection is determined through the examination and/or appeal processes, not by petition.

Patent Owner argues that the examiner's conclusion that the ratio of copper to zinc is clearly a recommendation or a preferred amount is a new position. As quoted above, the cited portion of PHP states, "Some doctors **recommend** these nutrients..." This is clearly not a new position.

Patent Owner argues that the interpretation of "approximately" as meaning "comes near" or "nearly exact" is a new position. This is simply the dictionary definition of "approximately."[1] As noted in MPEP 2258 (cited in both the first Office action and the ACP), words of a claim are generally given their ordinary and customary meaning, i.e., the broadest reasonable interpretation consistent with the specification. The examiner determined that the specification did not assign any other meaning to the term "approximately," so the ordinary meaning applies and the prior art is found to be close enough to the claimed limits as to render the invention obvious. This is the requester's position, adopted by the examiner in the first Office action and maintained in the ACP (pp. 9-10). The examiner's position on this issue is manifestly clear.

---

[1] Webster's II New Riverside University Dictionary, 1984, pp. 119-120 (attached)

Finally Patent Owner observes that the examiner "criticized" some of the evidence proffered in response to the first Office action. As explained above, consideration and rebuttal of the patent owner's arguments is required of the examiner as part of the normal course of events in a reexamination proceeding. The examiner has done nothing improper and there is no ground for granting the requested relief.

The analysis above describes why the examiner's remarks in the ACP do not amount to new grounds of rejection or significant changes in the examiner's position. With regard to "development" of the issues, Patent Owner's attention is directed to MPEP 2671.02, which states that "grounds of rejection and determinations of patentability must (in the ACP) be clearly developed to such an extent that the patent owner and the third party requester may readily judge the advisability of filing comments after an ACP." Patent Owner has done nothing to explain how the examiner's positions are so unclear that it is unable to determine how to proceed. Nowhere does the petition point out how the examiner's position is unclear. At worst, the examiner's positions are restated in slightly different terms or are factually incorrect. But reiterating a position using different words does not make it new, and "factually incorrect" does not equate to "not clearly developed." In fact, the examiner's positions are developed clearly enough for Patent Owner to assert that they are incorrect and to produce affidavits arguing against them. Therefore Patent Owner's arguments fail to persuade.

CONCLUSION

1. Patent Owner's petition filed November 13, 2009 is **DENIED** for the reasons discussed above.

2. The present *inter partes* reexamination proceeding is being returned to the examiner for consideration of Patent Owner's response filed November 13, 2009 and Requester's comments filed December 14, 2009.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

Attachment: Webster's Dictionary excerpt

WEBSTER'S II
New Riverside University Dictionary

(1984)

5. Close attention : DILIGENCE. **6. a.** A request, as for aid, employment, or admission. **b.** The form or document for such a request.

ap·pli·ca·tive (ăp'lĭ-kā'tĭv, ə-plĭk'ə-) *adj.* **1.** Marked by actual application : APPLIED. **2.** Practical. **—ap'pli·ca'tive·ly** *adv.*

ap·pli·ca·tor (ăp'lĭ-kā'tər) *n.* An instrument for applying something, as a healing agent or cosmetic.

ap·pli·ca·to·ry (ăp'lĭ-kə-tôr'ē, -tōr'ē, ə-plĭk'ə-) *adj.* Practical.

ap·plied (ə-plīd') *adj.* Put into practice or to a particular use <*applied* engineering>

ap·pli·qué (ăp'lĭ-kā') *n.* [Fr., p.part. of *appliquer*, to apply < Lat. *applicare*, to affix. —see APPLY.] A decoration or ornament, as in needlework, made by cutting pieces of one material and attaching them to the surface of another. —*vt.* **-quéd, -qué·ing, -qués.** To decorate with appliqué. **—ap'pli·qué'** *adj.*

ap·ply (ə-plī') *v.* **-plied, -ply·ing, -plies.** [ME *applien* < OFr. *aplier* < Lat. *applicare*, to affix : *ad-*, to + *plicare*, to fold together.] —*vt.* **1.** To put on <*apply* paint to a wall> **2.** To put to or adapt for a special use <*applied* my earnings to tuition> **3.** To put (e.g., automotive brakes) into action. **4.** To devote (oneself or one's efforts) to something. —*vi.* **1.** To be pertinent or relevant <The law *applies to* everyone.> **2.** To ask or seek aid, employment, or admission.

ap·pog·gia·tu·ra (ə-pŏj'ə-tŏŏr'ə) *n.* [Ital. < *appoggiare*, to lean on < Vlat. **appodiare* : Lat. *ad-*, to + *podium*, support < Gk. *podion*, base < *pous*, foot.] *Mus.* An embellishing note, usu. one step above or below the note it precedes and indicated by a small note or sign.

ap·point (ə-point') *vt.* **-point·ed, -point·ing, -points.** [ME *appointen*, to decide < OFr. *apointier*, to arrange < *à point*, to the point : *à*, to (< Lat. *ad*) + *point*, point < Lat. *punctum* < *pungere*, to prick.] **1.** To name to fill an office or position. **2.** To fix or set, as a date or time, by authority or mutual agreement. **3.** To furnish or equip (e.g., an apartment), esp. appropriately. **4.** *Law.* To direct the disposition of (property) to a beneficiary in exercise of a power granted for this purpose by a preceding deed.

ap·point·ee (ə-poin'tē', ăp'oin-) *n.* **1.** One named to an office or position. **2.** *Law.* One to whom a power of appointment of property is granted.

ap·point·ive (ə-poin'tĭv) *adj.* Relating to or filled by appointment.

ap·point·ment (ə-point'mənt) *n.* **1.** The act of appointing for an office or position. **2.** The office or position to which one has been appointed. **3.** An engagement <made an *appointment* with the dentist> **4. appointments.** Furnishings, fittings, or equipment. **5.** *Law.* The act of directing the disposition of property by virtue of a power granted for this purpose.

ap·point·or (ə-poin'tər, ə-poin'tôr') *n. Law.* One that executes a power of appointment of property.

ap·por·tion (ə-pôr'shən, ə-pōr'-) *vt.* **-tioned, -tion·ing, -tions.** [OFr. *apportioner* : *à-* (< Lat. *ad*) + *portionner*, to divide into portions < *portion*, portion. —see PORTION.] To divide and distribute according to a plan or proportion : ALLOT.

ap·por·tion·ment (ə-pôr'shən-mənt, ə-pōr'-) *n.* **1.** The act of apportioning or state of being apportioned. **2. a.** Proportional distribution of the number of members of the U.S. House of Representatives on the basis of the population of each state. **b.** The allotment of direct taxes on the basis of state population.

ap·pose (ă-pōz') *vt.* **-posed, -pos·ing, -pos·es.** [Back-formation < APPOSITION.] To place close to each other or side by side.

ap·po·site (ăp'ə-zĭt) *adj.* [Lat. *appositus*, p.part. of *apponere*, to put near : *ad-*, to + *ponere*, to put.] Suitable : appropriate. **—ap'po·site·ly** *adv.* **—ap'po·site·ness** *n.*

ap·po·si·tion (ăp'ə-zĭsh'ən) *n.* [ME *apposicioun* < Med. Lat. *appositio* < Lat. *apponere*, to put near. —see APPOSITE.] **1. a.** A construction in which a noun or noun phrase is placed with another as an explanatory equivalent, both having the same syntactic relation to the other elements in the sentence, as *Byron* and *the poet* in *The poet Byron died in Greece.* **b.** The relationship between such nouns or noun phrases. **2.** Placement side by side or close to each other. **3.** *Biol.* Growth of successive layers of a cell wall. **—ap'po·si'tion·al** *adj.* **—ap'po·si'tion·al·ly** *adv.*

ap·pos·i·tive (ə-pŏz'ĭ-tĭv) *adj.* Of or being in apposition. —*n.* A word or phrase in apposition. **—ap·pos'i·tive·ly** *adv.*

ap·prais·al (ə-prā'zəl) *n.* **1.** An act of appraising. **2.** An expert or official valuation as for taxation.

ap·praise (ə-prāz') *vt.* **-praised, -prais·ing, -prais·es.** [ME *appreisen*, alteration of *apprisen* < OFr. *aprisier* < LLat. *appretiare* : Lat. *ad-*, to + Lat. *pretium*, price.] **1.** To determine the value of, esp. officially. **2.** To estimate the worth or features of : JUDGE <*appraise* a new product> **—ap·prais'a·ble** *adj.* **—ap·praise'ment** *n.* **—ap·prais'er** *n.*

ap·pre·cia·ble (ə-prē'shə-bəl) *adj.* Capable of being noticed, estimated, or measured : NOTICEABLE. **—ap·pre'cia·bly** *adv.*

ap·pre·ci·ate (ə-prē'shē-āt') *v.* **-at·ed, -at·ing, -ates.** [LLat. *appretiare, appretiat-*, to appraise.] —*vt.* **1.** To recognize the quality, significance, or magnitude of. **2.** To be fully conscious of or sensitive to : REALIZE <*I appreciate* your difficulties.> **3.** To be thankful or show gratitude for. **4.** To perceive with aesthetic enjoyment. **5.** To raise in value or price. —*vi.* To increase in value or price. **—ap·pre'ci·a'tor** *n.* **—ap·pre'cia·to'ry** (-shə-tôr'ē, -tōr'ē) *adj.*

☆ ***syns:*** APPRECIATE, CHERISH, ESTEEM, PRIZE, RESPECT, SAVOR, TREASURE, VALUE *v. core meaning* : to recognize the worth, importance, or value of <a person who *appreciates* classical music>

ap·pre·ci·a·tion (ə-prē'shē-ā'shən) *n.* **1.** Recognition of the quality, value, significance, or magnitude of. **2.** A judgment or opinion, esp. a favorable one. **3.** An expression of gratitude. **4.** Awareness or perception, esp. of aesthetic qualities or values. **5.** An increase in value or price.

ap·pre·cia·tive (ə-prē'shə-tĭv, -shē-ā'tĭv) *adj.* Capable of or showing appreciation. **—ap·pre'cia·tive·ly** *adv.*

ap·pre·hend (ăp'rĭ-hĕnd') *v.* **-hend·ed, -hend·ing, -hends.** [ME *apprehenden* < Lat. *apprehendere*, to seize : *ad-*, to + *prehendere*, to grasp.] —*vt.* **1.** To take into custody : ARREST. **2.** To grasp mentally : UNDERSTAND. **3.** To anticipate fearfully. —*vi.* To understand.

ap·pre·hen·si·ble (ăp'rĭ-hĕn'sə-bəl) *adj.* Capable of being apprehended or understood. **—ap'pre·hen'si·bly** *adv.*

ap·pre·hen·sion (ăp'rĭ-hĕn'shən) *n.* [LLat. *apprehensio*, understanding < *apprehendere*, to seize. —see APPREHEND.] **1.** A fearful or uneasy anticipation of the future : DREAD. **2.** The act of seizing or capturing : ARREST. **3.** Ability to understand.

ap·pre·hen·sive (ăp'rĭ-hĕn'sĭv) *adj.* **1.** Fearful or uneasy about the future : ANXIOUS. **2.** Capable of understanding : DISCERNING. **—ap'pre·hen'sive·ly** *adv.* **—ap'pre·hen'sive·ness** *n.*

ap·pren·tice (ə-prĕn'tĭs) *n.* [ME *apprentis* < OFr. < *aprendre*, to learn < Lat. *apprehendere*, to seize. —see APPREHEND.] **1.** One legally bound to work for another for a designated amount of time in return for instruction in a trade, art, or business. **2.** One who is learning a trade or occupation, esp. as a member of a labor union. **3.** One who lacks experience : BEGINNER. —*vt.* **-ticed, -tic·ing, -tic·es.** To place or take on as an apprentice. **—ap·pren'tice·ship'** *n.*

ap·pressed (ə-prĕst') *adj.* [< Lat. *appressus*, p.part. of *apprimere*, to press down : *ad-*, to + *premere*, to press.] Lying flat or pressed closely against something, as leaves on a stem.

ap·prise (ə-prīz') *vt.* **-prised, -pris·ing, -pris·es.** [Fr. *apprendre, appris-* < OFr. *aprendre*, to learn. —see APPRENTICE.] To inform.

ap·prize (ə-prīz') *v. Chiefly Brit. var. of* APPRISE.

ap·proach (ə-prōch') *v.* **-proached, -proach·ing, -proach·es.** [ME *approchen* < OFr. *aprochier* < LLat. *appropiare* : Lat. *ad-*, to + Lat. *propius*, nearer, comp. of *prope*, near.] —*vi.* To come close or closer, as in space or time. —*vt.* **1.** To move close or closer to. **2.** To approximate <enthusiam *approaching* fanaticism> **3.** To make overtures to <*approached* the star with a TV offer> **4.** To begin to deal with or work on. —*n.* **1.** The act of approaching. **2.** An approximation. **3.** A way or means of reaching something : ACCESS <an *approach* to the tower> **4.** The method used in dealing with or effecting something <an organized *approach*> **5.** An overture made by one person to another. **6.** The golf stroke following the drive from the tee with which a player tries to get the ball onto the putting green. **7.** Works, as trenches or bulwarks, for protecting troops who are besieging a fortified position.

ap·proach·a·ble (ə-prō'chə-bəl) *adj.* **1.** Capable of being approached. **2.** Not aloof : FRIENDLY. **—ap·proach'a·bil'i·ty** *n.*

ap·pro·bate (ăp'rə-bāt') *vt.* **-bat·ed, -bat·ing, -bates.** [ME *approbaten* < Lat. *approbare*, to approve.] To approve, esp. officially. **—ap'pro·ba'tive, ap·pro'ba·to'ry** (ə-prō'bə-tôr'ē, -tōr'ē) *adj.*

ap·pro·ba·tion (ăp'rə-bā'shən) *n.* **1.** Commendation : praise. **2.** Official approval.

ap·pro·pri·a·ble (ə-prō'prē-ə-bəl) *adj.* Capable of being appropriated, as property.

ap·pro·pri·ate (ə-prō'prē-ĭt) *adj.* [ME *appropriat* < Med. Lat. *appropriatus*, p.part. of *appropriare*, to make one's own : Lat. *ad-*, to + Lat. *propius*, own.] Suitable : fitting. —*vt.* (-āt') **-at·ed, -at·ing, -ates.** **1.** To set apart for a specific use. **2.** To take possession of or make use of for oneself, often without permission or legal right. **—ap·pro'pri·ate·ly** *adv.* **—ap·pro'pri·ate·ness** *n.* **—ap·pro'pri·a'tive** (-ā'tĭv) *adj.* **—ap·pro'pri·a'tor** *n.*

ap·pro·pri·a·tion (ə-prō'prē-ā'shən) *n.* **1.** An act of appropriating. **2.** Something appropriated, esp. public funds set aside for a specific purpose. **3.** A legislative act authorizing the expenditure of a designated amount of public funds for a given purpose.

ap·prov·al (ə-prōō'vəl) *n.* **1.** An act of approving. **2.** Official approbation : SANCTION. **3.** Favorable regard : COMMENDATION. **—on approval.** For examination or trial by a potential customer without the obligation to buy.

ap·prove (ə-prōōv') *v.* **-proved, -prov·ing, -proves.** [ME *approven* < OFr. *aprover* < Lat. *approbare* : *ad-*, to + *probare*, to test < *probus*, good.] —*vt.* **1.** To regard favorably <*approved* the new location> **2.** To confirm or agree to officially : SANCTION <The House *approved* the bill.> **3.** *Obs.* To prove or demonstrate. —*vi.* To feel, voice, or show approval <*approves* of fluoridation> **—ap·prov'a·ble** *adj.* **—ap·prov'ing·ly** *adv.*

approved school *n. Chiefly Brit.* A reform school.

ap·prox·i·mate (ə-prŏk'sə-mĭt) *adj.* [LLat. *approximatus*, p.part. of *approximare*, to approach : Lat. *ad-*, to + *proximare*, to come near < *proximus*, nearest.] **1.** Nearly exact, accurate, complete, or perfect.

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2. Closely resembling : similar. 3. Close together : NEAR. —*v.* (-māt') **-mat·ed, -mat·ing, -mates.** —*vt.* 1. To be nearly the same as. 2. To bring near. —*vi.* To come near or close, as in nature, degree, or quality. **—ap·prox'i·mate·ly** *adv.*

ap·prox·i·ma·tion (ə-prŏk'sə-mā'shən) *n.* 1. The act or result of approximating. 2. *Math.* An inexact result adequate for a given purpose. **—ap·prox'i·ma'tive** *adj.* **—ap·prox'i·ma'tive·ly** *adv.*

ap·pur·te·nance (ə-pûr'tn-əns) *n.* [ME *appurtenaunce* < AN *apurtenance* < VLat. **appertinentia* < LLat. *appertinēre,* to appertain.] 1. Something added to a more important thing : ACCESSORY. 2. **appurtenances.** Equipment, as clothing, tools, or instruments, used for a particular purpose or task : GEAR. 3. *Law.* A right, privilege, or property considered incident to the principal property for purposes such as passage of title, conveyance, or inheritance. **—ap·pur·te·nant** *adj.*

a·prax·i·a (ā-prăk'sē-ə) *n.* [Gk., inaction : *a-,* without + *praxis,* action < *prassein,* to do.] Inability to perform coordinated movements due to lesions in the cerebral cortex. **—a·prac'tic** (ā-prăk'tĭk), **a·prax'ic** (ā-prăk'sĭk) *adj.*

a·près-ski (ä'prā-skē', ăp'rā-) *n.* [Fr. : *après,* after + *ski,* skiing.] Social activities or events after skiing. **—a'près-ski'** *adj.*

a·pri·cot (ăp'rĭ-kŏt', ā'prĭ-) *n.* [Alteration of earlier *abrecock* < Port. *albricoque* < Ar. *al-birqūq,* the apricot : *al,* the + LGk. *praikokion* < Lat. *praecoquus,* ripe early (*prae-,* before + *coquere,* to ripen).] 1. **a.** A tree native to western Asia and Africa, *Prunus armeniaca* widely cultivated for its edible fruit. **b.** The yellow-orange peachlike fruit of the apricot. 2. A moderate, light, or strong orange to strong orange yellow.

A·pril (ā'prəl) *n.* [ME < Lat. *aprilis.*] The fourth month of the year according to the Gregorian calendar. —See table at CALENDAR.

April fool *n.* The victim of a trick played on April Fools' Day.

April Fools' Day *n.* Apr. 1, traditionally a day for playing practical jokes.

a pri·o·ri (ä' prē-ôr'ē, -ōr'ē, ā' prī-ôr'ī, -ōr'ī') *adj.* [Lat., from the former.] 1. Proceeding from a known or assumed cause to a necessarily related effect : DEDUCTIVE. 2. Based on a hypothesis or theory rather than on experiment or experience. 3. Made before or without examination and not supported by factual study. **—a priori** *adv.* **—a'pri·or'i·ty** (-ôr'ĭ-tē, -ōr'-) *n.*

a·pron (ā'prən) *n.* [ME < the phrase *a napron,* an apron < OFr. *naperon,* dim. of *nape,* tablecloth < Lat. *mappa,* napkin.] 1. A garment, usu. tied or snapped in back, worn over the front of the body to protect clothing. 2. Something resembling an apron, as a protective shield for a machine. 3. The paved strip in front of and around airport hangars and terminal buildings. 4. The part of a theatrical stage in front of the curtain. 5. **a.** A platform at the entrance to a dock. **b.** A covering or structure along a shoreline for protection against erosion. **c.** A platform below a dam or in a sluiceway. 6. A continuous conveyor belt. 7. An area covered by sand and gravel deposited at the front of a glacial moraine. —*vt.* **a·proned, a·pron·ing, a·prons.** To cover, protect, or provide with an apron.

▲ word history: *An apron* was originally *a napron. Apron* is one of the numerous English words that have either lost or gained an initial *n* because of an incorrect division between the indefinite article and the noun. *Apron* is thus closely related to *napkin* and *napery.*

apron string *n.* 1. The string of an apron. 2. Complete control. —Used esp. in the phrase *tied to (someone's) apron strings.*

ap·ro·pos (ăp'rə-pō') *adj.* [Fr. *à propos,* to the purpose.] Pertinent : appropriate. —*adv.* 1. Pertinently : appropriately. 2. By the way : INCIDENTALLY. —*prep.* Concerning : regarding <*apropos* your job application>

apropos of *prep.* [< APROPOS (adj.).] With reference to <a good story *apropos of* fishing>

apse (ăps) *n.* [LLat. *apsis.* —see APSIS.] 1. A semicircular or polygonal, usu. domed projection of a building, esp. the altar or east end of a church. 2. APSIS 2. **—ap'si·dal** (ăp'sĭ-dəl) *adj.*

ap·sis (ăp'sĭs) *n., pl.* **-si·des** (-sĭ-dēz') [LLat. *apsis* < Lat., arch, vault < Gk. *hapsis* < *haptein,* to fasten.] 1. APSE 1. 2. *Astron.* The point in orbit of greatest or least distance of a celestial body from a center of attraction.

apt (ăpt) *adj.* [ME < Lat. *aptus,* p.part. of *apere,* to fasten.] 1. Perfectly suitable : APPROPRIATE <an *apt* turn of phrase> 2. Having probability : LIKELY <*apt* to be chilly tonight> 3. Having a tendency : INCLINED <*apt* to talk too much> 4. Quick to learn or understand. *usage: Apt* is used instead of *likely* to indicate a natural tendency to error or undesirable behavior: *I am apt to lose my temper under severe stress* but *I am likely* (not *apt*) *to remain calm under severe stress.* **—apt'ly** *adv.* **—apt'ness** *n.*

APT (ā'pē-tē') *n.* [A(UTOMATICALLY) + P(ROGRAMMED) + T(OOL).] A computer language designed for programming numerically controlled machine tools.

ap·ter·al (ăp'tər-əl) *adj.* [< Gk. *apteros,* wingless : *a-,* without + *pteron,* wing.] Having no architectural columns along the sides.

ap·ter·ous (ăp'tər-əs) *adj.* 1. *Zool.* Having no wings. 2. *Bot.* Having no winglike parts or extensions.

ap·ter·yx (ăp'tə-rĭks') *n.* [NLat. : A-[1] + Gk. *pterux,* wing.] The kiwi.

ap·ti·tude (ăp'tĭ-tōōd', -tyōōd') *n.* [ME, tendency < Med. Lat. *aptitudo,* aptitude < *aptus,* apt.] 1. A natural or acquired talent or ab : INCLINATION. 2. Quickness in learning and understanding : INTE GENCE. 3. The quality or condition of being appropriate.

aptitude test *n.* A standardized test for measuring the abilit an individual to acquire knowledge or develop skills.

A·pus (ā'pəs) *n.* [Lat. *apus,* a kind of swallow < Gk. *apous,* martin < *apous,* without feet. —see APODAL.] A constellation in Southern Hemisphere.

aq·ua (ăk'wə, ä'kwə) *n., pl.* **aq·uae** (ăk'wē, ä'kwī') *or* **aq·uas.** [1. Water. 2. An aqueous solution. 3. A light bluish green to greenish blue. **—aq'ua** *adj.*

aq·ua·cade (ăk'wə-kād', ä'kwə-) *n.* [AQUA + (CAVAL)CADE] entertainment spectacle of swimmers and divers, often performin unison to music.

aq·ua for·tis *also* **aq·ua·for·tis** (ăk'wə-fôr'tĭs, ä'kwə-) *n.* [N strong water.] Nitric acid.

Aqua Lung. A trademark for an underwater breathing appara

aq·ua·ma·rine (ăk'wə-mə-rēn', ä'kwə-) *n.* [Lat. *aqua marina* water.] 1. A transparent blue-green variety of beryl, used as a stone. 2. A pale blue to light greenish blue.

aq·ua·naut (ăk'wə-nôt', ä'kwə-) *n.* [AQUA + Gk. *nautēs* sailo *naus,* ship.] One trained and equipped to live in underwater ins tions and conduct, aid in, or be a subject of scientific research.

aq·ua·plane (ăk'wə-plān', ä'kwə-) *n.* [AQUA + PLANE[1].] A b pulled by a motorboat and ridden by a person standing up on it. **-planed, -plan·ing, -planes.** To ride on an aquaplane.

aqua re·gi·a (rē'jē-ə, rē'jə) *n.* [Lat., royal water.] A corrosive, fu ing, volatile mixture of hydrochloric and nitric acids, used for tes metals and dissolving platinum and gold.

aq·ua·relle (ăk'wə-rĕl', ä'kwə-) *n.* [Fr. < obs. Ital. *acquarella,* w color, dim. of *acqua,* water < Lat. *aqua.*] A drawing in transpar water colors. **—aq'ua·rel'list** *n.*

a·quar·i·a (ə-kwâr'ē-ə) *n. var. pl. of* AQUARIUM.

a·quar·ist (ə-kwâr'ĭst) *n.* One who maintains an aquarium.

a·quar·i·um (ə-kwâr'ē-əm) *n., pl.* **-i·ums** *or* **-i·a** (-ē-ə) [< *aquarius,* of water < *aqua,* water.] 1. A water-filled containe which fish or other aquatic animals and often plants are kept. place for the public display of aquatic animals and plants.

A·quar·i·us (ə-kwâr'ē-əs) *n.* [ME < Lat., water carrier < *aqua* ter.] 1. A constellation in the Southern Hemisphere. 2. **a.** The l sign of the zodiac. **b.** One born under this sign.

a·quat·ic (ə-kwŏt'ĭk, ə-kwät'-) *adj.* [OFr. *aquatique* < Lat. *aquat* < *aqua,* water.] 1. Of or in water. 2. Living or growing in or on water. 3. Taking place in or on the water, as sports. —*n.* 1. aquatic organism. 2. **aquatics.** Sports performed in or on the wa

aq·ua·tint (ăk'wə-tĭnt', ä'kwə-) *n.* [Fr. *aquatinte* < Ital. *aq tinta,* dyed water : *acqua,* water (< Lat. *aqua*) + *tinta,* dyed < *tincta,* p.part. of *tingere,* to dye.] 1. A process of etching capabl producing several tones by varying the etching time of different a of a copper plate so that the resulting print resembles the flat tint an ink or wash drawing. 2. An etching made by aquatint. —*vt.* **-ed, -tint·ing, -tints.** To etch in aquatint.

a·qua·vit (ä'kwə-vēt') *n.* [Swed., Dan., and Norw. *akvavit* < L Lat. *aqua vitae,* water of life.] A clear, strong Scandinavian liq distilled from potato or grain mash and flavored with caraway s

aqua vi·tae (vī'tē) *n.* [ME *aquavite* < Med. Lat. *aqua vitae,* w of life.] 1. Alcohol. 2. A strong liquor, as brandy.

aq·ue·duct (ăk'wĭ-dŭkt') *n.* [Lat. *aquaeductus* : *aqua,* water *ductus,* p.part. of *ducere,* to lead.] 1. A pipe or channel for transp ing water from a remote source, usu. by gravity. 2. A bridgelike str ture supporting a conduit or canal passing over a river or low grou 3. *Anat.* A fluid passage or channel.

a·que·ous (ā'kwē-əs, ăk'wē-) *adj.* [Med. Lat. *aqueus* < Lat. *aq* water.] 1. Relating to, like, containing, or dissolved in water : TERY. 2. *Geol.* Formed from matter deposited by water, as cer sedimentary rocks.

aqueous humor *n.* A clear, lymphlike fluid in the chambe the eye between the cornea and the lens.

aqui- *pref.* [Lat. < *aqua,* water.] Water <*aqui*culture>

aq·ui·cul·ture (ăk'wĭ-kŭl'chər, ä'kwĭ-) *n.* Hydroponics. **—aq cul'tural** *adj.*

aq·ui·fer (ăk'wə-fər, ä'kwə-) *n.* A water-bearing rock, rock for tion, or group of rock formations. **—a·quif'er·ous** (ə-kwĭf'ər-əs) f

Aq·ui·la (ăk'wə-lə) *n.* [Lat. *aquila,* eagle.] A constellation in Northern Hemisphere.

aq·ui·le·gi·a (ăk'wə-lē'jē-ə, -lē'jə) *n.* [NLat. *Aquilegia,* genus n < Med. Lat. *aquilegia,* columbine.] The columbine.

aq·ui·line (ăk'wə-lĭn', -līn) *adj.* [Lat. *aquilinus* < *aquila,* ea 1. Of or like an eagle. 2. Curved or hooked like an eagle's beak an elegant, *aquiline* nose>

a·quiv·er (ə-kwĭv'ər) *adj.* Marked by quivering.

ar (är) *n. var. of* ARE[2].

Ar *symbol for* ARGON.

-ar *suff.* [ME < OFr. *-er* < Lat. *-aris,* taining to, or resembling <*polar*>

A·ra (âr'ə) *n.* [Lat. *ara,* altar.] A const sphere.

Ar·ab (ăr'əb) *n.* [Fr. *Arabe* < Lat. *Ar* 1. A native or resident of Arabia. 2. from Arabia but later widely scatter North Africa, and the Arabian Penin ple living in North African and Near of a breed of swift, intelligent, graceft street Arab : WAIF. —*adj.* Arabian.

ar·a·besque (ăr'ə-bĕsk') *n.* [Fr. < Ita < *Arab,* an Arab < Lat. *Arabs.*] 1. An intertwined floral, foliate, and geom which a ballet dancer stands on one le ward with straight knee, and with th tional position. —*adj.* Formed as or

A·ra·bi·an (ə-rā'bē-ən) *adj.* Of or re —*n.* 1. A native or resident of Arabia

Arabian camel *n.* The dromedary

Ar·a·bic (ăr'ə-bĭk) *adj.* Of or relati language, or their culture. —*n.* A Sem merous dialects that is the principa Syria, Iraq, Lebanon, Egypt, and parts

Arabic numeral *n.* One of the nu 7, 8, 9, and 0.

Ar·ab·ist (ăr'ə-bĭst) *n.* One who spe or culture.

ar·a·ble (ăr'ə-bəl) *adj.* [ME < OFr. < Suitable for cultivation <*arable* soil>

A·rach·ne (ə-răk'nē) *n.* [Lat. < Gk *Gk. Myth.* A maiden who was transf for challenging her to a weaving cont

a·rach·nid (ə-răk'nĭd) *n.* [NLat. *Ar khnē,* spider.] Any of various arthrop spider, scorpion, mite, or tick, with dan (-nī-dən) *adj.* & *n.*

a·rach·noid (ə-răk'noid') *adj.* [N *khnoeidēs,* cobweblike : *arakhnē,* sp bling a spider's web. 2. Of or pertaini with or made up of thin, soft, entang 2. A delicate membrane of the spinal the pia mater and dura mater.

Ar·a·go·nese (ăr'ə-gə-nēz', -nēs') *ad* inhabitants, their language, or their c native or inhabitant of Aragon.

a·rag·o·nite (ə-răg'ə-nīt', ăr'ə-gə-) Spain.] An orthorhombic mineral fo bonate, dimorphous with calcite.

Ar·a·mae·an (ăr'ə-mē'ən) *n. var. of*

Ar·a·ma·ic (ăr'ə-mā'ĭk) *n.* The Semit Arameans but widely used by non- southwest Asia from the 7th cent. B.C ma'ic *adj.*

Ar·a·me·an *also* **Ar·a·mae·an** (ăr Aram, its inhabitants, their language, tive or resident of Aram. 2. Aramaic.

A·rap·a·ho *also* **A·rap·a·hoe** (ə-r **-hos** *also* **Arapahoe** *or* **-hoes.** [Crow tribe of Indians once living in the ar rivers, now settled in Oklahoma and W tribe. 2. The Algonquian language of t

ar·a·pai·ma (ăr'ə-pī'mə) *n.* [Sp. (Sou very large South American freshwate occas. reaching a length of 15 feet.

ar·a·ro·ba (ăr'ə-rō'bə) *n.* [Port., prob. tree, *Andira araroba,* with yellowish w powder is obtained. 2. The powder of

Ar·au·ca·ni·an (ăr'ô-kā'nē-ən) *also A araucano,* after *Arauco,* a province i group of Indian peoples of south-centra pas of Argentina. 2. The language of t an independent language family. **—Ar**

ar·au·car·i·a (ăr'ô-kâr'ē-ə) *n.* [< Sp. *A* province in Chile.] Any of several every *caria,* as the monkey puzzle and Norfo

Ar·a·wak (ăr'ə-wäk') *n., pl.* **Arawak** people now living chiefly in certain r member of this people. 2. The Arawal

Ar·a·wa·kan (ăr'ə-wä'kən) *n., pl.* **Ara** ber of a group of Indian peoples living i ica. 2. A language family consisting of Arawakan peoples. **—Ar'a·wa'kan** *adj.*

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,304	10/05/2007	6640872	A10019 7000	2131

7590 03/18/2010

EXAMINER	
ART UNIT	PAPER NUMBER

Phillip L. Kenner
RENNER, KENNER, GREIVE, BOBAK, TAYLOR & WEBER
First National Tower
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Akron, OH 44308-1456

DATE MAILED: 03/18/2010

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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P.O. Box 7037
Atlanta, GA 33057-0037

Date:

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000304
PATENT NO. : 6640872
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

MAR 18 2010

CENTRAL REEXAMINATION UNIT

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P.O. BOX 7037
ATLANTA, GA 33057-0037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,304
Filed: October 5, 2007
For: U.S. Patent No. 6,640,872

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

This is a decision on third party requester's paper entitled "PETITION UNDER 37 CFR 1.183," filed on January 8, 2010 concurrently with a "RESPONDENT'S BRIEF OF REQUESTER."

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth herein, third party requester's petition under 37 CFR 1.183 is dismissed, and the concurrently filed respondent brief is being expunged as an improper paper.

FEES

The petition fee of $400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to third party requester's deposit account no. 09-0528 on January 12, 2010.

BACKGROUND

1. On November 4, 2003, United States Patent Number 6,640,872 (the '872 patent) issued.

2. On October 5, 2007, a request for *inter partes* reexamination of the '872 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,304 (the '304 proceeding).

3. On December 14, 2007, the Office issued an order granting *inter partes* reexamination in the '304 proceeding, accompanied by a non-final Office action on the merits.

4. The '304 proceeding progressed to the point where, on August 27, 2009, the Office mailed a Right of Appeal Notice.

5. On September 24, 2009, patent owner filed a Notice of Appeal in the '304 proceeding.

6. On October 8, 2009, third party requester filed a Notice of Cross Appeal in the '304 proceeding.

7. On December 8, 2009, patent owner filed an appellant brief in the '304 proceeding.

8. Also on December 8, 2009, third party requester filed an appellant brief in the '304 proceeding.

9. On January 8, 2010, third party requester filed a respondent brief in the '304 proceeding.

10. Concurrently, on January 8, 2010, third party requester filed the instant petition paper entitled "PETITION UNDER 37 CFR 1.183," requesting waiver of the 15-page limit of 37 CFR 1.943(c) for its respondent brief.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.906 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(a) provides:

> 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(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 1.957(a) provides:

> 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.

Third Party Requester's Petition under 37 CFR 1.183

In its January 8, 2010 petition under 37 CFR 1.183, third party requester requests waiver of 37 CFR 1.943(c) "to the extent of accepting the Respondent's Brief of Requester, filed herewith."[1] In particular, requester asserts that the respondent brief, exclusive of the appendices, "is 22 pages and 8,834 words in length."[2]

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 brief claim appendices and "reference materials such as prior art references." Section 1.943(c) does not, however, specify that "reference materials" are excluded from the page count of a respondent 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

[1] Petition under 37 CFR 1.183 at page 1.
[2] Petition under 37 CFR 1.183 at page 1.

appendix to the respondent brief are not being counted toward the 15-page (or 7,000 word) limit of 37 CFR 1.943(c). Furthermore, the sections of the respondent brief required under 37 CFR 41.68(b)(1)(i)-(iv) and (viii)-(x)[3] are deemed to be included in "reference materials" that do not count toward the 15-page limit.[4]

It is to be noted, that the "Related Proceedings" appendix required by 37 CFR 41.68(b)(1)(ix) is considered "reference materials" and is excluded from the page count only insofar as the documents 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 size limit of the brief.

On its face, requester's January 8, 2010 respondent brief is 24 pages long. Pursuant to the page count guidance set forth herein, pages 1 and 22-24 are considered "reference materials" and, therefore, are excluded from the page count. Thus, the requester's January 8, 2010 respondent brief exceeds the 15-page limit of 37 CFR 1.943(c) by 5 pages.

In evaluating third party requester's January 8, 2010 respondent brief for page count, comments directed **to the conduct of the patent owner** during the '304 proceeding have been identified in the requester's respondent brief. See, e.g., respondent brief at pages 3, 5 and 17-18, for example, the section at page 3 beginning with "A. Introduction" and ending with "and 1.906(c)" and the sentence at page 18 beginning with "Patent Owner has" and ending with "likewise rejected." 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 patents and printed publications. Thus, comments on party conduct are not proper in an *inter partes* reexamination proceeding as they are beyond the scope of reexamination. *See* MPEP 2658. Therefore, pursuant to 37 CFR 1.957(d), the January 8, 2010 third party requester respondent brief will not be considered and is being expunged from the official file of the '304 proceeding by closing the paper in the Office's Image File Wrapper (IFW) database. Papers which have been closed in the Office's IFW are not part of the official file, and are not available to the public. Any future submission of a paper that contains issues not within the scope of reexamination, such as any paper (including a petition) that raises conduct issues, will not be entered and will be expunged by closing the paper in the IFW for the '304 proceeding.

Since the requester's concurrently-filed respondent brief is not to be part of the record, requester's January 8, 2010 petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(c) for as to that respondent brief is dismissed as moot.

Pursuant to 37 CFR 41.68(c), third party requester is hereby given a non-extendable time period of 15 days from the mailing date of the instant decision to submit a re-drafted, page-length

---

[3] (i) *Real Party in Interest*, (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (viii) *Evidence Appendix*, (ix) *Related Proceedings Appendix*, and (x) *Certificate of Service.*

[4] 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.

compliant respondent brief that does not include comments which are beyond the scope of *inter partes* reexamination.[5]

CONCLUSION

1. Third party requester's January 8, 2010 respondent brief paper is being **expunged** from the official file of the '304 proceeding, by closing the paper in the Office's Image File Wrapper (IFW) database.

2. Third party requester's January 8, 2010 petition under 37 CFR 1.183 is **dismissed as moot** in view of the expungement of requester's concurrently-filed respondent brief.

3. Pursuant to 37 CFR 41.68(c), third party requester is hereby given a non-extendable time period of **15 days from the mailing date of the instant decision** to submit a re-drafted, page-length compliant respondent brief that does not include comments which are beyond the scope of *inter partes* reexamination, and taking into account the waiver set forth in the body of this decision.

4. Jurisdiction for the '304 reexamination proceeding is returned to the CRU.

5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

3-17-10
Kenappeal/length

[5] It is noted that by removing the improper comments, requester's respondent brief should no longer exceed the 15-page limit of 37 CFR 1.943(c).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,306	01/04/2008	6852191	8584	6429

7590 06/04/2009

EXAMINER	

Thomas N. Young
YOUNG & BASILE
3001 W. Big Beaver Road
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Troy, MI 48084-3107

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
William E. Hilton
GAUTHIER & CONNORS, LLP
225 Franklin Street, Suite 2300
Boston, MA 02110

Date:

MAILED

JUN 0 4 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000306
PATENT NO. : 6852191
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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(For patent Owner)

MAILED

JUN 0 4 2009

CENTRAL REEXAMINATION UNIT

William E. Hilton
Gautheir & Connors, LLP
225 Franklin Street, Suite 2300
Boston, MA 02110

(For the Third-Party Requester)

In re Bayzelon et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,306
Filed: January 4, 2008
For: U.S. Patent No. 6,852,191

: **DECISION DIMISSING**
: **REQUEST FOR SUSPENSION**
: **OF *INTER PARTES***
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the request for suspension of examination filed by the patent owner on June 19, 2008, requesting temporary suspension in the *inter partes* reexamination proceeding of reexamination proceeding control Nos. 95/000,306. This decision also addresses the notice of termination of participation filed by the third party requester on December 23, 2008.

The patent owner's request and the third party requester's notice of termination of participation are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner's request for suspension is dismissed, and the third party requester's notice of termination of participation will be treated as a waiver of the third party requester's right to comment.

REVIEW OF FACTS

1. On February 8, 2005, U.S. Patent No. 6,852,191 (the '191 patent) issued to Bayzelon et al.

2. On October 12, 2007, a request for *inter partes* reexamination of the '191 patent was filed by a third party requester, and was assigned control number 95/000,306 (the '306 reexamination proceeding).

3. On November 27, 2007, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed. The notice assigned the filing date of October 12, 2007, to the request for *inter partes* reexamination.

4. On December 19, 2006, the Office mailed a decision *sua sponte* vacating the filing date of the reexamination because the request failed to comply with the requirements of 37 CFR

1.915(b)(3), which requires a statement pointing out each substantial new question of patentability and a detailed explanation.

5. On January 4, 2008, the third party requester filed a corrected request for *inter partes* reexamination.

6. On February 22, 2008, the Office granted the reexamination request and ordered reexamination for the '306 proceeding.

7. On February 27, 2008, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed. The notice assigned the filing date of January 4, 2008, to the request for *inter partes* reexamination.

8. On February 29, 2008, a first non-final Office action on the merits was mailed in the '306 reexamination proceeding.

9. On April 4, 2008, a response to the first non-final Office action was filed, presenting arguments in response to the rejections of record, as well as a declaration under 37 CFR 1.132 of Frederic LaBrie and an amendment presenting new claims 34-37.

10. On May 01, 2008, a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" was mailed notifying the patent owner that the new claims 34-37 presented in the amendment filed on April 4, 2008, must be completely underlined, and the amendment filed on April 4, 2008 will not be entered and considered.

11. On May 20, 2008, the patent owner filed a corrected amendment.

12. On May 21, 2008, a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" was mailed notifying the patent owner that the new claims 34-37 presented in the amendment filed on May 20, 2008, must be completely underlined, which includes the numbering of the claims, and the amendment filed on May 20, 2008 will not be entered and considered.

13. On June 16, 2008, the patent owner filed a second corrected amendment.

14. On June 18, 2008, the third party requester filed an information disclosure statement, comments to the patent owner's response and the Office action mailed on February 29, 2008, and a declaration under 37 CFR 1.132 of Edward Allie.

15. On June 19, 2008, the patent owner filed the instant request for suspension of examination.

16. On June 20, 2008, the third party requester filed a notice of court action, and an opposition to the patent owner's request for suspension of examination, including a copy of the opinion and order granting a motion to stay proceedings and denying an emergency motion to stay a discovery order issued by the United States District Court, Eastern District of Michigan Southern Division.

17. On June 23, 2008, the patent owner filed a information update letter notifying the Office that the United States District Court has overruled the Order of the Magistrate Judge (that ordered a discovery) and has stayed all discovery activity in the ongoing litigation in that Court.

18. On December 23, 2008, the third party requester filed a notice of termination of its participation in the '306 reexamination proceeding.

DECISION ON REQUEST FOR SUSPENSION OF EXAMINATION

Section 2686.04 of the Manual of Patent Examining Procedure (MPEP) provides, in part, that:

> [I]f, pursuant to 35 U.S.C. 318, a court stays litigation as to the patent being reexamined, action in the reexamination proceeding would not be suspended. This is so because action in the reexamination proceeding would be needed to resolve the "issue of patentability of any claims of the patent which are the subject of the *inter partes* reexamination order" set forth in 35 U.S.C. 318."

In the patent owner's request for suspension filed on June 19, 2008, patent owner requested a temporary suspension in the '306 reexamination proceeding. The patent owner stated that a copy of the Order entered by a Magistrate Judge in the United States District Court for the Eastern District of Michigan was enclosed. However, a review of the records in the official file of the '306 reexamination proceeding does not show that a copy of the Order was filed with the suspension request. The patent owner also stated that the Order may provide the patent owner with evidence that will be relevant to the examiner's consideration of the questions of obviousness.

In the third party requester's opposition filed on June 20, 2008, the third party requester stated that on June 17, 2008, the United States District Court for the District of Michigan, in Civil Action No. 07-13306 involving the '191 patent (that is being reexamined in the '306 reexamination proceeding) issued an Order granting a stay of the litigation. A copy of the Order granting the stay of all action in the case was provided with the opposition. Since the discovery order relied upon by the patent owner as the basis for its request for suspension has been stayed, and there is no other justification offered by the patent owner to suspend the examination in the '306 reexamination proceeding, the request for suspension must be dismissed. 35 U.S.C. 314(c) mandates that *inter partes* reexamination proceedings must be conducted "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the patent owner's request for suspension of examination in the '306 reexamination proceeding is dismissed.

WAIVER OF THIRD PARTY REQUESTER'S RIGHT TO COMMENT

35 U.S.C. 314(b)(2) provides, in part, that:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 provides, in part, that:

> 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.

37 CFR 1.951 provides that:

> (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.
>
> (b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

On February 29, 2008, the Office mailed a first non-final Office action in the '306 reexamination proceeding. In response to the Office action, the patent owner filed a response on April 4, 2008 (and a corrected amendment on June 16, 2008). The third party requester filed comments to the patent owner's response and the Office action on June 18, 2008. In accordance with the procedure set forth in the MPEP, the '191 patent under reexamination in the '306 reexamination proceeding will be reconsidered in view of the patent owner's response and the third party requester's comments. *See* MPEP § 2671. After the '191 patent has been reconsidered, the patent owner and the third party requester will be notified in an Office action as to any claims rejected, any claims found patentable and any objections or requirements made. If the patent owner files a response to the Office action, the third party requester would normally have a right to file written comments under 35 U.S.C. 314(b)(2) and 37 CFR 1.947 (or 37 CFR 1.951(b) if the Office action is an action closing prosecution). However, on December 23, 2008, the third party requester filed a notice of termination of participation in the '306 reexamination proceeding. The notice states that in accordance with the terms of a Settlement Agreement between the parties in Civil Action No.07-13306 (involving the '191 patent) that was filed on August 8, 2007 in the U.S. District Court for the District of Michigan, the third party requester notifies the Office

that the third party requester is terminating its participation in the '306 reexamination proceeding.

The Office is taking the third party requester's termination of its participation in the '306 reexamination proceeding as a waiver of the third party requester's right to file written comments under 35 U.S.C. 314(b)(2), 37 CFR 1.947 and 37 CFR 1.951(b). Therefore, the '306 reexamination proceeding will be acted on promptly after the examiner receives the patent owner's response to any Office action mailed after the mailing of this decision, without waiting 30 days for the third party requester to file written comments. Should the third party requester wish to contest this construction of the third party requester's notice of termination, the third party requester must so within fifteen (15) days of the mailing of this decision.

CONCLUSION

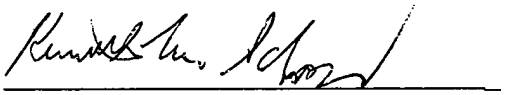
1) The request for suspension of examination filed on June 19, 2008, in the '306 reexamination proceeding is dismissed.

2) Jurisdiction over the '306 reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing not inconsistent with this decision.

3) The examiner will consider the response filed by the patent owner on April 4, 2008, the corrected amendment filed by the patent owner on June 16, 2008, and the third party requester's comments filed on June 18, 2008, and provide an Office action, in due course.

4) If no third party requester contest received within fifteen (15) days from the mailing of this decision, the examiner may act on the proceeding after receiving the patent owner's response to any Office action mailed after the mailing of this decision, without waiting 30 days for the third party requester to file written comments.

5) Telephone inquiries related to this decision should be directed to Joni Y. Chang, Senior Legal Advisor, at (571) 272-7720.



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,308	10/24/2007	6,399,002	230.0042	1455

25534 7590 01/30/2009

CAHN & SAMUELS LLP
1100 17th STREET NW
SUITE 401
WASHINGTON, DC 20036

EXAMINER	
DIAMOND, ALAN D	

ART UNIT	PAPER NUMBER
3991	

MAIL DATE	DELIVERY MODE
01/30/2009	PAPER

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

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Matthew J. Schmidt
REISING, ETHINGTON, BARNES, KISSELLE, P.C.
P.O. BOX 4390
Troy, MI 48099

MAILED

JAN 3 0 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,308*.

PATENT NUMBER *6,399,002*.

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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CAHN & SAMUELS LLP
1100 17th STREET NW
SUITE 401
WASHINGTON DC 20036

(For Patent Owner)

MAILED

JAN 3 0 2009

CENTRAL REEXAMINATION UNIT

Matthew J. Schmidt
Reising, Ethington, Barnes & Kisselle, P.C.
P.O. Box 4390
Troy, MI 48099

(For Third Party Requester)

In re Lupke *et al.*
Inter Parte Reexamination Proceeding
Control No.: 95/000,308
Deposited: October 24, 2007
For: U.S. Patent No.: 6,399,002

DECISION VACATING REEXAMINATION PROCEEDING

This is a decision on the January 23, 2009 patent owner petition requesting vacatur and termination of the above-captioned *inter partes* reexamination proceeding

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the eligibility for *inter partes* reexamination of the patent for which *inter partes* reexamination was requested.

U.S. Patent 6,399,002, for which *inter partes* reexamination was requested, is found not to be eligible for *inter partes* reexamination (pursuant to Section 4608 of the American Inventor's Protection Act). Accordingly, the petition is granted to the extent that the above-captioned *inter partes* reexamination proceeding is hereby vacated. All action taken in this proceeding to this point is likewise vacated.

REVIEW OF FACTS

1. U.S. Patent No. 6,399,002 (hereinafter, the '002 patent) issued on June 4, 2002. The '002 patent issued from application number 09/197,435, filed November 23, 1998.

2. On October 24, 2007, a request for *inter parte* reexamination was deposited by the third party requester, and this reexamination proceeding was assigned Control No. 95/000,308 (hereinafter, the '308 proceeding).

3. A Notice of Reexamination Request Filing Date was issued on November 5, 2007.

4. On December 10, 2007 the Office issued an order granting the request for *inter partes* reexamination in the '308 proceeding, accompanied by a first Office action on the merits.

5. Prosecution in the '308 proceeding advanced to the point where an Action Closing Prosecution (ACP) was issued.

6. On January 23, 2009, patent owner filed a petition requesting vacatur and termination of the '308 proceeding. In a separate paper, patent owner requests an extension of time to respond to the ACP in the event the petition for vacatur and termination is not granted.

DECISION

The reexamination statute was amended on November 29, 1999, by the 1999 American Inventors Protection Act (AIPA), Public Law 106-113, to expand reexamination by providing an "*inter partes*" option. Section 4608 (effective date) of the AIPA provides:

> "(a) In General. — ... this subtitle and the amendments made by this subtitle shall take effect on the date of the 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 [November 29, 1999]." [Emphasis added]

The application for the '002 patent, for which patent the present reexamination has been requested, was filed November 23, 1998, which was prior to November 29, 1999 (the date of enactment of the AIPA). Thus, the instant '002 patent is not eligible for *inter partes* reexamination.

Since, under the AIPA, the '002 patent is not eligible for *inter partes* reexamination, the Notice of Reexamination Request Filing Date and the Order granting the '308 proceeding's request for *inter partes* reexamination were issued in error. The filing date, the order granting the '308 proceeding's request for *inter partes* reexamination, and all subsequent action in the '308 proceeding are vacated. Since there is no pending proceeding (as a result of the vacateur), patent owner's request for an extension of time is moot.

Because a filing date was accorded to the present reexamination request papers, a file history was created in the electronic Image File Wrapper (IFW). As the reexamination proceeding has been vacated, the file history papers will be marked "closed" and "non-public," and will not constitute part of the public record.

CONCLUSION

1. The petition is granted to the extent that the above-captioned *inter partes* reexamination proceeding is hereby vacated. All action taken in this proceeding to this point is likewise vacated.

2. A refund of the $8,800 reexamination filing fee will be made to requester in due course.

3. The proceeding will be processed to mark its file history papers "closed" and "non-public," and make a refund of the reexamination filing fee.

4. Jurisdiction over the vacated *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit, to carry out the above processing.

5. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., at (571) 272-7759.

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

1-28-09
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95_308_-not eligable for IP reexam_applic filed too early_found after some prosecution happened.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,310	10/24/2007	6830766	2664.036	1937

23405 7590 06/15/2009

HESLIN ROTHENBERG FARLEY & MESITI PC
5 COLUMBIA CIRCLE
ALBANY, NY 12203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
IAN G. DIBERNARDO, ESQ.
STROOCK & STROOCK & LAVAN LLP
180 MAIDEN LANE
NEW YORK, NY 10038

Date: MAILED

JUN 15 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000310
PATENT NO. : 6830766
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)

IAN G. DIBERNARDO
STROOK & STROOK & LAVAN LLP
180 MAIDEN LANE
NEW YORK, NY 10038

(For Requester)

MAILED

JUN 15 2009

CENTRAL REEXAMINATION UNIT

In re McCabe
Inter Partes Reexamination Proceeding
Control No. 95/000,310
Filed: October 24, 2007
For: U.S. Patent No. 6,830,766

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the May 12, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is **dismissed.**

BACKGROUND

- On October 24, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,310 ("the '310 proceeding").

- Prosecution progressed until, on March 12, 2009, an Action Closing Prosecution (ACP) was issued.

- On April 9, 2009, the Office issued a decision granting a patent owner request for extension of time under 37 CFR 1.956(c) filed on April 2, 2009, extending the period for response set forth in 37 CFR 1.951(a) until May 12, 2009.

- On May 12, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of an amendment, evidence, and remarks filed with the petition.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

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

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.

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.

---

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

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. 37 CFR 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP, subject to the criteria of 37 CFR 1.116.

The May 12, 2009, patent owner petition is filed under 37 CFR 1.182 requesting entry of amendments, evidence, and remarks submitted on May 12, 2009. 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 submission under 37 CFR 1.951(a), or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

Furthermore, the May 12, 2009 patent owner petition, although filed under 37 CFR 1.182 requesting entry of amendments, evidence, and remarks submitted on May 12, 2009, has been filed within the time period set forth for response in the ACP. During this period, 37 CFR 1.951(a) specifically provides for the consideration of the comments and amendments, subject to the criteria of 37 CFR 1.116. Since patent owner's submission may be addressed through 37 CFR 1.951, consideration of the present petition under 37 CFR 1.182 is premature.

To accommodate the need for statutory special dispatch in reexamination, jurisdiction is being forwarded to the Central Reexamination Unit to process the May 12, 2009 patent owner amendment, evidence, and remarks (filed with the petition) as a submission under 37 CFR 1.951(a), and for the examiner to treat it as such. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date, relief has not been granted under 37 CFR 1.951 or through another section. Until such time, the issue is not ripe for consideration by the Office.

Accordingly, the petition is **dismissed** as being premature.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Prosecution is not being reopened by this decision.

3. Jurisdiction is being forwarded to the Central Reexamination Unit to process the May 12, 2009 patent owner amendment, evidence, and remarks (filed with the petition) as a submission under 37 CFR 1.951(a), and for the examiner to treat it as such.

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 Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

June 13, 2009
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ALBANY NY 12203

(For Patent Owner)

IAN G. DIBERNARDO
STROOK & STROOK & LAVAN LLP
180 MAIDEN LANE
NEW YORK, NY 10038

(For Requester)

MAILED

JUN 08 2009

CENTRAL REEXAMINATION UNIT

In re McCabe
Inter Partes Reexamination Proceeding
Control No. 95/000,311
Filed: October 24, 2007
For: U.S. Patent No. 6,827,955

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the May 12, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is **dismissed.**

BACKGROUND

- On October 24, 2007, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,311 ("the '311 proceeding").

- Prosecution progressed until, on March 12, 2009, an Action Closing Prosecution (ACP) was issued.

- On April 8, 2009, the Office issued a decision granting a patent owner request for extension of time under 37 CFR 1.956(c) filed on March 27, 2009, extending the period for response set forth in 37 CFR 1.951(a) until May 12, 2009.

- On May 12, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of an amendment, evidence, and remarks filed with the petition.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

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

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.

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.

---

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

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. 37 CFR 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP.

The May 12, 2009, patent owner petition is filed under 37 CFR 1.182 requesting entry of amendments, evidence, and remarks submitted on May 12, 2009. 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 submission under 37 CFR 1.951(a) or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

Furthermore, the May 12, 2009 patent owner petition, although filed under 37 CFR 1.182 requesting entry of amendments, evidence, and remarks submitted on May 12, 2009, has been filed within the time period set forth for response in the ACP. For this reason, 37 CFR 1.951(a) specifically provides for the consideration of the comments and amendments. The submission will be addressed by the Central Reexamination Unit as a response under 37 CFR 1.951(a).

Since the situation is currently in the process of being addressed through 37 CFR 1.951, consideration of the situation under 37 CFR 1.182 would be premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date relief has not been granted under 37 CFR 1.951 or through another section. Until such time, the issue is not ripe for consideration by the Office.

Accordingly, the petition is **dismissed** as being premature.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Prosecution is not being reopened by this decision.

3. Jurisdiction is being forwarded to the Central Reexamination Unit to process the May 12, 2009 patent owner amendment, evidence, and remarks (filed with the petition) as a submission under 37 CFR 1.951(a), and for the examiner to treat it as such.

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
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Alexandria, VA 22314

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

5. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth M. Schor

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

June 5, 2009
C:\Kiva\Kenpet7\IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,313	10/31/2007	6925469	108.0007-00000	7392

22882 7590 01/15/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/15/2010

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JOHN C. PHILLIPS
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

Date: MAILED

JAN 15 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000313
PATENT NO. : 6925469
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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JAN 15 2010

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Requester)

In re Headings et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,313
Filed: October 31, 2007
For: U.S. Patent No. 6,925,469 B2

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the December 4, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition fee of $400.00 under 37 C.F.R. § 1.17(f) has been charged.

The petition is **granted to the extent set forth below**.

BACKGROUND

1. On October 31, 2007, a request for *inter partes* reexamination of all of the claims (1-47) of U.S. Patent Number 6,925,469 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 95/000,313 ("the '313 proceeding").

2. On January 29, 2008, an order granting reexamination of all the claims of the '469 patent was mailed in the '313 proceeding.

3. On February 13, 2008, a non-final Office action, in which all pending claims were rejected, was mailed in the '313 proceeding.

4. On April 14, 2008, patent owner submitted a timely response to the outstanding Office action, including amendments and new claims 48-71.

5. On May 14, 2008, third party requester submitted timely comments after patent owner's response in accordance with 37 C.F.R. § 1.947.

6. On March 19, 2009, an action closing prosecution (ACP) was mailed, rejecting all of the pending claims (1-71).

7. On May 19, 2009, patent owner submitted a timely amendment and remarks in reply to the March 19, 2009 ACP. The amendment included cancellation of claims 11, 22, 39-46, 64-66, and 68-71, and amendments to claims 1, 12, 13, 20, 23, 24, 58, and 60, including independent claims 1 and 20.

8. On June 16, 2009, third party requester submitted timely comments after patent owner's response in accordance with 37 C.F.R. § 1.951(b).

9. On November 4, 2009, a right of appeal notice (RAN) was mailed by the Office, stating that the patent owner has not met the burden of showing good and sufficient reasons why the May 19, 2009 amendment is necessary and was not presented earlier, and informing patent owner that the amendment would not be entered. The RAN repeated the rejections of claims 1-71 set forth in the March 19, 2009 ACP.

10. On December 4, 2009, the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION" was filed seeking continuation of the reexamination proceeding and entry of the amendments and cancellations of the claims set forth in the May 19, 2009 patent owner paper.

11. Also on December 4, 2009, patent owner filed a Notice of appeal, and a petition under 37 CFR § 1.183 seeking an extension of time for filing an appeal brief.

12. On an even date herewith, the Office is issuing a decision dismissing as moot the December 4, 2009 patent owner petition under 37 CFR § 1.183.

PERTINENT REGULATIONS

37 C.F.R. § 1.182 provides:

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

DECISION

The December 4, 2009 patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of an amendment previously denied entry. 37 C.F.R. § 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 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding **to seek entry of an amendment and/or evidence that was denied entry** after an action closing prosecution in an *inter partes* reexamination proceeding.

The § 1.182 petition procedure was created to address a need for an amendment or evidence submission, the need for which did not become 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. § 305 that "[a]ll 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 C.F.R. § 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 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 did not become apparent until the issuance of the final rejection or action closing prosecution.

On December 4, 2009, the patent owner timely filed the instant § 1.182 petition. First, at the current stage of the proceedings, no regulation specifically provides for the entry of patent owner's submission to continue reexamination, thereby meeting the "situations not specifically provided for" language in § 1.182. Second, with respect to reasons why the need for the amendment could not have been anticipated earlier, patent owner states that the amendment was in response to rejections first set forth in the ACP. The instant submission includes an amendment intended to address issues, such as the rejections based upon 35 U.S.C. §§ 102(e), 112 and 314(a), first raised in the ACP. 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. Third, the requirement that the amendment has been previously denied entry is deemed to have been met. The petition was filed after an ACP in an *inter partes* reexamination proceeding to seek entry of an amendment not previously considered, and was previously denied entry in the November 4, 2009 RAN.

Fourth, the effect of entry of the amendment is determined to be in accordance with furthering the prosecution by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. Entry of the May 19, 2009 amendment would cancel claims 11, 22, 39-46, 64-66, and 68-71. Entry of the amendment would also address the rejections based upon 35 U.S.C. §§ 102(e), 112 and 314(a), first raised in the ACP. The

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

examiner's refusal to enter the amendment pursuant to 37 C.F.R. § 1.116 was based upon (1) an insufficient showing that the amendment was necessary, (2) more than a cursory review would be required, (3) the amendment would not remedy all previous rejections under 35 U.S.C. § 112 and would raise new issues, and (4) the amendment would not overcome all previous prior art rejections.

None of these reasons are contrary to a finding that entry of the amendment would further prosecution. The standard for continuation of examination via a petition under 37 C.F.R. § 1.182 is different than the standard for entry of a submission after final under 37 C.F.R. § 1.116. Although guided by similar principles, a submission properly refused entry under 37 C.F.R. § 1.116 may still be entered under 37 C.F.R. § 1.182 where the proceeding would be furthered and both the equities of the matter and the requirement of special dispatch would be best served. With respect to reasons (1) and (2), a lack of showing that an amendment is necessary, or that more than a cursory review is required, does not prevent an amendment from furthering the reexamination proceeding towards appeal or issuance of a certificate. With respect to reasons (3) and (4), an amendment may fail to overcome all rejections, yet still reduce or simplify issues for appeal. With further respect to reason (3), an amendment that does not overcome a rejection under § 112 might raise a new issue in the sense that the particular language had not been previously considered. However, the amended language may still act to simplify the issues for appeal, as the amendment provides the patent owner's viewpoint of a proper claim in full knowledge of the examiner's position. Viewed as a whole, the May 19, 2009 amendment, which cancels some claims and amends others in response to rejections newly raised in the ACP, is deemed to further prosecution by simplifying or reducing issues for appeal.

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 concurrently with the instant petition, on December 4, 2009, to keep the proceeding pending. While the patent owner has filed a notice of appeal, neither an appeal brief nor an examiner's answer has been filed. Therefore, any delay caused by the submission of the December 4, 2009 notice of appeal is not significant enough to outweigh the benefit to be obtained by consideration of the proffered amendment.

Based on the facts in this case, it is found that continuation of examination through entry of the May 19, 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 March 19, 2009 ACP is withdrawn, and prosecution of the proceeding is reopened to the following extent:

The instant reexamination proceeding will be returned to the Central Reexamination Unit (CRU) for entry[2] of the May 19, 2009 response, and subsequently to await submission of any third party comments under 37 C.F.R. § 1.947 regarding the May 19, 2009 patent owner amendment. Following the submission of third party requester comments, or the lapse of the time period for

[2] This decision takes no position on the propriety of the amendment or whether it introduces new matter. Any issues raised by the amendment will be addressed by the Examiner in the next Office action.

third party comment, the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the May 19, 2009 amendment and any third party comments that comply with 37 C.F.R. § 1.947. The examiner will then issue an Office action treating the patent owner papers as a response and comments received **after** a first Office action.

CONCLUSION

- The petition is **granted to the extent set forth herein**.
- The prosecution of the present '313 *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 March 19, 2009 ACP is hereby withdrawn, and prosecution of the proceeding is reopened.
- **Third party requester has thirty (30) days from the date of mailing of this decision to submit comments pursuant to 37 CFR 1.947.**
- The May 19, 2009 response will be entered by the CRU. The CRU will await submission of third party comments, or the expiration of the time for same and then jurisdiction of the proceeding will be transferred to the examiner for consideration of both the amendment and any third party comments.
- Jurisdiction over the reexamination proceeding is being forwarded to the CRU 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.

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

January 14, 2009
C:\Kiva\Kenpet7\RCR\

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.
95/000,313	10/31/2007	6925469	108.0007-00000	7392

22882 7590 01/15/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/15/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN C. PHILLIPS
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

Date:
MAILED

JAN 15 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000313
PATENT NO. : 6925469
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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JAN 15 2010

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

JOHN C. PHILLIPS
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12390 EL CAMINO REAL
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(For Requester)

In re Headings et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,313
Filed: October 31, 2007
For: U.S. Patent No. 6,925,469 B2

DECISION
DISMISSING PETITION
UNDER 1.183

This is a decision on the December 4, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 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."

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

The petition fee of $400.00 under 37 C.F.R. § 1.17(f) has been charged.

The petition is **dismissed as moot**.

BACKGROUND

1. On October 31, 2007, a request for *inter partes* reexamination of all of the claims (1-47) of U.S. Patent Number 6,925,469 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 95/000,313 ("the '313 proceeding").

2. On January 29, 2008, an order granting reexamination of all the claims of the '469 patent was mailed in the '313 proceeding.

3. On February 13, 2008, a non-final Office action, in which all pending claims were rejected, was mailed in the '313 proceeding.

4. On April 14, 2008, patent owner submitted a timely response to the outstanding Office action, including amendments and new claims 48-71.

5. On May 14, 2008, third party requester submitted timely comments after patent owner's response in accordance with 37 C.F.R. § 1.947.

6. On March 19, 2009, an action closing prosecution (ACP) was mailed, rejecting all of the pending claims (1-71).

7. On May 19, 2009, patent owner submitted a timely amendment and remarks in reply to the March 19, 2009 ACP. The amendment included cancellation of claims 11, 22, 39-46, 64-66, and 68-71, and amendments to claims 1, 12, 13, 20, 23, 24, 58, and 60, including independent claims 1 and 20.

8. On June 16, 2009, third party requester submitted timely comments after patent owner's response in accordance with 37 C.F.R. § 1.951(b).

9. On November 4, 2009, a right of appeal notice (RAN) was mailed by the Office, stating that the patent owner has not met the burden of showing good and sufficient reasons why the May 19, 2009 amendment is necessary and was not presented earlier, and informing patent owner that the amendment would not be entered. The RAN repeated the rejections of claims 1-71 set forth in the March 19, 2009 ACP.

10. On December 4, 2009, a petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION" was filed seeking continuation of the reexamination proceeding and entry of the amendments and cancellations of the claims set forth in the May 19, 2009 patent owner paper.

11. Also on December 4, 2009, patent owner filed the instant petition under 37 CFR § 1.183 seeking an extension of time for filing an appeal brief, along with a Notice of appeal.

12. On an even date herewith, the Office is issuing a decision granting the December 4, 2009 patent owner petition under 37 CFR § 1.182.

PERTINENT REGULATIONS

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 41.66(a) provides:

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.

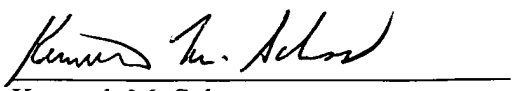
DECISION

On an even date herewith, the Office is issuing a decision granting patent owner's petition under § 1.182 petition, therefore reopening prosecution in the '313 proceeding. The May 19, 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. Therefore, a waiver of the rules for an extension of time is no longer needed, and patent owner's petition for waiver of the prohibition of extension of time to file an appeal brief set forth in 37 C.F.R. § 41.66(a) has become moot. The instant petition under 37 C.F.R. § 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 C.F.R. § 1.183, if at some future date a situation requiring waiver of 37 C.F.R. § 41.66(a) is believed to arise.

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.



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

January 14, 2009
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FEB 27 2008

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In re Ishida
Reexamination Proceeding
Control No. 95/000,314
Filed: November 6, 2007
For: U.S. Patent No. D499,385

DECISION DISMISSING PETITION

This is a decision on the December 7, 2007, patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 requesting suspension of the instant *inter partes* reexamination proceeding prior to a determination on the request, or alternatively requesting suspension of the instant *inter partes* reexamination proceeding after a determination on the request, but prior to an Office action on the merits. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended. The petition to suspend is also taken as a petition under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 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). The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. §§ 1.182 and 1.183 was paid.

The petition is before the Office of Patent Legal Administration for decision.

The petition is granted to the extent that the documents have been considered, but the substantive relief requested in the patent owner petition is **dismissed**, for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. D499,385 issued to Ishida on December 7, 2004.

2. On November 6, 2007, a request for *inter partes* reexamination of the sole design claim of the '385 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,314.

3. A patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 requesting suspension of the instant *inter partes* reexamination proceeding was filed in the '314 proceeding on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

4. Reexamination was ordered in the '314 proceeding on February 5, 2008. An Office action on the merits has not yet been mailed.

5. A second Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985 was filed by patent owner on February 13, 2008.

DECISION

The present PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 requesting suspension of the instant *inter partes* reexamination proceeding prior to a determination on the request, or alternatively requesting suspension of the instant *inter*

partes reexamination proceeding after a determination on the request, but prior to an Office action on the merits, has been fully considered.

RELEVANT STATUTE, REGULATIONS, AND EXAMINING PROCEDURE

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.

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:

> 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. § 1.182 states (in part):

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

37 C.F.R. § 1.183 states (in part):

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

37 C.F.R. § 1.987 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.

DISCUSSION

Petitioner indicates that Seoul Semiconductor Co., Ltd. (hereinafter "Seoul"), identified as the real party in interest in the instant *inter partes* reexamination, has received a jury verdict in federal district court that Seoul willfully infringed the sole claim of the '385 design patent, and also failed to prove that the claim of the '385 design patent is invalid. Petitioner contends that Seoul now attempts to litigate in the U.S. Patent & Trademark Office issues that Seoul could have raised but failed to raise in the near-final district court action. Petitioner states that each reference relied upon in the instant request for *inter partes* reexamination was published prior to the litigation and discovered by Seoul in the very first document production of that litigation. Petitioner suggests that because Seoul thereafter made the strategic decision to waive its defenses and counterclaims based on anticipation and obviousness to avoid certain discovery, any further administrative review in this just-requested *inter partes* reexamination will likely be mooted by the concurrent litigation under the estoppel provision in 35 U.S.C. 317(b). Petitioner asserts that Seoul seeks to initiate an unnecessary and improper reexamination proceeding merely to get "another bite at the apple" after losing in district court. Petitioner purports that the present case is substantially identical to *Sony Computer Entertainment America Inc., v. Dudas*, No. 05-01447, 2006 WL 1472462 (E.D. Va. May 22, 2006), in which the Director suspended two *inter partes* reexaminations after a jury trial upholding patent validity but before an appeal was completed. Petitioner suggests that the Office should not expend its resources in determining whether "a substantial new question of patentability" exists; rather, the Director should find that there is "good cause" to suspend, under the Director's statutory authority in 35 U.S.C. 314(c), any further administrative review until the earlier of (i) the lapse of Seoul's right to appeal its adverse jury verdict, or (ii) a decision is rendered in such appeal. Petitioner alternatively

requests suspension subsequent to a determination ordering reexamination, and postponement of issuance of any Office Action on the merits, until such time as mentioned above.

Petitioner's arguments have been fully considered, but are not deemed persuasive. First, 35 U.S.C. 311 states that 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. Secondly, the statute also requires a determination as to whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, not later than 3 months after the filing of a request for *inter partes* reexamination under section 311. Therefore, while the rules provide that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived, the statutory requirement that a determination will be made as to whether a substantial new question of patentability is raised by a request for *inter partes* reexamination cannot be waived.

One of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial new question of patentability not previously considered by the Office. It is therefore in the public interest of patent quality that where a substantial new question of patentability is raised by a request for reexamination, that the reexamination of the patent proceed, and with "special dispatch" pursuant to 35 U.S.C. 314(c). Note that the reexamination of a patent is not merely a duplication of a validity challenge in court. In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit noted that district courts and the Office use different standards of proof in determining invalidity, and therefore, on the same evidence, could quite correctly come to different conclusions. *Id.* At 1427-29. Since the "clear and convincing" standard used in court proceedings is more difficult to satisfy than the "preponderance" standard applied by the Office, claims held valid by the courts may still be rejected in a reexamination proceeding. Also, because a patent owner can amend the claims in a reexamination proceeding, the Office gives claims their broadest reasonable interpretation consistent with the specification, which is different than the claims interpretation employed by the courts. *In re American Academy of Science Tech*

Center, 367 F.3d 1359, 1364 (Fed. Cir. 2004), *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). Therefore, since the two copending proceedings are not duplicate proceedings, it is appropriate, as contemplated by the statute, that both proceedings continue until one of them reaches a "final decision," which then will require the termination of the validity challenge to those same patent claims in the other forum, pursuant to 35 U.S.C. 317(b):

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . ., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or . . ., 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.

In other words, a validity challenge in a district court action and *inter partes* reexamination of a patent may occur simultaneously, at least for some period of time. However, once one proceeding is finally concluded, then the issues raised or that could have been raised with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other proceeding. It should be noted that since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as meaning after a final, non-appealable decision.

A review of the concurrent litigation documents filed by petitioner on same date as the instant petition reveals that the U.S. District Court issued a jury verdict on November 8, 2007. The Notice of concurrent proceeding(s) filed by patent owner on February 13, 2008, indicates that the U.S. District Court for the Northern District of California entered Final Judgement on February 7, 2008, in favor of plaintiff (patent owner) and against defendants (Seoul), since the jury found defendants willfully infringed U.S. Design Patent Nos. 491,538, 490,784, 503,338, and 499,385, and found each such patent valid. If an appeal of the district court decision is filed, it is uncertain whether the Court of Appeals for the Federal Circuit's decision

will ultimately estop a reexamination of the litigated patent claim, as the possibility exists that the district court's decision on validity may be reversed or vacated, with a remand for a new trial. In that situation, reexamination of the litigated claim would continue since there would be no "final" decision. It appears that the time period for Seoul to file an appeal of the district court decision has not yet expired. If an appeal is filed, it may be some time before a final, non-appealable decision is issued by the Court of Appeals for the Federal Circuit. Until that time, the Office is obligated to move forward in the *inter partes* reexamination, and with "special dispatch."

With regard to petitioner's assertion that the present case is substantially identical to *Sony Computer Entertainment America Inc., v. Dudas*, No. 05-01447, 2006 WL 1472462 (E.D. Va. May 22, 2006), in which the Director suspended two *inter partes* reexaminations after a jury trial upholding patent validity but before an appeal was completed, such is not persuasive. Although the sole design claim in the present case may be subject to copending litigation and *inter partes* reexamination, the status of such litigation does not yet appear to have advanced to a point that may be considered near to its final stages, for the reasons discussed *supra* with regard to a "final decision." Since reexamination is intended to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial new question of patentability not previously considered by the Office, it is in the public interest of patent quality that where a substantial new question of patentability is raised by a request for reexamination, that the reexamination of the patent proceed, and with "special dispatch" pursuant to 35 U.S.C. 314(c), until a final, non-appealable decision is issued in a copending litigation of the patent. It should be noted that a patent remains valid and in force throughout the reexamination process, whether *ex parte* or *inter partes*. *Heinl v. Godici*, 143 F.Supp.2d 593, 600 (E.D.Va. 2001)(citing *Patlex I*, 758 F.2d. at 603); see also *Patlex Corp. V. Quigg*, 680 F.Supp. 33, 35 (D.D.C. 1988). In fact, this does not change unless and until a Federal Circuit mandate issues, invalidating the claims (assuming appeal rights are exhausted). In contrast, the initial action on the merits in an *inter partes* reexamination is only the first step in the proceeding, and on balance, "good cause" does not exist at this time to warrant suspending the reexamination proceeding prior to a first Office action being mailed.

It does not appear that petitioner has yet provided evidence that a final, non-appealable court decision has been issued. Both patent owner and third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

The PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 requesting suspension of the proceeding prior to a determination on the request is **dismissed as moot**. The alternative request for suspension of the instant *inter partes* reexamination proceeding after a determination on the request, but prior to an Office action on the merits, is **dismissed as premature**.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 is **dismissed**.

2. The *inter partes* reexamination proceeding is before the examiner for preparation of the first Office action on the merits pursuant to MPEP 2660.

3. Both patent owner and third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

4. Any future correspondence with respect to this *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

5. Any telephone inquiries with regard to this decision should be directed to Lynn M. Kryza, Senior Patent Special Projects Advisor at (571) 272-7722.

Brian E. Hanlon

Brian E. Hanlon, Deputy Director
Office of Patent Legal Administration

February 26, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,314	11/06/2007	D499385	705679-0001	7458

22428 7590 05/12/2008

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAY 12 2008
CENTRAL REEXAMINATION UNIT

Foley and Lardner LLP
Suite 500
3000 K Street NW
Washington, DC 20007

(For Patent Owner)

Malcolm K. McGowan
Bingham McCutchen LLP
2020 K Street NW
Washington, DC 20006

(For Third-Party Requester)

In re Ishida
Reexamination Proceeding
Control No. 95/000,314
Request Deposited: November 6, 2007
For: U.S. Design Patent No. D499,385

: DECISION GRANTING
: PETITION
: FOR EXTENSTION OF TIME
: 37 CFR 1.956
:

This is a decision on the April 30, 2008, patent owner "PETITION FOR EXTENSION OF TIME" requesting that the time to submit a response to the office action mailed March 13, 2008 be extended an additional one month.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Design Patent No. D499,385 (hereinafter, the '385 patent), issued to Ishida, on December 7, 2004.

2. On November 6, 2007, a third party deposited a Request for *Inter Partes* Reexamination of the '385 patent. The reexamination proceeding was assigned Control No. 95/000,314 (hereinafter, the '314 proceeding).

3. The reexamination order was granted in the '314 proceeding on March 13, 2008. An office action was attached to the order setting a two-month period for response.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed March 13, 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 April 30, 2008, together with 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.

Petitioner's request for an extension of time is **granted.** An extension of time of one month is considered sufficient.

Accordingly, the time for filing the response is extended for thirty days and therefore the response is due on or before June 13, 2008.

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

CONCLUSION

1. Petitioner's request is granted. The period during which Patent Owner may file a response has been extended to June 13, 2008.

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.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,314	11/06/2007	D499385	705679-0001	7458

22428 7590 05/28/2008

FOLEY AND LARDNER LLP
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/28/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MALCOLM K. MCGOWAN
BINGHAM MCCUTCHEN LLP
2020 K STREET, NW
WASHINGTON, D.C. 20006

Date:
MAILED
MAY 28 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000314
PATENT NO. : D499385
ART UNIT : 2900

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

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

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Stephen B. Maebius
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3000 K Street, NW
Suite 500
Washington, DC 20007-5109

(For Patent Owner)

MAILED

MAY 28 2008

CENTRAL REEXAMINATION UNIT

Malcolm K. McGowan
BINGHAM MCCUTCHEN LLP
2020 K Street, NW
Washington, DC 20006-1806

(For *Inter Partes* Requester)

In re Ishida :
Reexamination Proceeding : **DECISION**
Control No. 95/000,314 : **DISMISSING**
Filed: November 6, 2007 : **PETITION**
For: U.S. Patent No. D499,385 :

This is a decision on the April 11, 2008, patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c) for suspension of the instant *inter partes* reexamination proceeding. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182 because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.182 was charged to patent owner's credit card, as authorized by the patent owner on page 7 of the instant petition.

The petition is before the Office of Patent Legal Administration for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. D499,385 issued to Ishida on December 7, 2004 (the '385 design patent).

2. On November 6, 2007, a request for *inter partes* reexamination of the sole design claim of the '385 design patent was filed by a third party requester, which proceeding was assigned control no. 95/000,314 (the '314 proceeding).

3. A patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '314 proceeding, was filed on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

4. Reexamination was ordered in the '314 proceeding on February 5, 2008.

5. On February 27, 2008, a Decision was mailed, dismissing the patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, filed on December 7, 2007.

6. On March 13, 2008, a first Office action was mailed, rejecting the sole claim of the '385 design patent.

7. A renewed patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, was filed on April 11, 2008, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

8. On April 30, 2008, patent owner filed a PETITION UNDER 37 C.F.R. § 1.956, requesting a one month extension of time to file its response to the outstanding Office action.

9. On May 12, 2008, a Decision was mailed, granting the patent owner PETITION UNDER 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the outstanding Office action has been extended accordingly and a response is now due on or before June 13, 2008.

DECISION

The present PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, has been fully considered.

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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:

> 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. § 1.103(a) provides (in part):

> *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months.

37 C.F.R. § 1.182 states (in part):

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

37 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.

The Manual of Patent Examining Procedure (MPEP) § 2686.01 states (in part):

> It may also be desirable in certain situations to suspend one of the proceedings for a short and specified period of time. For example, a suspension of a first reexamination proceeding may be issued to allow time for the decision on the second request. Further, after the second proceeding has been ordered, it may be

desirable to suspend the second proceeding prior to merging, where the first proceeding is presently on appeal before a Federal court to await the court's decision prior to merging. A suspension will only be granted in exceptional (extraordinary) instances because of the statutory requirements that examination proceed with "special dispatch", and the express written approval by the OPLA must be obtained. Suspension will not be granted when there is an outstanding Office action.

II. DISCUSSION

Petitioner indicates that facts have changed since the previously filed PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '314 proceeding, was dismissed as premature on February 27, 2008. In particular, petitioner indicates that trial proceedings in federal district court concluded in the concurrent litigation between petitioner and the real party in interest in the '314 proceeding, Seoul Semiconductor Co., Ltd. (hereinafter "Seoul"), when Seoul's post-trial motions were finally denied on April 8, 2008.[1] Additionally, petitioner indicates that Seoul filed an appeal to the U.S. Court of Appeals for the Federal Circuit on April 10, 2008, seeking review of the district court's findings adverse to Seoul.

Petitioner submits that although a first Office action was mailed in the '314 proceeding on March 13, 2008, Seoul's pending appeal to the Federal Circuit will likely conclude long before the '314 proceeding ends.[2] Thus, petitioner asserts that because trial court proceedings on the validity of the '385 design patent have concluded and Seoul's appeal of the trial court's decision to the U.S. Court of Appeals for the Federal Circuit will lead to a final decision well before the '314 proceeding is concluded, the U.S. Patent and Trademark Office should not frustrate the purpose of the estoppel provision of 35 U.S.C. § 317(b) and should immediately suspend the '314 proceeding under 37 C.F.R. § 1.987.[3]

While there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 C.F.R. § 1.103 provides such a mechanism for requesting a suspension of action in an application. Accordingly, the requirements of 37 C.F.R. § 1.103(a) will be applied analogously to a suspension in a reexamination proceeding. 37 C.F.R. § 1.103(a) provides that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding." Also, MPEP § 2686.01 provides that, for a suspension based upon the existence of a proceeding as to the patent being reexamined other than the reexamination, a "[s]uspension will not be granted when there is an outstanding Office action."

In the present petition, petitioner is requesting suspension of the '314 proceeding based on concurrent litigation as to the '385 design patent; yet, petitioner has not responded to the non-final Office action of March 18, 2008. Thus, because a response to the March 18, 2008 non-final Office action has not been received, the petition is **dismissed**.

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[1] *Nichia Corp. v. Seoul Semiconductor Ltd., et al.*, No. 3:06-00162 MMC (N.D. Cal. filed Jan. 10, 2006).

[2] *See* petition at page 4.

[3] *See* petition at page 1.

III. ADDITIONAL DISCUSSION

In the instant petition, petitioner asserts that the '314 proceeding is now, in all relevant respects, substantially identical to the suspended '093 and '094 *inter partes* reexaminations at issue in *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006) and, therefore, requests that the '314 proceeding be suspended until the U.S. Court of Appeals for the Federal Circuit issues a decision in the co-pending appeal.[4] In asserting that the '314 proceeding is now "squarely aligned" with the '093 and '094 proceedings, petitioner notes that, like the petitioner in the '093 and '094 proceedings, it now renews its petition to suspend after the district court litigation has been appealed.[5]

The fact that all remaining claims had been litigated and on appeal when the renewed petition to suspend was filed in the '093 and '094 proceedings, however, was not the only factor considered in the decision granting the renewed petition to suspend.[6] Rather, the Office considered the relative stages of the concurrent appeal and the reexamination proceedings. As noted by the district court in *Sony*, "the PTO correctly concluded that the two 'races' between the parties were at very different stages: The Federal Circuit appeal was nearing its conclusion, while the PTO's *inter partes* review was just beginning."[7]

While the stage of the '314 proceeding is known (i.e., a first Office action on the merits has been mailed), petitioner has not provided information regarding the stage of the concurrent appeal. Accordingly, should petitioner renew its request for suspension of the '314 proceeding **after responses to the outstanding Office action have been filed**, petitioner should include information regarding the stage of the concurrent appeal (e.g., scheduling information, such as a Notice of Docketing, setting forth some of the deadlines in the appeal) in its request.

Accordingly, the PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987, and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, is **dismissed** in view of the outstanding Office action, mailed on March 13, 2008.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987, and 35 U.S.C. § 314(c) is **dismissed**.

2. The time period for response to the outstanding Office action of March 13, 2008, continues to run. As set forth in the May 12, 2008 decision granting a one-month extension of time, any response to the March 13, 2008 Office action is due on or before June 13, 2008.

---

[4] *See* petition at pages 5-7.
[5] *See* petition at page 5.
[6] *See* the decision entitled "Decision Granting Petitions to Suspend", mailed on November 17, 2005, in reexamination proceeding control no. 95/000,094.
[7] *Sony*. 2006 U.S. Dist. LEXIS 36856, at *19.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await any response to the outstanding Office action of March 13, 2008, or the expiration of the time period for response to the March 13, 2008 Office action.

4. The patent owner and the third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

5. Any future correspondence with respect to this *inter partes* reexamination proceeding 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

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

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

6. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.

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

May 28, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,314	11/06/2007	D499385	705679-0001	7458

22428 7590 09/30/2008

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON, D.C. 20001-4413

Date:
MAILED
SEP 30 2008
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000314
PATENT NO. : D499385
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

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 30 2008

CENTRAL REEXAMINATION UNIT

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In re Ishida :
Reexamination Proceeding : **DECISION**
Control No. 95/000,314 : **DISMISSING**
Filed: November 6, 2007 : **PETITION**
For: U.S. Patent No. D499,385 :

This is a decision on the July 24, 2008 patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c) for suspension of the instant *inter partes* reexamination proceeding. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended. This decision also treats the August 21, 2008 third party requester Petition and Opposition Under 37 C.F.R. § 1.183 in Response to Patent Holder's Petition to Suspend *Inter Partes* Reexamination Proceeding.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the patent owner's petition under 37 C.F.R. § 1.182 was charged to patent owner's credit card, as authorized by the patent owner on page 8 of the patent owner's petition. The petition fee of $400.00 for the requester's petition under 37 C.F.R. § 1.183 has been charged to the third party requester's credit card as authorized on page 5 of the requester's petition.

The proceeding, the patent owner petition, and the third party petition and opposition are before the Office of Patent Legal Administration for consideration.

The patent owner's petition requesting suspension of the reexamination proceeding is **dismissed**, for the reasons set forth below. The third party requester's petition for suspension of the rules to have its opposition remarks considered is **granted**, and such remarks have been considered.

REVIEW OF FACTS

1. U.S. Patent No. D499,385 (the '385 design patent) issued to Ishida on December 7, 2004.

2. A civil litigation involving the '385 design patent commenced on January 10, 2006, captioned *Nichia Corp. v. Seoul Semiconductor Ltd. et al.*, U.S. District Court, Northern District of California, San Francisco Division, Case No. 3:06-00162 MMC.

3. On November 6, 2007, a request for *inter partes* reexamination of the sole design claim of the '385 design patent was filed by a third party requester, Seoul Semiconductor Co., Ltd. (a party to the concurrent civil litigation), which proceeding was assigned control no. 95/000,314 (the '314 proceeding).

4. On November 8, 2007, in the civil litigation, a jury found that Seoul willfully infringed the sole design claim and failed to prove that it is highly probable that the sole design claim is invalid.

5. A patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '314 proceeding, was filed on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

6. Reexamination was ordered in the '314 proceeding on February 5, 2008.

7. On February 27, 2008, a Decision was mailed, dismissing the patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, filed on December 7, 2007, as no final decision had been rendered in the concurrent litigation.

8. On March 13, 2008, a first Office action was mailed, rejecting the sole claim of the '385 design patent.

9. On April 10, 2008, the third party requester Seoul filed an appeal to the U.S. Court of Appeals for the Federal Circuit seeking review of the district court's findings in the concurrent litigation. The Federal Circuit appeal is styled *Nichia Corp. v. Seoul Semiconductor Co., Ltd. et al.*, Appeal No. 2008-1309, -1336, -1380 (hereafter the Federal Circuit appeal).

10. A renewed patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, was filed on April 11, 2008. The renewed petition was accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

11. On April 30, 2008, patent owner filed a Petition Under 37 C.F.R. § 1.956, requesting a one month extension of time to file its response to the outstanding Office action.

12. On May 12, 2008, a Decision was mailed, granting the patent owner Petition Under 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the outstanding Office action was extended accordingly.

13. On May 28, 2008, a Decision was mailed, dismissing the April 11, 2008 patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), because the response to the March 13, 2008 Office action was outstanding.

14. The response to the outstanding March 13, 2008 Office action was filed on June 12, 2008.

15. On July 23, 2008, Seoul filed its principal brief in the Federal Circuit appeal and argued, *inter alia*, that the district court erred by granting summary judgment rejecting Seoul's claim that Nichia's design patents are invalid because of functionality and that the district court erred by refusing to grant JMOL and/or a new trial for Seoul's defense that Nichia's design patents are invalid because their appearance is not a matter of concern. Seoul asked for a new trial.

16. On July 24, 2008, the patent owner filed the subject "Petition to Suspend *Inter Partes* Reexamination Proceeding and for OPLA to Retain Jurisdiction Pending Decision on Suspension," which is being treated as a petition under 37 C.F.R. § 1.182 as explained in the first paragraph of this decision.

17. On August 21, 2008, the third party requester filed the subject "Petition and Opposition Under 37 C.F.R. § 1.183 in Response to Patent Holder's Petition to Suspend *Inter Partes* Reexamination Proceeding," the merits of which are addressed herein.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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:

> 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. § 1.182 states (in part):

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

37 C.F.R. § 1.907 states (in part):

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

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.

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

* * * * *

The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. **317**(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. **317**(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.

In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.

* * * * *

Taking the above into account, 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?

II. DISCUSSION

A. Patent Owner Requests Suspension of the '314 Proceeding

Petitioner asserts that good cause exists to suspend the '314 proceeding for five reasons, including: (1) a reply (response) to the first Office action is no longer outstanding; (2) the '314 proceeding is at its early stages, while the civil litigation is nearing a final disposition; (3) the sole claim of the '385 patent is the subject of both the civil litigation and the '314 proceeding; (4) the third party requester in the '314 proceeding is the same party as the defendant/appellant in the civil litigation; and (5) all of the references relied upon by the third party requester in requesting reexamination were published before and discovered during the civil litigation (before the defendant waived its obviousness defenses prior to trial).

Further as to reason (2), petitioner submits that although a first Office action has been mailed in the '314 proceeding, third party requester's pending appeal to the Federal Circuit will likely conclude long before the '314 proceeding ends. Patent owner argues that the '314 proceeding is squarely aligned with the *inter partes* proceedings that were suspended, which were addressed in *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006). The patent owner therefore requests that this proceeding be suspended until the Federal Circuit issues a final decision in the concurrent appeal proceeding.

Patent owner additionally requests that the jurisdiction over the '314 proceeding be maintained by OPLA for at least 10 days after this decision is mailed to avoid the issuance of conflicting decisions.

B. Third Party Requester Opposed the Patent Owner's Request

As pointed out above, the petition requesting a suspension of the rules to have the opposition remarks considered is granted. The third party requester argues that there is no good cause to suspend this proceeding for three reasons: (1) there is no indication that the patent owner is likely to prevail on appeal; (2) the *inter partes* proceeding concerns an issue that was not considered by

the district court; and (3) as an Office action has been issued in this proceeding, the stage of the proceeding is not analogous to the fact situation in *Sony*.

As to issue (1), the likelihood of the patent owner prevailing on appeal is not a factor that is considered by the Office when determining whether it is appropriate to suspend action in the reexamination proceeding. It is not for the Office to determine how the appeal will be resolved. It is sufficient that the patent owner has already prevailed in the District Court on the merits of the civil action, and such was the situation in *Sony*, where the Office's suspension of the reexamination proceedings was supported by the court.

As to issue (2), the estoppel provisions of 35 U.S.C. § 317(b) apply to issues that the requester or its privies raised *or could have raised* in the civil action. Thus, the fact that this *inter partes* proceeding concerns an issue not considered by the district court is not the proper inquiry. The proper inquiry is whether the requester or its privies raised *or could have raised* the issue. The patent owner asserts that the prior art issues could have been raised in the civil action as the prior art references were known to the third party requester during the discovery phase of the district court action; this patent owner assertion has not been rebutted by the third party requester.

As to issue (3), the distinction between the stage of the prosecution in this proceeding and the stage in the *Sony* action is acknowledged. In this proceeding, the first Office action has issued and a response has been filed. In *Sony*, the proceeding was suspended prior to the issuance of a first Office action on the merits of the patentability of the claims.

C. Analysis and Findings

The factors to be considered in determining whether it is appropriate to terminate action in an *inter partes* proceeding based on litigation in which the third party requester is a party to the litigation are detailed in MPEP 2686.04, subsection V, reproduced above. In this case, the civil litigation and the '314 proceeding both involve the sole claim of the '385 patent. The patent owner has raised the presumption that the prior art issues in the '314 proceeding could have been raised in the civil litigation. This presumption has not been rebutted by the third party requester. There is no concurrent *ex parte* proceeding for the '385 patent.

The above factors indicate that estoppel may attach to the claim in the *inter partes* proceeding; however, the most significant factor is whether a final decision adverse to the requester has been issued. In this case, no final decision has been issued. Even the decision has not yet become final, a *stay or suspension* of a proceeding may be appropriate if (a) all other factors for estoppel attachment are present and (b) the litigation has advanced to a late enough stage that a final decision will be rendered in the near future and there is sufficient probability that a final decision will be adverse to the requester based solely on the prior district court decision (as pointed out, the Office cannot enter into the appeals court's province to try to assess the probability as to which party will win on appeal). In this situation, the Federal Circuit appeal has just commenced, with only the principal brief having been filed to date. Moreover, the question on appeal as to the validity of the '385 patent is whether the district court erred as a matter of law by granting summary judgment that the '385 patent claim is not invalid and by refusing to grant

JMOL and/or a new trial to the defendant (third party requester) on its claim that the '385 patent claim is invalid. The appellant (third party requester) asks that a new trial be ordered.

Thus, the significant facts in this proceeding are:

(1) The '314 proceeding is in active reexamination phase, in which the claim patentability issues have been addressed in the first action, and the proceeding is awaiting examiner action on the response to the Office action; and

(2) The appeal is in the early briefing phase, and a decision is not expected in the near future.

These facts, taken with the rest of the facts and circumstances of this case, do not support a finding of good cause to suspend the '314 proceeding.

The facts in this proceeding are not squarely aligned with the facts in *Sony*. Although all remaining (reexamination proceeding) claims had been litigated and on appeal when the renewed petition to suspend was filed in the proceedings in *Sony,* that was not the only factor considered in the decision granting the renewed petition to suspend. [1] Rather, the Office considered the relative stages of the concurrent appeal and the reexamination proceedings. As noted by the district court in *Sony*, "the PTO correctly concluded that the two 'races' between the parties were at very different stages: The Federal Circuit appeal was nearing its conclusion, while the PTO's *inter partes* review was just beginning." [2] The relative stages in this situation are much closer. In contrast to the *Sony inter partes* reexamination proceedings, which were just at their beginning stages (e.g., the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of patentability), the present reexamination proceeding has advanced significantly beyond the beginning stage. In this instance, the Office has issued a non-final Office action, in response to which the patent owner has filed a patent owner's response. Thus, patentability issues have been defined and argued by parties, and the Office's work in the merged reexamination proceeding has not been limited to merely finding that the requests for reexamination raised a substantial new question of patentability (at which point a patentability determination has not yet been made). On the other hand, the Federal Circuit briefing is just beginning.

Accordingly, good cause for suspension has not been shown, and the Petition under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, is **dismissed**.

As to retaining this proceeding within OPLA's jurisdiction for at least 10 more days, the patent owner's argument is not pertinent. Conflicting decisions cannot be issued, since the examiner does not render decisions for petitions for suspension, but rather will issue an action on the merits of patent owner's June 12, 2008 reply. There is no compelling reason for OPLA to retain jurisdiction over this proceeding for at least 10 more days, as requested by patent owner, since reexamination of the '385 patent must be conducted with special dispatch in accordance with 35

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[1] *See* the decision entitled "Decision Granting Petitions to Suspend," mailed on November 17, 2005, in reexamination proceeding control no. 95/000,094.

[2] *Sony*, 2006 U.S. Dist. LEXIS 36856, at *19.

U.S.C. § 314(c). With the mailing of this decision, jurisdiction is returned to the Central Reexamination Unit in order for the June 12, 2008 response to be properly considered in a manner consistent with the mandate of special dispatch.

CONCLUSION

1. The patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

2. The third party Petition Under 37 C.F.R. § 1.183 is granted for consideration of the opposition arguments.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to continue reexamination and consider patent owner's response filed June 12, 2008.

4. The patent owner and the third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

5. Any future correspondence with respect 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:	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

6. Any questions concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at 571-272-7729.

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

09-26-08
C:\kiva\kenpet7\IP\suspend\95_0314 Supend for Fed Cir appealed case-Dismiss -OA issued+initial briefing stage of appeal

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,314	11/06/2007	D499385	705679-0001	7458

22428 7590 01/13/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED
JAN 13 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000314
PATENT NO. : D499385
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

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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JAN 13 2009

CENTRAL REEXAMINATION UNIT

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In re Ishida
Inter Partes Reexamination Proceeding
Control No. 95/000,314
Filed: November 6, 2007
For: U.S. Patent No. D499,385

: **DECISION**
: **DISMISSING PETITION,**
: ***SUA SPONTE,* SUSPENDING**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the November 5, 2008 patent owner petition under 37 CFR §§ 1.181, 1.182, 1.183, and 1.907, and 35 U.S.C. § 317(b) to terminate the instant *inter partes* reexamination proceeding. The patent owner petition to terminate 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 terminated.*

The petition fee of $400.00 pursuant to 37 CFR § 1.17(f) for the patent owner's petition under 37 CFR § 1.182 was charged to patent owner's credit card, as authorized by the patent owner on page 13 of the patent owner's petition.

The patent owner petition and the instant 95/000,314 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition requesting termination of the reexamination proceeding is dismissed. Furthermore, the decision, *sua sponte*, suspends the examination and prosecution of the instant *inter partes* reexamination proceeding until the circumstances in the parallel litigation warrant termination or resumption of the examination and prosecution.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. D499,385 (the '385 design patent) issued to Ishida on December 7, 2004.

* It is noted that 37 CFR 1.181 is a general rule that is non-specific to reexamination and provides a mechanism to file a petition to terminate an *ultra vires* reexamination order that is not based on prior art patents and printed publications.

2. The '385 design patent is the subject of civil litigation captioned *Nichia Corp. v. Seoul Semiconductor Ltd. et al.*, U.S. District Court, Northern District of California, San Francisco Division, Case No. 3:06-00162 MMC that commenced on January 10, 2006. A copy of the complaint in the litigation is attached to the patent owner petition filed on November 5, 2008 as Exhibit 4.

3. On July 21, 2006, Seoul filed a Second Amended Answer and Amended Counterclaims (Docket No. 119) in Civil Action No. 06-00162 MMC, asserting a counterclaim against Nichia that the sole claim of the '385 patent was invalid under 35 U.S.C. §§ 102, 103, 119, and/or 171 and seeking a declaratory judgment of invalidity of the same. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 5.

4. On August 28, 2006, in response to Seoul's discovery request, Nichia sent to Seoul a document production containing Japanese Patent JP 1077515 (labeled Bates Numbers NC00000913-917), Japanese Patent JP 6-204569 (labeled Bates Numbers NC00002860-2863), Japanese Patent JP 2001-36154 (labeled Bates Numbers NC00002315-2324), and Surface Mount Type LED - Light Emitting Diode, Product Guide, Jan. 2001, 6 pages, Cat. No. 01033K, Nichia Corporation, Japan (labeled Bates Numbers NC00000269-274). A copy of Nichia's cover letter that accompanied the document production of August 28, 2006 is attached to the patent owner petition filed on November 5, 2008 as Exhibit 6.

5. On November 13, 2006, in a Joint Letter Regarding Discovery Disputes ("the 11/13/06 Joint Letter") (Docket No. 148) filed in Civil Action No. 06-00162 MMC, Nichia sought from Seoul certain documents and interrogatory responses relevant to rebutting Seoul's obviousness defense, *id.* at 10, to which Seoul responded by expressly waiving all obviousness defenses against the '385 patent: "Nichia suggests that it needs foreign sales related documents to show commercial success as a rebuttal to Seoul's claim of obviousness. But Seoul is no longer claiming obviousness." *Id.* at 16 (emphasis added). Seoul specifically stated in the 11/13/06 Joint Letter to the district court that its invalidity defenses and counterclaims were limited to "the design patent tests of 'hidden-in-use' and functionality." *Id.* A copy of the letter submitted by Seoul to the district court is attached to the patent owner petition filed on November 5, 2008 as Exhibit 7.

6. On June 29, 2007, Seoul filed an Opposition to Nichia Corporation's Motion for Summary Judgment of Patent Infringement, Validity and Seoul's Equitable Defenses ("Seoul's 06/29/07 Opposition") (Docket No. 484) (Redacted Version) in Civil Action No. 06-00162 MMC. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 8.

7. On August 14, 2007, Magistrate Judge Spero issued a Report and Recommendation ("Magistrate Judge Spero's 08/14/07 Report and Recommendation") (Docket No. 508) in Civil Action No. 06-00162 MMC, granting Nichia's motion to bar Seoul's obviousness defense because Seoul "specifically agreed not to raise the obviousness defense" in the 11/13/06 Joint Letter, on which the Court had relied. *Id.* at 2-3. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 9.

8. On August 31, 2007, District Judge Chesney issued an Order (Docket No. 723) in Civil Action No. 06-00162 MMC, adopting Magistrate Judge Spero's 08/14/07 Report and Recommendation *in toto,* and further granting Nichia's motion for summary

judgment against Seoul's claim of obviousness as to the '385 patent. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 11.

9. On November 6, 2007, a request for inter partes reexamination of the sole claim of the '385 design patent was filed by a third party requester, Seoul Semiconductor Co., Ltd. (a party to the concurrent civil litigation), which proceeding was assigned Control no. 95/000,314 (the '314 proceeding).

10. On November 8, 2007, in the civil litigation, a jury found that Seoul willfully infringed the sole design claim and failed to prove that it is highly probable that the sole design claim is invalid. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 13.

11. A patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '314 proceeding, was filed on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

12. Reexamination was ordered in the '314 proceeding on February 5, 2008.

13. On February 7, 2008, the district court entered a Final Judgment against Seoul, finding among other things that the '385 patent was valid. A copy of the Final Judgment is attached patent owner petition filed on November 5, 2008 as Exhibit 14.

14. On February 27, 2008, a Decision was mailed, dismissing the patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, filed on December 7, 2007, as no final decision had been rendered in the concurrent litigation.

15. On March 13, 2008, a first Office action was mailed, rejecting the sole claim of the '385 design patent.

16. On April 10, 2008, the third party requester Seoul filed an appeal to the U.S. Court of Appeals for the Federal Circuit seeking review of the district court's findings in the concurrent litigation. The Federal Circuit appeal is styled *Nichia Corp. v. Seoul Semiconductor Co., Ltd. et al.*, Appeal No. 2008-1309, -1336, -1380 (hereafter the Federal Circuit appeal).

17. A renewed patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, was filed on April 11, 2008. The renewed petition was accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

18. On April 30, 2008, patent owner filed a petition under 37 C.F.R. § 1.956, requesting a one month extension of time to file its response to the outstanding Office action.

19. On May 12, 2008, a Decision was mailed, granting the patent owner petition under 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the outstanding Office action was extended accordingly.

20. On May 28, 2008, a Decision was mailed, dismissing the April 11, 2008 patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), because the response to the March 13, 2008 Office action was outstanding.

21. The response to the outstanding March 13, 2008 Office action was filed on June 12, 2008.

22. On July 23, 2008, Seoul filed its principal brief in the Federal Circuit appeal and argued, *inter alia*, that the district court erred by granting summary judgment rejecting Seoul's claim that Nichia's design patents are invalid because of functionality and that the district court erred by refusing to grant JMOL and/or a new trial for Seoul's defense that Nichia's design patents are invalid because their appearance is not a matter of concern. Seoul asked for a new trial.

23. On July 24, 2008, the patent owner filed the subject "Petition to Suspend *Inter Partes* Reexamination Proceeding and for OPLA to Retain Jurisdiction Pending Decision on Suspension," which was treated as a petition under 37 CFR § 1.182.

24. On August 21, 2008, the third party requester filed the subject "Petition and Opposition under 37 C.F.R. § 1.183 in Response to Patent Holder's Petition to Suspend *Inter Partes* Reexamination Proceeding."

25. On September 30, 2008, a Decision was mailed, dismissing the July 24, 2008 patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '314 proceeding, and granting the August 21, 2008 third party requester petition under 37 CFR § 1.183 for consideration of the opposition arguments.

26. On November 5, 2008, the patent owner filed the present petition under 37 CFR §§ 1.181, 1.182, 1.183, and 1.907, and 35 U.S.C. § 317(b) to terminate the instant *inter partes* reexamination proceeding.

27. On December 17, 2008, the patent owner filed a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985. The Notice states that the Brief of Plaintiff-Cross Appellant Nichia Corporation was filed on October 2, 2008 in the Federal Circuit appeal and that no decision has been rendered yet by the Court of Appeals for the Federal Circuit.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 171 states:

> Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
> The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. § 282 states in pertinent part:

> A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other

claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1)Noninfringement, absence of liability for infringement, or unenforceability,
(2)Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,
(3)Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,
(4)Any other fact or act made a defense by this title.

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:

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 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.

37 CFR § 1.937(a) states:

All inter partes reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless

the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR § 1.987 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.

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

> *****
>
> The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.
>
> In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.
>
> *****
>
> Taking the above into account, 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?

II. DISCUSSION

A. Patent Owner Requests Termination of the '314 Proceeding

Petitioner asserts that the instant *inter partes* reexamination proceeding should be terminated by the Office because the third party requester, Seoul Semiconductor Co., Ltd. ("Seoul"), is estopped from maintaining the proceeding under 35 U.S.C. § 317(b) now that there is a final decision in the parallel litigation as to the issues that could have been raised between the parallel litigation and the instant reexamination proceeding. Petitioner concludes that there is now a final decision because (1) there are "final" adverse rulings from the parallel district court litigation against Seoul's obviousness defenses to the '385 patent (see pages 5-6 of the instant petition), (2) Seoul has not pursued an appeal of the adverse obviousness rulings made by the district court, and thus these rulings are now "final", and (3) the exceptions to the estoppel provisions do not apply in this reexamination.

Petitioner asserts that all issues involved in this reexamination proceeding have been finally resolved in the federal courts and that the only remaining invalidity issues before the Federal Circuit (i.e., ornamentality and functionality) are not presently before the USPTO in this reexamination proceeding, i.e., the present reexamination proceeding is based solely on obviousness (see page 9 and footnote 6 of the instant petition).

Petitioner also argues that the exceptions to the estoppel provisions that are stated in 35 U.S.C. § 317(b) do not apply in this case since Seoul could have raised in the prior district court litigation every grounds for obviousness asserted in the present reexamination. Each reference relied upon in Seoul's reexamination request for the '385 patents was both published prior to the district court litigation and specifically disclosed to Seoul while Seoul still had ample opportunity to raise these references in the district court litigation (see page 10 of present petition).

B. Analysis and Findings

I. Termination of the '314 Reexamination Proceeding is Not Required by 35 U.S.C. § 317(b)

The factors to be considered in determining whether it is appropriate to either suspend or terminate action in an *inter partes* proceeding based on litigation in which the third party requester is a party to the litigation are detailed in MPEP § 2686.04, subsection V, reproduced above. In this case, the civil litigation and the '314 proceeding both involve the sole claim of the '385 design patent. It is noted that the Seoul's obviousness defense in the district court litigation was based in part upon different prior art (see footnote 5 on page 9 of instant petition). Seoul's obviousness defense was barred as untimely in the district court litigation (see order issued by District Judge Chesney on August 31, 2007 attached as Exhibit 11 to the instant petition). The patent owner has asserted that the patentability issues based upon the prior art in the '314 proceeding could have been raised in the civil litigation. This argument has not been rebutted by the third party requester. There is no concurrent *ex parte* proceeding for the '385 patent.

The above factors indicate that while the estoppel provisions of 35 U.S.C. § 317(b) may ultimately operate so as to preclude the Office from maintaining the '314 *inter partes*

proceeding, at the present time there is no final nonappealable decision adverse to the requester that has been issued in the litigation. Stated differently, because the litigation is presently involved in a pending appeal at the Federal Circuit, the Office disagrees with the petitioner's assertion that there is presently a decision in the parallel litigation that constitutes a "final decision" for purposes of triggering the estoppel provisions of 35 U.S.C. § 317(b). For reasons discussed in the immediately succeeding paragraphs, it is not impossible that a decision from the Federal Circuit may remand the litigation to the district court with instructions to include prior art based patentability issues in the remanded litigation.

35 U.S.C. § 317(b) does not limit the invalidity or patentability of any claim to the issue of obviousness based on prior art publications. 35 U.S.C. § 282 states that invalidity of the patent or any claim in suit on any ground is specified in part II of Title 35 of the United States Code as a condition for patentability. The question on appeal to the Federal Circuit as to the validity of the '385 design patent is whether the district court erred as a matter of law by granting summary judgment rejecting Seoul's claim that '385 design patent is invalid because of functionality and that the district court erred by refusing to grant JMOL and/or a new trial for Seoul's defense that '385 design patent is invalid because the appearance is not a matter of concern. The appellant (third party requester) has requested that a new trial be ordered.

Thus, the district court decision in the litigation which is still pending on appeal is not a final decision that inevitably precludes consideration of prior patent/printed publication based assertions of claim invalidity. A final decision has not been rendered regarding whether the sole claim of the '385 is invalid because of functionality. A design claim that is primarily functional is rejected under 35 U.S.C. § 171 for lack of ornamentality. That section of the statute is specified in part II of Title 35 of the United States Code. See MPEP §1504.01(c) under the heading "I. FUNCTIONALITY VS. ORNAMENTALITY". Therefore, a final decision within the meaning of 35 U.S.C. § 317(b) has not been made regarding the invalidity or patentability of the sole design claim in the '385 patent.

II. Suspension of the '314 Reexamination Proceeding is Appropriate

Even if the decision has not yet become final, a *stay or suspension* of a proceeding may be appropriate if (a) all other factors for estoppel attachment are present, (b) the litigation has advanced to a late enough stage that a final decision will be rendered in the near future and (c) there is sufficient probability that a final decision will be adverse to the requester based solely on the prior district court decision (as pointed out in the previous September 30, 2008 Office Decision, the Office cannot enter into the appeals court's province to try to assess the probability as to which party will prevail on appeal). In this situation, the Federal Circuit appeal has advanced since the last Office Decision mailed on September 30, 2008 for the instant *inter partes* reexamination proceeding. A plaintiff-cross appellant brief has been filed on October 2, 2008 by the patent owner and a reply brief by third party requester has been filed on December 15, 2008 (docket information for the concurrent litigation obtained from LexisNexis Courtlink on December 17, 2008). The third party requester filed its principal brief on July 23, 2008.

The significant facts in this proceeding are:

(1) The '314 proceeding is in the early reexamination phase (a patent owner response has been filed on June 12, 2008 in response to a first non-final office action), and

(2) The Federal Circuit appeal has progressed with both parties having filed their principal appeal briefs.

The facts in this proceeding now closely parallel the facts in *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006). In *Sony*, "the PTO also concluded that because the Federal Circuit appeal was far advanced in comparison to the reexamination proceedings, which had only recently been commenced, there was ample good cause to suspend the reexamination proceedings pending completion of the Federal Circuit appeal. Good cause, the PTO noted, was supported by the statutory estoppel that would operate after completion of the Federal Circuit appeal. *See* 35 U.S.C. § 317(b)." (Sony, 2006 U.S. Dist. LEXIS 36856, at *7). As in *Sony*, "[i]t is not in the [PTO's] and the parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation [in the Federal Circuit] which is soon to be finally resolved. That is particularly true here where the administrative proceedings have only just begun." *Id.*

The Office has discretion pursuant to 35 U.S.C. § 314(c) to suspend the instant *inter partes* reexamination proceeding in the interest of conserving Office resources and where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 USC § 317(b).

The Office recognizes that upon completion of the appellate process in the Federal Circuit pertaining to the sole litigated claim, there are only two possible outcomes for the instant *inter partes* reexamination proceeding: (a) the sole design claim is found valid or invalid because of functionality, and the reexamination proceeding in either case would be moot or (b) the district court's decision on claim validity is reversed or vacated, with a remand to grant the third party requester a new trial, and the reexamination proceeding may continue or resume if the proceeding has been suspended.

As discussed in MPEP § 2686.04, the issuance of a final Court decision after all appeals (in a civil action arising in whole or in part under 28 U.S.C. § 1388) upholding validity during an *inter partes* reexamination, where the person who filed the request was a party to the litigation will have the effect that the Office will discontinue examination of all claims affected by the holding of validity for issues raised or could have been raised as to the claims asserted by the patent owner and challenged by the third party requester. If the provisions of 37 CFR § 1.907(b) apply, then the reexamination proceeding must be terminated. A final Court holding of invalidity is binding on the Office and if all claims being examined are finally held invalid, the reexamination proceeding must be terminated.

These facts, taken with the rest of the facts and circumstances of this case, support a finding of good cause pursuant to 35 U.S.C. § 314(c) and 37 CFR § 1.937(a) to suspend the '314 proceeding.

CONCLUSION

1. The patent owner petition under 37 CFR §§ 1.181, 1.182, 1.183, and 1.907, and 35 U.S.C. § 317(b) is dismissed.

2. The instant *inter partes* reexamination proceeding is suspended, *sua sponte*, until the there is a final, nonappealable decision in the civil litigation regarding the validity of the claim in the '385 patent.

3. The patent owner in the '314 *inter partes* reexamination proceeding is respectfully reminded of its continuing duty pursuant to 37 CFR § 1.985 to keep the Office apprised of the progress of the appeal in the concurrent litigation, and to notify the Office when that appeal has been resolved and may no longer be appealed.

4. **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.

5. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711, or, in her absence, to the undersigned at 571-272-7710.

Robert A Clarke

Robert A. Clarke
Director
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Ishida
Reexamination Proceeding
Control No. 95/000,317
Filed: November 6, 2007
For: U.S. Patent No. D503,388

DECISION DISMISSING PETITION

This is a decision on the December 7, 2007, patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 requesting suspension of the instant *inter partes* reexamination proceeding prior to a determination on the request, or alternatively requesting suspension of the instant *inter partes* reexamination proceeding after a determination on the request, but prior to an Office action on the merits. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended. The petition to suspend is also taken as a petition under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 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). The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. §§ 1.182 and 1.183 was paid.

The petition is before the Office of Patent Legal Administration for decision.

The petition is granted to the extent that the documents have been considered, but the substantive relief requested in the patent owner petition is **dismissed**, for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. D503,388 issued to Ishida on March 29, 2005.

2. On November 6, 2007, a request for *inter partes* reexamination of the sole design claim of the '388 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,317.

3. A patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 requesting suspension of the instant *inter partes* reexamination proceeding was filed in the '317 proceeding on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

4. Reexamination was ordered in the '317 proceeding on February 5, 2008. An Office action on the merits has not yet been mailed.

5. A second Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985 was filed by patent owner on February 13, 2008.

DECISION

The present PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 requesting suspension of the instant *inter partes* reexamination proceeding prior to a determination on the request, or alternatively requesting suspension of the instant *inter partes* reexamination proceeding after a determination on the

request, but prior to an Office action on the merits, has been fully considered.

RELEVANT STATUTE, REGULATIONS, AND EXAMINING PROCEDURE

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.

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:

> 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. § 1.182 states (in part):

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

37 C.F.R. § 1.183 states (in part):

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

37 C.F.R. § 1.987 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.

DISCUSSION

Petitioner indicates that Seoul Semiconductor Co., Ltd. (hereinafter "Seoul"), identified as the real party in interest in the instant *inter partes* reexamination, has received a jury verdict in federal district court that Seoul willfully infringed the sole claim of the '388 design patent, and also failed to prove that the claim of the '388 design patent is invalid. Petitioner contends that Seoul now attempts to litigate in the U.S. Patent & Trademark Office issues that Seoul could have raised but failed to raise in the near-final district court action. Petitioner states that each reference relied upon in the instant request for *inter partes* reexamination was published prior to the litigation and discovered by Seoul in the very first document production of that litigation. Petitioner suggests that because Seoul thereafter made the strategic decision to waive its defenses and counterclaims based on anticipation and obviousness to avoid certain discovery, any further administrative review in this just-requested *inter partes* reexamination will likely be mooted by the concurrent litigation under the estoppel provision in 35 U.S.C. 317(b). Petitioner asserts that Seoul seeks to initiate an unnecessary and improper reexamination proceeding merely to get "another bite at the apple" after losing in district court. Petitioner purports that the present case is substantially identical to *Sony Computer Entertainment America Inc., v. Dudas*, No. 05-01447, 2006 WL 1472462 (E.D. Va. May 22, 2006), in which the Director suspended two *inter partes* reexaminations after a jury trial upholding patent validity but before an appeal was completed. Petitioner suggests that the Office should not expend its resources in determining whether "a substantial new question of patentability" exists; rather, the Director should find that there is "good cause" to suspend, under the Director's statutory authority in 35 U.S.C. 314(c), any further administrative review until the earlier of (i) the lapse of Seoul's right to appeal its adverse jury verdict, or (ii) a decision is rendered in such appeal. Petitioner alternatively

requests suspension subsequent to a determination ordering reexamination, and postponement of issuance of any Office Action on the merits, until such time as mentioned above.

Petitioner's arguments have been fully considered, but are not deemed persuasive. First, 35 U.S.C. 311 states that 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. Secondly, the statute also requires a determination as to whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, not later than 3 months after the filing of a request for *inter partes* reexamination under section 311. Therefore, while the rules provide that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived, the statutory requirement that a determination will be made as to whether a substantial new question of patentability is raised by a request for *inter partes* reexamination cannot be waived.

One of the fundamental purposes of reexamination is to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial new question of patentability not previously considered by the Office. It is therefore in the public interest of patent quality that where a substantial new question of patentability is raised by a request for reexamination, that the reexamination of the patent proceed, and with "special dispatch" pursuant to 35 U.S.C. 314(c). Note that the reexamination of a patent is not merely a duplication of a validity challenge in court. In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit noted that district courts and the Office use different standards of proof in determining invalidity, and therefore, on the same evidence, could quite correctly come to different conclusions. *Id.* At 1427-29. Since the "clear and convincing" standard used in court proceedings is more difficult to satisfy than the "preponderance" standard applied by the Office, claims held valid by the courts may still be rejected in a reexamination proceeding. Also, because a patent owner can amend the claims in a reexamination proceeding, the Office gives claims their broadest reasonable interpretation consistent with the specification, which is different than the claims interpretation employed by the courts. *In re American Academy of Science Tech*

Center, 367 F.3d 1359, 1364 (Fed. Cir. 2004), *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). Therefore, since the two copending proceedings are not duplicate proceedings, it is appropriate, as contemplated by the statute, that both proceedings continue until one of them reaches a "final decision," which then will require the termination of the validity challenge to those same patent claims in the other forum, pursuant to 35 U.S.C. 317(b):

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . ., then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or . . ., 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.

In other words, a validity challenge in a district court action and *inter partes* reexamination of a patent may occur simultaneously, at least for some period of time. However, once one proceeding is finally concluded, then the issues raised or that could have been raised with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other proceeding. It should be noted that since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as meaning after a final, non-appealable decision.

A review of the concurrent litigation documents filed by petitioner on same date as the instant petition reveals that the U.S. District Court issued a jury verdict on November 8, 2007. The Notice of concurrent proceeding(s) filed by patent owner on February 13, 2008, indicates that the U.S. District Court for the Northern District of California entered Final Judgement on February 7, 2008, in favor of plaintiff (patent owner) and against defendants (Seoul), since the jury found defendants willfully infringed U.S. Design Patent Nos. 491,538, 490,784, 503,338, and 499,385, and found each such patent valid. If an appeal of the district court decision is filed, it is uncertain whether the Court of Appeals for the Federal Circuit's decision

will ultimately estop a reexamination of the litigated patent claim, as the possibility exists that the district court's decision on validity may be reversed or vacated, with a remand for a new trial. In that situation, reexamination of the litigated claim would continue since there would be no "final" decision. It appears that the time period for Seoul to file an appeal of the district court decision has not yet expired. If an appeal is filed, it may be some time before a final, non-appealable decision is issued by the Court of Appeals for the Federal Circuit. Until that time, the Office is obligated to move forward in the *inter partes* reexamination, and with "special dispatch."

With regard to petitioner's assertion that the present case is substantially identical to *Sony Computer Entertainment America Inc., v. Dudas*, No. 05-01447, 2006 WL 1472462 (E.D. Va. May 22, 2006), in which the Director suspended two *inter partes* reexaminations after a jury trial upholding patent validity but before an appeal was completed, such is not persuasive. Although the sole design claim in the present case may be subject to copending litigation and *inter partes* reexamination, the status of such litigation does not yet appear to have advanced to a point that may be considered near to its final stages, for the reasons discussed *supra* with regard to a "final decision." Since reexamination is intended to promote and maintain a system of valid patents by having the Office take a second look at patents in which there is a substantial new question of patentability not previously considered by the Office, it is in the public interest of patent quality that where a substantial new question of patentability is raised by a request for reexamination, that the reexamination of the patent proceed, and with "special dispatch" pursuant to 35 U.S.C. 314(c), until a final, non-appealable decision is issued in a copending litigation of the patent. It should be noted that a patent remains valid and in force throughout the reexamination process, whether *ex parte* or *inter partes*. *Heinl v. Godici*, 143 F.Supp.2d 593, 600 (E.D.Va. 2001)(citing *Patlex I*, 758 F.2d. at 603); see also *Patlex Corp. V. Quigg*, 680 F.Supp. 33, 35 (D.D.C. 1988). In fact, this does not change unless and until a Federal Circuit mandate issues, invalidating the claims (assuming appeal rights are exhausted). In contrast, the initial action on the merits in an *inter partes* reexamination is only the first step in the proceeding, and on balance, "good cause" does not exist at this time to warrant suspending the reexamination proceeding prior to a first Office action being mailed.

It does not appear that petitioner has yet provided evidence that a final, non-appealable court decision has been issued. Both patent owner and third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

The PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 requesting suspension of the proceeding prior to a determination on the request is **dismissed as moot**. The alternative request for suspension of the instant *inter partes* reexamination proceeding after a determination on the request, but prior to an Office action on the merits, is **dismissed as premature**.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 is **dismissed**.

2. The *inter partes* reexamination proceeding is before the examiner for preparation of the first Office action on the merits pursuant to MPEP 2660.

3. Both patent owner and third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

4. Any future correspondence with respect to this *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

5. Any telephone inquiries with regard to this decision should be directed to Lynn M. Kryza, Senior Patent Special Projects Advisor at (571) 272-7722.

Brian E. Hanlon

Brian E. Hanlon, Deputy Director
Office of Patent Legal Administration

February 26, 2008

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.
95/000,317	11/06/2007	D503388	705677-0001	2839

22428 7590 05/12/2008

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
MAY 12 2008
CENTRAL REEXAMINATION UNIT

Foley and Lardner LLP
Suite 500
3000 K Street NW
Washington, DC 20007

(For Patent Owner)

Malcolm K. McGowan
Bingham McCutchen LLP
2020 K Street NW
Washington, DC 20006

(For Third-Party Requester)

In re Ishida
Reexamination Proceeding
Control No. 95/000,317
Request Deposited: November 6, 2007
For: U.S. Design Patent No. D503,388

: DECISION GRANTING
: PETITION
: FOR EXTENSTION OF TIME
: 37 CFR 1.956
:

This is a decision on the April 30, 2008, patent owner "PETITION FOR EXTENSION OF TIME" requesting that the time to submit a response to the office action mailed March 13, 2008 be extended an additional one month.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Design Patent No. D503,388 (hereinafter, the '388 patent), issued to Ishida, on March 29, 2005.

2. On November 6, 2007, a third party deposited a Request for *Inter Partes* Reexamination of the '388 patent. The reexamination proceeding was assigned Control No. 95/000,317 (hereinafter, the '317 proceeding).

3. The reexamination order was granted in the '317 proceeding on March 13, 2008. An office action was attached to the order setting a two-month period for response.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed March 13, 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 April 30, 2008, together with 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.

Petitioner's request for an extension of time is **granted.** An extension of time of one month is considered sufficient.

Accordingly, the time for filing the response is extended for thirty days and therefore the response is due on or before June 13, 2008.

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

CONCLUSION

1. Petitioner's request is granted. The period during which Patent Owner may file a response has been extended to June 13, 2008.

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.

Eric Keasel FOR

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,317	11/06/2007	D503388	705677-0001	2839

22428 7590 05/28/2008

FOLEY AND LARDNER LLP
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MALCOLM K. MCGOWAN
BINGHAM MCCUTCHEN LLP
2020 K STREET, N.W.
WASHINGTON, D.C. 20006

Date:

MAILED

MAY 28 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000317
PATENT NO. : d503388
ART UNIT : 2900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Stephen B. Maebius
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3000 K Street, NW
Suite 500
Washington, DC 20007-5109

(For Patent Owner)

MAILED

MAY 28 2008

CENTRAL REEXAMINATION UNIT

Malcolm K. McGowan
BINGHAM MCCUTCHEN LLP
2020 K Street, NW
Washington, DC 20006-1806

(For *Inter Partes* Requester)

In re Ishida
Reexamination Proceeding
Control No. 95/000,317
Filed: November 6, 2007
For: U.S. Patent No. D503,388

DECISION
DISMISSING
PETITION

This is a decision on the April 11, 2008, patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c) for suspension of the instant *inter partes* reexamination proceeding. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182 because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.182 was charged to patent owner's credit card, as authorized by the patent ownr on page 7 of the instant petition.

The petition is before the Office of Patent Legal Administration for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. D503,388 issued to Ishida on March 29, 2005 (the '388 design patent).

2. On November 6, 2007, a request for *inter partes* reexamination of the sole design claim of the '388 design patent was filed by a third party requester, which proceeding was assigned control no. 95/000,317 (the '317 proceeding).

3. A patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '317 proceeding, was filed on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

4. Reexamination was ordered in the '317 proceeding on February 5, 2008.

5. On February 27, 2008, a Decision was mailed, dismissing the patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, filed on December 7, 2007.

6. On March 13, 2008, a first Office action was mailed, rejecting the sole claim of the '388 design patent.

7. A renewed patent owner PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, was filed on April 11, 2008, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

8. On April 30, 2008, patent owner filed a PETITION UNDER 37 C.F.R. § 1.956, requesting a one month extension of time to file its response to the outstanding Office action.

9. On May 12, 2008, a Decision was mailed, granting the patent owner PETITION UNDER 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the outstanding Office action has been extended accordingly and a response is now due on or before June 13, 2008.

DECISION

The present PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, has been fully considered.

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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:

> 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. § 1.103(a) provides (in part):

> *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months.

37 C.F.R. § 1.182 states (in part):

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

37 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.

The Manual of Patent Examining Procedure (MPEP) § 2686.01 states (in part):

> It may also be desirable in certain situations to suspend one of the proceedings for a short and specified period of time. For example, a suspension of a first reexamination proceeding may be issued to allow time for the decision on the second request. Further, after the second proceeding has been ordered, it may be

desirable to suspend the second proceeding prior to merging, where the first proceeding is presently on appeal before a Federal court to await the court's decision prior to merging. A suspension will only be granted in exceptional (extraordinary) instances because of the statutory requirements that examination proceed with "special dispatch", and the express written approval by the OPLA must be obtained. Suspension will not be granted when there is an outstanding Office action.

II. DISCUSSION

Petitioner indicates that facts have changed since the previously filed PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '317 proceeding, was dismissed as premature on February 27, 2008. In particular, petitioner indicates that trial proceedings in federal district court concluded in the concurrent litigation between petitioner and the real party in interest in the '317 proceeding, Seoul Semiconductor Co., Ltd. (hereinafter "Seoul"), when Seoul's post-trial motions were finally denied on April 8, 2008.[1] Additionally, petitioner indicates that Seoul filed an appeal to the U.S. Court of Appeals for the Federal Circuit on April 10, 2008, seeking review of the district court's findings adverse to Seoul.

Petitioner submits that although a first Office action was mailed in the '317 proceeding on March 13, 2008, Seoul's pending appeal to the Federal Circuit will likely conclude long before the '317 proceeding ends.[2] Thus, petitioner asserts that because trial court proceedings on the validity of the '388 design patent have concluded and Seoul's appeal of the trial court's decision to the U.S. Court of Appeals for the Federal Circuit will lead to a final decision well before the '317 proceeding is concluded, the U.S. Patent and Trademark Office should not frustrate the purpose of the estoppel provision of 35 U.S.C. § 317(b) and should immediately suspend the '317 proceeding under 37 C.F.R. § 1.987.[3]

While there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 C.F.R. § 1.103 provides such a mechanism for requesting a suspension of action in an application. Accordingly, the requirements of 37 C.F.R. § 1.103(a) will be applied analogously to a suspension in a reexamination proceeding. 37 C.F.R. § 1.103(a) provides that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding." Also, MPEP § 2686.01 provides that, for a suspension based upon the existence of a proceeding as to the patent being reexamined other than the reexamination, a "[s]uspension will not be granted when there is an outstanding Office action."

In the present petition, petitioner is requesting suspension of the '317 proceeding based on concurrent litigation as to the '388 design patent; yet, petitioner has not responded to the non-final Office action of March 18, 2008. Thus, because a response to the March 18, 2008 non-final Office action has not been received, the petition is **dismissed**.

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[1] *Nichia Corp. v. Seoul Semiconductor Ltd., et al.*, No. 3:06-00162 MMC (N.D. Cal. filed Jan. 10, 2006).

[2] *See* petition at page 4.

[3] *See* petition at page 1.

III. ADDITIONAL DISCUSSION

In the instant petition, petitioner asserts that the '317 proceeding is now, in all relevant respects, substantially identical to the suspended '093 and '094 *inter partes* reexaminations at issue in *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006) and, therefore, requests that the '317 proceeding be suspended until the U.S. Court of Appeals for the Federal Circuit issues a decision in the co-pending appeal.[4] In asserting that the '317 proceeding is now "squarely aligned" with the '093 and '094 proceedings, petitioner notes that, like the petitioner in the '093 and '094 proceedings, it now renews its petition to suspend after the district court litigation has been appealed.[5]

The fact that all remaining claims had been litigated and on appeal when the renewed petition to suspend was filed in the '093 and '094 proceedings, however, was not the only factor considered in the decision granting the renewed petition to suspend.[6] Rather, the Office considered the relative stages of the concurrent appeal and the reexamination proceedings. As noted by the district court in *Sony*, "the PTO correctly concluded that the two 'races' between the parties were at very different stages: The Federal Circuit appeal was nearing its conclusion, while the PTO's *inter partes* review was just beginning."[7]

While the stage of the '317 proceeding is known (i.e., a first Office action on the merits has been mailed), petitioner has not provided information regarding the stage of the concurrent appeal. Accordingly, should petitioner renew its request for suspension of the '317 proceeding **after responses to the outstanding Office action have been filed**, petitioner should include information regarding the stage of the concurrent appeal (e.g., scheduling information, such as a Notice of Docketing, setting forth some of the deadlines in the appeal) in its request.

Accordingly, the PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, is **dismissed** in view of the outstanding Office action, mailed on March 13, 2008.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

2. The time period for response to the outstanding Office action of March 13, 2008, continues to run. As set forth in the May 12, 2008 decision granting a one-month extension of time, any response to the March 13, 2008 Office action is due on or before June 13, 2008.

---

[4] *See* petition at pages 5-7.
[5] *See* petition at page 5.
[6] *See* the decision entitled "Decision Granting Petitions to Suspend," mailed on November 17, 2005, in reexamination proceeding control no. 95/000,094.
[7] *Sony*. 2006 U.S. Dist. LEXIS 36856, at *19.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await any response to the outstanding Office action of March 13, 2008, or the expiration of the time period for response to the March 13, 2008 Office action.

4. The patent owner and the third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

5. Any future correspondence with respect to this *inter partes* reexamination proceeding 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

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

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

6. 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

May 28, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,317	11/06/2007	D503388	705677-0001	2839

22852 7590 09/29/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2008

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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.
95/000,317	11/06/07	D503388	705677-0001

EXAMINER
ARONOVICH,ADIR

FOLEY AND LARDNER, LLP
3000 K STREET NW
SUITE 500
WASHINGTON, DC 20007-5109

ART UNIT	PAPER
2916	

DATE MAILED:

09/29/08

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

Commissioner for Patents
United States Patent and Trademark Office
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3000 K Street, NW
Suite 500
Washington, DC 20007-5109

(For Patent Owner)

MAILED

SEP 29 2008

CENTRAL REEXAMINATION UNIT

Bruce C. Zotter
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 New York Ave., NW
Washington, DC 20001-4413

(For *Inter Partes* Requester)

In re Ishida :
Reexamination Proceeding : **DECISION**
Control No. 95/000,317 : **DISMISSING**
Filed: November 6, 2007 : **PETITION**
For: U.S. Patent No. D503,388 :

This is a decision on the July 24, 2008 patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c) for suspension of the instant *inter partes* reexamination proceeding. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended. This decision also treats the August 21, 2008 third party requester Petition and Opposition Under 37 C.F.R. § 1.183 in Response to Patent Holder's Petition to Suspend *Inter Partes* Reexamination Proceeding.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the patent owner's petition under 37 C.F.R. § 1.182 was charged to patent owner's credit card, as authorized by the patent owner on page 8 of the patent owner's petition. The petition fee of $400.00 for the requester's petition under 37 C.F.R. § 1.183 has been charged to the third party requester's credit card as authorized on page 5 of the requester's petition.

The proceeding, the patent owner petition, and the third party petition and opposition are before the Office of Patent Legal Administration for consideration.

The patent owner's petition requesting suspension of the reexamination proceeding is **dismissed**, for the reasons set forth below. The third party requester's petition for suspension of the rules to have its opposition remarks considered is **granted**, and such remarks have been considered.

REVIEW OF FACTS

1. U.S. Patent No. D503,388 (the '388 design patent) issued to Ishida on March 29, 2005.

2. A civil litigation involving the '388 design patent commenced on January 10, 2006, captioned *Nichia Corp. v. Seoul Semiconductor Ltd. et al.*, U.S. District Court, Northern District of California, San Francisco Division, Case No. 3:06-00162 MMC.

3. On November 6, 2007, a request for *inter partes* reexamination of the sole design claim of the '388 design patent was filed by a third party requester, Seoul Semiconductor Co., Ltd. (a party to the concurrent civil litigation), which proceeding was assigned control no. 95/000,317 (the '317 proceeding).

4. On November 8, 2007, in the civil litigation, a jury found that Seoul willfully infringed the sole design claim and failed to prove that it is highly probable that the sole design claim is invalid.

5. A patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '317 proceeding, was filed on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

6. Reexamination was ordered in the '317 proceeding on February 5, 2008.

7. On February 27, 2008, a Decision was mailed, dismissing the patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, filed on December 7, 2007, as no final decision had been rendered in the concurrent litigation.

8. On March 13, 2008, a first Office action was mailed, rejecting the sole claim of the '388 design patent.

9. On April 10, 2008, the third party requester Seoul filed an appeal to the U.S. Court of Appeals for the Federal Circuit seeking review of the district court's findings in the concurrent litigation. The Federal Circuit appeal is styled *Nichia Corp. v. Seoul Semiconductor Co., Ltd. et al.*, Appeal No. 2008-1309, -1336, -1380 (hereafter the Federal Circuit appeal).

10. A renewed patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, was filed on April 11, 2008. The renewed petition was accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

11. On April 30, 2008, patent owner filed a Petition Under 37 C.F.R. § 1.956, requesting a one month extension of time to file its response to the outstanding Office action.

12. On May 12, 2008, a Decision was mailed, granting the patent owner Petition Under 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the outstanding Office action was extended accordingly.

13. On May 28, 2008, a Decision was mailed, dismissing the April 11, 2008 patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), because the response to the March 13, 2008 Office action was outstanding.

14. The response to the outstanding March 13, 2008 Office action was filed on June 12, 2008.

15. On July 23, 2008, Seoul filed its principal brief in the Federal Circuit appeal and argued, *inter alia*, that the district court erred by granting summary judgment rejecting Seoul's claim that Nichia's design patents are invalid because of functionality and that the district court erred by refusing to grant JMOL and/or a new trial for Seoul's defense that Nichia's design patents are invalid because their appearance is not a matter of concern. Seoul asked for a new trial.

16. On July 24, 2008, the patent owner filed the subject "Petition to Suspend *Inter Partes* Reexamination Proceeding and for OPLA to Retain Jurisdiction Pending Decision on Suspension," which is being treated as a petition under 37 C.F.R. § 1.182 as explained in the first paragraph of this decision.

17. On August 21, 2008, the third party requester filed the subject "Petition and Opposition Under 37 C.F.R. § 1.183 in Response to Patent Holder's Petition to Suspend *Inter Partes* Reexamination Proceeding," the merits of which are addressed herein.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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:

> 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. § 1.182 states (in part):

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

37 C.F.R. § 1.907 states (in part):

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

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.

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

* * * * *

The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. **317**(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. **317**(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.

In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.

* * * * *

Taking the above into account, 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?

II. DISCUSSION

A. Patent Owner Requests Suspension of the '317 Proceeding

Petitioner asserts that good cause exists to suspend the '317 proceeding for five reasons, including: (1) a reply (response) to the first Office action is no longer outstanding; (2) the '317 proceeding is at its early stages, while the civil litigation is nearing a final disposition; (3) the sole claim of the '388 patent is the subject of both the civil litigation and the '317 proceeding; (4) the third party requester in the '317 proceeding is the same party as the defendant/appellant in the civil litigation; and (5) all of the references relied upon by the third party requester in requesting reexamination were published before and discovered during the civil litigation (before the defendant waived its obviousness defenses prior to trial).

Further as to reason (2), petitioner submits that although a first Office action has been mailed in the '317 proceeding, third party requester's pending appeal to the Federal Circuit will likely conclude long before the '317 proceeding ends. Patent owner argues that the '317 proceeding is squarely aligned with the *inter partes* proceedings that were suspended, which were addressed in *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006). The patent owner therefore requests that this proceeding be suspended until the Federal Circuit issues a final decision in the concurrent appeal proceeding.

Patent owner additionally requests that the jurisdiction over the '317 proceeding be maintained by OPLA for at least 10 days after this decision is mailed to avoid the issuance of conflicting decisions.

B. Third Party Requester Opposed the Patent Owner's Request

As pointed out above, the petition requesting a suspension of the rules to have the opposition remarks considered is granted. The third party requester argues that there is no good cause to suspend this proceeding for three reasons: (1) there is no indication that the patent owner is likely to prevail on appeal; (2) the *inter partes* proceeding concerns an issue that was not considered by

the district court; and (3) as an Office action has been issued in this proceeding, the stage of the proceeding is not analogous to the fact situation in *Sony*.

As to issue (1), the likelihood of the patent owner prevailing on appeal is not a factor that is considered by the Office when determining whether it is appropriate to suspend action in the reexamination proceeding. It is not for the Office to determine how the appeal will be resolved. It is sufficient that the patent owner has already prevailed in the District Court on the merits of the civil action, and such was the situation in *Sony*, where the Office's suspension of the reexamination proceedings was supported by the court.

As to issue (2), the estoppel provisions of 35 U.S.C. § 317(b) apply to issues that the requester or its privies raised *or could have raised* in the civil action. Thus, the fact that this *inter partes* proceeding concerns an issue not considered by the district court is not the proper inquiry. The proper inquiry is whether the requester or its privies raised *or could have raised* the issue. The patent owner asserts that the prior art issues could have been raised in the civil action as the prior art references were known to the third party requester during the discovery phase of the district court action; this patent owner assertion has not been rebutted by the third party requester.

As to issue (3), the distinction between the stage of the prosecution in this proceeding and the stage in the *Sony* action is acknowledged. In this proceeding, the first Office action has issued and a response has been filed. In *Sony*, the proceeding was suspended prior to the issuance of a first Office action on the merits of the patentability of the claims.

C. Analysis and Findings

The factors to be considered in determining whether it is appropriate to terminate action in an *inter partes* proceeding based on litigation in which the third party requester is a party to the litigation are detailed in MPEP 2686.04, subsection V, reproduced above. In this case, the civil litigation and the '317 proceeding both involve the sole claim of the '388 patent. The patent owner has raised the presumption that the prior art issues in the '317 proceeding could have been raised in the civil litigation. This presumption has not been rebutted by the third party requester. There is no concurrent *ex parte* proceeding for the '388 patent.

The above factors indicate that estoppel may attach to the claim in the *inter partes* proceeding; however, the most significant factor is whether a final decision adverse to the requester has been issued. In this case, no final decision has been issued. Even the decision has not yet become final, a *stay or suspension* of a proceeding may be appropriate if (a) all other factors for estoppel attachment are present and (b) the litigation has advanced to a late enough stage that a final decision will be rendered in the near future and there is sufficient probability that a final decision will be adverse to the requester based solely on the prior district court decision (as pointed out, the Office cannot enter into the appeals court's province to try to assess the probability as to which party will win on appeal). In this situation, the Federal Circuit appeal has just commenced, with only the principal brief having been filed to date. Moreover, the question on appeal as to the validity of the '388 patent is whether the district court erred as a matter of law by granting summary judgment that the '388 patent claim is not invalid and by refusing to grant

JMOL and/or a new trial to the defendant (third party requester) on its claim that the '388 patent claim is invalid. The appellant (third party requester) asks that a new trial be ordered.

Thus, the significant facts in this proceeding are:

(1) The '317 proceeding is in active reexamination phase, in which the claim patentability issues have been addressed in the first action, and the proceeding is awaiting examiner action on the response to the Office action; and

(2) The appeal is in the early briefing phase, and a decision is not expected in the near future.

These facts, taken with the rest of the facts and circumstances of this case, do not support a finding of good cause to suspend the '317 proceeding.

The facts in this proceeding are not squarely aligned with the facts in *Sony*. Although all remaining (reexamination proceeding) claims had been litigated and on appeal when the renewed petition to suspend was filed in the proceedings in *Sony,* that was not the only factor considered in the decision granting the renewed petition to suspend. [1] Rather, the Office considered the relative stages of the concurrent appeal and the reexamination proceedings. As noted by the district court in *Sony*, "the PTO correctly concluded that the two 'races' between the parties were at very different stages: The Federal Circuit appeal was nearing its conclusion, while the PTO's *inter partes* review was just beginning." [2] The relative stages in this situation are much closer. In contrast to the *Sony inter partes* reexamination proceedings, which were just at their beginning stages (e.g., the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of patentability), the present reexamination proceeding has advanced significantly beyond the beginning stage. In this instance, the Office has issued a non-final Office action, in response to which the patent owner has filed a patent owner's response. Thus, patentability issues have been defined and argued by parties, and the Office's work in the merged reexamination proceeding has not been limited to merely finding that the requests for reexamination raised a substantial new question of patentability (at which point a patentability determination has not yet been made). On the other hand, the Federal Circuit briefing is just beginning.

Accordingly, good cause for suspension has not been shown, and the Petition under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, is **dismissed**.

As to retaining this proceeding within OPLA's jurisdiction for at least 10 more days, the patent owner's argument is not pertinent. Conflicting decisions cannot be issued, since the examiner does not render decisions for petitions for suspension, but rather will issue an action on the merits of patent owner's June 12, 2008 reply. There is no compelling reason for OPLA to retain jurisdiction over this proceeding for at least 10 more days, as requested by patent owner, since reexamination of the '388 patent must be conducted with special dispatch in accordance with 35

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[1] *See* the decision entitled "Decision Granting Petitions to Suspend," mailed on November 17, 2005, in reexamination proceeding control no. 95/000,094.

[2] *Sony*, 2006 U.S. Dist. LEXIS 36856, at *19.

U.S.C. § 314(c). With the mailing of this decision, jurisdiction is returned to the Central Reexamination Unit in order for the June 12, 2008 response to be properly considered in a manner consistent with the mandate of special dispatch.

CONCLUSION

1. The patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

2. The third party Petition Under 37 C.F.R. § 1.183 is granted for consideration of the opposition arguments.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to continue reexamination and consider patent owner's response filed June 12, 2008.

4. The patent owner and the third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

5. Any future correspondence with respect 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:	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

6. Any questions concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at 571-272-7729.

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

09-26-08
C:\kiva\kenpet7\IP\suspend\95_0317 Supend for Fed Cir appealed case-Dismiss -OA issued+initial briefing stage of appeal

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,317	11/06/2007	D503388	705677-0001	2839

22852 7590 01/13/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,317	11/06/07	D503388	705677-0001

EXAMINER
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ART UNIT	PAPER
2916	

DATE MAILED:
MAILED
JAN 13 2009
CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

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(For Patent Owner)

MAILED

JAN 13 2009

CENTRAL REEXAMINATION UNIT

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Washington, DC 20001-4413

(For Third Party Requester)

In re Ishida
Inter Partes Reexamination Proceeding
Control No. 95/000,317
Filed: November 6, 2007
For: U.S. Patent No. D503,388

: **DECISION**
: **DISMISSING PETITION,**
: ***SUA SPONTE,* SUSPENDING**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the November 5, 2008 patent owner petition under 37 CFR §§ 1.181, 1.182, 1.183, and 1.907, and 35 U.S.C. § 317(b) to terminate the instant *inter partes* reexamination proceeding. The patent owner petition to terminate 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 terminated.*

The petition fee of $400.00 pursuant to 37 CFR § 1.17(f) for the patent owner's petition under 37 CFR § 1.182 was charged to patent owner's credit card, as authorized by the patent owner on page 13 of the patent owner's petition.

The patent owner petition and the instant 95/000,317 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition requesting termination of the reexamination proceeding is dismissed. Furthermore, the decision, *sua sponte*, suspends the examination and prosecution of the instant *inter partes* reexamination proceeding until the circumstances in the parallel litigation warrant termination or resumption of the examination and prosecution.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. D503,388 (the '388 design patent) issued to Ishida on March 29, 2005.

* It is noted that 37 CFR 1.181 is a general rule that is non-specific to reexamination and provides a mechanism to file a petition to terminate an *ultra vires* reexamination order that is not based on prior art patents and printed publications.

2. The '388 design patent is the subject of civil litigation captioned *Nichia Corp. v. Seoul Semiconductor Ltd. et al.*, U.S. District Court, Northern District of California, San Francisco Division, Case No. 3:06-00162 MMC that commenced on January 10, 2006. A copy of the complaint in the litigation is attached to the patent owner petition filed on November 5, 2008 as Exhibit 4.

3. On July 21, 2006, Seoul filed a Second Amended Answer and Amended Counterclaims (Docket No. 119) in Civil Action No. 06-00162 MMC, asserting a counterclaim against Nichia that the sole claim of the '388 patent was invalid under 35 U.S.C. §§ 102, 103, 119, and/or 171 and seeking a declaratory judgment of invalidity of the same. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 5.

4. On August 28, 2006, in response to Seoul's discovery request, Nichia sent to Seoul a document production containing Japanese Patent JP 1077515 (labeled Bates Numbers NC00000913-917), Japanese Patent JP 6-204569 (labeled Bates Numbers NC00002860-2863), Japanese Patent JP 2001-36154 (labeled Bates Numbers NC00002315-2324), and Surface Mount Type LED - Light Emitting Diode, Product Guide, Jan. 2001, 6 pages, Cat. No. 01033K, Nichia Corporation, Japan (labeled Bates Numbers NC00000269-274). A copy of Nichia's cover letter that accompanied the document production of August 28, 2006 is attached to the patent owner petition filed on November 5, 2008 as Exhibit 6.

5. On November 13, 2006, in a Joint Letter Regarding Discovery Disputes ("the 11/13/06 Joint Letter") (Docket No. 148) filed in Civil Action No. 06-00162 MMC, Nichia sought from Seoul certain documents and interrogatory responses relevant to rebutting Seoul's obviousness defense, *id.* at 10, to which Seoul responded by expressly waiving all obviousness defenses against the '388 patent: "Nichia suggests that it needs foreign sales related documents to show commercial success as a rebuttal to Seoul's claim of obviousness. But Seoul is no longer claiming obviousness." *Id.* at 16 (emphasis added). Seoul specifically stated in the 11/13/06 Joint Letter to the district court that its invalidity defenses and counterclaims were limited to "the design patent tests of 'hidden-in-use' and functionality." *Id.* A copy of the letter submitted by Seoul to the district court is attached to the patent owner petition filed on November 5, 2008 as Exhibit 7.

6. On June 29, 2007, Seoul filed an Opposition to Nichia Corporation's Motion for Summary Judgment of Patent Infringement, Validity and Seoul's Equitable Defenses ("Seoul's 06/29/07 Opposition") (Docket No. 484) (Redacted Version) in Civil Action No. 06-00162 MMC. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 8.

7. On August 14, 2007, Magistrate Judge Spero issued a Report and Recommendation ("Magistrate Judge Spero's 08/14/07 Report and Recommendation") (Docket No. 508) in Civil Action No. 06-00162 MMC, granting Nichia's motion to bar Seoul's obviousness defense because Seoul "specifically agreed not to raise the obviousness defense" in the 11/13/06 Joint Letter, on which the Court had relied. Id. at 2-3. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 9.

8. On August 31, 2007, District Judge Chesney issued an Order (Docket No. 723) in Civil Action No. 06-00162 MMC, adopting Magistrate Judge Spero's 08/14/07 Report and Recommendation in toto, and further granting Nichia's motion for summary judgment

against Seoul's claim of obviousness as to the '388 patent. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 11.

9. On November 6, 2007, a request for inter partes reexamination of the sole claim of the '388 design patent was filed by a third party requester, Seoul Semiconductor Co., Ltd. (a party to the concurrent civil litigation), which proceeding was assigned Control no. 95/000,317 (the '317 proceeding).

10. On November 8, 2007, in the civil litigation, a jury found that Seoul willfully infringed the sole design claim and failed to prove that it is highly probable that the sole design claim is invalid. A copy is attached to the patent owner petition filed on November 5, 2008 as Exhibit 13.

11. A patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, requesting suspension of the '317 proceeding, was filed on December 7, 2007, accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

12. Reexamination was ordered in the '317 proceeding on February 5, 2008.

13. On February 7, 2008, the district court entered a Final Judgment against Seoul, finding among other things that the '388 patent was valid. A copy of the Final Judgment is attached patent owner petition filed on November 5, 2008 as Exhibit 14.

14. On February 27, 2008, a Decision was mailed, dismissing the patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987, filed on December 7, 2007, as no final decision had been rendered in the concurrent litigation.

15. On March 13, 2008, a first Office action was mailed, rejecting the sole claim of the '388 design patent.

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17. A renewed patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, was filed on April 11, 2008. The renewed petition was accompanied by a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985.

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19. On May 12, 2008, a Decision was mailed, granting the patent owner petition under 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the outstanding Office action was extended accordingly.

20. On May 28, 2008, a Decision was mailed, dismissing the April 11, 2008 patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), because the response to the March 13, 2008 Office action was outstanding.

21. The response to the outstanding March 13, 2008 Office action was filed on June 12, 2008.

22. On July 23, 2008, Seoul filed its principal brief in the Federal Circuit appeal and argued, *inter alia*, that the district court erred by granting summary judgment rejecting Seoul's claim that Nichia's design patents are invalid because of functionality and that the district court erred by refusing to grant JMOL and/or a new trial for Seoul's defense that Nichia's design patents are invalid because their appearance is not a matter of concern. Seoul asked for a new trial.

23. On July 24, 2008, the patent owner filed the subject "Petition to Suspend *Inter Partes* Reexamination Proceeding and for OPLA to Retain Jurisdiction Pending Decision on Suspension," which was treated as a petition under 37 CFR § 1.182.

24. On August 21, 2008, the third party requester filed the subject "Petition and Opposition under 37 C.F.R. § 1.183 in Response to Patent Holder's Petition to Suspend *Inter Partes* Reexamination Proceeding."

25. On September 29, 2008, a Decision was mailed, dismissing the July 24, 2008 patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '317 proceeding, and granting the August 21, 2008 third party requester petition under 37 CFR § 1.183 for consideration of the opposition arguments.

26. On November 5, 2008, the patent owner filed the present petition under 37 CFR §§ 1.181, 1.182, 1.183, and 1.907, and 35 U.S.C. § 317(b) to terminate the instant *inter partes* reexamination proceeding.

27. On December 17, 2008, the patent owner filed a Notice of concurrent proceeding(s) pursuant to 37 C.F.R. § 1.985. The Notice states that the Brief of Plaintiff-Cross Appellant Nichia Corporation was filed on October 2, 2008 in the Federal Circuit appeal and that no decision has been rendered yet by the Court of Appeals for the Federal Circuit.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 171 states:

> Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
> The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. § 282 states in pertinent part:

> A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other

claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1)Noninfringement, absence of liability for infringement, or unenforceability,
(2)Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,
(3)Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,
(4)Any other fact or act made a defense by this title.

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:

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 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.

37 CFR § 1.937(a) states:

All inter partes reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless

the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR § 1.987 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.

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

> *****
>
> The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.
>
> In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.
>
> *****
>
> Taking the above into account, 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?

II. DISCUSSION

A. Patent Owner Requests Termination of the '317 Proceeding

Petitioner asserts that the instant *inter partes* reexamination proceeding should be terminated by the Office because the third party requester, Seoul Semiconductor Co., Ltd. ("Seoul"), is estopped from maintaining the proceeding under 35 U.S.C. § 317(b) now that there is a final decision in the parallel litigation as to the issues that could have been raised between the parallel litigation and the instant reexamination proceeding. Petitioner concludes that there is now a final decision because (1) there are "final" adverse rulings from the parallel district court litigation against Seoul's obviousness defenses to the '388 patent (see pages 5-6 of the instant petition), (2) Seoul has not pursued an appeal of the adverse obviousness rulings made by the district court, and thus these rulings are now "final", and (3) the exceptions to the estoppel provisions do not apply in this reexamination.

Petitioner asserts that all issues involved in this reexamination proceeding have been finally resolved in the federal courts and that the only remaining invalidity issues before the Federal Circuit (i.e., ornamentality and functionality) are not presently before the USPTO in this reexamination proceeding, i.e., the present reexamination proceeding is based solely on obviousness (see page 9 and footnote 6 of the instant petition).

Petitioner also argues that the exceptions to the estoppel provisions that are stated in 35 U.S.C. § 317(b) do not apply in this case since Seoul could have raised in the prior district court litigation every grounds for obviousness asserted in the present reexamination. Each reference relied upon in Seoul's reexamination request for the '388 patents was both published prior to the district court litigation and specifically disclosed to Seoul while Seoul still had ample opportunity to raise these references in the district court litigation (see page 10 of present petition).

B. Analysis and Findings

I. Termination of the '317 Reexamination Proceeding is Not Required by 35 U.S.C. § 317(b)

The factors to be considered in determining whether it is appropriate to either suspend or terminate action in an *inter partes* proceeding based on litigation in which the third party requester is a party to the litigation are detailed in MPEP § 2686.04, subsection V, reproduced above. In this case, the civil litigation and the '317 proceeding both involve the sole claim of the '388 design patent. It is noted that the Seoul's obviousness defense in the district court litigation was based in part upon different prior art (see footnote 5 on page 9 of instant petition). Seoul's obviousness defense was barred as untimely in the district court litigation (see order issued by District Judge Chesney on August 31, 2007 attached as Exhibit 11 to the instant petition). The patent owner has asserted that the patentability issues based upon the prior art in the '317 proceeding could have been raised in the civil litigation. This argument has not been rebutted by the third party requester. There is no concurrent *ex parte* proceeding for the '388 patent.

The above factors indicate that while the estoppel provisions of 35 U.S.C. § 317(b) may ultimately operate so as to preclude the Office from maintaining the '317 *inter partes*

proceeding, at the present time there is no final nonappealable decision adverse to the requester that has been issued in the litigation. Stated differently, because the litigation is presently involved in a pending appeal at the Federal Circuit, the Office disagrees with the petitioner's assertion that there is presently a decision in the parallel litigation that constitutes a "final decision" for purposes of triggering the estoppel provisions of 35 U.S.C. § 317(b). For reasons discussed in the immediately succeeding paragraphs, it is not impossible that a decision from the Federal Circuit may remand the litigation to the district court with instructions to include prior art based patentability issues in the remanded litigation.

35 U.S.C. § 317(b) does not limit the invalidity or patentability of any claim to the issue of obviousness based on prior art publications. 35 U.S.C. § 282 states that invalidity of the patent or any claim in suit on any ground is specified in part II of Title 35 of the United States Code as a condition for patentability. The question on appeal to the Federal Circuit as to the validity of the '388 design patent is whether the district court erred as a matter of law by granting summary judgment rejecting Seoul's claim that '388 design patent is invalid because of functionality and that the district court erred by refusing to grant JMOL and/or a new trial for Seoul's defense that '388 design patent is invalid because the appearance is not a matter of concern. The appellant (third party requester) has requested that a new trial be ordered.

Thus, the district court decision in the litigation which is still pending on appeal is not a final decision that inevitably precludes consideration of prior patent/printed publication based assertions of claim invalidity. A final decision has not been rendered regarding whether the sole claim of the '388 is invalid because of functionality. A design claim that is primarily functional is rejected under 35 U.S.C. § 171 for lack of ornamentality. That section of the statute is specified in part II of Title 35 of the United States Code. See MPEP §1504.01(c) under the heading "I. FUNCTIONALITY VS. ORNAMENTALITY". Therefore, a final decision within the meaning of 35 U.S.C. § 317(b) has not been made regarding the invalidity or patentability of the sole design claim in the '388 patent.

II. Suspension of the '317 Reexamination Proceeding is Appropriate

Even if the decision has not yet become final, a *stay or suspension* of a proceeding may be appropriate if (a) all other factors for estoppel attachment are present, (b) the litigation has advanced to a late enough stage that a final decision will be rendered in the near future and (c) there is sufficient probability that a final decision will be adverse to the requester based solely on the prior district court decision (as pointed out in the previous September 29, 2008 Office Decision, the Office cannot enter into the appeals court's province to try to assess the probability as to which party will prevail on appeal). In this situation, the Federal Circuit appeal has advanced since the last Office Decision mailed on September 29, 2008 for the instant *inter partes* reexamination proceeding. A plaintiff-cross appellant brief has been filed on October 2, 2008 by the patent owner and a reply brief by third party requester has been filed on December 15, 2008 (docket information for the concurrent litigation obtained from LexisNexis Courtlink on December 17, 2008). The third party requester filed its principal brief on July 23, 2008.

The significant facts in this proceeding are:

(1) The '317 proceeding is in the early reexamination phase (a patent owner response has been filed on June 12, 2008 in response to a first non-final office action), and

(2) The Federal Circuit appeal has progressed with both parties having filed their principal appeal briefs.

The facts in this proceeding now closely parallel the facts in *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006). In *Sony*, "the PTO also concluded that because the Federal Circuit appeal was far advanced in comparison to the reexamination proceedings, which had only recently been commenced, there was ample good cause to suspend the reexamination proceedings pending completion of the Federal Circuit appeal. Good cause, the PTO noted, was supported by the statutory estoppel that would operate after completion of the Federal Circuit appeal. *See* 35 U.S.C. § 317(b)." (Sony, 2006 U.S. Dist. LEXIS 36856, at *7). As in *Sony*, "[i]t is not in the [PTO's] and the parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation [in the Federal Circuit] which is soon to be finally resolved. That is particularly true here where the administrative proceedings have only just begun." *Id.*

The Office has discretion pursuant to 35 U.S.C. § 314(c) to suspend the instant *inter partes* reexamination proceeding in the interest of conserving Office resources and where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 USC § 317(b).

The Office recognizes that upon completion of the appellate process in the Federal Circuit pertaining to the sole litigated claim, there are only two possible outcomes for the instant *inter partes* reexamination proceeding: (a) the sole design claim is found valid or invalid because of functionality, and the reexamination proceeding in either case would be moot or (b) the district court's decision on claim validity is reversed or vacated, with a remand to grant the third party requester a new trial, and the reexamination proceeding may continue or resume if the proceeding has been suspended.

As discussed in MPEP § 2686.04, the issuance of a final Court decision after all appeals (in a civil action arising in whole or in part under 28 U.S.C. § 1388) upholding validity during an *inter partes* reexamination, where the person who filed the request was a party to the litigation will have the effect that the Office will discontinue examination of all claims affected by the holding of validity for issues raised or could have been raised as to the claims asserted by the patent owner and challenged by the third party requester. If the provisions of 37 CFR § 1.907(b) apply, then the reexamination proceeding must be terminated. A final Court holding of invalidity is binding on the Office and if all claims being examined are finally held invalid, the reexamination proceeding must be terminated.

These facts, taken with the rest of the facts and circumstances of this case, support a finding of good cause pursuant to 35 U.S.C. § 314(c) and 37 CFR § 1.937(a) to suspend the '317 proceeding.

CONCLUSION

1. The patent owner petition under 37 CFR §§ 1.181, 1.182, 1.183, and 1.907, and 35 U.S.C. § 317(b) is dismissed.

2. The instant *inter partes* reexamination proceeding is suspended, *sua sponte*, until the there is a final, nonappealable decision in the civil litigation regarding the validity of the claim in the '388 patent.

3. The patent owner in the '317 *inter partes* reexamination proceeding is respectfully reminded of its continuing duty pursuant to 37 CFR § 1.985 to keep the Office apprised of the progress of the appeal in the concurrent litigation, and to notify the Office when that appeal has been resolved and may no longer be appealed.

4. **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.

5. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711, or, in her absence, to the undersigned at 571-272-7710.

Robert A. Clarke

Robert A. Clarke
Director
Office of Patent Legal Administration

INCOMING DOCUMENT INDEX SHEET

☐ 136A_____
Preauthorization to have fees charged to Dep Acct

☐ A..._____
Response after Non-Final Action

☐ A..._____
Informal/Nonresponsive Amendment after Exr Action

☐ A.NE_____
Response-Not Entered

☐ A.PE_____
Pre-Examination Amd

☐ A.QU_____
Response after *ex parte* Quayle

☐ AF/D_____
Affidavits/Dec/ Exhibits

☐ C.AD_____
Corr Address change (patent owner)

☐ COFC_____
Cert of Correction

☐ DISQ_____
Term Disclaimer filed

☐ EABN_____
Request to terminate Reexam

☐ IDS_____
Info.Discl Statement filed

☐ M865_____
Request for Exr Interview filed

☐ N/AP_____
Notice of Appeal filed

☐ NDRW_____
New/Addtl Drawing Filed

☐ PA..._____
Chg in POA

☐ SA..._____
Suppl. Response after non-final Rej

☐ SAFR_____
Suppl. Amd after Final Rej

☐ RXAF/DR_____
Reexam AF/D Filed by 3rd Pty

☐ RXPET._____
Receipt of Pet in Reexam

☐ RXRQ4FP_____
Reexam Req for Foreign Priority

☐ RXAPBI _____
Reexam Defective Brief Filed

☐ RXRPET_____
Pet for Review of Reexam Denial

☐ RXRQMP_____
Req to Merge Reexam

☐ RXC.ADR_____
Reexam Correspondence Address Change for 3rd Pty Requestor

☐ RXRQ/T_____
Reexam Req for Ext of Time

☐ RXRQS._____
Req to Lift Suspension of Prosc

☐ RXC/M. _____
Reexam Certificate of Mailing

☐ RXNOCA_____
Reexam Notice of Court Action

☐ RXNOCP_____
Notice of concurrent proceeding

☐ RXC/SR _____
Reexam Certificate of Service

☐ RXAAF,_____
Reexam Response to Final Rej

☐ RXFEE_____
Reexam Fee Payment Only

☐ RXPA..R _____
Reexam Chg in POA for 3rd pty Requestor

☐ RXLET. _____
Reexam Misc Incoming Letter

☐ RXOR.U _____
Reexam Untimely Patent Owner's Statement in Response to Order

☐ RXRR.T _____
Reexam Timely Requestor's Reply in Response to Owner's Stmt

☐ RXRR.U_____
Reexam Untimely Requestor Reply To an Owner's Statement

✓ PETDEC

Document Date: 2.5.08

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

FEB 05 2008

CENTRAL REEXAMINATION UNIT

THELEN REID BROWN RAYSMAN & STEINER LLP
P.O. BOX 1510
NEW YORK, NY 10150-1510

In re Application of	:	
GLOWNY, et al.	:	
Control No. 95/000,321 (U.S. Patent 6,785,370)	:	DECISION ON PETITION
Filed: November 21, 2007	:	TO WITHDRAW
Attorney Docket No. V1100.0034	:	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 January 22, 2008.

The request is **NOT APPROVED** as **MOOT**.

A review of the file record indicates that the power of attorney to THELEN REID BROWN RAYSMAN & STEINER LLP has been revoked by the assignee of the patent application on January 16, 2008. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the first copied address below until otherwise notified by applicant.

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

Patricia Volpe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK NY 10008-0770

cc: DICKSTEIN SHAPIRO LLP (Third Party Requester)
1177 AVENUE OF THE AMERICAS
(6TH AVENUE)
NEW YORK, NY 10036-2714

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.
95/000,321	11/21/2007	6,785,370	V1100.0034	9067

76808 7590 03/27/2009

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

EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
03/27/2009	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michael J. Scheer
Dickstein Shapiro LLP
1177 Avenue of the Americas (6th Ave)
New York, NY 10036-2714

Date:
MAILED
MAR 27 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000321
PATENT NO. : 6785370
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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Leason Ellis LLP
81 Main Street
Suite 100
White Plains, NY 10601

(For Patent Owner)

Dickstein Shapiro LLP
1177 Avenue of the Americas
New York, NY 10036-2714

(For Third Party Requester)

MAILED

MAR 2 7 2009

CENTRAL REEXAMINATION UNIT

In re Nice Systems Inc. :
Inter Partes Reexamination Proceeding : DECISION
Control No.: 95/000,321 : DENYING
Filed: 11/21/2007 : PETITION
For: U.S. Patent No. 6,785,370 :

This is a decision on the third party requester petition entitled "PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.927 TO REVIEW THE ORDER DENYING REQUEST FOR *INTER PARTES* REEXAMINATION" filed on March 10, 2008. The petitions and *inter partes* reexamination control number 95/000123 are before the Director of the Central Reexamination Unit for consideration.

Summary: The third party requester petition is denied. The decision is final and nonappealable.

REVIEW OF FACTS

1. U.S. Patent No. 6,785,370 ("the '370 patent") issued to David A. Glowny et al. on August 31, 2004, and is currently assigned to Nice Systems, Inc.

2. A request for *inter partes* reexamination of the '370 patent was filed by a third party requester on November 21, 2007 and was assigned Control Number 95/000,321 ("the Request"). Reexamination was requested for claims 1-28 (i.e. all of the claims) of the '370 patent.

3. On February 8. 2008, an order denying the request *inter partes* reexamination of the '370 patent ("the Order") was mailed by the Office.

4. On March 10, 2008, the present third party requester petition ("the Petition") was filed.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("petitioner") in the '321 reexamination proceeding has petitioned seeking relief from the examiner's February 28, 2008 Order denying *inter partes* reexamination.

35 U.S.C. § 312(c) provides:

> A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

37 CFR § 1.927 provides:

> The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order inter partes reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable. [Emphasis added.]

MPEP § 2648 provides, in pertinent part:

> If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be de novo. Each decision by the CRU Director will conclude with the following paragraph:
>
> "This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position as presented in the instant petition, has been made as to whether the November 21, 2007 request for *inter partes* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '370 patent filed in the '321 proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. Examiner's Basis for Finding that the Request for Reexamination Did Not Raise an SNQ

The examiner's decision to deny the request for reexamination was based on a determination that the request for reexamination did not establish a SNQ because:

> (a) The Request relies on the teachings of U.S. Patents 5,559,875 and 6,314,089 in combination with various secondary references. (Order, page 2)

(b) The prosecution history of the '370 patent includes reasons for allowance that point to claim features lacking in the prior art, especially U.S. Patent 5,533,103, cited in the prosecution of the '370 patent. (Order, page 4)

(c) The teachings of U.S. Patents 5,559,875 and 6,314,089 do not show the features identified as missing from U.S. patent 5,533,103. As such, a reasonable examiner would not have considered these references important in making a decision as to the patentability of claims 1-28 of the '370 patent. (Order, pages 5-10)

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

Petitioner takes the position that the Request must be deemed to raise a substantial new question of patentability because:

(a) The Order did not address U.S. Patents 5,048,079 and 5,982,857, each of which was cited in the Request and allegedly raises a substantial new question of patentability. (Petition, page 3)

(b) The Order allegedly applied the wrong legal standard in determining whether to grant the Request. (Petition, page 5) In particular, the Petition alleges that a reasonable examiner would have considered each of U.S. patents 5,559,875 and 6,314,089 important if it teaches any of the elements identified as lacking in the reasons for allowance given in the '370 patent.

(c) Each of U.S. Patents 5,559,875 and 6,314,089 allegedly disclose all of the elements that were indicated as missing in the notice of allowability of the '370 patent and therefore would have been important to a reasonable examiner in determining the patentability of Claims 1-28 of the '370 patent. (Petition, pages 7-13)

Each of these arguments will be addressed in turn.

(a) The Order did not address U.S. Patents 5,048,079 and 5,982,857

The Request cites four U.S. patents. Of these, the '875 and '089 patents are proffered as anticipatory references (Request, heading VI, Subheadings A, B, H, J, K, N, O, P, V, W, X, Y, AA, BB, CC, GG, HH, JJ, and KK) and the '079 and '857 references are proffered as references that, as secondary references in combination with at least one of the '875 and '089 patents, render some of the claims obvious (Request, heading VI, subheadings C, D, E, F, G, I, L, M, Q, R, S, T, U, Z, DD, EE, FF, and II). The Petition states on page 4 that a reasonable examiner would consider the '079 and '857 references important in deciding whether or not a claim of the '370 patent is patentable and that the same question of patentability has not been decided in a previous examination. The Petition, however, fails to explicitly state what is the new, non-cumulative technical teaching presented by these references that a reasonable examiner would consider important in evaluating the patentability of the claims of the '370 patent.

Nevertheless, for completeness of the record, the '079 reference would not have been important to a reasonable examiner in determining the patentability of a claim. The petitioner asserted the '079 reference as a secondary reference in a proposed 35 USC 103 rejection of Claims 1,13, 24, 27 and 28. The request, however, primarily relies upon the teachings of the primary reference (the '875 patent) in order to raise a SNQ for certain claims. (Request, page 2) The petitioner asserted the same primary '875 reference by itself raises a SNQ for certain claims. The '875 primary reference was determined by the examiner to be cumulative to prior art previously

considered by the Office, thus failing to raise a SNQ for any claim. (Order, page 6 and 7) Assuming *arguendo* that the '079 reference does show the matching step of Claim 1 as identified on page 16 of the petition, the '079 does not show the remaining claim elements identified in section III(c), below. Accordingly, the '079 reference in combination with the '875 reference as described on pages 16, 38, 48, 57 and 67 of the request would not have been important to a reasonable examiner in deciding the patentability of a claim.

For similar reasons, the '857 reference would not have been important to a reasonable examiner in determining the patentability of a claim. The petitioner asserted the '857 reference as a secondary reference, which relies upon the teachings of the cumulative, primary reference (the '875 patent) in order to raise a SNQ. (Request, page 2) Moreover, the '857 reference was only applied in a proposed combination against dependent claims. To the extent that the '857 reference was not alleged to raise a substantial new question about the patentability of the independent claims, and no substantial new question of patentability with respect to the independent claims has been raised, the '857 reference would not have been important to a reasonable examiner in determining the patentability of a claim.

(b) The Order allegedly applied the wrong legal standard

The Petition, at pages 5-7, discusses the legal standard applied by the examiner in deciding if the cited references raise a substantial new question of patentability. The criteria for determining if a substantial new question of patentability exists in an inter partes proceeding is set forth in MPEP 2642.

> MPEP 2642 Criteria for Deciding Request
>
> I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY
> The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.
>
> ...
>
> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications to be merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.

The Petition maintains that a substantial new question is necessarily raised "...if the '875 reference or the '089 reference teaches the matching limitation, the updating limitation, or the combining limitation." The Petition states that, in this case, a reasonable examiner would consider the teachings important, and not cumulative. (Petition, page 7)

In the context of this proceeding, "a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable" is neither synonymous with "non-cumulative" nor "prima facie case of unpatentability." By statute, Congress has required that reexamination be ordered only where there is a "substantial new question of patentability," thus balancing the need to reexamine patents where other patents or printed publications raise questions of patentability with the need to protect patent owners from harassment.

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

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. Accordingly, MPEP 2616 states "[i]t is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested."

If the request for reexamination fails to raise a substantial new question of patentability for at least one claim, the request will be denied. MPEP 2647 sets guidelines for denying the request when the request does not raise a substantial new question of patentability. One reason for denying the request is that the reference is cumulative to the teachings of the art cited in the earlier concluded examination of the patent. Another reason is that, even though the reference is available against the claims and it is not cumulative, the additional teaching of the reference would not be important to a reasonable examiner in deciding whether any claim (of the patent for which reexamination is requested) is patentable.

As explained in the order denying reexamination and in section (c) below, the request failed to raise a substantial new question because the references fail to provide any new technical teaching that would be important to a reasonable examiner in deciding whether any claim is patentable. As explained in further detail in section (c) below, the references fail to teach the claim limitations that were recognized as not being taught by the prior art of record in the prior examinations. Therefore, the teachings of the references cited in the request would not be important to a reasonable examiner in determining the patentability for any of the claims of the '370 patent. Accordingly, the request for reexamination was properly denied.

---

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

(c) Each of U.S. Patents 5,559,875 and 6,314,089 allegedly disclose all of the elements that were indicated as missing in the notice of allowability of the '370 patent

Each of the '875 and '089 patents fail to disclose elements that were indicated as missing from the prior art of record in the notice of allowability of the '370 patent.

Claim elements indicated as missing from the '875 and '089 patents include matching the received telephony event with a constructed call record, updating the matching call record, and combining the updated call record with other data. (Order, page 4) Petitioner admits that said patents fail to explicitly teach said matching and updating claim elements. (Request, page 11 and 15)

To cure this lack of explicit disclosure, petitioner alleges each of the '875 and '089 patents inherently teach said matching and updating claim elements. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference...Inherency, however, may not be established may probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). See also MPEP 2112.IV. The '875 patent teaches entering new data, such as " bookmark information," into the call record, which fails to inherently teach matching the new data to data in the call record. (Order, page 5). Specifically, the examiner stated "[m]atching...is not a necessary outcome....the new data could be entered into a predetermined location in the call record, thus requiring no matching at all contrary to the requester's inherency argument." (Order, page 5). Petitioner responds on page 8 of the Petition that "current audio data file control block is marked with the bookmark, thereby matching the DTMF code [received telephony event] with the data structure," which is not a "predetermined" location. This argument is unpersuasive however because the current file location is known (predetermined) prior to adding data, otherwise the system would not know where in the file to add the data. Even assuming *arguendo* the current location is not predetermined; adding data to the current file location fails to inherently require matching the new data to any data at the current location in the call record. Simply co-locating the telephony event with the current call record, without more, is not inherently "matching" the two together, which is required by the claim language. Regarding the '089 patent, petitioner argues on page 11 of the Petition that data is added "dynamically" at an unknown time, thus the location in the call record (i.e., CCO) cannot be predetermined. This argument is unpersuasive however because the information can simply be added to either the current location of the file, which as discussed above is a known (predetermined) location, or at the end of the file, which is also a known (predetermined) location. Even assuming *arguendo* such locations are not predetermined, adding new data to either of these locations fail to inherently require matching the new data to data at the current location in the call record.

Thus, each of the '875 and '089 patents fail to teach the "matching" claim element. Without this "matching" element, said prior art patents must also fail to teach other claim elements, such as updating the matching call record and combining said updated call record with other data.

The remaining claim elements indicated as missing in the notice of allowability are constructing and maintaining representations of the lifetime of a telephone call. (Order, page 4). The "lifetime of the telephone call" is part a "master call record" comprising "data indicating the location of recorded audio data for the segment of the call," where "each segment" is "recorded on one or more recorders." (Claim 1 of the '370 patent). The '875 and '089 patents fail to teach these claim elements. Rather, said patents teach a substantially different structural, but

conventional, arrangement where multiple voice signals from different telephone call segments are summed together and then recorded. (Order, pages 7, 8 and 10). Thus, the location of the recorded audio data fails to correspond to any particular call segment. The prior art patents fail to teach, or even contemplate, constructing and maintaining representations of the lifetime of the telephone call.

Accordingly, the '875 and '089 patents, taken alone or in combination with the '079 or '857 patents, would not have been important to a reasonable examiner in determining the patentability of the claims of the '370 patent and thus do not raise a substantial new question of patentability.

The *de novo* review on the record of the request for reexamination in the '321 reexamination proceeding, undertaken in light of the arguments presented in the Petition compels the conclusion that the request for reexamination in the '321 reexamination proceeding did not raise a SNQ with respect to the claims of the '370 patent for which reexamination was requested.

CONCLUSION

1. The third party requester petition filed on March 10, 2008 is denied.

2. This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

3. Telephone inquiries related to the present decision may be directed to the undersigned, at 571-272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

THELEN REID BROWN RAYSMAN & STEINER LLP
P.O. BOX 1510
NEW YORK, NY 10150-1510

In re Application of :
GLOWNY, et al. :
Control No. 95/000,322 (U.S. Patent 6,728,345) : DECISION ON PETITION
Filed: November 21, 2007 : TO WITHDRAW
Attorney Docket No. V1100.0036 : 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 January 22, 2008.

The request is **NOT APPROVED** as **MOOT**.

A review of the file record indicates that the power of attorney to THELEN REID BROWN RAYSMAN & STEINER LLP has been revoked by the assignee of the patent application on January 16, 2008. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the first copied address below until otherwise notified by applicant.

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

Patricia Volpe for
Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: DARBY & DARBY P.C.
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cc: DICKSTEIN SHAPIRO LLP (Third Party Requester)
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,324	02/08/2008	6,857,001	112056-0501RX	8186

24267 7590 07/08/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RONALD L. YIN
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2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:

MAILED

JUL 0 8 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000324
PATENT NO. : 6857001
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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CESARI AND MCKENNA, LLP : (For Patent Owner)
88 BLACK FALCON AVENUE :
BOSTON MA 02210 :

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JUL 0 8 2010

CENTRAL REEXAMINATION UNIT

DLA PIPER LLP (US) : (For Third Party
2000 UNIVERSITY AVENUE : Requester)
EAST PALO ALTO, CA 94303-2248 :

In re: Hitz *et alia* : DECISION
Inter Partes Reexamination Proceeding : DISMISSING
Control No. 95/000,324 : PETITION
Deposited: 08 February 2008 : 37 CFR §§ 1.181, 1.182 & 1.983
For: US Patent No. 6,857,001 B2 :

This is a decision on the patent owner's petition dated 22 June 2010, which is entitled "Petition Pursuant to 37 CFR § 1.181, or Alternatively 37 CFR § 1.182, or Alternatively 37 CFR § 1.183 to Waive or Suspend the Page and Word Count Limitations of 37 CFR § 1.943"" requesting that the Office waive or suspend the page count requirement for the patent owner's Appeal Brief.

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. 6,857,001 B2 issued on 15 February 2005.
- A request for *inter partes* reexamination was filed concerning the '7001 patent and assigned control no. 95/000,324 on 08 February 2008.
- *Inter partes* reexamination was ordered in the above named proceeding.
- On 04 April 2008 a non-Final Office action was mailed, the proceeding advanced prosecution through the Right of Appeal Notice mailed 11 March 2010.
- The patent owner filed a Notice of Appeal on 09 April 2010.
- On 22 June 2010 the instant petition submitted by the patent owner was filed pursuant to 37 CFR §§ 1.181, 1.182 & 1.183 seeking to waive or suspend the page and word count limitations of 37 CFR § 1.943. The patent owner's brief was filed concurrently with the instant petition.

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. Petitions to waive or suspend page and word count limitations of 37 CFR § 1.943 are typically handled by the Office of Patent Legal Administration.

CONCLUSION

1. The petition dated 22 June 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

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CENTRAL REEXAMINATION UNIT

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(For Requester)

Mark H. Remus
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In re Nelson et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,326	:	FOR REOPENING
Filed: December 4, 2007	:	PROSECUTION
For: U.S. Patent No.: 7,214,017	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on March 17, 2009. The petition is entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181 TO REOPEN PROSECUTION," 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 March 9, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated March 17, 2009 is granted with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,326.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,214,017 (hereinafter, the '017 patent) issued on May 8, 2007.

2. A request for *inter partes* reexamination, assigned control No. 95/000,326, was filed by a third party requester on December 4, 2007.

3. *Inter partes* reexamination was ordered for the '326 reexamination proceeding on February 27, 2008. On the same day, a non-final Office action was mailed in the '326 reexamination proceeding.

4. The patent owner filed a response to the non-final Office action on April 28, 2008.[1] The response filed on April 28, 2008 was not compliant with amendment rules and practices in reexamination proceedings. On May 6, 2008, the patent owner filed a compliant amendment, which proposed to amended patent claims 1, 4, 5, 6, 10, 11, and 12, cancelled claims 8, 9, and 13-15, and add new claims 16-93. The response also included declarations filed under 37 CFR 1.131 to antedate the Smith reference applied in the rejections in the February 27, 2008 Office action.

5. The third party filed comments on May 27, 2008 to the patent owner's response, and introduced additional prior art.

6. On March 9, 2009, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP withdrew all the rejections set forth in the first Office action and made two new grounds of rejection, one under 35 U.S.C. 112 and one under 35 U.S.C. 103 based, in part, on some of the additional prior art cited in the information disclosure statement of May 27, 2008.

7. On March 17, 2009, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that prosecution be reopened. The patent owner also filed a petition requesting a two-month extension of time for response.

8. On April 7, 2009, a decision granting the two-month extension of time was mailed.

---

[1] April 27, 2008 was a Sunday. Therefore, filing the paper on April 28, 2008 was timely.

9. The third party request did not filed comments on patent owner's petition that prosecution be reopened.

DECISION

The patent owner (petitioner) states that the ACP dated March 9, 2009 "prematurely" cuts off prosecution, because the amendment to claim 10 did not necessitate the new grounds of rejection. Patent owner states that the amendment to claim 10 rewrote the dependent claim into independent format by including the limitations of claims 8 and 9, from which patent claim 10 depends. Therefore, patent owner argues that there was no substance change from the original scope of patent claim 10, and accordingly, the amendment did not necessitate the new grounds 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 public policy and Office procedures support the patent owner's position that the ACP was prematurely issued and cites to MPEP 2671.02 and 37 CFR 1.949 for support. Because of these grounds, petitioner requests that prosecution be reopened.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds there are good and sufficient reasons to do so for the reasons set forth below, and for the reasons set forth by the patent owner in the petition.

Turning to the facts in this proceeding, patent owner is correct that the amendment to claim 10 did not change the scope of the claim because the amendment did simply put claim 10 in independent format by including all the limitations of patent claims 8 and 9. Therefore, the amendment of May 6, 2008 cannot fairly be said to have necessitated the new grounds of rejection. The examiner applied two references, cited by the third party request in an information disclosure statement dated May 27, 2008. It appears that this additional citation of prior art may have necessitated the new ground of rejection under 35 USC 103(a). Office rules and procedures, however, only allow making an Office action that includes a new ground of rejection an Action Closing Prosecution if an amendment necessitated the new ground(s) of rejection.

Specifically, 37 CFR 1.949 states:

> Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and

> determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, ***unless the new ground was necessitated by an amendment***. [emphasis added].

Therefore, the examiner prematurely closed prosecution because the amendment itself does not appear to have necessitated the new ground of rejection under 35 USC 103(a), in accordance with 37 CFR 1.949. See also MPEP 2671.01 for more information.

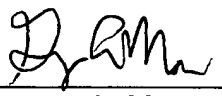
Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have been provided and the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is granted.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated March 9, 2009 and reopening of prosecution of the '326 reexamination proceeding is **granted**.

2. The Office action, dated March 9, 2009, is hereby **vacated** and the examiner will issue a **non-final** Office action, in due course, to replace the March 9, 2009 Office action.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,327	12/11/2007	7281842	24122-00084	2447

57600 7590 03/02/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,327	12/11/2007	7281842	24122-00084	2447

57600 7590 03/02/2010

EXAMINER	

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CLEVELAND, OH 44114-2653

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2010

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

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(For Patent Owner)

HOLLAND & HART LLP
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60 E. SOUTH TEMPLE, SUITE 2000
SALT LAKE CITY, UT 84110

MAILED

MAR 02 2010

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

RISTO PRIBISICH
MCDONALD HOPKINS LLC
600 SUPERIOR AVENUE, EAST, SUITE 2100
CLEVELAND, OH 44114-2653

In re Thomas D. Dickson, Jr.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,327	:	PETITIONS UNDER
Filed: December 11, 2007	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 7,281,842	:	

The third party Requester filed a paper on March 11, 2008, entitled "Petition Under 37 C.F.R. §§ 1.181 and 1.927 For Review of the March 3, 2008 Determination Refusing To Order *Inter Partes* Reexamination" (hereinafter the petition). Requester filed an additional paper on April 24, 2009, entitled "Supplemental Petition Under 37 C.F.R. §§ 1.181 and 1.927 For Review of the March 3, 2008 Determination Refusing To Order *Inter Partes* Reexamination" (hereinafter the supplemental petition). Both petitions are before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed January 16, 2009.

The Petitions are **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,281,842 (hereinafter, the '842 patent) issued on October 16, 2007.

2. A request for inter partes reexamination was filed on December 11, 2007. The resulting reexamination proceeding was assigned Control No. 95/000,327 (hereinafter, the '327 proceeding). Reexamination was requested for claims 1-15 of the '842 patent based upon U.S. Patent Application Publication No. 2007/0247966 to Miller et al., filed June 25, 2007, and published October 25, 2007, U.S. Patent No. 7,063,456 to Miller et al., issued on June 20, 2006, U.S. Patent No. D163,117 to Hobbs, issued on February 26, 1949, U.S. Patent No. D227,535 to Grimes, issued on July 3, 1973, U.S. Patent No. 5,219,419 to Prothe, issued on June 15, 1993 and a Sales Brochure for K-TEC Blendtec ABC Blender Jar, published October 2000.

3. A Notice of Reexamination Request Filing Date for the '327 proceeding was issued on January 3, 2008.

4. An order denying the request for reexamination for claims 1-15 in the '327 proceeding was mailed on March 3, 2008.

5. On March 11, 2008, the third party requester filed the present petition under 37 CFR §§ 1.181 and 1.927 in the '327 proceeding.

6. On April 24, 2009, the third party requester filed the present supplemental petition under 37 CFR §§ 1.181 and 1.927 in the '327 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner incorrectly concluded that the request did not present the "old art" in a new light or in a different way.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-15 was correct, and will not

necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-15 of the '842 patent. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition) nor any additional SNQs proposed for the first time in the petition.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously

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

considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

III. Analysis of the Request for Reexamination in the '327 proceeding

The Request in the '327 proceeding sets forth the following proposed rejections based upon a substantial new question (SNQ) of patentability:

I. The request indicates that Requester considers that claims 1-15 of the '842 patent are patentably indistinct from newly added claims 34-45 of the Miller '966 publication, and Requester seeks an interference against the claims of the '842 patent in accordance with 37 C.F.R. § 41.202 and MPEP § 2304.02.

II. The request indicates that Requester considers that 1-4 and 7-14 of the '842 patent are anticipated by Miller et al. (the '456 patent) under 35 U.S.C. §§ 102(e) and 102(g).

III. The request indicates that Requester considers that claims 1-15 of the '842 patent are obvious under 35 U.S.C. § 103(a) in view of Miller et al. and Hobbs.

IV. The request indicates that Requester considers that claims 1-15 of the '842 patent are obvious under 35 U.S.C. § 103(a) in view of Miller et al. and Grimes.

V. The request indicates that Requester considers that claims 4-6 of the '842 patent are obvious under 35 U.S.C. § 103(a) in view of Miller et al. and Prothe.

VI. The request indicates that Requester considers that claims 1-15 of the '842 patent are obvious under 35 U.S.C. § 103(a) in view of Miller et al. and Blendtec.

The Request was denied in the March 3, 2008 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that the cited prior art does not raise a SNQ that is different from the determinations made in the application that matured into the '842 patent. The examiner determined that the prior art was not being presented or viewed in a new light by the arguments set forth in the Request. Therefore, the examiner stated, the Request did not present a new non-cumulative technical teaching.

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

The petition alleges that the examiner erred in his consideration of proposed rejections II-VI.

A. Turning to the Request, pp. 11-12 state that claims 1-4 and 7-14 are anticipated by Miller et al. (the '456 patent). Anticipation requires not only that each and every element set forth in the claim be found in a single prior art reference, but also that the elements be arranged as required by the claim (MPEP 2131). Miller discloses blender jars having various shapes, but the portions of Miller et al. relied upon in the Request do not disclose an embodiment wherein all the claim elements are arranged as required by the claim. Specifically, the written description does not disclose a fifth truncating wall positioned closer to the blade axis than the other walls. Figure 3 shows a blender jar which might be considered generally rectangular in shape, but it lacks a fifth truncating wall. Figure 4 can be construed to show a blender jar which has a truncating wall positioned closer to the blade than the other walls, but it does not have a generally rectangular shape. Miller itself describes the jars in Figures 3 and 4 as having a "non-symmetrical shape," not rectangular (col. 3, lines 25-27). Prosecution history of the application which matured into the '842 patent (11/318,830, the '830 application) shows that the examiner applied Miller in a rejection under § 102, but the rejection was withdrawn after an amendment was made to the claims requiring a generally rectangular shape and the fifth wall being positioned closer than the other walls to the axis of the blender blade. Thus the Request fails to present the Miller reference in a new light, and therefore does not present a SNQ with regard to the claims.

B. The Request states at p. 13 that claims 1-15 are obvious over Miller in combination with Hobbs. Hobbs was applied in a rejection under § 103 during prosecution of the '830 application. The Request does not point out how the Hobbs patent is being viewed in a different light. Indeed, since this is a design patent and there is essentially no written description of the invention, it is difficult to envision how the examiner could have overlooked any pertinent detail of the Hobbs disclosure. The only basis for asserting that this combination of references raises a SNQ is that this combination of references was not applied in a rejection, but that is not the standard for raising a SNQ using entirely "old" art, as set forth above. All of the technical information presented in the Request was already considered in the '830 application. The fact that the examiner did not comment on this specific combination of references is not evidence that a particular combination of references was not considered, especially in the present situation, where it is readily apparent that the examiner previously considered the same prior art teachings cited in the Request. Thus the combination of Miller and Hobbs fails to present a SNQ.

C. The Request states at pp. 14-15 that claims 1-15 are obvious over Miller in combination with Grimes. Grimes was applied in a rejection under § 103 during prosecution of the '830 application. Like Hobbs, Grimes is a design patent and the Request does not point out how it is being viewed in a new light. Thus the combination

of Miller and Grimes fails to present an SNQ for the same reasons discussed in section B above.

D. The Request states at pp. 15-16 that claims 4-6 are obvious over Miller in combination with Prothe. Prothe was applied in a rejection under § 103 during prosecution of the '830 application and the Request does not point out how it is being viewed in a new light. The same features relied upon by Requester were discussed by the examiner in the '830 application. Thus the combination of Miller and Prothe fails to present an SNQ for the same reasons discussed in section B above.

E. The Request states at pp. 16-17 that claims 1-15 are obvious over the combination of Miller and Blendtec. Blendtec was considered during prosecution of the '830 application and applied in two rejections under § 103. The Request relies on Blendtec for its disclosure of the general shape of the blender jar and the way the handle is attached to the jar to allow jars to be stacked. The same features were cited by the examiner in the '830 application and the Request does not indicate how the reference is being viewed in a new light. Therefore the combination of Miller and Blendtec does not present a SNQ.

F. Turning to the petition, Requester argues that the rejection over Miller in the '830 application was withdrawn because the "generally rectangular" limitation was added to the claims. As evidence, Requester points to the interview summary of August 15, 2006 and Patent Owner's response of October 2, 2006. Based on this evidence, Requester maintains that the examiner in the '327 proceeding erred in concluding that the Request did not present the Miller patent in a new light.

This line of argument is not persuasive. Review of the cited interview summary shows that the examiner stated that "a bottom wall defining a generally rectangular area and the axis of the blade being positioned closer to the fifth wall...appears to define over the prior art" (emphasis added). It was the combination of these two elements, not the "generally rectangular" limitation alone, which led to the withdrawal of the anticipation rejection over Miller. As discussed in section A above, the "blade positioned closer to the fifth wall" limitation is disclosed only in the drawings of the Miller patent, not in the written description. None of the drawings shows a blender jar having a generally rectangular shape and the axis of the blade positioned closer to the fifth wall. The rejection was withdrawn initially made by the examiner was later withdrawn.

After the rejection over Miller was withdrawn, the examiner made new rejections under § 103 based on the Dickson patent (5,380,086) and Blendtec, each of which disclose a blender jar which is clearly rectangular in shape, in combination with secondary references showing containers having a truncating fifth wall (including Hobbs, Prothe and Grimes). One might argue that it would have been obvious to combine Miller's written description (generally rectangular shape) with Miller's Figure 4 (the axis of the blade positioned closer to the fifth wall), but review of the '830 prosecution history

shows that this combination of claim elements was found non-obvious in view of the affidavits and remarks submitted by Patent Owner on June 27, 2007. The record is clear that the original examiner considered both of these two claim elements in combination. Therefore the Request does not present the prior art in a new light, and so does not raise a SNQ.

G. The supplemental petition argues that, in reexamination proceeding 95/000,228, the examiner has interpreted Figure 4 of Miller differently. The cited claim interpretation was not present in the Request and therefore will not be considered in this review of the Order.

H. The petition did not allege any errors in the examiner's analysis of proposed rejections under 102(g). These proposed rejections have also been reviewed *de novo* and it is agreed that they do not raise a SNQ with regard to claims 1-15 of the '842 patent.

CONCLUSION

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

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

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,328	01/14/2008	6892211	112056-0499C5RX	4693

24267 7590 01/05/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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DLA PIPER US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303

Date:

MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000328
PATENT NO. : 6892211
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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JAN 05 2010

RONALD YIN :
DLA PIPER LLP (US) :(for Requester)
2000 UNIVERSITY AVENUE :
EAST PALO ALTO, CA 94303-2248 :

CENTRAL REEXAMINATION UNIT

In re Application of: Hintz et alia :
Control No.: 95/000,328 : DECISION ON PETITION
Deposited: January 14, 2008 : Under 37 CFR 1.59
For: US Patent No. 6,892,211 :

This is a response to the petition under 37 CFR 1.59(b), filed on December 8, 2009 by which petitioners request to expunge information from the above identified proceeding.

The petition was filed in a timely manner with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g). The fee of $ 200 required by 37 CFR 1.17(g) has been recieved.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On January 14, 2008 a third party requester requested *ex parte* reexamination of US Patent No 6,892,211 which is identified under control no. 95/000,328.

2. Reexamination was ordered, and prosecution has continued with the issuance of an Office action on September 8, 2009.

3. On December 8, 2009 the instant petition with artifacts under seal were filed.

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.59 (in-part)

Expungement of information or copy of papers in application file.

(a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

....

MPEP § 724.04(c) (in-part)

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR § 1.11(d) will be treated in the following manner:

(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR § 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR §1.11(d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR § 1.59(b) will be treated in accordance with MPEP § 724.05.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR § 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but

inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR § 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, Proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR § 1.17(g) for a petition under 37 CFR § 1.59(b).

DECISION

Petitioner requests that two documents marked "Attorney's Eyes Only" and submitted as an artifact pursuant to a protective order entered on February 20, 2008 in related litigation be expunged from the record. These documents were filed December 8, 2009.

The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

Jessica J. Harrison
SPE AU 3992
Central Reexamination Unit

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(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.

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(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR §1.11(d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR § 1.59(b) will be treated in accordance with MPEP § 724.05.

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(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
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The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

Jessica J. Harrison
SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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901 NEW YORK AVE., N.W.
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: FOR PATENT OWNER

MAILED

MAR 0 2 2010

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PATTERSON, THUENTE, SKAAR
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4800 IDS CENTER, 80 SOUTH 8th Street
MINNEAPOLIS, MN 55402-2100

: FOR THIRD PARTY
REQUESTER

CENTRAL REEXAMINATION UNIT

In re Cates et al.
Reexamination Proceeding
Control No. : 95/000,330
Filed: December 17, 2007
Patent No. 7,236,821

: DECISION
: ON
: REQUESTER'S
: PETITION
: UNDER 37 CFR 1.181

This is a decision addressing Third Party Requester's petition, filed February 12, 2010, under 37 CFR 1.181 requesting supervisory review of the examiner's action in issuing the Right of Appeal Notice (RAN). It is noted that Patent Owner filed a separate petition under 37 CFR 1.183, which will be addressed in another decision in due course.

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

SUMMARY

Third Party Requester's petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

Brief Statement of Relevant Facts

1. Patent No. 7,236,821 (the '821 patent) issued on June 26, 2007.

2. A request for reexamination, assigned Control No. 95/000,330 (the '330 proceeding), was filed by a third party Requester on December 17, 2007.

3. Reexamination was ordered in the '330 reexamination proceeding on January 30, 2008.

4. An Office action on the merits was mailed on the same day, January 30, 2008.

5. Prosecution continued in the reexamination proceeding, and on November 3, 2009, a Right of Appeal Notice (RAN) was mailed. The RAN confirmed the patentability of claims 150-152 and 155-160, the only claims under reexamination still pending in the proceeding.

6. On December 3, 2009, the Third Party Requester filed a Notice of Appeal.

7. On February 12, 2010, Third Party Requester filed the petition under 37 CFR 1.181. The Third Party Requester also filed a petition under 37 CFR 1.183 requesting waiver of the rules. The petition 37 CFR 1.183 will be addressed in separate decision in due course. The Third Party Requester also filed an appeal brief and evidence.

Discussion

The Third Party Requester (petitioner) requests supervisory review of the examiner's action in issuing the Right of Appeal Notice, dated November 3, 2009. The petitioner considers the RAN improper because of the withdrawal of the prior art rejections and indication of claims 150-152 and 155-160 as patentable.

The request to review the RAN is dismissed as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

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

...

Decision

The petitioner brings before the Office a petition under 37 CFR § 1.181 to review the RAN, dated November 3, 2009. The petitioner filed the petition on February 3, 2010.[1] The action from which relief is requested is the RAN, which was mailed on November 3, 2009. Therefore, the petition was filed over **two** months from the mailing date of the action (November 3, 2009) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

In other words, this petition is untimely to request relief from the examiner's actions in the RAN. It is noted that even if this petition was deemed timely filed, the grounds of argument presented in the petition only address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of claim interpretation and application of the prior art to the claims are appealable issues, and therefore, cannot be addressed by petitions.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed February 12, 2010, is **dismissed** as untimely for the reasons discussed above.

2. The present *inter partes* reexamination proceeding is being forwarded to the Office of Patent Legal Administration for consideration of petition under 37 CFR 1.183.

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

[1] See the certificate of mailing which stated the petition received February 12, 2010 was deposited in the USPS on February 3, 2010.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,330	12/17/2007	7236821	3884.41REX01	6376

22852 7590 06/02/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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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Date:

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JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000330
PATENT NO. : 7236821
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

United States Patent and Trademark Office

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(For Patent Owner)

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JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

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MINNEAPOLIS, MN 55402-2100

(For Requester)

In re Cates et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,330
Filed: December 17, 2007
For: U.S. Patent No. 7,236,821
Title: Chronically –Implanted Device for Sensing and Therapy

DECISION
GRANTING PETITION
UNDER 1.183

This is a decision on a February 12, 2010 third party requester petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c), and 37 C.F.R. § 1.939(a)," and on a March 3, 2010 patent owner petition entitled "OPPOSITION TO APPELLANT'S PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c), and 37 C.F.R. § 1.939(a)."

The third party requester and patent owner petitions are before the Office of Patent Legal Administration.

The petition fees under 37 C.F.R. § 1.17(f) of $400 have been charged to third party requester's Deposit Account No. 16-0631 as authorized on page 14 of requester's petition, and to patent owner's Deposit Account No. 06-0916 as authorized on page 6 of the opposition petition.

The third party requester petition is **granted** to the extent detailed below.

The patent owner opposition petition is **dismissed.**

Requester and patent owner should note the time frames below for submitting a revised Brief to avoid dismissal of the appeal, and a revised Respondent's Brief.

BACKGROUND

- On December 17, 2007, a request for *inter partes* reexamination of U.S. Patent Number 7,236,821 was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,330 ("the '330 proceeding").

- Reexamination was ordered in the '330 reexamination proceeding on January 30, 2008.

- Prosecution progressed until, on May 18, 2009, patent owner filed comments after an April 17, 2009 Action Closing Prosecution ("ACP") in which patent owner alleged that the Bulkes reference, that was applied by the examiner in rejections in the ACP, failed to disclose the claimed invention.[1]

- On June 17, 2009, third party requester filed comments responsive to the patent owner comments of May 18, 2009, addressing the interpretation, proposed by the patent owner, of the application of the disclosure of Bulkes to the claims.[2]

- On November 3, 2009, a Right of Appeal Notice ("RAN") was issued. After reviewing the patent owner's arguments and the third party requester's counter arguments, the examiner noted agreement with the patent owner's arguments. The RAN withdrew all previous grounds of rejection, and confirmed the patentability of claims 150-152 and 155-160, the only claims under reexamination still pending in the proceeding, based upon "review and reconsideration of Bulkes."[3]

- On December 3, 2009, third party requester filed a Notice of Appeal.

- On February 12, 2010, third party requester filed the instant petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c), and 37 C.F.R. § 1.939(a)," requesting suspension of the rules preventing submission of evidence addressing the examiner's position taken for the first time in the Right of Appeal Notice. The instant petition additionally requests suspension of the rule preventing improper submissions in an *inter partes* reexamination in order to permit review of a concurrently filed petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.181 FOR SUPERVISORY REVIEW."

- On February 12, 2010, third party requester filed, concurrently with the instant petition, an Appellant's Brief, a declaration by Dr. Mark Kroll addressing issues of patentability of the claims under reexamination, and a declaration by attorney Justin Woo in support of the instant third party requester petition, characterizing the issuance of the RAN as unprecedented.

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[1] *See, e.g.*, pages 7-10. Petitioners differ over whether this paper presented a "new" claim construction.
[2] *See, e.g.*, pages 2-3. Third party requester appears to argue that a claim limitation at issue is inherent in the device disclosed in Bulkes.
[3] *See, e.g.*, page 7.

- On March 2, 2010, the Office issued a decision dismissing as untimely the third party requester's February 12, 2010 petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.181 FOR SUPERVISORY REVIEW."

- On March 3, 2010, patent owner filed a Respondent's Brief, and a paper entitled "OPPOSITION TO APPELLANT'S PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c), and 37 C.F.R. § 1.939(a)."

THIRD PARTY REQUESTER PETITION UNDER 37 C.F. R. 1.183

In the instant third party requester petition filed on February 12, 2010, petitioner requests relief under 37 C.F.R. § 1.183 for waiver of 37 C.F.R. § 1.16(f) and 37 C.F.R. § 41.63(c), which restrict entry of evidentiary submissions filed after issuance of a Right of Appeal Notice (RAN).[4] The waiver is requested in view of the examiner's decision to reverse his previously held position and to issue an RAN withdrawing all previous grounds of rejection and confirming the patentability of all the claims still pending in the reexamination proceeding, based on such reversal, rather than to reopen prosecution on the new position taken by the examiner. The petition seeks to permit submission of evidence (a § 1.132 declaration by Dr. Mark Kroll) subsequent to the RAN to address the examiner's position taken for the first time in the RAN in the instant proceeding. Petitioner has submitted this evidence with an Appellant's Brief filed on February 12, 2010. The petition is supported by a § 1.132 declaration by attorney Justin Woo.

A petition requesting waiver of a rule may be granted under 37 C.F.R. § 1.183 in an extraordinary situation to satisfy the requirements of justice. Petitioner third party requester alleges that such an extraordinary situation exists because "The Examiner's decision to reverse his previously held positions in the Right to Appeal Notice ("RAN") instead of reopening prosecution unfairly prejudices the Requester . . . by denying the Requester the opportunity to present rebuttal evidence."[5] Petitioner third party requester wishes to present evidence rebutting the claim construction set forth in the RAN.[6]

Requester relies upon the declaration by attorney Woo to argue that there cannot be found another *inter partes* reexamination case in which there was a similar situation of a refusal for the very first time in a RAN to maintain previously adopted grounds of rejection that had never been refused prior to the RAN where the arguments made for the refusal of the grounds of rejection were first raised by the Owner after the ACP.[7] Petitioner believes that it is not reasonable or proper to require the requester to have the foresight to expect that the examiner would suddenly modify positions taken in the ACP in response to mere argument by the patent owner and

[4] The third party requester's petition for waiver of 37 C.F.R. § 1.939(a) requesting suspension of the rule preventing improper submissions in an *inter partes* reexamination in order to permit review of a concurrently filed petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.181 FOR SUPERVISORY REVIEW" is moot in view of the consideration of that petition in a decision mailed on March 2, 2010.

[5] Third Party Requester Petition at pages 1-2. Third Party Requester also alleges that such rebuttal evidence is required to be entered under the Administrative Procedures Act (APA). As the petition is being granted on other grounds, this issue need not be reached in this decision and will not be addressed here.

[6] *Id.* at pages 2-3.

[7] Petition at page 9.

thereby divine the need to seek to introduce evidence on behalf of a position for which the requester and the examiner are in agreement on.[8]

Petitioner recognizes that MPEP guidelines "do not suggest that an Examiner reopen prosecution if the Examiner is going to modify his/her position from a previous position in favor of the Requester in the ACP. Instead, the guidelines permit the Examiner to reverse his/her position from the ACP and take a position against the Requester in the RAN."[9] Requester's argument is that such permissiveness results in forcing requester to appeal but without opportunity under the Rules to submit rebuttal evidence as part of the appeal. Reference is made to 37 CFR § 1.116(e) as prohibiting the submission of affidavits (or declarations) or any other evidence in comments following the ACP, and to 37 CFR §§ 1.116(f) and 41.63(c) as prohibiting submission of evidence after notice of appeal.[10]

PATENT OWNER OPPOSITION TO PETITION UNDER 37 C.F.R. 1.183

The instant Opposition of March 3, 2010 opposes entry of the third party's February 12, 2010 evidence submission. Contrariwise, petitioner patent owner alleges that no such extraordinary situation exists here because the claim construction at issue was set forth in the May 18, 2009 patent owner's response to the Action Closing Prosecution, to which the requester filed a response on June 17, 2009 that included arguments against the patent owner's interpretation of the claim and Bulkes reference. Petitioner patent owner argues that the requester's June 17, 2009 response constituted an opportunity for the requester to present evidence responsive to the question of whether the Bulkes reference discloses the claimed invention, and that requester failed to take advantage of that opportunity and that requester is not entitled to a do-over.

DECISION

Relief under 37 C.F.R. § 1.183 is an equitable remedy that must take into account the balance of interests that will be affected by entry of third party requester's evidentiary submission. In *inter partes* reexamination, the third party requester, unlike the patent owner, does not have an identifiable property interest that is directly being decided in the USPTO proceeding. However, the third party requester has an interest, as the requester is subject to the estoppel provisions of 37 C.F.R. § 1.907(c), which affect the third party requester's right to subsequently request *inter partes* reexamination on the basis of issues that were raised or could have been raised in the instant reexamination proceeding. Therefore, both parties have substantial interests in the instant proceeding that will be affected by the refusal or entry of third party requester's proposed evidentiary submission. Furthermore, in an *inter partes* proceeding, the third party requester is provided, through 37 C.F.R. § 41.63(c), the right to appeal "any final determination not to make a proposed rejection."

As the grant of a petition under § 1.183 requires a finding of extraordinary circumstances such that the interests of justice require rule waiver, the facts of the proceeding must be examined to determine if, in this case, the third party requester has had a reasonable opportunity to present the

[8] Petition, page 10.
[9] *Id.*, at page 9.
[10] Petition, bridge of pages 9 and 10.

proposed evidence submission, the Kroll declaration, at any stage of the proceeding.

- Prior to the issuance of the ACP, patent owner had not made the argument that requester now seeks to submit evidence in regard. Accordingly, there was no opportunity to submit the evidence.
- After the ACP and prior to the RAN, patent owner had made the new argument for which requester now seeks to submit evidence. Requester did reply with argument apparently believing that evidence was not necessary to support requester's reply as the examiner had previously adopted requester's position in issuing the ACP, and in any case requester believed that § 1.116(e) would not support submission of evidence.

Contrary to requester's position, 37 CFR § 1.116(e) did provide an opportunity to present evidentiary materials after the ACP in the requester's June 17, 2009 response to the owner's response to the ACP. Section 1.116(e) permits entry of an affidavit or other evidence after an action closing prosecution in an *inter partes* reexamination upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Requester recognizes that the owner's response included a new argument.[11] The new argument may have supported the entry of evidence after the ACP. Requester, however, made no attempt to provide such submission and obtain a ruling thereon. The declaration by Dr. Kroll is dated February 3, 2010 well after the May 18, 2009 comments by the patent owner containing the new argument. It is apparent that the declaration was not first prepared in reply to patent owner comments but in reply to the November 3, 2009 RAN change of position by the examiner.

Nonetheless, in view of (1) the apparent unusual circumstance within which the RAN was issued, such as detailed in the declaration of attorney Woo, (2) requester's presumably good faith belief that evidence could not be submitted after the ACP, and (3) presentation of rebuttal evidence as to inherent properties relating to this particular issue of anticipation before the Board of Patent Appeals and Interferences, being highly relevant to a proper determination of the issue at the Board,[12] entry of the Kroll declaration is required in view of the facts and circumstances specific to this proceeding in the interests of justice.

Having decided that entry of the Kroll declaration is required, the impact of the entry of third party requester's proposed evidentiary submission on the administration of the proceeding must be determined. In the present instance, the third party requester seeks to augment the appeal of a final determination not to make a proposed rejection. Although both parties have filed briefs in the proceeding, the examiner has not yet prepared an examiner's answer, nor has the Board taken up the proceeding on appeal. The burdens would therefore rest upon both parties to revise and refile appellant's and respondent's briefs, rather than on the examiner or on the Board. It is also a consideration that in an *inter partes* reexamination, 35 U.S.C. § 314(c) mandates that the proceeding must be conducted "with special dispatch within the Office." For this reason, any waiver of the rules in the proceeding to submit additional evidence must not result in undue

[11] Petition at page 6 wherein it is stated that the owner responded to the ACP by arguing for the first time that the cited references fail to disclose "a sensing circuit coupled to a pulse generator" and an electrode "to deliver electrical stimulation to the heart upon detection by the sensing circuit of an arrhythmia." (Emphasis deleted).

[12] *See In the Matter of the Application of James W. Echerd and Warren K. Watters*, 471 F.2d 632, 635-36 (CCPA 1973) (*citing In re Bulina*, 362 F.2d 555 (CCPA 1966)) (utilization of an entirely new theory should accord an opportunity to present rebuttal evidence).

delay.

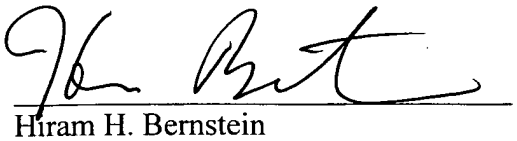
Based on the facts and circumstances in the present proceeding, the interests of justice favor waiver of 37 C.F.R. § 1.16(f) and 37 C.F.R. § 41.63(c) to permit entry of third party requester's evidentiary submission of Dr. Kroll. Consistent with the requirement of special dispatch, the third party requester is hereby granted a period of two (2) months from the date of this decision to revise the previously submitted Brief by submitting a Supplemental Appellant's Brief to include addressing the new argument raised by patent owner after the ACP. The submission is to be complete in and of itself and therefore be accompanied by the evidence relied upon to address the new argument made after the ACP, the declaration by Dr. Kroll.[13] No additional evidence will be permitted. To the extent that the previously submitted brief would be adequate to address the new argument, the previously submitted brief may be resubmitted without revision. Within one month of the date of service of the date of submission of a Supplemental Appellant's Brief, patent owner may file a revised Respondent's Brief pursuant to 37 C.F.R. §§ 41.66 and 41.68. Reliance may not be had on the previously submitted Respondent's Brief, although if revisions thereto are not desired, the prior Respondent's Brief may be resubmitted. The provisions of 37 C.F.R § 1.16(f) and 37 C.F.R § 41.63(c) are also waived for the patent owner to submit a revised Respondent's Brief that may provide evidentiary support countering the facts set forth in the Supplemental Appellant's Brief regarding the Declaration of Dr. Kroll and the referred to textbook by Dr. Kroll. Note that the page limits for the briefs remain as set forth in 37 C.F.R. § 1.943(c), and appellant's and respondent's attention is directed towards the guidance set forth in MPEP 2667 (I)(A)(2) for determination of the number of pages in an *inter partes* response. Failure by requester to timely submit the Supplemental Appellant Brief will result in dismissal of the appeal.

CONCLUSION

- The third party requester petition is **granted**.
- The patent owner opposition petition is **dismissed.**
- The third party requester is hereby granted a period of two (2) months from the date of this decision to submit a Supplemental Appellant's Brief. Within one month of the date of service of the date of submission of a Supplemental Appellant's Brief, patent owner may file a Respondent's Brief pursuant to 37 C.F.R. §§ 41.66 and 41.68.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- A copy of this decision will be made of record in the reexamination file.

[13] While requester's petition is limited to a request to submit the declaration of Dr. Kroll, petition at pages 4 and 14, patent owner notes, bridge of pages 1 and 2, that the appellant in its brief sites to both the Declaration of Dr. Kroll and a textbook in-part authored by Dr. Kroll. The textbook cite to the extent it supports the position argued by Dr. Kroll in his declaration is also admissible.

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
6/4/2010

APPLICABLE REGULATIONS and MPEP PROVISION

37 C.F.R. § 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 C.F.R. § 1.116 states in-part:

> (e) An affidavit or other evidence submitted 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 day of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.
>
> (f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

37 C.F.R. § 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 C.F.R. § 41.61(a)(2) states:

> Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

37 C.F.R. § 41.63(c) states:

> Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

MPEP 2673.01 Reopening Prosecution After ACP

I. MANDATORY REOPENING

Where a submission after Action Closing Prosecution (ACP) has been filed pursuant to 37 CFR 1.951(a) (and 37 CFR 1.951(b0) and the examiner decides to modify his/her position, the examiner should ordinarily reopen prosecution, in accordance with the following guidelines.

***

As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened. The third party has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage*, unless the patent owner responds (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability during reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond). (Emphasis in original).

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

SEP 29 2009

CENTRAL REEXAMINATION UNIT

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HOUSTON, TX 77002

(For Third Party Requester)

In re: Friedman *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,332
Deposited: 08 January 2008
For: US Patent No. 7,228,383

DECISION
DENYING PETITION
FOR DIRECTOR ACTION
PURSUANT TO
37 CFR § 1.181(a)(3)

This is a decision on the 17 June 2009, patent owner's "Petition Under 37 § 1.181(a)(3)" requesting the Director exercise authority to strike Third Party response submitted 27 May 2009 as untimely.

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 the Director exercise authority to strike the third party response dated 27 May 2009. The petition was timely filed on 17 June 2009. No petition fee is required for this petition. The patent owner submitted certificate of service with the instant petition.

STATEMENT OF RELEVANT FACTS

1. On 06 February 2009 a non-final Office action was mailed with a two month response due thereto by the patent owner.

2. On 06 April 2009 a response by the patent owner was submitted.

3. On 20 April 2009 a Notice of Defective Paper in *Inter-Partes* Reexamination was mailed to the patent owner noting defects in the response dated 06 April 2009. In this paper the patent owner was given 30 days or one month to respond.

4. On 27 April 2009 the patent owner submitted a corrected compliant response.

5. On 27 May 2009 the third party requester submitted comments to the compliant patent owner's response.

6. On 27 June the instant petition was submitted for consideration.

CITATION OF RELEVANT AUTHORITY

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

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

37 CFR § 1.947 Comments by third party requester to patent owner's response in inter partes reexamination.

> 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.

ANALYSIS AND FINDINGS

The patent owner petitions the Director to strike the third party requester's response dated 27 May 2009 as being untimely. The patent owner submitted a response dated 06 April 2009. The Office determined that the response was defective and held non-compliant. The Patent owner was given thirty days or one month to respond thereto. The patent owner submitted a compliant request on 27 April 2009. The third party requester submitted comments on 27 May 2009. The third party requester's comments were submitted thirty days following the compliant response by the patent owner. Pursuant to 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 within a period of 30 days from the date of service of the patent owner's response." Since the third party requester's comments were provided thirty days following the patent owner's response the remarks are timely and proper pursuant to 37 CFR § 1.947.

The patent owner's petition to strike the third party requester's comments dated 27 May 2009 is hereby denied.

CONCLUSION

1. The patent owner's petition to strike third party response dated 27 May 2009 is hereby **denied**.

2. The proceeding is returned to the examiner for further action.

3. Correspondence to the Office should be addressed as follows:

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

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

By Hand: Customer Service Window
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.

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
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.
95/000,332	01/08/2008	7,228,383	321264US91RX	1059

22850 7590 04/15/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

APR 15 2010

CENTRAL REEXAMINATION UNIT

For the Patent Owner:

Scott A. McKeown
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

For the Requester:

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, TX 77002

DECISION
DENYING
PETITION

In re Reexamination proceeding 95/000,332
Filed JANUARY 8, 2008
For: SYSTEM AND METHOD FOR PROGRESSIVE AND HIERARCHICAL CACHING
For: U.S. Patent No.: 7,228,383

This is a decision on patent owner's petition filed October 8, 2009 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the September 29, 2009 decision of the Director of the Central Reexamination Unit (CRU Director), which denied patent owner's request to strike third party requester's May 27, 2009 comments under 37 CFR 1.947.

The petition to overturn the September 29, 2009 decision of the CRU Director is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review.

BACKGROUND

1. On 08 January 2008, a request for reexamination of U.S. Patent 7,228,383 was filed, and the request was assigned control number 95/000,332 (the '0332 proceeding).

2. On 06 February 2009, a non-final Office action was mailed for the '0332 proceeding, setting a two month period for response by patent owner.

3. On 06 April 2009, a response to the non-final Office action was filed by patent owner.

4. On 20 April 2009 a Notice of Defective Paper in *Inter-Partes* Reexamination was mailed to patent owner notifying patent owner that the 06 April 2009 response was defective. The defect identified in this paper was (paraphrasing) the use of strikeout rather than bracketing to identify subject matter removed from a patent claim. Patent owner was given 30 days or one month to respond to the Notice. On page 2 of the Notice (see the electronic record), the third party requester was informed that "[p]rior 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."

5. On 29 April 2009,[1] the patent owner submitted a corrected response to the non-final Office action of 06 February 2009. In the 29 April 2009 submission, on page 1 of the "Supplemental amendment...", the submission is described as a "response to the *Inter Partes* Reexamination Communication dated April 20, 2009."

6. On 27 May 2009, the requester submitted comments after the patent owner's response of 29 April 2009.

7. On 17 June 2009, the patent owner submitted a petition under 37 CFR 1.181 requesting that the Director exercise his supervisory authority to strike the third party response of 27 May 2009 as non-compliant for being untimely.

8. On 09 September 2009, the 17 June 2009 petition was denied by the CRU Director.

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[1] The electronic record shows a submission on 27 April 2009 and a submission on 29 April 2009 from the patent owner. The instant petition, on page 2, indicates that a telephone call was made to correct defects in the paper of 27 April 2009, resulting in the compliant submission of 29 April 2009.

9. On 08 October 2009, the patent owner submitted the present petition requesting reconsideration of the CRU Director's decision of 09 September 2009.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

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 1.181 states, in part:

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

37 CFR 1.947 states:

> Comments by third party requester to patent owner's response in *inter partes* reexamination
>
> 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 2262 states, in part:

The time periods for response and comments for the various stages of an *inter partes* reexamination proceeding are as follows:

...(B) After an Office letter indicating that a response by the patent owner is not proper.

After an Office letter indicates that a response filed by the patent owner is not completely responsive to a prior Office action (i.e., an incomplete response), the patent owner is required to complete the response within the time period set in the Office letter. 37 CFR 1.957(d). A time period of 30 days or one month (whichever is longer) is normally set. Any third party requester comments on a supplemental patent owner response that completes the initial response must be filed within 30 days from the date of service of the patent owner's supplemental response on the third party requester.

MPEP 2666.60 states, in part:

After the patent owner or the third party requester has provided a submission directed solely to correcting the defect, the other party is not permitted to comment on the submission correcting the defect, since the submission correcting the defect is directed to form and does not go to the merits of the case. This would be the case, for example, where the failure to provide a signature or a certificate of service is corrected, or where a permanent copy is submitted to replace an "easily erasable" paper that was originally submitted.

In the case of correcting a defective amendment, however, other issues come into play. Where for example, new claims 10-20 are improperly presented in a patent owner response (e.g., not properly underlined), they generally will not be entered and form PTOL-2069 (Box 4) will be used to notify the patent owner of the need to correct this defect. Until the defect is corrected, claims 10-20 do not yet exist in the proceeding for the third party requester to comment on. Likewise, any argument that was directed to such claims is not truly ripe for the third party requester comment. After the patent owner corrects the defect, claims 10-20 come into existence in the proceeding, and the argument presented by the patent owner becomes relevant. At this point, the third party requester has a right to provide comments in response to the patent owner's argument, whether or not the argument that was included in the original patent owner submission is re-presented with the paper correcting the defect. Thus, any third party requester

comments submitted either in response to the patent owner's initial paper (presenting the informal claims) or in response to the patent owner's supplemental paper (correcting the informality) will be considered by the examiner.

OPINION

Petitioner (Patent Owner) seeks intervention by the Director to reverse the CRU Director's decision of 29 September, 2009, on the grounds that, by statute (35 U.S.C. § 314(b)(2)), the third party response requester's 27 May 2009 comments paper was required to have been filed 30 days from the patent owner's initial (non-compliant) response of 06 April 2009, rather than 30 days from the patent owner's corrected response of 29 April 2009. Accordingly, petitioner seeks expungement of third-party requester's 27 May 2009 comments paper.

For the Director to intervene, petitioner must show that the 29 September, 2009 decision by the CRU Director was made in clear error. Petitioner has not provided a showing of clear error. A petition under 37 CFR 1.181, requesting that the Director of the USPTO exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). The CRU Director's ultimate decision is entitled to an administrative presumption of correctness in the absence of a convincing showing of clear error. A review of the record indicates that the CRU Director did not abuse his discretion, or act in an arbitrary and capricious manner, in the petition decision of February 5, 2008. The record establishes that the CRU Director had a reasonable basis to support his findings and conclusion.

Both the record of this proceeding and Office policy on this matter are clear that the third party requester was permitted to file its comments submission under 37 CFR 1.947 within 30 days from Patent Owner's corrected response.

(1) Page 2 (transmittal) of the electronic record of the 20 April 2009 "Notice re Defective Paper in *Inter Partes* Reexamination" states that third-party requester may once file comments each time the Patent Owner responds to "this communication" (i.e. the Notice).

(2) MPEP 2666.60, third paragraph, directly addresses the situation where a defective amendment has been filed, and patent owner is notified of same:

> **In the case of correcting a defective amendment, however, other issues come into play**. Where for example, new claims 10-20 are improperly presented in a patent owner response (e.g., not properly underlined), they generally will not

be entered and form PTOL-2069 (Box 4) will be used to notify the patent owner of the need to correct this defect. Until the defect is corrected, claims 10-20 do not yet exist in the proceeding for the third party requester to comment on. Likewise, any argument that was directed to such claims is not truly ripe for the third party requester comment. **After the patent owner corrects the defect, claims 10-20 come into existence in the proceeding, and the argument presented by the patent owner becomes relevant. At this point, the third party requester has a right to provide comments in response to the patent owner's argument, whether or not the argument that was included in the original patent owner submission is re-presented with the paper correcting the defect. Thus, any third party requester comments submitted either in response to the patent owner's initial paper (presenting the informal claims) or in response to the patent owner's supplemental paper (correcting the informality) will be considered by the examiner.** (emphasis added)

Petitioner makes reference to the second paragraph of MPEP 2666.60 (petition of 08 October 2009, page 3, bottom; page 5, second block quote; page 6, lines 14 and 21) but has not taken note of the third paragraph where a defective amendment requires correction, which squarely addresses the present situation.

In the present situation, the flaw in the paper of 06 April 2009 was a defective amendment. Accordingly, the time for the third party requester to respond was 30 days from the date of the correction of the defect.

Since the decision of the CRU Director was in compliance with Office policy, the petition under 37 CFR 1.181 is denied.

DECISION

1. The petition is granted only to the extent that the decision of the CRU Director of 29 September 2009 has been reconsidered, but is denied with respect to making any change therein. The petition is **denied as to the relief requested**.

2. A review of the record indicates that the CRU Director acted in accord with stated Office policy in denying the petition of 17 June 2009.

3. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

3. Any further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

4. Jurisdiction over the proceeding is transferred to the Central Reexamination Unit (CRU)

5. Telephone inquiries concerning this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy

3-25-10
Kenpet8

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.
95/000,337	01/04/2008	6805891	118366-0144	1308

23388 7590 08/27/2008

TROJAN LAW OFFICES
9250 WILSHIRE BLVD
SUITE 325
BEVERLY HILLS, CA 90212

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/27/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AUG 27 2008

CENTRAL REEXAMINATION UNIT

J. Nicholas Gross (For Patent Owner)
United Module Corporation
2030 Addison St., Suite 610
Berkeley, CA 94704

Blakely, Sokoloff, (For '337 Third Party Requester)
Taylor & Zafman
3200 Park Center Drive
Suite 700
Costa Mesa, CA 92626

Banner & Witcoff, LTD. (For '376 Third Party Requester)
1100 13th Street, NW
Suite 1200
Washington, DC 20005

Trojan Law Offices (Courtesy copy)
9250 Wilshire Blvd
Suite 325
Beverly Hills, CA 90212

In re Vijayen et al.	:	
Inter partes Reexamination Proceeding	:	
Control No. 95/000,337	:	
Filed: January 4, 2008	:	
For: U.S. Patent No. 6,805,891	:	**DECISION, *SUA SPONTE*,**
	:	**TO MERGE**
In re Vijayen et al.	:	**REEXAMINATION**
Inter partes Reexamination Proceeding	:	**PROCEEDINGS**
Control No. 95/000,376	:	
Filed: June 3, 2008	:	
For: U.S. Patent No. 6,805,891	:	

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 October 19, 2004 United States Patent Number 6,805,191(the '191 patent) issued.

2. On January 4, 2008 a first request for *inter partes* reexamination of the '191 patent, assigned Reexamination Control No. 95/000,337 (the '337 proceeding), was filed by first third party requester, Western Digital Technologies, Inc.

3. On February 29, 2008 the Office issued an order granting *inter partes* reexamination in the '337 proceeding.

4. On March 17, 2008 the Office issued an Office action in the '337 proceeding.

5. On May 12, 2008, patent owner petitioned for a one-month extension of time in which to respond to the outstanding Office action in the '337 proceeding.

6. On May 20, 2008, the Office issues a decision granting patent owner's request for a one-month extension of time to respond to the outstanding Office action.

7. On June 3, 2008, a second request for *inter partes* reexamination of the '191 patent, assigned Reexamination Control No. 95/000,376 (the '376 proceeding), was filed by a second third party requester, Seagate Technologies LLC.

8. On June 13, 2008 patent owner petitioned for a second one-month extension of time in which to respond to the outstanding Office action in the '337 proceeding.

9. On July 17, 2008 patent owner responded to the February 29, 2008 Office Action in the '337 proceeding, which response included an amendment to the claims.

10. On July 28, 2008 the Office issued a decision granting patent owner's request for a second one-month extension of time to respond to the outstanding Office action in the '337 proceeding.

11. On August 13, 2008, the Office issued an order granting *inter partes* reexamination in the '376 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. Both of the proceedings are *inter partes* reexamination proceeding. The first *inter partes* proceeding is still pending, and has not been terminated. Therefore, consideration of merger is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/000,337 and 95/000,376 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

1. Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. A review of the reexamination files for the '337 proceeding reflects that original patent claims 1-14 are present and unamended, but new claims 15-16 have been added. A review of the '376 proceeding reflects that only the original and unamended patent claims 1-14 are present. Therefore an appropriate "housekeeping amendment" is required within ONE (1) MONTH of this decision placing the same amendments in both cases.

2. The response to this requirement must be strictly limited to placing the same amendments in both cases; patent owner must not address any issues of patentability in the housekeeping

amendment. Any discussion of the merits or issues of the proceedings 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.

3. Submission by patent owner of a housekeeping amendment will not create a reply right for the *inter partes* third party requesters. Any comments paper filed by the requesters in response to any such housekeeping amendment would be improper, since the housekeeping amendment is not to address the merits of the proceeding. Any such comments paper would not be entered into the record, as it would be an improper submission under 37 CFR 1.939. Any amended/new claims of the housekeeping amendment may be addressed by the inter partes third party requesters at the next opportunity that requesters have to file a paper directed to the merits having an entry right.

4. In the event that the required housekeeping amendment (to place identical amendments in all (both) files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim,

and thus failing to particularly point out the invention - see Part II, item 4, above.

3. Each Office action issued by the examiner will take the form of a single action which jointly applies to both reexamination proceedings. Each action will contain identifying data for both of the cases, *i.e.* the '337 proceeding and the '376 proceeding and each action will be entered into both files (which will be maintained as separate files).

4. All parties are required to file papers (*e.g.*, Office actions, patent owner responses, requester comments, *etc.*) in duplicate, for placement of papers in both files. Any patent owner or requester papers must consist of a single response, with two copies being filed for entry in the two files, each of which must bear a signature. Any such paper must contain identifying data for both of the cases, *i.e.*, the '337 proceeding and the '376 proceeding. Any such paper must be served on all other parties. Copies of proof of service upon all other parties must accompany the filing of the paper in the Office.

All papers filed by the patent owner and the third party requesters are to be directed:

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

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

By hand 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 each other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such

paper was served on each other party, pursuant to 37 C.F.R. § 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 in the merged proceeding, which paper 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 appellant brief (patent owner or requesters) 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 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 clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '337 proceeding and (3) the '376 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 J. Nicholas Gross, United Module Corporation, 2030 Addison St., Suite 610, Berkeley, CA 94704.

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

(a) Designate one of the two correspondence addresses and parties prosecuting these proceedings as the correspondence address and party of record in both proceedings (to provide one address and party for the merged proceeding) and the patent file, and

(b) If there is a newly designated attorney, 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. Pending clarification, the address of J. Nicholas Gross, United Module Corporation, 2030 Addison St., Suite 610, Berkeley, CA 94704, will be used in future correspondence.

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,228 and 95/000,376 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Pursuant to Part II of this decision, patent owner is required to, within ONE MONTH of this decision, file a housekeeping amendment, placing the same amendments in all (both) cases of the present merged proceeding.

3. The patent owner is further required to, within ONE MONTH of this decision, unify the correspondence addresses and parties prosecuting these proceedings as set forth in the last section of this decision.

4. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action.

5. 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 (from the mailing of this decision) for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings, or

   (b) The receipt of both the required housekeeping amendment (i) and correspondence address and attorney papers (ii).

6. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

7. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

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.
95/000,341	02/01/2008	6833016	8935-0005	8816

7590 06/05/2008

EXAMINER	

LAW OFFICE OF BERNHARD MOLDREM
224 HARRISON STREET
SUITE 200
SYRACUSE, NY 13202

ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2008

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J. Mark Smith
Pendleton, Friedberg, Wilson & Hennessey, P.C.
1875 Lawrence Street Tenth Floor
Denver, CO 80202

(For Third Party Requester)

Law Office of Bernhard Moldrem
224 Harrison Street
Suite 200
Syracuse, NY 13202

(For Patent Owner)

MAILED
JUN 05 2008
CENTRAL REEXAMINATION UNIT

In re Witter :
Reexamination Proceeding :
Control No.: 95/000,341 : **DECISION**
Filed: March 27, 2003 : **ON PETITION**
Reissue #11/357,894: filed February 17, 2006 : **UNDER 37 CFR 1.182**
Notice of Reissue number: RE40048 :
Issue Date: February 12, 2008 :
For: U.S. Patent No.: 6,102,802 :

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration (OPLA) regarding a petition filed by the third party requester on June 4, 2008 under 37 CFR 1.182 to deem the date of service of the patent owner's response to the Office action to May 30, 2008, because a copy of the patentee's response was never delivered to the petitioner or the petitioner's attorney of record.

The petition is granted for the reasons set forth below.

BACKGROUND

1. On April 11, 2008, the Office issued an order granting the No. 95/000,341 reexamination request.
2. The attorneys of record for the patent owner and the requester (petitioner) received the April 11 office action.
3. On May 2, 2008, the patent owner mailed a response to the April 11th Office action. A copy of the response is stated (in the certificate of mailing) to have been mailed to the petitioner's attorney of record at the correct address and with the appropriate postage.
4. On May 6, 2008, the Office received the patent owner's response to the April 11th Office action.
5. The present petition avers that petitioner's attorney of record did not receive the copy of the patent owner's response from the patent owner.
6. The present petition avers that petitioner's attorney of record did not learn about the patent owner's response, or of its filing, until checking the PAIR record on May 30, 2008.

7. This instant petition requests that the service date for the patent owner's response be deemed May 30, 2008, the date petitioner learned of it.

DECISION

Based on the averments of the petition, made by a registered practitioner, through no fault of the petitioner, the patent owner's response to the April 11th Office action was never delivered to the requester or the petitioner's attorney of record. The requester and the petitioner's attorney of record were never aware of the patent owner's response or of its date of service until May 30, 2008. Therefore, under 37 CFR 1.182, it is appropriate to deem the date of service of the patent owner's May 6, 2008 response to be May 30, 2008, and to thereby provide the petitioner with 30 days thereafter to file any comments.

CONCLUSION

1. The third party requester request for the Office to deem the date of service of the patent owner's response to the Office action to be May 30, 2008 May 30, 2008 is granted.

2. The accompanying petition fee, as set forth in 37 CFR 1.17(f), has been accepted.

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

4. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, at (571) 272-7710.

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

June 4, 2008
C:\kiva\kenpet7/IP/95_0341 re-set service date.doc

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.
95/000,344	02/06/2008	7283519	062891.2233	2651

7590 08/05/2008

EXAMINER	
ART UNIT	PAPER NUMBER

GEORGE WHEELER
MCANDREWS, HELD & MALLOY, LTD
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CHICAGO, IL 60661

DATE MAILED: 08/05/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

Date:
MAILED

AUG 05 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000344
PATENT NO. : 7283519
ART UNIT : 3992

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

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

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(For Patent Owner) MAILED

AUG 05 2008

CENTRAL REEXAMINATION UNIT

Baker Botts, L.L.P.
2001 Ross Avenue
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(For Third Party Requester)

In re Gregory Girard
Inter Partes Reexamination Proceeding
Control No. 95/000,344
Filed: February 6, 2008
For: U.S. Patent No. 7,283,519

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

This is a decision on the July 23, 2008 patent owner petition under 37 CFR 1.183 titled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO OFFICE ACTION (37 CFR §§ 1.183 AND 1.943)." The petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed 50 pages in length. The requisite fee of $400.00 mandated by the 37 CFR 1.17(f) is being charged to Deposit Account 02-0384 .

The petition and *inter partes* reexamination control number 95/000,344 are before the Office of Patent Legal Administration.

The petition is granted to the extent that the page limit for the response to the September 8, 2005 first Office action is extended to not exceed 100 pages in length.

BACKGROUND

1. U.S. patent No. 7,283,519 ("the '519 patent") issued to Gregory D. Girard on October 16, 2007, with 19 claims, and it is currently assigned to ESN, LLC ("ESN").

2. On February 6, 2008, a request for *inter partes* reexamination of the '519 patent, assigned control No. 95/000,344 (the '344 reexamination"), was filed by a third party requester on behalf of real party in interest Cisco Systems, Inc. (the "requester").

3. On April 16, 2008, the Office issued an order granting the request for *inter partes* reexamination for claims 1-19 of the '519 patent.

4. On June 13, 2008, the Office issued an Office action in the '344 *inter partes* reexamination proceeding, rejecting claims for claims 1-19 of the '519 patent. The period for patent owner to file a respond under 37 CFR 1.945 to this action expires on August 13, 2008.

5. On July 23, 2008, the patent owner filed the present petition requesting waiver of the 50 page limit on the length of the response as set out in 37 CFR 1.943(b).

APPLICABLE PROVISIONS

35 U.S.C. 2 Powers and duties.

(b) SPECIFIC POWERS. – The Office –

...

(2) may establish regulations, not inconsistent with law, which –
(A) shall govern the conduct of proceedings in the Office;

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(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.

37 CFR § 1.943(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

DECISION

A. Waiver of the 50 page limit imposed by 47 CFR 1.943(b)

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 June 13, 2008.

The February 6, 2008 request for *inter partes* reexamination, filed by a third party requester, was eighty-three (83) pages in length and listed sixty-seven (67) appendices constituting claim charts describing proposed prior art novelty and obviousness rejections against claims 1-19 of the '519 patent. Following the request for reexamination, the Office ordered reexamination for the '344 proceeding on April 16, 2008. Subsequently, on June 13, 2008, an Office action of two hundred thirty-eight (238) pages in length, was issued by the examiner. The Office action, tracking the request for reexamination, asserted 67 grounds of rejection based on 13 references to assorted combinations of claims. For each proposed rejection with respect to each individual claim, the examiner either: (a) adopted the rejection essentially as proposed, (b) adopted the rejection with modification, or (c) declined to adopt the rejection. For the most part, the body of the examiner's action is limited to stating the grounds of rejection and providing an explanation for any modification or refusal to adopt a ground of rejection as applied to a specific claim.

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(b) based, on the fact that, by petitioner's count, the examiner imposed 286 rejections of the various claims in an Office action composed of fifty-seven (57) pages stating grounds of rejection and a two-hundred seventy-four (274) page appendix of claim charts. Furthermore, the appendix is not cumulative. By petitioner's count, for two-hundred twenty-six (226) of the rejections, the manner of applying the art to the claims is only detailed in the appendix, and such explanations are incorporated by reference into the body of the Office action within the statements of the grounds of the rejection. Petitioner (patent owner) states that "Patent Owner simply cannot respond to the 286 rejections of the various claims .., as required by 37 CFR 1.111, within the 50 page limit required by 37 CFR 1.943." Petitioner further asserts that these facts establish an extraordinary situation such that justice requires waiver of the 50 page limit on the size of a response set out in 37 CFR 1.943(b).

The petition fails to specifically state how many additional pages, beyond the permitted 50-page length, petitioner is requesting in order to fairly address the Office action and its contents. Given this lack of specificity in petitioner's request and the presence of the fifty-page limit set forth in 37 CFR 1.943(b), the petition as presented cannot be granted as requested. Page limits upon responses in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305. To allow petitioner the unfettered ability to provide a response of whatever page limit petitioner deems necessary to address each of the grounds of the Office action could foreseeably open the door for a response so voluminous as to substantially delay the instant reexamination proceeding.

Nevertheless, given the numerous grounds of rejection set forth by the examiner and petitioner's timely request, the Office will grant the present petition to the extent of waiving the 37 CFR 1.943(b) response limit of 50 pages to the following extent:

(A) For only the next immediate response to be supplied by the patent owner in response to the June 13, 2008 Office action, and

(B) To permit patent owner to provide as many as one-hundred (100) pages for patent owner's response to the June 13, 2008 Office action. The Office will enforce compliance with this new page limit of one-hundred (100) pages, and a strict review of the length of patent owner's response will be made upon its receipt.

This one-hundred (100) page limit is deemed equitable in light of the length of the June 13, 2008 Office action.

B. Authority of the Office to impose page limits

Petitioner maintains that the Office does not have the authority to place a page limit on responses and thus patent owner should be permitted to respond without any limitation as to the number of pages. Petitioner argues that 35 U.S.C. § 314 provides that *inter partes* reexamination shall be "conducted according to the procedures established for initial examination under the provisions of sections 132 and 133," and since there are no page limitations imposed on responses to Office actions in prosecution of applications, then the imposition of such limitations in *inter partes* reexamination is contrary to the statute. Furthermore, petitioner maintains that 25 U.S.C. § 2(b)(2)(A) can not be relied on as the authority for the page limitations imposed by 37 CFR § 1.943, because that portion of the statute only grants the director power "to establish regulations not inconsistent with law."

Petitioner's assumption that all rules provided for in initial examination were promulgated as implementations of 35 U.S.C. §§ 132 and 133, even if correct as petitioner characterizes it, would not be dispositive of the issue.

35 U.S.C. § 132 sets out the requirements that the Office establish an orderly procedure for examination of applications in which the Office must notify applicants of the reasons for refusing a grant of a patent and provide for the applicant to respond to such action if applicant judges that continuing to prosecute the application is appropriate. 35 U.S.C. § 133 provides by statute that if applicant fails to prosecute within six months after any action, or within a shorter time as fixed by the Director in an action, then the application is abandoned. That is, these sections set out the contours of an administrative procedure to be established that afford applicant due process in the pursuit of patent grants.

The use of the term "procedure" in 35 U.S.C. § 314 refers to a general scheme of examination - not the specific regulatory provisions. The meaning of Section 314 is that the procedures of handling a reexamination proceeding would be analogous to those of initial examination *i.e.*, procedures that provide for the Office to conduct an initial examination, provide notification of the result of such examination, set a time for response to the position taken by the Office, and then conduct further examination, ultimately leading to a final position by the examiner and providing a right of appeal therefrom. Section 314(b) further recognizes the special status of the third-party requester, allowing input into the proceeding by providing written comments each time the patent owner files a response in the proceeding. Finally, section (c) requires that the proceeding be conducted with special dispatch within the Office.

Clearly Section 314 cannot mean that the procedures for handling *inter partes* reexamination are to be identical to those for the examining (and appeal) procedures that apply to the examination of nonprovisional applications (pursuant to the regulations that have been promulgated under 35 U.S.C. §§ 132 and 133 to provide for such examination). First of all, the legislative history of Section 314 states that "proposed sections 313-314 under this subsection are similarly modeled after sections 304-305," [1] thus establishing that *inter partes* reexamination was modeled on *ex parte* reexamination. As the established regulations that provide for *ex parte* reexamination practice differed in many respects from the regulations that provide examination practice applicable to nonprovisional applications, it is clear that Congress did not contemplate identity of examining practice in *inter partes* and nonprovisional application examination. Thus, Section 314 cannot mean that the regulations that establish examining practice for *inter partes* reexamination be identical to the regulations established under 35 U.S.C. §§ 132 and 133 with respect to the examination of nonprovisional applications, but rather, that a procedure affording the parties proper process within the administrative agency be established for *inter partes* reexamination proceedings.

Second, it is not reasonable to read Section 314 as elevating the regulations established under Sections 132 & 133 to the force of statute, because that would then prevent any changes in any of those regulations without recourse to a statutory change.

Finally, 35 U.S.C. § 2(b)(2)(A) would allow the Office to impose page limitations in initial examination as a procedural rule not inconsistent with any statute. Therefore, the establishment of such a regulation limited to *inter partes* reexamination is also not inconsistent with the statute. The Office could have written a rule that specifically listed page limits as "no page limit" for the examination of nonprovisional applications and "50" for the examination of *inter partes* reexamination proceedings. The mere omission of a regulation providing no page limit for applicant responses during the examination of nonprovisional applications fails to establish that Section 2(b)(2)(A does not permit the Office to establish regulations providing for page limits on responses in a given Office examining procedure.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to the extent that the page limit for the response to the June 13, 2008 first Office action is extended to not exceed one-hundred (100) pages in length.

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

[1] 145 Cong. Rec. S14696-03 1999 WL 1041313 (Cong Rec.) at 14720

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

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

08-05-08
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,344	02/06/2008	7283519	062891.2233	2651

23446 7590 12/04/2008

MCANDREWS HELD & MALLOY, LTD
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CHICAGO, IL 60661

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/04/2008

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Date:
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DEC 04 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000344
PATENT NO. : 7283519
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 Patent Owner)

MAILED

DEC 04 2008

CENTRAL REEXAMINATION UNIT

Baker Botts, L.L.P.
2001 Ross Avenue
Suite 600
Dallas, Texas 75201-2980

(For Third Party Requester)

In re *Inter Partes* Reexamination Proceeding : DECISION
Control No. 95/000,344 : DISMISSING
Filed: November 22, 2006 : PETITIONS
For: U.S. Patent No. 7,283,519 :

This is a decision addressing the August 21, 2008 third party requester petition entitled "Petition to Suspend Page Limit for Written Comments by the Third Party Requester (37 C.F.R. §§ 1.183 and 1.943)." This decision also addresses the August 28, 2008 patent owner petition entitled "Opposition to Third Party Requestor's Petition to Suspend Page Limit Under 37 C.F.R. § 1.83." *

The above described requester and patent owner papers, and *inter partes* reexamination control number 95/000,344, are before the Office of Patent Legal Administration for decision on the requester petition.

FEES

Petitioner third party requester has authorized a charge of the required $400.00 fee (37 CFR 1.17(f) for a 37 CFR 1.183 petition to Deposit Account No. 02-0384. Patent owner has authorized a charge against Deposit Account No. 13-0017 of the $400.00 fee for its opposition paper, which paper will also be considered under 37 CFR 1.183.

* The patent owner petition is taken as having been filed pursuant to 37 CFR 1.183.

REVIEW OF FACTS

1. United States Patent Number 7,283,519 ("the '519 patent") issued on October 16, 2007.

2. A request for *inter partes* reexamination of the '519 patent was deposited on February 6, 2808, by a third party requester. The request named Cisco Systems, Inc. as the real party in interest, and was assigned Reexamination Control Number 95/000,344 (the '344 reexamination proceeding"). Papers filed by the *inter partes* reexamination requester on behalf of the real party in interest will hereinafter be referred to as having been filed by "requester."

3. On April, 16, 2007, the Office mailed, in the '344 reexamination proceeding, an order for *inter partes* reexamination.

4. On June 13, 2008, the Office mailed a non-final Office action in the '344 reexamination proceeding.

5. On July 23, 2008, patent owner filed a petition requesting the page limitation imposed by 37 CFR 1.943 on patent owner's response to the June 13, 2008 Office action be waived, and that patent owner be permitted to file a response.

6. On August 5, 2008, the Office mailed a decision waiving the provisions of 37 CFR 1.943 to the extent that the patent owner was permitted to file a response not to exceed one-hundred (100) pages in length.

7. On August 13, 2008, patent owner filed a response that was sixty-six (66) pages in length.

8. On August 21, 2008, requester filed the present requester petition requesting waiver of the provisions of 37 CFR 1.943 to the extent that requester be permitted to file written comments directed to the patent owner's August 13, 2008 that would run up to one-hundred (100) pages.

9. On August 28, 2008, patent owner filed the present patent owner petition opposing the August 21, 2008 requester petition.

10. On September 12, 2008, requester filed its written comments. The written comments contain thirty-nine (39) pages.

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 1.183 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 1.945(a) provides:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

DECISION

The record shows that on June 13, 2008, the Office mailed a non-final Office action. On August 13, 2008, patent owner filed a sixty-six (66) page response to that Office action, in accordance with the "Decision Granting Petition" dated August 5, 2008 that waived the fifty (50) page limit imposed by 37 CFR 1.943(b) to permit patent owner to file a response containing as much as one-hundred (100) pages. On August 21, 2008, requester filed a petition seeking a waiver of the provisions of 37 CFR 1.9439(b) to permit requester to file written comments directed to the outstanding Office action and patent owner reply thereto that would include as much as one-hundred (100) pages. Patent owner filed a petition on August 28, 2008 opposing requester's August 21, 2008 petition. The Office took no action on either requester's petition or patent owner's opposition petition prior to the due date for requester to file its written comments.

The record further shows that third party requester filed its written comments on September 12, 2008, the last day of the period for such written comments. The written

comments filed by requester contained thirty-nine (39) pages, and therefore, complied with the provisions of 37 CFR 1.943(b).

35 U.S.C. § 314(b)(2) provides that a requester in an *inter partes* reexamination proceeding may once file written comments directed to an Office action and the patent owner's response to that Office action. The statute also provides that such written comments must be received in the Office within thirty (30) days after the date that of service of the patent owner response to the Office action. In the present '344 reexamination proceeding, the requester has timely filed written comments that comply with the page limits set by 37 CFR 1.943(b). Requester may not now file additional written comments. Accordingly, the August 21, 2008 requester petition seeking waiver of the provisions of 37 CFR 1.943(b) is moot. It follows that the August 28, 2008 patent owner petition opposing the August 21, 2008 requester petition is also moot.

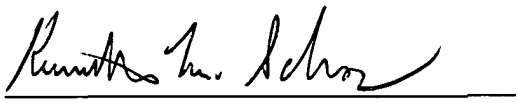
CONCLUSION

1. The requester petition filed on August 21, 2008 is dismissed as moot.

2. The August 28, 2008 patent owner petition opposing the August 21, 2008 requester petition dismissed as moot.

3. The '344 reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for appropriate action.

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



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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,344	02/06/2008	7283519	17568US04	2651

23446 7590 08/11/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/11/2009

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Date:

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AUG 11 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000344
PATENT NO. : 7283519
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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CHICAGO, IL 60661

(For Patent Owner)

MAILED

AUG 11 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,344
Filed: February 6, 2008
For: U.S. Patent No. 7,283,519

DECISION
GRANTING
PETITION

This is a decision on patent owner's petition entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO OFFICE ACTION (37 CFR §§ 1.183 AND 1.943)," filed on May 27, 2009.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 13-0017 on May 27, 2009.

The petition under 37 CFR 1.183 is granted.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,283,519 ("the '519 patent") issued on October 16, 2007.

2. A request for *inter partes* reexamination of the '519 patent was filed on February 6, 2008, by a third party requester, and was assigned Reexamination Control Number 95/000,344 ("the '344 proceeding").

3. On April 16, 2008, the Office mailed an order for *inter partes* reexamination in the '344 proceeding.

4. Prosecution in the '344 proceeding continued up until the point where, on April 27, 2009, the Office mailed an Action Closing Prosecution.

5. On May 27, 2009, patent owner filed the instant petition entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO OFFICE ACTION (37 CFR §§ 1.183 AND 1.943)" ("the petition under 37 CFR 1.183").

6. Concurrently, on May 27, 2009, patent owner filed a "RESPONSE TO OFFICE ACTION IN AN *INTER PARTES* REEXAMINATION PROCEEDING."

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.

The instant petition under 37 CFR 1.183 has been fully considered. On May 27, 2009, concurrently with the petition under 37 CFR 1.183, patent owner filed a response to the April 27, 2009 Action Closing Prosecution. Patent owner asserts that the May 27, 2009 response is 72 pages long, exclusive of pages numbered 2 and 3, which do not include arguments that would be counted toward the page limit.[1] Patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the May 27, 2009 response.

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the instant petition under 37 CFR 1.183. Further, in the petition under 1.183, patent owner has

[1] Petition under 1.183 at page 1. Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2).

substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts justifying an increase in the number of pages available for patent owner to respond to the April 27, 2009 Action Closing Prosecution.[2]

Based on the specific facts set forth in the petition under 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response, which is in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the portions of patent owner's May 27, 2009 response that are included in the regulatory page count exceed the 50-page limit by 22 pages.

Accordingly, patent owner's 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 22 pages of the portions of patent owner's May 27, 2009 response that are included in the regulatory page count exceed the 50-page limit.

THIRD PARTY REQUESTER

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments paper filed by third party requester in response to patent owner's response as set forth in this decision shall not exceed 72 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision granting patent owner's petition under 37 CFR 1.183 to file a comments paper pursuant to 37 CFR 1.947.[3]

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted to the extent that the page length of the May 27, 2009 patent owner "RESPONSE TO OFFICE ACTION IN AN INTER PARTES REEXAMINATION PROCEEDING" will be accepted.

2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 72 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision granting patent owner's petition under 37 CFR 1.183 to file a comment paper pursuant to 37 CFR 1.947.

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[2] *See* Petition under 1.183 at pages 2-5 (discussing such factors as the effective length of the Action Closing Prosecution and the number of claim rejections).

[3] *See* MPEP 2666.05(I).

3. Jurisdiction for the '344 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

Kenpet7
8-7-09

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,347	02/19/2008	7113152	346720000013	3327

49443 7590 11/18/2008

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York, NY 10036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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David L. Fehrman
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555 West Fifth Street, Suite 3500
Los Angeles, CA 90013

MAILED

NOV 18 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,347*.

PATENT NUMBER *7,113,152*.

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 Patent Owner)

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CHARLES A. BRILL
TEXAS INSTRUMENTS INCORPORATED
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DALLAS, TX 75265

(For 95/001,031 Requester)

MAILED

NOV 18 2008

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,348
Filed: February 19, 2008
For: U.S. Patent No. 7,113,152

Inter Partes Reexamination Proceeding
Control No. 95/000,347
Filed: February 19, 2008
For: U.S. Patent No. 7,113,152

Inter Partes Reexamination Proceeding
Control No. 95/001,031
Filed: March 11, 2008
For: U.S. Patent No. 7,113,152

DECISION GRANTING PETITION TO MERGE REEXAMINATION PROCEEDINGS

This is a decision on the third party requester petition entitled "Petition To Merge Multiple Copending Reexamination Proceedings Under M.P.E.P. § 2686.01(VI)" filed September 16, 2008 in *inter partes* Reexamination Control No. 95/000,348, requesting that the above-captioned reexamination proceedings be merged.

The petition is before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

The petition is granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,113,152 (the '152 patent) issued to Ben-David *et al.* on September 26, 2006.

2. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was filed on February 19, 2008, by third party requester Samsung Electronics Co., Ltd. (Samsung), and the request was assigned control number 95/000,348 (the '348 *inter partes* proceeding).

3. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was filed on February 19, 2008, by third party requester Mitsubishi Electric Corporation and Mitsubishi Digital Electronics America, Inc. (hereinafter, collectively identified as "third party requester Mitsubishi"), and the request was assigned control number 95/000,347 (the '347 *inter partes* proceeding).

4. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was initially deposited on February 14, 2008, by third party requester Texas Instruments Incorporated (Texas Instruments), and the request was assigned control number 95/001,031 (the '1031 *inter partes* proceeding) and subsequently received a filing date of March 11, 2008.

5. On May 2, 2008, *inter partes* reexamination was ordered in the '347 *inter partes* proceeding for claims 1-10 of the '152 patent, based on the examiner's determination that the February 19, 2008 request raised a substantial new question of patentability affecting these claims.

6. On May 10, 2008, *inter partes* reexamination was ordered in the '348 *inter partes* proceeding for claims 1-10 of the '152 patent, based on the examiner's determination that the February 19, 2008 request raised a substantial new question of patentability affecting these claims.

7. On May 14, 2008, *inter partes* reexamination was ordered in the '1031 *inter partes* proceeding for claims 1-10 of the '152 patent, based on the examiner's determination that the March 11, 2008 request raised a substantial new question of patentability affecting these claims.

8. On September 16, 2008, the instant petition was filed in the '348 *inter partes* proceeding by third party requester Samsung. The petition was re-filed on September 17, 2008.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three reexamination proceedings are currently pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

The petition filed September 16, 2008 in the '348 *inter partes* proceeding is granted.

In accordance with 37 CFR 1.989(a), the 95/000,348, 95/000,347, and 95/001,031 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in all three proceedings. The patent owner is required to continue to maintain the same claims (and specification) in each of the three files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is accordingly 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 all three proceedings. All papers issued by the Office, or filed by the patent owner and third party requesters Samsung, Mitsubishi , and Texas Instruments, will contain the identifying data for each file and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in triplicate, each bearing a signature and identifying data for each file, 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 third party requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all of the other parties (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All patent owner and requester 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 one of the *inter partes* reexamination requesters) 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. The petition requesting merger is granted.

2. *Inter partes* Reexamination Control No. 95/000,348, *inter partes* Reexamination Control No. 95/000,347, and *inter partes* Reexamination Control No. 95/001,031 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at 571-272-7727.

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

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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.
95/000,348	02/19/2008	7113152	31179.0005-US03	3362

49443 7590 11/18/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,348*.

PATENT NUMBER *7113152*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3992*.

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CHARLES A. BRILL
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DALLAS, TX 75265

(For 95/001,031 Requester)

MAILED

NOV 18 2008

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,348
Filed: February 19, 2008
For: U.S. Patent No. 7,113,152

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Control No. 95/000,347
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Inter Partes Reexamination Proceeding
Control No. 95/001,031
Filed: March 11, 2008
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The petition is before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

The petition is granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,113,152 (the '152 patent) issued to Ben-David *et al.* on September 26, 2006.

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3. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was filed on February 19, 2008, by third party requester Mitsubishi Electric Corporation and Mitsubishi Digital Electronics America, Inc. (hereinafter, collectively identified as "third party requester Mitsubishi"), and the request was assigned control number 95/000,347 (the '347 *inter partes* proceeding).

4. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was initially deposited on February 14, 2008, by third party requester Texas Instruments Incorporated (Texas Instruments), and the request was assigned control number 95/001,031 (the '1031 *inter partes* proceeding) and subsequently received a filing date of March 11, 2008.

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DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three reexamination proceedings are currently pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

The petition filed September 16, 2008 in the '348 *inter partes* proceeding is granted.

In accordance with 37 CFR 1.989(a), the 95/000,348, 95/000,347, and 95/001,031 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in all three proceedings. The patent owner is required to continue to maintain the same claims (and specification) in each of the three files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is accordingly governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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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
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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 third party requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all of the other parties (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All patent owner and requester 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 one of the *inter partes* reexamination requesters) 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. The petition requesting merger is granted.

2. *Inter partes* Reexamination Control No. 95/000,348, *inter partes* Reexamination Control No. 95/000,347, and *inter partes* Reexamination Control No. 95/001,031 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at 571-272-7727.

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.
95/000,351	02/21/2008	7,096,242	72037.00200.RE02	7268

43023 7590 07/02/2008

THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER, CO 80302

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2008

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)

Michael D. Bednarek
PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th Street, NW
Washington, DC 20005

MAILED

JUL 02 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,351*.

PATENT NUMBER *7,096,242*.

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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THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER CO 80302

(For Patent Owner)

MAILED

JUL 02 2008

CENTRAL REEXAMINATION UNIT

Michael D. Bednarek
PAUL, HASTINGS, JANOFSKY
& WALKER LLP
875 15TH STREET, NW
WASHINGTON, DC 20005

(For Third Party Requester)

DECISION DISMISSING PETITION
FOR EXTENSION OF TIME
(37 CFR § 1.956)
AND
PETITION FOR ADDITIONAL
PAGES
(37 CFR § 1.181 & § 1.943)

In re: Wilber
Inter partes Reexamination Proceeding
Control No. 95/000,351
Deposited: 21 February 2008
For: U.S. Patent No. 7,096,242

This is a decision on the 17 June 2008, patent owner petition titled "Request For Extension of Time Under 37 CFR § 1.956 and Petition for Additional Pages to Respond to Office Action."

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

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

DECISION

The petition is filed, together with authorization to charge the required petition fee of $200.00 as set forth in 37 CFR § 1.17 (g) required by 37 CFR § 1.956 for the extension of time and petition for additional pages filed under 37 CFR § 1.181 & § 1.943. This is the first request for a one-month extension of time and additional pages.

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. Since the petition contains two separate matters on which a decision is requested the petition fails to meet the requirements of 37 CFR § 1.4. Because the petitions do not meet these requirements the petition is hereby **dismissed.**

37 CFR § 1.4 Nature of correspondence and signature requirements.

"(a) Correspondence with the Patent and Trademark Office comprises:
(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents, orders for copies of records, transmission of assignments for recording, and the like, and
(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of ex parte reexaminations of patents in subpart D, §§ 1.501 to 1.570; of extension of patent term in subpart F, §§ 1.710 to 1.785; of inter partes reexaminations of patents in subpart H, §§ 1.902 to 1.997; and of the Board of Patent Appeals and Interferences in part 41 of this title.
(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, or other proceeding.
(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR § 1.181 Petition to the Director.

"(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.
(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
(e) Oral hearing will not be granted except when considered necessary by the Director.
(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions."

37 CFR § 1.943 Requirements of responses, written comments, and briefs in inter partes reexamination.

(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.

(c) 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 § 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. (Emphasis added.)

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

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...

Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. (Emphasis in the original.)

The patent owner requests a decision on a petition for extension of time under 37 CFR § 1.956. Likewise in the same petition the patent owner seeks relief from the page limit for response which is addressed under 37 CFR § 1.181 and § 1.943.

CONCLUSION

1. Patent owner's petition for an extension of time under 37 CFR § 1.956 in which to file a response to the Office action and to waive the page limit under 37 CFR § 1.181 & § 1.943 dated 17 June 2008 is hereby **dismissed**

2. The period for response remains as set two months from the date of the mailing of the Office action mailed 27 May 2008.

3. Patent owners page limit remains set at 50 pages under 37 CFR § 1.943.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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, alternatively where Mark Reinhart is unavailable, Eric Keasel, Supervisory Patent Examiner, Art Unit 3992, at 571-272-4929 may be contacted.

MARK J. REINHART
CRU SPE-AU 3992

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.
95/000,351	02/21/2008	7,096,242	72037.00200.RE02	7268

43023 7590 07/23/2008

THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER, CO 80302

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th STREET, N.W.
WASHINGTON, DC 20005

Date:
MAILED

JUL 23 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000351
PATENT NO. : 7096242
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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Thomas Swenson
1118 13th Street, A-5
Boulder Co 80302

(For Patent Owner)

MAILED

JUL 23 2008

CENTRAL REEXAMINATION UNIT

Michael D. Bednarek
Paul, Hastings, Janofsky & Walker LLP
875 15th Street, NW
Washington, DC 20005

(For Requester)

In re: Wilber
Interpartes Reexamination Proceeding
Control No. 95/000,351
Deposited: 21 February 2008
For: U.S. Patent No. 7,066,242

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 8, 2008 patent owner petition under 37 CFR 1.183 titled "PETITION FOR ADDITIONAL PAGES TO RESPOND TO OFFICE ACTION." The petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length, to the extent that 100 pages be permitted.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 7,096,242 (the '242 patent) issued August 22, 2006.

2. A request for reexamination of the '242 patent was filed on February 21, 2008. The request was assigned control No. 95/000,351 (the '351 reexamination proceeding).

3. Reexamination was ordered for the '351 proceeding on April 29, 2008.

4. A first Office action in the '352 proceeding was mailed on May 27, 2008.

5. On July 8, 2008, the patent owner filed the present petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed 50 pages in length.

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 May 27, 2008. Petitioner has supplemented the original petition by specifically stating how many additional pages, beyond the permitted 50-page length, petitioner is requesting to "fairly address" the Office action and its contents. Petitioner has requested a 100 page limit for the response to the Office action of May 27, 2008.

Upon consideration of the matter, it is noted that third party request for reexamination was 829 pages in length, and the non-final Office action was 101 pages in length. It is also noted that the Office action included a large number of rejections, and that the examiner incorporated from the request, into the Office action of May 27, 2008, some of the rejections proposed by the requester. Based upon the extent of the proposed rejections incorporated, the requested 100 pages is deemed equitable in addressing the Office action.

Accordingly, the petition is granted:

(A) For only the next immediate response to be supplied by the patent owner in response to the May 27, 2008 Office action, and

(B) To permit patent owner to provide as much as one hundred (100) pages for patent owner's response to the May 27, 2008 Office action. The Office will enforce compliance with this new page limit of 100 pages, and a strict review of the length of patent owner's response will be made upon its receipt. As such, petitioner is urged to use space efficiently and incorporate the request by reference where appropriate. Petitioner is reminded that any affidavits/declarations submitted should be objective, and that any argument made in an affidavit/declaration will count toward the one hundred (100) page limit.

It is also equitable in the instant case to permit the third party requester to provide as much as one hundred (100) pages in any comments that may be filed after patent owner's response to the May 27, 2008 Office action. Wavier of the 50 page limit for comments is only for the next immediate comments paper that may be supplied by the third party in response patent owner's response to the May 27, 2008 Office action.

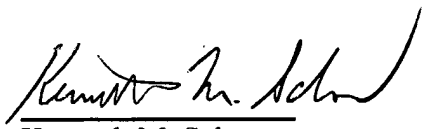
CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to permit a patent owner response to the May 27, 2008 first Office action not exceeding one hundred (100) pages in length.

2. Sua sponte waiver is also granted to the extent that the third party requester is also permitted to file comments not to exceed one hundred (100) pages in length after patent owner's response to the May 27, 2008 first Office Action.

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

4. Telephone inquiries with regard to this decision should be directed to the undersigned, Office of Patent Legal Administration, at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

7/22/08
C:\Kiva\Kenpet6\95_0351-1.183 waive response page limit + comments limit.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,351	02/21/2008	7,096,242	72037.00200.RE02	7268

43023 7590 08/07/2008

THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER, CO 80302

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/07/2008

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

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THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER CO 80302

(For Patent Owner)

MAILED

AUG 07 2008

CENTRAL REEXAMINATION UNIT

Michael D. Bednarek
PAUL, HASTINGS, JANOFSKY
& WALKER LLP
875 15TH STREET, NW
WASHINGTON, DC 20005

(For Third Party
Requester)

: DECISION GRANTING PETITION
: FOR EXTENSION OF TIME
: (37 CFR § 1.956)

In re: Wilber
Inter partes Reexamination Proceeding
Control No. 95/000,351
Deposited: 21 February 2008
For: U.S. Patent No. 7,096,242

This is a decision on the 8 July 2008, patent owner petition titled "Request For Extension of Time Under 37 CFR § 1.956."

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

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

DECISION

Patent Owner Has provided a statement of sufficient cause to justify granting a one-month extension of time. The petition for a one-month extension of time is filed, together with authorization to charge the required petition fee of $200.00 as set forth in 37 CFR § 1.17 (g) required by 37 CFR § 1.956 for the extension of time.

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. (Emphasis added.)

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. (Emphasis in the original.)

The Patent owner has set forth that based upon the extensive number of rejections, the length of the outstanding Office action and the short amount of time with which to respond as the reasons setting forth the sufficient cause for requesting the petition for extension of time. On balance, it is considered that the petition provides sufficient basis as to why an extension of time should be granted.

CONCLUSION

1. Patent owner's petition for a one-month extension of time in which to file a response to the Office action dated 27 May 2008 is hereby **granted**.

2. The period for response is hereby extended to **27 August 2008**.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,352	02/21/2008	6,763,364	72037.00200.RE01	7208

43023 7590 07/02/2008

THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER, CO 80302

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Michael D. Bednarek
PAUL, HASTINGS, JANOFSKY & WALKER, LLP
875 15th Street, N.W.
Washington, DC 20005

MAILED

JUL 02 2008

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,352*.

PATENT NUMBER *6,763,364*.

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
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THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER CO 80302

(For Patent Owner)

MAILED
JUN 02 2008
CENTRAL REEXAMINATION UNIT

Michael D. Bednarek
PAUL, HASTINGS, JANOFSKY
& WALKER LLP
875 15TH STREET, NW
WASHINGTON, DC 20005

(For Third Party Requester)

DECISION DISMISSING PETITION
FOR EXTENSION OF TIME
(37 CFR § 1.956)
AND
PETITION FOR ADDITIONAL
PAGES
(37 CFR § 1.181 & § 1.943)

In re: Wilber
Inter partes Reexamination Proceeding
Control No. 95/000,352
Deposited: 21 February 2008
For: U.S. Patent No. 6,763,364

This is a decision on the 17 June 2008, patent owner petition titled "Request For Extension of Time Under 37 CFR § 1.956 and Petition for Additional Pages to Respond to Office Action."

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

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

DECISION

The petition is filed, together with authorization to charge the required petition fee of $200.00 as set forth in 37 CFR § 1.17 (g) required by 37 CFR § 1.956 for the extension of time and petition for additional pages filed under 37 CFR § 1.181 & § 1.943. This is the first request for a one-month extension of time and additional pages.

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. Since the petition contains two separate matters on which a decision is requested the petition fails to meet the requirements of 37 CFR § 1.4. Because the petitions do not meet these requirements the petition is hereby **dismissed.**

37 CFR § 1.4 Nature of correspondence and signature requirements.

"(a) Correspondence with the Patent and Trademark Office comprises:
(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents, orders for copies of records, transmission of assignments for recording, and the like, and
(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of ex parte reexaminations of patents in subpart D, §§ 1.501 to 1.570; of extension of patent term in subpart F, §§ 1.710 to 1.785; of inter partes reexaminations of patents in subpart H, §§ 1.902 to 1.997; and of the Board of Patent Appeals and Interferences in part 41 of this title.
(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, or other proceeding.
(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR § 1.181 Petition to the Director.

"(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.
(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
(e) Oral hearing will not be granted except when considered necessary by the Director.
(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions."

37 CFR § 1.943 Requirements of responses, written comments, and briefs in inter partes reexamination.

(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.

(c) 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 § 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. (Emphasis added.)

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. (Emphasis in the original.)

The patent owner requests a decision on a petition for extension of time under 37 CFR § 1.956. Likewise in the same petition the patent owner seeks relief from the page limit for response which is addressed under 37 CFR § 1.181 and § 1.943.

CONCLUSION

1. Patent owner's petition for an extension of time under 37 CFR § 1.956 in which to file a response to the Office action and to waive the page limit under 37 CFR § 1.181 & § 1.943 dated 17 June 2008 is hereby **dismissed**

2. The period for response remains as set two months from the date of the mailing of the Office action mailed 27 May 2008.

3. Patent owners page limit remains set at 50 pages under 37 CFR § 1.943.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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, alternatively where Mark Reinhart is unavailable, Eric Keasel, Supervisory Patent Examiner, Art Unit 3992, at 571-272-4929 may be contacted.

MARK J. REINHART
CRU SPE-AU 3992

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,352	02/21/2008	6,763,364	72037.00200.RE01	7208

43023 7590 07/23/2008

THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER, CO 80302

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MICHAEL D. BEDNAREK
PAUL,HASTINGS,JANOFSKY & WALKER LLP
875 15th STREET, N.W.
WASHINGTON, DC 20005

Date:
MAILED

JUL 23 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000352
PATENT NO. : 6763364
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas Swenson
1118 13th Street, A-5
Boulder Co 80302

(For Patent Owner)

MAILED

JUL 23 2008

CENTRAL REEXAMINATION UNIT

Michael D. Bednarek
Paul, Hastings, Janofsky & Walker LLP
875 15th Street, NW
Washington, DC 20005

(For Requester)

In re: Wilber
Interpartes Reexamination Proceeding
Control No. 95/000,352
Deposited: 21 February 2008
For: U.S. Patent No. 6,763,364

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 8, 2008 patent owner petition under 37 CFR 1.183 titled "PETITION FOR ADDITIONAL PAGES TO RESPONDE TO OFFICE ACTION" The petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length, to the extent that 100 pages be permitted.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,763,364 (the '364 patent) issued on July 13, 2004.

2. A request for reexamination of the '364 patent was filed on February 21, 2008. The request was assigned control No. 95/000,352 (the '352 reexamination proceeding).

3. Reexamination was ordered for the '352 proceeding on May 2, 2008.

4. A first Office action in the '352 proceeding was mailed on May 27, 2008.

5. On July 8, 2008, the patent owner filed the present petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed 50 pages in length.

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 May 27, 2008. Petitioner has supplemented the original petition by specifically stating how many additional pages, beyond the permitted 50-page length, petitioner is requesting to "fairly address" the Office action and its contents. Petitioner has requested a 100 page limit for the response to the Office action of May 27, 2008.

Upon consideration of the matter, it is noted that the third party request for reexamination approximately 800 pages in length, and the non-final Office action was 139 pages in length. It is also noted that the Office action included a large number of rejections, and that the examiner incorporated from the request, into the Office action of May 27, 2008, some of the rejections proposed by the requester. Based upon the extent of the proposed rejections incorporated, the requested 100 pages is deemed equitable in addressing the Office action. Accordingly, the petition is granted:

(A) For only the next immediate response to be supplied by the patent owner in response to the May 27, 2008 Office action, and

(B) To permit patent owner to provide as much as one hundred (100) pages for patent owner's response to the May 27, 2008 Office action. The Office will enforce compliance with this new page limit of 100 pages, and a strict review of the length of patent owner's response will be made upon its receipt. As such, petitioner is urged to use space efficiently and incorporate the request by reference where appropriate. Petitioner is reminded that any affidavits/declarations submitted should be objective, and that any argument made in an affidavit/declaration will count toward the one hundred (100) page limit.

It is also equitable in the instant case to permit the third party requester to provide as much as one hundred (100) pages in any comments that may be filed after patent owner's response to the May 27, 2008 Office action. Wavier of the 50 page limit for comments is only for the next immediate comments paper that may be supplied by the third party in response patent owner's response to the May 27, 2008 Office action.

CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to permit a patent owner response to the May 27, 2008 first Office action not exceeding one hundred (100) pages in length.

2. Sua sponte waiver is also granted to the extent that the third party requester is also permitted to file comments not to exceed one hundred (100) pages in length after patent owner's response to the May 27, 2008 first Office Action.

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

4. Telephone inquiries with regard to this decision should be directed to the undersigned, Office of Patent Legal Administration, at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

7/22/08
C:\Kiva\Kenpet6\95_0352-1.183 waive response page limit + comments limit.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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,352	02/21/2008	6,763,364	72037.00200.RE01	7208

43023 7590 08/07/2008

THOMAS SWENSON
1118 13TH STREET, A-5
BOULDER, CO 80302

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/07/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THOMAS SWENSON : (For Patent Owner)
1118 13TH STREET, A-5 :
BOULDER CO 80302 :

MAILED
AUG 07 2008
CENTRAL REEXAMINATION UNIT

Michael D. Bednarek :
PAUL, HASTINGS, JANOFSKY : (For Third Party
& WALKER LLP : Requester)
875 15TH STREET, NW :
WASHINGTON, DC 20005 :

: DECISION GRANTING PETITION
: FOR EXTENSION OF TIME
: (37 CFR § 1.956)

In re: Wilber :
Inter partes Reexamination Proceeding :
Control No. 95/000,352 :
Deposited: 21 February 2008 :
For: U.S. Patent No. 6,763,364 :

This is a decision on the 8 July 2008, patent owner petition titled "Request For Extension of Time Under 37 CFR § 1.956."

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

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

DECISION

Patent Owner Has provided a statement of sufficient cause to justify granting a one-month extension of time. The petition for a one-month extension of time is filed, together with authorization to charge the required petition fee of $200.00 as set forth in 37 CFR § 1.17 (g) required by 37 CFR § 1.956 for the extension of time.

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. (Emphasis added.)

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. (Emphasis in the original.)

The Patent owner has set forth that based upon the extensive number of rejections, complexity of the technology, and the length of the outstanding Office action and the short amount of time with which to respond as the reasons setting forth the sufficient cause for requesting the petition for extension of time. On balance, it is considered that the petition provides sufficient basis as to why an extension of time should be granted.

CONCLUSION

1. Patent owner's petition for a one-month extension of time in which to file a response to the Office action dated 27 May 2008 is hereby **granted**.

2. The period for response is hereby extended to **27 August 2008**.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992
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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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

7590 06/13/2008

EXAMINER	
ART UNIT	PAPER NUMBER

MANELLI DENISON & SELTER PLLC
7TH FLOOR
2000 M STREET, NW
WASHINGTON, DC 20036-3307

DATE MAILED: 06/13/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

MAILED

JUN 13 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William H. Bollman, Esq.
Manelli Denison & Selter PLLC
7th Floor
2000 M Street, N.W.
Washington, D.C. 20036-3307

(For Patent Owner)

MAILED

JUN 13 2008

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

(For Third Party Requester)

In re Chris Knotts :
Inter partes Reexamination Proceeding : **DECISION**
Control No: 95/000,353 : **GRANTING**
Filing Date: February 29, 2008 : **PETITION**
For: U.S. Patent No.: 6,985,748 :

This is a decision on the third party requester petition filed on June 12, 2008, entitled "Petition Under 37 CFR §§§ 1.181, 1.182, and 1.183."

The petition papers are before the Office of Patent Legal Administration for consideration. The fee for the petition under 37 CFR 1.17(f) of $400 has been paid.

The third party requester's petition under 37 CFR 1.183 for suspension of 37 CFR 1.939 regarding filing of papers prior to initial Office action is granted, for the limited extent of consideration of the present petition.

The third party requester's petition under 37 CFR 1.181 and 1.182 for the Director to *temporarily seal* the entire Information Disclosure Statement and attached 56 page form PTO-1449 form listing 499 references from the litigation (identified below) submitted May 29, 2008 by patent owner is granted to allow time for review of the submitted documents by the third party requester, Sybase, in order to honor the December 6, 2006 Protective Order in the concurrent litigation before the U.S. District Court for the Eastern District of Virginia, 3:06CV485.

BACKGROUND

1. Patent number 6,985,748 (the '748 patent) issued on January 10, 2006, with claims 1-19.

2. The '748 patent is the subject of a concurrent proceeding styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia 3:06CV485.

3. On February 29, 2008, a third party, Sybase, Inc., filed a request for *inter partes* reexamination of claims 1-19 that was assigned control no. 95/000,353 (the '353 proceeding).

4. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

5. On May 28, 2008, patent owner filed a petition under 37 CFR §§ 1.987, 1.181, 1.182, 1.183, and 1.907(b) to terminate or suspend the '353 proceeding. A decision on the petition is pending.

6. On May 29, 2008, three separate Information Disclosure Statements (IDSs) were filed including an IDS with a 1 page form PTO-1449, an IDS with a 38 page form PTO-1449, and an IDS with a 56 page form PTO-1449.

7. On June 12, 2008, the third party requester filed the present petition directed only to the IDS filed on May 29, 2008 including the 56 page form PTO-1449. The IDS and attached form and documents have not yet been scanned into the Image File Wrapper (IFW) data base of the Office.

DECISION

I. Pertinent Regulations

37 CFR § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ **1.111**) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR § 1.182 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 § 1.939 Unauthorized papers in *inter partes* reexamination

(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.

II. Decision

Consideration of Third Party Petition Prior to First Office Action

No paper shall be filed prior to the initial Office action on the merits in an *inter partes* reexamination, unless otherwise authorized. Unauthorized papers will not be considered and may be returned. See 37 CFR 1.939. In this case, the third party requester requests that this requirement be suspended because of an extraordinary situation created by the filing of an IDS by the patent owner that may expose information, subject to a protective order from the U.S. District Court for the Eastern District of Virginia, to unauthorized parties.

Due to the potential imminent disclosure of such information to the public by entry into the public record of the '353 proceeding, an urgent situation has been created that requires temporary suspension of Rule 939 so that this third party petition may be considered. In view of the presence of the court's protective order, justice requires that Rule 1.939 be suspended in this instance to permit the Office to consider the June 12, 2008 petition. The request under Rule 1.183 is granted.

Provisional Sealing of the May 29, 2008 IDS including 56 Pages of Form PTO-1449

The June 12, 2008 petition asserts that certain materials included in the IDS with the 56 page form PTO-1449 are confidential and therefore subject to the protective order. A brief review of the court documents confirms that several of the documents noted in the petition have been sealed by the court. Therefore, in the interest of honoring the court's protective order, the request that the IDS at issue be temporarily sealed is provisionally granted until a determination regarding compliance with the protective order can be made. The request under Rules 1.181 and 1.182 is granted.

The third party requester is given a period of **fifteen (15) days** to present a petition identifying the materials subject to the court's protective order and detailed evidence that disclosure of the materials in the IDS at issue would violate the court's protective order.[1] Patent owner will be permitted to file an opposition to such a petition within **fifteen (15) days** of service of any petition filed by the third party. At that time, a decision will be made regarding whether the IDS at issue will be permanently removed from the file record or sealed.

Permission For Third Party to File Petition and For Patent Owner to File Opposition

This decision also *sua sponte* waives Rule 1.939 to permit the filing of the following papers prior to the first Office action: (1) the third party petition that may be filed within the time period set herein with the showing that the IDS must be permanently sealed or redacted in view of the protective order, and (2) a patent owner opposition filed in response to such petition within the time period set herein.

CONCLUSION

1. The third party requester petition under Rule 1.183 filed on June 12, 2008, is granted to the extent that the June 12, 2008 petition has been considered.

2. The third party requester petition under Rules 1.181 and 1.182 filed on June 12, 2008, is granted and the May 29, 2008 IDS including the 56 page form PTO-1449 is **provisionally sealed** (by not scanning the papers into the IFW system) pending a final determination regarding the confidential nature of the materials and their applicability under the court's protective order.

3. The third party requester is granted a period of **fifteen (15) days** from the mail date of this decision to file a detailed petition to request that the IDS at issue be permanently sealed or appropriately redacted. The papers will remain inaccessible to the public until a final

[1] Petitioner contends that "***Submission to the USPTO for inclusion in the publicly accessible file wrapper is not permitted without written agreement by Sybase or by Order of the Court.*** *See* Exhibit A, pp. 4-6." (Emphasis in original) Review of the cited portion of Exhibit A does not make this claim evident. This matter should be clearly addressed in the petition to be filed.

determination is made. If a petition is not filed within the time period, the provisional seal of the IDS will be lifted, and the papers will be scanned into the IFW system and made publicly available.

4. The patent owner is granted a period of **fifteen (15) days** from the date of service of the third party requester's petition permitted above (item 3) to file an opposition.

5. Jurisdiction over the proceeding will remain with the Office of Patent Legal Administration until a final determination is made regarding the IDS at issue or until the time period above expires if the third party requester fails to timely file the petition permitted above (item 3).

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729, or in her absence, Pinchus Laufer, Legal Advisor, at (571) 272-7726.

Kenneth M. Schor

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Senior Legal Advisor
Office of Patent Legal Administration

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6-13-08

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MAILED

AUG 18 2008

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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(For Third Party Requester)

In re Chris Knotts :
Inter partes Reexamination Proceeding :
Control No: 95/000,353 : **DECISION DISMISSING**
Filing Date: February 29, 2008 : **PETITION TO PROTECT**
For: U.S. Patent No.: 6,985,748 : **CONFIDENTIAL DOCUMENTS**

This is a decision on the third party requester's petition filed on June 30, 2008, entitled 'Petition Under 37 C.F.R. §§ 1.181 or 1.182 to Protect Sybase and Third Party Confidential Documents Filed in Violation of the District Court Protective Order' (the "Petition"). In addition, patent owner filed a response July 3, 2008, entitled 'Petition to the Director Pursuant to 37 CFR § 1.987, § 1.181, § 1.182, § 1.183 and § 1.907(b) and MPEP §2686.04(V) for Patent Owner Response to the Patent and Trademark Office June 13, 2008 Decision and Sybase's Petition: (1) To Seal 56 Alleged "Prior Art" Documents Filed in this Reexamination Which Sybase Asserts are Confidential, and (2) To Strike All 56 Allegedly "Confidential" Documents From the Record of this Reexamination Because "Confidential" Information Cannot Constitute Statutory "Prior Art" ' (the "Opposition").

The Petition, the Opposition, and *inter partes* reexamination control number 95/000,353 are before the Office of Patent Legal Administration for consideration. The fee for the petition under 37 CFR 1.17(f) of $400 has been paid.

The petition is dismissed because the filing does not appropriately respond to the Decision mailed June 13, 2008. **The third party requester is provided an opportunity to make a satisfactory showing prior to conclusion of the proceeding that the IDS at issue should be sealed; any such paper must be limited to the showing.** The patent owner will be permitted to respond accordingly to any responsive third party requester submission, as explained below.

BACKGROUND

1. Patent number 6,985,748 (the '748 patent) issued on January 10, 2006, with claims 1-19.

2. The '748 patent is the subject of a concurrent proceeding styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia 3:06CV485. The action is still listed in the court as "open."

3. On February 29, 2008, a third party, Sybase, Inc. (now owner of Mobile 365), filed a request for *inter partes* reexamination of claims 1-19 that was assigned control no. 95/000,353 (the '353 proceeding).

4. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

5. On May 28, 2008, patent owner filed a petition under 37 CFR §§ 1.987, 1.181, 1.182, 1.183, and 1.907(b) to terminate or suspend the '353 proceeding. A decision on the May 28th petition to suspend will be mailed separately.

6. On May 29, 2008, three separate Information Disclosure Statements (IDSs) were filed by the patent owner including an IDS with a 1 page form PTO-1449, an IDS with a 38 page form PTO-1449, and an IDS with a 56 page form PTO-1449.

7. On June 12, 2008, the third party requester filed a petition directed to the IDS filed on May 29, 2008 that includes the 56 page form PTO-1449 requesting that the submission be sealed, as it is subject to a court protective order. That IDS and attached form and documents have not been scanned into the Image File Wrapper (IFW) data base of the Office.

8. A Decision was mailed on June 13, 2008, by the Office granting the June 12, 2008 third party petition to the extent that the May 29, 2008, Information Disclosure Statement and attached 56 page form PTO-1449 was temporarily sealed. The Decision required the third party to respond with a petition identifying the materials subject to the protective order and to provide detailed evidence that disclosure of the materials would violate the court's order. Patent owner was granted permission to file an opposition in response to such a third party petition, if filed.

9. On June 20, 2008, the third party requester filed an opposition to the patent owner's May 28 petition to suspend. The merits of the third party opposition arguments will be treated in the corresponding decision for the May 28 petition to suspend.

10. On June 24, 2008, the patent owner filed a reply in support of its May 28 petition to suspend, which is treated as a supplemental petition that asserts new facts introduced by the third party's June 12 petition to seal the IDS that bear on the issue raised in patent owner's May 28 petition. The reply will be treated in the corresponding decision for the May 28 petition to suspend.

11. On June 30, 2008, the third party requester filed this petition in response to the Office's June 13, 2008, Decision. This requester's petition is the subject of the present decision.

12. On July 3, 2008, the patent owner filed an opposition to the third party's June 30, 2008 petition. The patent owner's opposition is treated herein.

DECISION

I. Pertinent Regulations

37 CFR § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ **1.111**) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR § 1.182 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).

II. Findings and Analysis

Third Party Requester Petition

1. The third party requester filed a petition on June 12, 2008 asserting that certain materials included in the IDS filed May 29, 2008, that included a 56 page form PTO-1449, are confidential and therefore subject to the protective order issued in the corresponding district court litigation. A brief review of the court documents confirmed that several of the documents noted in the petition have been sealed by the court. In the interest of honoring the court's protective order, the Office issued the Decision of June 13, 2008, provisionally granting the request that the IDS at issue be temporarily sealed until a determination regarding compliance with the protective order could be made. The third party requester was provided the opportunity to present a petition **identifying the materials** subject to the court's protective order with **detailed evidence** that disclosure of the materials in the IDS at issue would violate the court's protective order. The Decision also called upon the petitioner to provide **support for the contention** that submission of materials to the USPTO for inclusion in the publicly accessible file wrapper is not permitted without written agreement by Sybase or by Order of the Court.

The third party requester petition filed June 30, 2008, in response to the June 13, 2008 Decision, does not appropriately respond to the decision. Instead, the third party requester broadly states that the filing of each of the documents was a violation of the protective order and indicates that the documents have been reviewed to determine which may be material to the patentability of the claims. Accordingly, requester has not addressed what was called for in the June 13, 2008 Decision.

2. The third party requester additionally has submitted a box of documents allegedly corresponding to certain documents submitted by the patent owner in the IDS at issue. The documents have not been entered into the file. The petition goes into great detail regarding the duty of disclosure and the definitions of the various levels of confidentiality, but completely fails to respond to the specific requests made in the June 13, 2008 Decision.

It is to be noted that while a patent owner has a duty to disclose information that it deems material to the patentability and the examiner is called upon to be the arbiter of whether particular information is material, the third party requester has no right to address whether information submitted by the patent owner in an Information Disclosure Statement is material. The third party requester in an *inter partes* reexamination proceeding has participation rights that are strictly limited to patentability based on prior art patents and printed publications. Comments in general on matters outside the scope of reexamination are not entitled to entry in the record, and comments in particular by the third party requester beyond those permitted by the rules are not entitled to entry in the record. However, as the requester petition paper of June 30 does not substantively address the materiality of the listed documents, the petition will remain in the file. Rather, the designation of materiality by the requester will simply not be considered.

In addition, the submission of prior art documents by third-party requester after the inception of an *inter partes* reexamination is prohibited unless it conforms with 37 CFR 1.948. That regulation only permits prior art submissions by requester, subject to further conditions, as part of requester comments under 37 C.F.R. 1.947 or 1.951(b). The sealed documents submitted by

the requester on June 30, 2008, do not meet the requirements of rule 1.948, and accordingly will not be entered into the file.

3. Upon further consideration of the matter at hand, the information of the May 29, 2008 IDS that included a 56 page form PTO-1449 will remain provisionally sealed until the proceeding is ready for conclusion. During that time, the third party requester will have an opportunity to (1) identify which information/documents submitted with the IDS is subject to the protective order, (2) provide detailed evidence that disclosure of the information/documents in the IDS at issue would violate the court's protective order, and (3) explain the submissions of (1) and (2). This period of time that extends until the conclusion of the proceeding will provide requester with time to approach the court and obtain an order of the court as to which information submitted with the IDS is subject to the protective order. Failure to respond to each of these three items **will result in the opening of the materials to the public at the conclusion of the proceeding.** On the other hand, as to the information established as protected, then only such information determined to be material to patentability will be opened to the public. This will be discussed further in the next section of this decision.

Patent Owner Reply

1. Patent owner replied to the third party requester's petition and asserts that none of the documents "about which the third party requester complains" (presumably that is the entire IDS submission at issue) are entitled to be treated as "confidential." The patent owner states that the third party requester gave up entitlement to continued secrecy for documents relating to patentability by initiating this *inter partes* reexamination proceeding. No legal authority to support this assertion has been provided. Patent owner is called upon to provide evidence that the filing of the request affects the confidentiality of the documents covered under the protective order. The patent owner requests that an order be entered holding that the identified documents do not qualify as prior art. The patent owner's requests are dismissed. Again, no legal authority has been provided for supporting the assertion that maintaining an IDS submission sealed from the public disqualifies information as prior art.

2. It is noted that MPEP 724 addresses situations in which parties to Office proceedings have submitted trade secret, proprietary, and/or protective order materials. In this case, the requester asserts that certain materials submitted by patent owner are covered by the district court's protective order. Even if the requester does not respond as above provided, the patent owner can identify materials by as being covered by the protective order. If so, patent owner can petition to retain sealed the documents that are covered by the protective order, and expunge them under 37 CFR 1.59 at the conclusion of the proceeding. In accordance with MPEP 724.04(c), protected material will remain sealed from public view until a determination is made as to whether it is material to patentability. If it is not material to patentability it may be expunged by a proper petition. If it is material to patentability it will be opened to the public, but may be made available in a redacted form, if appropriate and if requested by a grantable petition.

3. In the event that less than all of the materials that were submitted in the subject IDS are identified by patent owner as being covered by the protective order, the following requirement is made. A substitute filing must be made by the patent owner to replace the IDS at issue, as it is

not administratively reasonable to require the Office to sort and identify which documents of the 499 documents submitted require special handling and whiled ensuring that inadvertent opening of confidential material to the public is avoided. In that case, the submission must be sorted and separately submitted as follows: (1) documents that are not to be sealed and may be entered for public access and (2) documents that are covered by the protective order and must be sealed from the public in separate sealed and appropriately labeled envelopes with a transmittal as set forth in MPEP 724.02. A petition to expunge under 37 CFR 1.59, as set forth in MPEP 724.04(c), should be filed with any documents that are to be sealed. Additionally, if desired, a redacted version of protected documents and a petition under 37 CFR 1.182, as set forth in MPEP 724.04(c), may be filed with any documents to be sealed. **If these requirements are not met, all of the documents will be entered into the file and made available to the public.**

Permission For Third Party to File Petition and For Patent Owner to File Opposition

To the extent that this decision requires, Rule 1.939 continues to be waived only to permit the filing of the following papers prior to the first Office action: (1) the third party petition that may be filed prior to conclusion of the proceeding with the required showings noted above, and (2) a patent owner opposition filed in response to such petition with the appropriate showings noted above within the time period set herein.

In view of the third party requester's failure to appropriately respond to the June 13 Decision, the petition is dismissed.

CONCLUSION

1. The third party requester petition filed on June 30, 2008, is dismissed. The July 3, 2008 patent owner reply has been considered in rendering this decision and the requests made therein are dismissed.

2. The third party requester is granted an opportunity to file, prior to conclusion of this proceeding, a detailed petition to identify which documents in the IDS at issue should be permanently sealed, the reasons that they are subject to the protective order, and evidence that the patent owner must obtain written permission or a court order to file the documents. **If no petition is filed within that time period, the IDS documents will be entered into the file and laid open to the public, unless the patent owner takes the action set forth above.**

3. The patent owner is granted **fifteen (15) days** from the date of service of the third party requester's petition permitted above (item 2) to file an opposition with the proper resubmissions if appropriate.

4. The third party requester may make arrangements to retrieve the materials submitted on June 30, 2008 from the Office within the next thirty (30) days. If no arrangements are made, the Office will dispose of the materials.

5. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729, or in her absence, Pinchus Laufer, Legal Advisor, at (571) 272-7726.

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

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Chris Knotts :
Inter partes Reexamination Proceeding :
Control No: 95/000,353 : **DECISION DISMISSING**
Filing Date: February 29, 2008 : **PETITION TO TERMINATE**
For: U.S. Patent No.: 6,985,748 : **OR SUSPEND PROCEEDING**

This is a decision on the patent owner petition filed on May 28, 2008, entitled "Petition To the Director Pursuant to 37 C.F.R. § 1.987, § 1.181, § 1.182, § 1.183 and § 1.907(b) and MPEP § 2686.04(V) to Terminate the *Inter Partes* Reexamination or to Suspend the *Inter Partes* Reexamination Pending Appeal of the Jury Verdict of Infringement Entered Over a Year Ago" (the "Petition".) In addition, third party requester filed a paper on June 24, 2008 entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate or to Suspend the *Inter Partes* Reexamination (the "Opposition") and patent owner's supplemental petition filed June 24, 2008 (the "Supplemental petition").

The Petition, Opposition, Supplemental petition, and *inter partes* reexamination control number 95/000,353 are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted. The fee for the petition under 37 CFR 1.17(f) of $400 has been paid.

The patent owner's petition is dismissed for the reasons below, and reexamination will proceed with special dispatch.

BACKGROUND

1. Patent number 6,985;748 (the '748 patent) issued on January 10, 2006, with claims 1-19.

2. The '748 patent is the subject of a concurrent proceeding styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia 3:06CV485. The action is still listed in the court as "open."

3. On February 29, 2008, a third party, Sybase, Inc. (now owner of Mobile 365), filed a request for *inter partes* reexamination of claims 1-19 that was assigned control no. 95/000,353 (the '353 proceeding).

4. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

5. On May 28, 2008, patent owner filed a petition under 37 CFR §§ 1.987, 1.181, 1.182, 1.183, and 1.907(b) to terminate or suspend the '353 proceeding. This petition is the subject of the present decision.

6. On May 29, 2008, three separate Information Disclosure Statements (IDSs) were filed by the patent owner including an IDS with a 1 page form PTO-1449, an IDS with a 38 page form PTO-1449, and an IDS with a 56 page form PTO-1449.

7. On June 12, 2008, the third party requester filed a petition directed to the IDS filed on May 29, 2008 that includes the 56 page form PTO-1449 requesting that the submission be sealed, as it is subject to a court protective order. That IDS and attached form and documents have not been scanned into the Image File Wrapper (IFW) data base of the Office.

8. A Decision was mailed on June 13, 2008, by the Office granting the June 12, 2008 third party petition to the extent that the May 29, 2008, Information Disclosure Statement and attached 56 page form PTO-1449 was temporarily sealed. The Decision required the third party to respond with a petition identifying the materials subject to the protective order and to provide detailed evidence that disclosure of the materials would violate the court's order. Patent owner was granted permission to file opposition papers in response to any such third party petition.

9. On June 20, 2008, the third party requester filed an opposition to the patent owner's May 28 petition for suspension of the '353 proceeding. The merits of the third party opposition arguments are considered and treated herein.

10. On June 24, 2008, the patent owner filed a reply in support of its May 28 petition to suspend, which is being treated herein as a supplemental petition that asserts *new facts* introduced by the third party's June 12 petition requesting that the IDS be sealed that bear on the issue raised in patent owner's May 28 petition to suspend. The reply is addressed herein.

11. On June 30, 2008, the third party filed a petition in response to the Office's June 13, 2008 Decision.

12. On July 3, 2008, the patent owner filed a reply to the third party's June 30, 2008 petition. A Decision on the June 30 petition and July 3 reply addressing the IDS materials and protective order will be mailed separately.

DECISION

I. Pertinent Regulations

37 CFR § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ **1.111**) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR § 1.182 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).

35 U.S.C. 317 Inter partes reexamination prohibited

(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 § 1.907 Inter partes reexamination prohibited.

(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 § 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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 § 1.937 Conduct of inter partes reexamination.

(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.

(c) All communications between the Office and the parties to the inter partes reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

II. Findings and Analysis

Pursuant to 37 CFR 1.985, patent owner has advised the Office of a concurrent proceeding addressing the '748 patent, being conducted in the U.S. District Court for the Eastern District of Virginia. Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of an appeal to the U.S. Court of Appeals for the Federal Circuit (hereinafter, the Federal Circuit) in relation to the concurrent proceeding. In the district court proceeding, a jury verdict found that Mobile 365 (now owned by the third party requester) willfully infringed claims 1, 3-6, 9-14 and 17-19 of the '748 patent and failed to prove invalidity of these claims. The district court ordered a permanent injunction against Mobile 365, which has been stayed pending appeal to the Federal Circuit. The patent owner has not specifically averred that an appeal to the Federal Circuit has already been filed. The action at the district court remains open with several outstanding motions to be decided, including a motion for judgment as a matter of law or, in the alternative, a new trial. **Patent owner is called upon to update the status of the concurrent proceeding in Eastern District of Virginia and at the Federal Circuit, if in existence.**

In *Ethicon v. Quigg*[1] the Federal Circuit addressed the propriety of the Office suspending reexamination proceedings. The court considered whether the Commissioner had "authority to stay reexamination pending the outcome of district court litigation."[2]

The Federal circuit held that an indefinite suspension, granted under the authority of 37 CFR 1.565(b) was not consistent with the statutory requirement of 35 U.S.C. 305 of conducting reexamination proceedings in the Office with special dispatch.

> "Special dispatch" is not defined in the statute. However, "a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." *Perrin v. United States, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see LSI Computer Systems, Inc. v. United States Int'l Trade Comm'n, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed.Cir. 1987).* According to Webster's New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that "reexamination proceedings will be 'special' throughout their pendency" in the office, and provides for an accelerated schedule. MPEP § 2261. ***Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation.*** If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none. [Emphasis added] *(Ethicon, at 1426.)*

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[1] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*
[2] *Id. at 1425*

Petitioner has requested an indefinite suspension in this *inter partes* reexamination proceeding, which also must be conducted with special dispatch in the same manner as *ex parte* reexamination proceedings. The *inter partes* reexamination statute (35 U.S.C. 314(c)) does provide an exception to the special dispatch mandate where "otherwise provided by the Director for good cause"; thus, a suspension may be granted for "good cause." In the present case, however, good cause has not been shown; accordingly, the requested relief will not be granted.

Patent owner argues that the third party request for *inter partes* reexamination is an unfair tactical attempt to delay the completion of the lawsuit rather than a good faith assertion of invalidity based on meaningful prior art that could not have been asserted at trial. Patent owner asserts that termination or suspension of this proceeding is proper because the reexamination request was filed nearly two years after suit was filed for infringement of the '748 patent and almost one year after a jury verdict. Additionally, patent owner requests that the district court jury verdict and permanent injunction (presently stayed) should be considered by the Office as a "final" decision and should further be considered a decision that has estoppel effect. Patent owner finally argues that the district court will not likely stay the lawsuit pending completion of this reexamination proceeding.

There has been no final decision on all of the claims under reexamination. A final decision comes into being after all appeals have been exhausted. The patent owner states in the petition that there is an appeal at the Federal Circuit relating to the permanent injunction. Moreover, as noted above, an appeal to the Federal Circuit of the issues directly relating to the validity of the claims has not been identified by patent owner. Further, it appears that the district court action has not concluded. As such, a final decision by the Federal Circuit that would bear on the validity of claims 1, 3-6, 9-14, and 17-19 of the '748 patent is far off in the future. Even further, any final decision that could be rendered by the Federal Circuit would not bear on all of the claims that are under reexamination in this proceeding, which include claims 1-19 of the '748 patent. Regardless of the outcome of a Federal Circuit appeal pertaining to claims 1, 3-6, 9-14, and 17-19, reexamination will continue for claims 2, 7, 8, 15, and 16.

Good cause for suspension has not been shown. For *inter partes* reexamination, 35 USC 314 states: "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." Good cause has not been shown as to why this proceeding should not be conducted with special dispatch in accordance with § 314. The related court decision is not **final** and does not involve **all** of the claims for which reexamination has been ordered. As the court proceeding has not resulted in a final decision, no estoppel can attach that bars the third party from making an *inter partes* reexamination request or mandates termination of the proceeding. And, as pointed out above, a final decision by the Federal Circuit that would bear on the validity of claims 1, 3-6, 9-14, and 17-19 of the '748 patent is far off in the future. In addition, estoppel cannot attach to the claims that were not subject to the litigation. Thus, the proceeding must go forward regardless of the outcome of any appeal, and there is no good cause to suspend it.

Stated another way, the fact that estoppel could attach as to some of the patent claims at some uncertain point in the future, as argued by patent owner, is not a sufficient showing of good cause for suspension. Further, the likelihood that the district court will stay the lawsuit is not

relevant to this proceeding. Patent owner compares the facts of this situation to those in *Sony Computer Entertainment America, Inc. v. Dudas*, 2006 WL 1472462 (E.D. Va. 2006) in support of showing good cause for suspending these proceedings. However, the facts in *Sony* are distinguishable from this proceeding. In *Sony*, reexamination was limited to the claims that were being litigated, unlike this proceeding. Further, a final decision was on the horizon in the *Sony* fact situation, which is not the case here.

In opposition, the third party also asserts that this proceeding raises a substantial number of new art/issues that were not raised and could not have been raised during the district court litigation. In the request for reexamination, the third party requester identifies twenty eight prior art references that form the basis of substantial new questions of patentability. The order for reexamination in the '353 proceeding identifies twenty two substantial new questions of patentability using these prior art references. In the opposition, the third party admits to previously knowing of only two of the twenty eight references, while the patent owner's supplemental response (discussed below) asserts that the third party should have known of an additional seven of the twenty eight prior art references. The patent owner does not identify with specificity which substantial new questions of patentability in the request or order were allegedly known or should have been known to the third party. Thus, the requester's assertions that new issues are raised, and that at least nineteen new prior art references are identified in the request, has not been rebutted (in either the original or supplemental petitions, or the record as a whole). Moreover, a final court decision has not been rendered, and estoppel has not attached to the claims at dispute in the litigation, nor is a final court decision expected in the near future.

The patent owner supplements the arguments with the June 24, 2008 filing. The patent owner asserts that the third party has "taken control over the ability of the patent owner to disclose prior art and information that the patent owner is obligated, and in fact is required, to file in Information Disclosure Statements." Based on this assertion, patent owner urges that this proceeding should be suspended for good cause. (The information at issue has been designated as confidential by the third party and is the subject of a concurrent petition, which will have a decision rendered under separate cover.)

In response, it is pointed out that patent owner has not been prevented from complying with its duty of disclosure as to information already submitted. Patent owner can simply petition to seal the documents containing information that is covered by the protective order. In addition, patent owner has not shown any difficulty in complying with its duty of disclosure as to any information items patent owner might desire to submit in the future. Also, as to any information patent owner might desire to submit in the future, MPEP 724 addresses situations in which it is necessary, or desirable, for parties to Office proceedings to submit trade secret, proprietary, and/or protective order information. In accordance with MPEP 724.04(c), information submitted under MPEP § 724.02 will be sealed from public view until a determination is made as to whether it is material to patentability. If it is not material to patentability, the information may be expunged by a proper petition. If the information is material to patentability, it will be opened to the public, but may be made available in a redacted form, if appropriate, where requested by a grantable petition. Further, as to what information "the patent owner is obligated, and in fact is required, to file in Information Disclosure Statements," patent owner may approach the court before which the concurrent litigation is being conducted, and obtain its guidance as to what patent owner is to submit, or is not to submit. Thus, patent owner can comply with the Office's

duty of disclosure while honoring the court's protective order. Therefore, the existence of materials subject to a protective order is not good cause for suspending the proceeding.

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The patent owner petition filed on May 28, 2008, and supplemented on June 24, 2008, is dismissed.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

3. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729, or in her absence, Pinchus Laufer, Legal Advisor, at (571) 272-7726.

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

cdd

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

7590 06/22/2009

EXAMINER	

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ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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JUN 22 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
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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Mark Newman
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(For Patent Owner)

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JUN 22 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Chris Knotts	:	
Inter partes Reexamination Proceeding	:	**DECISION GRANTING**
Control No: 95/000,353	:	**PETITION TO REPLACE**
Filing Date: February 29, 2008	:	**INFORMATION DISCLOSURE**
For: U.S. Patent No.: 6,985,748	:	**STATEMENTS**

This is a decision on the patent owner's petition filed on June 4, 2009 entitled "Petition Under 37 C.F.R. §1.182 to Replace Information Disclosure Statements Filed on May 29, 2008 with Information Disclosure Statements Filed June 4, 2009 and to Expunge Information Disclosure Statement Filed on May 29, 2008" (the "Petition").

The petition is granted. The Information Disclosure Documents filed June 4, 2009 are accepted for entry into the reexamination proceeding and the Information Disclosure Documents filed May 29, 2008 are being expunged from the record.

RELEVANT BACKGROUND

1. Patent number 6,985,748 (the '748 patent) issued on January 10, 2006, with claims 1-19.

2. The '748 patent is the subject of a concurrent proceeding styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia 3:06CV485. On December 6, 2006, a protective order was issued in the litigation with respect to materials provided by each of the parties in the course of discovery.

3. On February 29, 2008, a third party, Sybase, Inc. (now owner of Mobile 365), filed a request for *inter partes* reexamination of claims 1-19 that was assigned control no. 95/000,353 (the '353 proceeding).

4. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

5. On May 29, 2008, three separate Information Disclosure Statements (IDSs) were filed by the patent owner including an IDS with a 1 page form PTO-1449, an IDS with a 38 page form PTO-1449, and an IDS with a 56 page form PTO-1449.

6. On June 12, 2008, the third party requester filed a petition directed to the IDS filed on May 29, 2008 that includes the 56 page form PTO-1449 requesting that the submission be sealed, as it is subject to a court protective order. That IDS and attached form and documents have not been scanned into the Image File Wrapper (IFW) data base of the Office.

7. A Decision was mailed on June 13, 2008, by the Office granting the June 12, 2008 third party petition to the extent that the May 29, 2008, Information Disclosure Statement and attached 56 page form PTO-1449 were temporarily sealed. The Decision required the third party to respond with a petition identifying the materials subject to the protective order and to provide detailed evidence that disclosure of the materials would violate the court's order. Patent owner was granted permission to file an opposition in response to such a third party petition, if filed.

8. On June 30, 2008, the third party requester filed a petition (titled "Petition Under 37 C.F.R. §§ 1.181 or 1.182 to Protect Sybase and Third Party Confidential Documents Filed in Violation of the District Court Protective Order") in response to the Office's June 13, 2008, Decision and on July 3, 2008, the patent owner filed an opposition to the third party's June 30, 2008 petition.

9. On August 18, 2008, the Office mailed a decision dismissing the June 30, 2008 petition. That decision provided that the information of the May 29, 2008 IDS that included a 56 page form PTO-1449 will remain provisionally sealed until the proceeding is ready for conclusion.

10. On March 31, 2009, an order was issued in the aforementioned litigation which bears on the disposition of the protective order materials.

11. On May 19, 2009 the Office issued an order maintaining the provisional seal on the involved documents for an additional 30 days and seeking patent owner compliance with the March 31, 2009 order in the district court litigation.

12. On June 4, 2009, in the interest of complying with the court's March 31, 2009 order, patent owner filed papers including, *inter alia*, the petition which is the subject of this decision.

I. Pertinent Regulations

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).

DECISION

1. Prior History

On March 31, 2009 an order, a final judgment, and a memorandum opinion were issued in *Telecommunication Systems, Inc. v. Mobile 365,* Inc. Civil Action No. 3:06-CV-485(JRS) (E.D. VA) ("*TCS v. Mobile 365*"). The memorandum opinion stated that the December 6, 2006 protective order applies to the documents submitted to the Office and held TCS in civil contempt of the protective order.

The Order entered on March 31, 2009 in *TCS v. Mobile 365* provides:

> Further this Court GRANTS Defendant the relief they seek and hereby ORDERS that:
> ...
> 3. TCS is further ORDERED to contact the PTO to request expungement of Mobile 365's confidential documents upon completion of PTO's review.

On May 19, 2009, the Office issued as "Order Seeking Compliance with Court Order of March 31, 2009" in which patent owner TCS was advised that

> Office policy as set out in MPEP 724 requires that documents that are not meant to be made public should be submitted under seal and be accompanied by a petition to expunge the materials upon a finding of non-materiality. The documents submitted May 29, 2008 were not submitted under seal and were not accompanied by a petition under 37 CFR 1.59 requesting expungement of the documents.
>
> ... TCS is called upon to adhere to Office practice for submission and handling of documents subject to protective orders. ... TCS is required to re-submit the documents in the manner described above, and, in keeping with the Court Order of March 31, 2009, TCS must contact the Office to request expungement of the documents.

2. Patent Owner's Petition to Replace and expunge the May 29, 2008 IDS.

On June 4, 2009, TCS re-submitted all documents previously submitted in the information disclosure of May 29, 2008. The submission included the 38 page IDS, a redacted version of the 56 page IDS that excluded the documents still subject to protective order, an IDS submitted under seal, in compliance with the provisions of MPEP 724.02, directed to the documents subject to the protective order, and a redacted version of the sealed IDS listing for entry in the reexamination proceeding. Patent owner concurrently filed copies of all non-patent literature and foreign patent documents listed on the June 4, 2009 IDSs.

Patent owner requests that to facilitate compliance with the court's order with respect to the protective order in the related litigation, that these documents be accepted as a replacement for the May 29, 2008 papers and that the IDS of May 29, 2008 be expunged from the record.

Patent owner's petition to accept the June 4, 2009 submission as a replacement of the May 29, 2008 IDS is **granted.** The 56 page IDS and the sealed IDS of June 4, 2009 are accepted as replacing the 56 page IDS of May 29, 2008. The 38 page IDS of June 4, 2009 is accepted as replacing the 38 page IDS of May 29, 2008

The record of the '353 reexamination reveals that the 38 page IDS of May 29, 2008 has not been provisionally sealed and the 56 page IDS was sequestered prior to scanning (to an artifact folder) and was thus not made part of the Image file wrapper.

Accordingly, the petition to expunge the May 29, 2008 IDS is **granted** to the extent that the 56 page IDS will be removed from the file record. The third party requester is required to make arrangements to retrieve the non-scanned materials submitted on May 29, 2008 from the Office within the next thirty (30) days. The third party requester must retain these materials for the enforceable life of the patent.

Furthermore, the 38 page IDS of May 29, 2008, will be expunged from the record by marking it as "closed" in the IFW and making it unavailable to the public. However, since it is identical to the replacement 38 page IDS and none of the documents are subject to a protective order, no requirement of retaining these documents is imposed.

CONCLUSION

1. The patent owner petition to replace the May 29, 2008 Information Disclosure Statements with the June 4, 2009 statements is granted.

2. The patent owner petition to expunge the May 29, 2008 Information Disclosure Statements is granted.

2. The third party requester may make arrangements to retrieve the non-scanned materials submitted on May 29, 2008 from the Office within the next thirty (30) days. The third party requester must retain these materials for the enforceable life of the patent.

3 Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

6. Telephone inquiries related to this decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7735.

Robert A Clarke

Robert A. Clarke, Director
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

7590 06/22/2009

EXAMINER	

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ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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JUN 22 2009

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(For Third Party Requester) CENTRAL REEXAMINATION UNIT

In re Chris Knotts	:	**DECISION ON**
Inter partes Reexamination Proceeding	:	**PETITION UNDER**
Control No: 95/000,353	:	**37 CFR 1.59(b) TO**
Filing Date: February 29, 2008	:	**EXPUNGE MATERIAL**
For: U.S. Patent No.: 6,985,748	:	**SUBMITTED UNDER SEAL**

This is a decision on patent owner TCS's June 4, 2009 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**.

DECISION

Petitioner TCS requests that the documents submitted by Patent owner under seal on June 4, 2009 be expunged from the record if they are found not to be material to examination. TCS states that the information is subject to a protective order,[1] the information has not been made public, and requester Sybase 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

[1] The papers refer to a protective order issued by the U.S. District Court, Eastern District of Virginia n Civil action No 3:06-CV-485 , *TeleCommunication Systems, Inc. v. Mobile 365, Inc.*

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 documents submitted under seal on June 4, 2009 is dismissed as premature.

2. Patent owner, TCS, may re-submit a petition to expunge the sealed information once the issue of materiality of the information is resolved. Requester, Sybase, 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 Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

6. Telephone inquiries related to this decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7735.

Robert A. Clarke, Director
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

7590 08/17/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/17/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,353	02/29/08	6985748	2187.011REX0

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HENEGHAN, MATTHEW	
ART UNIT	**PAPER**
3992	

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EXAMINER	
HENEGHAN, MATTHEW	
ART UNIT	**PAPER**
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DATE MAILED:

08/17/09

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AUG 17 2009

CENTRAL REEXAMINATION UNIT

In re Chris Knotts :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,353 : **DISMISSING**
Filed: February 29, 2008 : **PETITION**
For: U.S. Patent No. 6,985,748 :

This is a decision on the May 22, 2009 patent owner petition entitled "Petition Under 37 CFR 1.182 for Relief Not Specifically Provided By the Rules" ("the May 22, 2009 patent owner petition").

This decision also addresses the June 25, 2009 requester opposition to the May 22, 2009 patent owner petition.

The May 22, 2009 patent owner petition, the June 25, 2009 requester opposition, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The May 22, 2009 patent owner petition under 37 CFR 1.182 is accompanied by the appropriate petition fee of $400 under 37 CFR 1.17(f).

SUMMARY

The May 22, 2009 patent owner petition under 37 CFR 1.182 is **dismissed**, because it is **incomplete**. Because the May 22, 2009 requester opposition is dismissed, the June 25, 2009 requester opposition will not be considered. If the patent owner timely files a renewed petition under 37 CFR 1.182 in response to this decision, the June 25, 2009 requester opposition will be considered.

DECISION

The petitioner argues that the facts of the present proceeding are similar to those of *Sony Computer Entertainment America Inc. v. Dudas,* 85 USPQ2d 1594 (E.D. Va. 2006), in which there had been a final judgment by the district court in parallel litigation, and the decision had been appealed to the Federal Circuit. The petitioner states that on March 31, 2009, a final judgment was issued in "concurrent litigation styled 'Telecommunciation Systems Inc. v. Mobile 365, Inc.' in the U.S. District Court for the Eastern District of Virginia, No. 3:06CV485". The petitioner also states that on April 29, 2009, a notice of appeal from the final judgment was filed. The petitioner further states that the final judgment and the notice of appeal are attached to the

May 22, 2009 patent owner petition as Exhibits B and C, and that a copy of a press release, entitled "Sybase Completes Acquisition Mobile 365" is attached as Exhibit A.[1]

Office records do not reveal, however, that Exhibits A, B, or C were received by the Office. The "EFS Acknowledgment Receipt", which appears in the Image File Wrapper (IFW) file of the present proceeding, shows that only a six-page patent owner petition, a one-page certificate of service, and a two-page fee worksheet, were submitted on May 22, 2009. For this reason, the May 22, 2009 patent owner petition is **incomplete**.

The May 22, 2009 patent owner petition has been reviewed for completeness only, and has not been further reviewed for any other issues, such as the merits of the petition.

Accordingly, the May 22, 2009 patent owner petition is **dismissed**.

Because the May 22, 2009 patent owner petition is dismissed, the June 25, 2009 requester opposition to the May 22, 2009 patent owner petition will not be considered. If the patent owner timely files a renewed petition under 37 CFR 1.182 in response to this decision, the June 25, 2009 requester opposition will be considered. The requester also has the option of filing an opposition within 30 days of the date of service of any renewed petition filed by the patent owner in response to this decision.

CONCLUSION

- The May 22, 2009 patent owner petition is **dismissed**, because it is **incomplete**.

- The June 25, 2009 requester opposition will not be considered. If the patent owner timely files a renewed petition under 37 CFR 1.182 in response to this decision, the June 25, 2009 requester opposition will be considered.

- Any renewed petition filed by the patent owner in response to this decision must be filed **within 30 days** of the date of this decision. Any opposition by the third party requester must be filed **within 30 days** from the date of service of any renewed petition filed by the patent owner in response to this decision.

- Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration, pending a response to the decision, or the expiration of time for response to this decision.

- If no response by the patent owner is timely received in response to this decision, the requester opposition will not be considered, and jurisdiction over this reexamination proceeding will be forwarded to the examiner.

---

[1] See item nos. 1, 7, and 8, as well as footnotes 1, 4, and 5, which appear on pages 1 and 2 of the May 22, 2009 patent owner petition.

- Any further correspondence with respect to this matter should be addressed as follows:

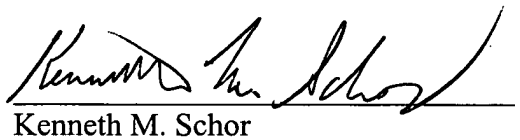
  By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.

  By Mail: Mail Stop Petition
  Commissioner for Patents
  Post Office Box 1450
  Alexandria, VA 22313-1450

  By Fax: (571) 273-9900

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

- Any inquiry concerning this communication should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729, or in her absence, to the undersigned at (571) 272-7710.



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

37086 7590 09/30/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

MAILED

SEP 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

7590 08/31/2009

MARK NEWMAN
1613 RIGGS PLACE, NW
WASHINGTON, DC 20009

EXAMINER	
HENEGHAN, MATTHEW E	
ART UNIT	**PAPER NUMBER**
3992	

MAIL DATE	DELIVERY MODE
	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mark Newman
1613 Riggs Place, NW
Washington, DC 20009

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

(For Third Party Requester)

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

(Courtesy Copy)

In re Chris Knotts :
Inter partes Reexamination Proceeding :
Control No: 95/000,353 : **DECISION DISMISSING**
Filing Date: February 29, 2008 : **PETITION UNDER 37 CFR 1.182**
For: U.S. Patent No.: 6,985,748 : **TO SUSPEND PROCEEDING**

This is a decision on the patent owner petition filed on August 19, 2009, entitled "Renewed Petition Under 37 C.F.R. § 1.182 For Relief Not Specifically Provided by the Rules." In addition, third party requester filed a paper on August 25, 2009 entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.182 For Relief Not Specifically Provided by the Rules" (the "Opposition").

The Petition, Opposition, and *inter partes* reexamination control number 95/000,353 are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted. The fee for the petition under 37 CFR 1.17(f) of $400 has been paid.

The patent owner's petition is dismissed for the reasons below, and reexamination will proceed with special dispatch.

BACKGROUND

1. Patent number 6,985,748 (the '748 patent) issued on January 10, 2006, with claims 1-19.

2. The '748 patent is the subject of a concurrent proceeding styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia 3:06CV485 (hereinafter "the TCS v M365 litigation").

3. On February 29, 2008, a third party, Sybase, Inc. (now owner of Mobile 365), filed a request for *inter partes* reexamination of claims 1-19 that was assigned control no. 95/000,353 (the '353 proceeding).

4. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

5. On May 28, 2008, patent owner filed a petition under 37 CFR §§ 1.987, 1.181, 1.182, 1.183, and 1.907(b) to terminate or suspend the '353 proceeding.

6. On June 20, 2008, the third party requester filed an opposition to the patent owner's May 28 petition for suspension of the '353 proceeding.

7. On June 24, 2008, the patent owner filed a reply in support of its May 28 petition to suspend, treated as a supplemental petition that asserts *new facts* that bear on the issue raised in patent owner's May 28 petition to suspend.

8. On August 18, 2008, the Office issued a decision dismissing the May 28 petition to suspend the proceeding.

9. On May 22, 2009, patent owner filed a petition under 37 CFR § 1.182 to suspend the '353 proceeding.

10. On June 5, 2009, third party requester filed a petition 37 CFR § 1.181 to expedite prosecution of the '353 proceeding.

11. On June 25, 2009, third party requester filed a petition under 37 CFR § 1.183 for suspension of 37 CFR § 1.939 to allow third party requester to file an opposition to patent owner's May 22, 2009 petition to suspend the '353 proceeding.

12. On August 4, 2009, the Office issued a non-final action in the '353 proceeding rejecting all claims under reexamination, claims 1-19.

13. On August 17, 2009, the Office issued a decision dismissing patent owner's May 22, 2009 petition, as the petition was found to lack the presence of three exhibits relied upon in the petition. Accordingly, the requester opposition was not considered.

14. On August 19, 2009, patent owner filed a renewed petition under 37 CFR § 1.182 to suspend the '353 proceeding, identical in substance with the original petition, and including the missing exhibits not included in the original petition.

15. On August 25, 2009, third party requester filed a petition 37 CFR § 1.181 to expedite prosecution of the '353 proceeding, supplanting the earlier June 5, 2009 petition.

16. On August 25, 2009, third party requester also filed a renewed opposition to patent owner's August 19, 2009 petition to suspend the '353 proceeding.

17. On August 31, 2009, the Office issued a supplemental non-final Office action rejecting claims 1, 3-6, 9-14, and 17-19, all of the claims remaining under reexamination.

18. On September 28, 2009, a search performed by the Office using an electronic database revealed that the concurrent court proceeding, styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, is listed in the court as "closed." Appeals by each party to the Federal Circuit were dismissed on July 30, 2009. The reasons for the dismissals, and the status of the case, were not available through that source.

DECISION

I. Pertinent Regulations

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).

35 U.S.C. 317 Inter partes reexamination prohibited

(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 § 1.907 Inter partes reexamination prohibited.

(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 § 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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 § 1.937 Conduct of inter partes reexamination.

(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.

(c) All communications between the Office and the parties to the inter partes reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

II. Findings and Analysis

Pursuant to 37 CFR 1.985, patent owner has advised the Office of a concurrent proceeding addressing the '748 patent, being conducted in the U.S. District Court for the Eastern District of Virginia. Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of an appeal to the U.S. Court of Appeals for the Federal Circuit (hereinafter, the Federal Circuit) in relation to the concurrent proceeding. In the district court proceeding, a jury verdict found that Mobile 365 (now owned by the third party requester) willfully infringed claims 1, 3-6, 9-14 and 17-19 of the '748 patent and failed to prove invalidity of these claims. The district court ordered a permanent injunction against Mobile 365, which has been stayed pending appeal to the Federal Circuit. The patent owner has not specifically averred that an appeal to the Federal Circuit has already been filed. A search of the Federal Circuit docket reveals that the appeals to the Federal Circuit by both parties have been dismissed by n order issued on July 30, 2009. **Patent owner is called upon to apprise the Office of the current status of the TCS v M365 litigation by filing a notification pursuant to MPEP 2686.** This would include notification of any final disposition of the litigation and papers supporting that final disposition as well as reasons for the dismissals of the appeals at the Federal Circuit on July 30, 2009.

While there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 CFR 1.103 provides such a mechanism for requesting a suspension of action in an application. Accordingly, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a).

37 CFR 1.103(a) provides that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding." Also, MPEP 2686.01 provides, for a suspension based upon the existence of a proceeding as to the patent being reexamined other than the reexamination, that a "[s]uspension will not be granted when there is an outstanding Office action." In the present instance, the patent owner is requesting suspension based on a litigation proceeding as to the '748 patent; yet, the patent owner has not responded to the non-final Office action of August 31, 2009. Thus, a response to the non-final Office action is still outstanding, and the petition must be dismissed.

Although the proceeding will not be suspended while there is an Office action outstanding, termination of the proceeding based upon the estoppel provision of 35 U.S.C. 317, if such estoppel provision applies, would be effected, despite the existence of an outstanding Office action.

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

PATENT OWNER'S ADDRESS

A change of correspondence address has been filed in the reexamination proceeding, designating correspondence to be sent to Novak Druce & Quigg, LLP, NDQ Reexamination Group, 1000 Louisiana Street, Fifty-Third Floor, Houston, TX 77002. However, 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 Mark Newman, 1613 Riggs Place, NW, Washington, DC 20009.

The certificate of service for the third party requester rendered service upon Novak Druce & Quigg, LLP, NDQ Reexamination Group, 1000 Louisiana Street, Fifty-Third Floor, Houston, TX 77002. As a courtesy, this decision is being mailed to both addresses.

The address of Mark Newman, 1613 Riggs Place, NW, Washington, DC 20009, will be the sole address used in future correspondence, until a change in correspondence address in the patent is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The patent owner petition filed on August 19, 2009 is dismissed.

2. The third party opposition filed August 25, 2009 will not be considered.

3. **Patent owner is called upon to apprise the Office of the current status of the TCS v M365 litigation by filing a notification pursuant to MPEP 2686.**

4. Patent owner is further called upon to clarify the correct correspondence address and ensure that the correct address is properly of record in the patent file.

5. The time for patent owner to respond to the outstanding office action, and if desired to file a petition to terminate proceedings, is extended *sua sponte* to run until November 31, 2009.

6. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

7. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus Laufer, Legal Advisor, at (571) 272-7726.

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.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

37086 7590 11/27/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date: MAILED

NOV 27 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO.: 95000353
PATENT NO. : 6985748
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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Novak Druce & Quigg, LLP
NDQ Reexamination Group
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Patent Owner)

MAILED

NOV 27 2009

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

(For Third Party Requester)

In re Chris Knotts :
Inter partes Reexamination Proceeding : **DECISION DISMISSING**
Control No: 95/000,353 : **PETITION UNDER 37 CFR 1.182**
Filing Date: February 29, 2008 : **TO RECONSIDER DECISION ON**
For: U.S. Patent No.: 6,985,748 : **SUSPENSION OF PROCEEDING**

This is a decision on the patent owner petition filed on October 13, 2009, entitled "Petition for Reconsideration of Decision Dismissing Petition Under 37 CFR 1.182 to Suspend Proceeding." In addition, third party requester filed a paper on November 4, 2009 entitled "Third Party Requester's Opposition to Patent Owner's Petition For Reconsideration of Decision Dismissing Petition Under 37 CFR 1.182 To Suspend Proceeding" (the "opposition").

The petition, opposition, and *inter partes* reexamination control number 95/000,353 are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted. The fee for the petition under 37 CFR 1.17(f) of $400 has been paid.

The patent owner's petition is dismissed for the reasons below, and reexamination will proceed with special dispatch.

BACKGROUND

1. Patent number 6,985,748 (the '748 patent) issued on January 10, 2006, with claims 1-19.

2. The '748 patent is the subject of a concurrent proceeding styled *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia 3:06CV485 (hereinafter "the TCS v M365 litigation").

3. On February 29, 2008, a third party, Sybase, Inc. (now owner of Mobile 365), filed a request for *inter partes* reexamination of claims 1-19 that was assigned control no. 95/000,353 (the '353 proceeding).

4. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

5. On May 28, 2008, patent owner filed a petition under 37 CFR §§ 1.987, 1.181, 1.182, 1.183, and 1.907(b) to terminate or suspend the '353 proceeding.

6. On June 20, 2008, the third party requester filed an opposition to the patent owner's May 28 petition for suspension of the '353 proceeding.

7. On June 24, 2008, the patent owner filed a reply in support of its May 28 petition to suspend, treated as a supplemental petition that asserts *new facts* that bear on the issue raised in patent owner's May 28 petition to suspend.

8. On August 18, 2008, the Office issued a decision dismissing the May 28 petition to suspend the proceeding.

9. On May 22, 2009, patent owner filed a petition under 37 CFR § 1.182 to suspend the '353 proceeding.

10. On June 5, 2009, third party requester filed a petition 37 CFR § 1.181 to expedite prosecution of the '353 proceeding.

11. On June 25, 2009, third party requester filed a petition under 37 CFR § 1.183 for suspension of 37 CFR § 1.939 to allow third party requester to file an opposition to patent owner's May 22, 2009 petition to suspend the '353 proceeding.

12. On August 4, 2009, the Office issued a non-final action in the '353 proceeding rejecting all claims under reexamination, claims 1-19.

13. On August 17, 2009, the Office issued a decision dismissing patent owner's May 22, 2009 petition, as the petition was found to lack the presence of three exhibits relied upon in the petition. Accordingly, the requester opposition was not considered.

14. On August 19, 2009, patent owner filed a renewed petition under 37 CFR § 1.182 to suspend the '353 proceeding, identical in substance with the original petition, and including the missing exhibits not included in the original petition.

15. On August 25, 2009, third party requester filed a petition 37 CFR § 1.181 to expedite prosecution of the '353 proceeding, supplanting the earlier June 5, 2009 petition.

16. On August 25, 2009, third party requester also filed a renewed opposition to patent owner's August 19, 2009 petition to suspend the '353 proceeding.

17. On August 31, 2009, the Office issued a supplemental non-final Office action rejecting claims 1, 3-6, 9-14, and 17-19, all of the claims remaining under reexamination.

18. On September 30, 2009, the patent owner petition filed on August 19, 2009 was dismissed.

19. On October 13, 2009, patent owner filed the instant petition, entitled "Petition for Reconsideration of Decision Dismissing Petition Under 37 CFR 1.182 to Suspend Proceeding."

20. On November 4, 2009, third party requester filed an opposition to patent owner's October 13, 2009 petition for reconsideration.

DECISION

I. Pertinent Regulations

§ 1.103 Suspension of action by the Office, states, in pertinent part:

(a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding.

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).

35 U.S.C. 317 Inter partes reexamination prohibited

(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 1.907 Inter partes reexamination prohibited.

(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 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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 1.937 Conduct of inter partes reexamination.

(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.

(c) All communications between the Office and the parties to the inter partes reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

MPEP 2686.04 Reexamination and Litigation Proceedings states, in pertinent part:

[W]hen 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 decision adverse to the third party requester as to at least one claim of the patent?

(2) **Was the Federal Court 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 vacating the reexamination proceeding. . . .

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. . . .

Also, suspension will not be considered on its merits when there is an outstanding Office action. In order to ensure consideration on the merits of a petition to suspend where there is an outstanding Office action, the patent owner must (1) provide a complete response to the outstanding Office action, (2) include a petition to suspend under 37 CFR 1.182, and (3) include a petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding prior to issuing an Office action on the submitted response and retain such jurisdiction until OPLA issues its decision on the petition to suspend. **(emphasis added)**

II. Findings and Analysis

Patent owner has filed the instant petition requesting reconsideration of the September 30, 2009 decision dismissing the August 19, 2009 patent owner petition to suspend the instant proceeding. Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of an appeal to the Federal Circuit in the concurrent litigation[1]. Patent owner presents two principal lines of argument for the proposition that the decision of September 30, 2009 not to suspend the '353 proceeding to await the outcome of the litigation was improper: (1) *Sony v. Dudas* sets the standard for determining when suspension is appropriate and suspension of the '353 proceeding is proper in accordance with that decision; and (2) reliance on 37 CFR 1.103(a) so as not to suspend when reply to an Office action is outstanding is misplaced, since 37 CFR 1.103 does not apply in reexamination proceedings.

(1) Conduct of the *Inter Partes* Proceeding With Special Dispatch is Entirely Consistent With *Sony*

Patent owner's attempt to analogize the '353 proceeding to the reexamination proceedings at issue in *Sony* is not persuasive. The facts in the instant proceeding are distinguishable from the facts in *Sony* for at least the reasons set out below.

(i) The timing of the reexamination request: In *Sony*, the litigation had proceeded to the point at which a jury verdict had been delivered, final judgment was entered, and post-verdict motions were denied by the district court, ***before the third party filed a request for reexamination***. Thus, in *Sony*, the reexamination was initiated at the close of district court proceedings. In contrast to *Sony*, the instant reexamination proceeding was initiated during the district court proceedings and, the district court decision did not issue until a year after the reexamination was filed by the third party.

(ii) The cause of the relative state of progress of the two proceedings: In the period between the filing of the '353 reexamination proceeding and the filing of the instant petition to suspend said proceeding, patent owner filed materials of another party that were subject to a protective order of the district court without any attempt to maintain their confidentiality. This engendered significant delay to the progress of the reexamination proceeding as the Office attempted to obtain the cooperation of patent owner in resolving any issues relating to possible improper exposure of third parties' confidential material. Patent owner's actions with respect to these materials (which ultimately resulted in court sanctions) significantly delayed the prosecution of the '353 proceeding to the extent that the '353 proceeding is awaiting Patent owner's response to a non-final Office action, while the litigation has progressed to the point that the district court has rendered a verdict and appeals have been filed to the Federal Circuit. Thus, there was significant delay attributable to the patent owner which was responsible for bringing the

[1] In the district court proceeding, a jury verdict found that Mobile 365 (now owned by the third party requester) willfully infringed claims 1, 3-6, 9-14 and 17-19 of the '748 patent, and failed to prove invalidity of these claims. The district court ordered a permanent injunction against Mobile 365, which has been stayed pending appeal to the Federal Circuit.

litigation to a point analogous to the *Sony* litigation to the extent that action at the district court has been concluded, and the case is on appeal to the Federal Circuit. However, unlike *Sony*, patent owner significantly contributed to the delay in conducting the reexamination proceeding such that it is now concurrent with a pending appeal to the Federal Circuit.

(iii) Office Resources Expended: Furthermore, an Office action has been issued in the instant case, unlike *Sony*, in which no Office action on the merits had been issued. In *Sony*, the rationale for suspension was grounded in an effort to conserve Office resources:

> To decline to suspend the reexamination, in the PTO's view, would risk wasting resources. As the PTO put it: It is not in the [PTO's] and the parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation [in the Federal Circuit] which is soon to be finally resolved. That is particularly true here where the administrative proceedings have only just begun.

In the instant case, the Office has, in keeping with the requirement of special dispatch, expended resources in issuing an Office action, as well as responding to numerous petitions. The present situation differs from *Sony* in that significant resources have already been expended by the Office, and by both parties, in this administrative proceeding.

Thus the equities in this instance do not favor granting patent owner a suspension of the *inter partes* reexamination proceeding. Parties challenging determinations of patent validity may simultaneously engage in litigation and *inter partes* reexamination proceedings.[2] As the *Sony* court colloquially stated, "a party can choose to run horses in both races, but the conclusion of one race automatically ends the other; a party cannot ride both horses to conclusion." In this instance, requester started its "horse" in the reexamination race (as per the colloquial description in *Sony*) much earlier than the situation described by the court in *Sony*, and furthermore, patent owner's actions have been a major factor contributing to the delay of that reexamination race. Taking these facts into account, it has been determined that, unlike *Sony*, there is no good cause in this proceeding to wait for the eventual outcome of the Federal Circuit appeal.

(2) Suspension when a reply to an Office action is outstanding

Patent owner further argues that application of 37 CFR 1.103 to reexamination proceedings, either directly or by analogy, is improper. The decision of September 30, 2009 stated:

> [w]hile there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 CFR 1.103 provides such a mechanism for requesting a suspension of action in an application. Accordingly, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a). 37 CFR 1.103(a) provides that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding."

Patent owner is correct that 37 CFR 1.103(a) does not directly apply to reexamination

[2] *Sony*, 85 USPQ2d 1594 (page 19).

proceedings; however, this is entirely consistent with the September 30, 2009 decision. The September 30, 2009 decision **explicitly states** that there is no such direct application of 37 CFR 1.103. However, patent owner has brought this petition under 37 CFR 1.182, which states that "all situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation." Through such a petition, patent owner requests the Office to exercise its discretion to address a situation where there is no specific rule that expressly applies. Patent owner, however, argues that the Office erred in looking to similar situations applicable to non-provisional applications, because this would apply to a reexamination proceeding a provision that does not expressly apply to a reexamination proceeding. Patent owner, then, sets an impossible task that the Office provide relief not covered by a reexamination rule, and, at the same time, remain within the express provisions of the reexamination rules. In setting forth the conduct for *inter partes* reexamination proceedings, 35 U.S.C. 314 makes reference to, and incorporates, the well established procedures for examination of non-provisional applications. In formulating relief for examination situations in *inter partes* proceedings where no special *inter partes* rule has been promulgated, the Office is justified in similarly looking for guidance (insofar as the situation may warrant) to the well established procedures for applications.

Patent owner further argues that application of 37 CFR 1.103 to an *inter partes* proceeding is improper because the public has not clearly been put on notice by the Office that it intends to do so. However, as discussed above, patent owner petitions here for relief not provided for by a rule. As such, an argument that the nature of the relief must have been previously communicated to the public disregards the purpose of the rule upon which the patent owner petitions for relief. Furthermore, MPEP 2686.04 provides, for a suspension based upon concurrent litigation, that a "suspension will not be considered on its merits when there is an outstanding Office action" (emphasis added). MPEP 2686.04 further specified the procedure to be followed in such an instance:

> In order to ensure consideration on the merits of a petition to suspend where there is an outstanding Office action, the patent owner must (1) provide a complete response to the outstanding Office action, (2) include a petition to suspend under 37 CFR 1.182, and (3) include a petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding prior to issuing an Office action on the submitted response and retain such jurisdiction until OPLA issues its decision on the petition to suspend.

The MPEP therefore clearly put the public, including patent owner, on notice of the procedure to be followed where suspension is requested while there is an outstanding Office action. In the August 19, 2009 petition, patent owner requested suspension based on a litigation proceeding as to the '748 patent; yet, the patent owner did not provide a response to the non-final Office action of August 31, 2009. Thus, patent owner's petition failed to comply with the procedure set forth at MPEP 2686.04, and the petition was properly dismissed.

It is also to be observed that this decision is consistent with prior decisions dismissing petitions for suspension of action where there is an outstanding Office action dating back to 2005, and such decisions were of public record in the reexamination proceedings (see for example the June 9, 2005 decision in reexamination proceeding 95/000,071).

It is noted that there is, in fact, a single sentence in the August 19, 2009 petition requesting OPLA to take jurisdiction; however, patent owner is reminded that 37 CFR 1.4(c) requires that each distinct inquiry must be contained in a separate paper. In addition, given the statutory mandate for special dispatch in reexamination, it is far from clear that a separate petition to take jurisdiction, thus delaying action, would have been granted.

With respect to the issue of vacating the Office action of August 31, 2009, such an issue would have been properly addressed by a petition to the Central Reexamination Unit by way of 37 CFR 1.181. Patent owner has filed no such petition, and thus cannot argue that the Office action should be vacated in this request for suspension. It is to be noted that such a petition would have been required under 37 CFR 1.181(f) to have been filed within 2 months of the issuance of the Office action from which relief would have been requested.

As stated in the previous decision of September 30, 2009, it is again noted that, although the proceeding will not be suspended while there is an Office action outstanding, termination of the proceeding based upon the estoppel provision of 35 U.S.C. 317, if such estoppel provision applies, would be effected, despite the existence of any outstanding Office action.

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The patent owner petition filed on October 13, 2009 is dismissed.

2. The third party opposition filed November 14, 2009 will not be considered.

3. The time for patent owner to respond to the outstanding Office action continues to run until November 31, 2009.

4. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

5. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

Kenpet7 11-25-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

37086 7590 12/01/2009

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1000 LOUISIANA STREET
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HOUSTON, TX 77002

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/01/2009

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

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STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

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DEC 0 1 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
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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HOUSTON TX 77002

(For Patent Owner)

MAILED

DEC 0 1 2009

CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Third Party Requester)

In re: Chris Knotts
Inter Partes Reexamination Proceeding
Control No. 95/000,353
Deposited on: 29 February 2008
For: US Patent No. 6,985,748

DECISION
GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 25 November 2009, "Petition for Extension of Time" under 37 CFR § 1.956 and requesting that the time for responding to the non-Final Office action mailed 31 August 2009, MPEP 2665, be further extended by one (1) month. The petition was timely filed with certificate of service.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period of time be further extended in which to file a response to the non-final Office action mailed 31 August 2009, which set two (2)

months time for filing a response thereto. The petition for extension of time was timely filed on 25 November 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.

CITATION OF RELEVANT AUTHORITY

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be

considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the 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 31 August 2009. The patent owner submitted a

timely filed the petition on 25 November 2009 with the appropriate fee and certificate of service.

The petition dated 25 November 2009 cites several reasons for the need for additional time. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the untimely death of the attorney who was preparing papers for this proceeding as well as the need to obtain papers held by the late practitioner.

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

CONCLUSION

1. The patent owner's petition for further extension for one (1) month time in which to file a response to the non-final Office action dated 31 August 2009 is hereby **granted.**

2. The period for response is further extended by one (1) month.

3. The response is extended to **31 December 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

_____

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

37086 7590 07/16/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/16/2010

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JUL 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
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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(For Patent Owner)

MAILED

JUL 16 2010

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

(For Third Party Requester)

In re Chris Knotts :
Inter partes Reexamination Proceeding : **DECISION DISMISSING**
Control No: 95/000,353 : **PETITION UNDER 37 CFR 1.182**
Filing Date: February 29, 2008 : **TO TERMINATE *INTER PARTES***
For: U.S. Patent No.: 6,985,748 : **REEXAMINATION PROCEEDING**

This is a decision on the patent owner petition under 37 CFR 1.182, filed on March 30, 2010, entitled "Petition to Terminate *Inter Partes* Reexamination Proceeding Based on Statutory Estoppel" (the March 30, 2010 patent owner petition).

The March 30, 2010 patent owner petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fee for the petition under 37 CFR 1.17(f) has been paid.

The March 30, 2010 patent owner petition under 37 CFR 1.182 is **dismissed**.

BACKGROUND

1. On January 10, 2006, U.S. Patent 6,985,748 (the '748 patent) issued.

2. On February 29, 2008, a third party, Sybase, Inc. (now owner of Mobile 365), filed a request for *inter partes* reexamination of claims 1-19 of the '748 patent, which was assigned control no. 95/000,353 (the '353 proceeding).

3. On May 20, 2008, reexamination was ordered in the '353 proceeding for claims 1-19 of the '748 patent.

4. On May 28, 2008, patent owner filed a petition under 37 CFR §§ 1.987, 1.181, 1.182, 1.183, and 1.907(b) to terminate or suspend the '353 proceeding.

5. On June 20, 2008, the third party requester filed an opposition to the patent owner's May 28 petition for suspension of the '353 proceeding.

6. On June 24, 2008, the patent owner filed a reply in support of its May 28 petition to suspend, treated as a supplemental petition that asserts *new facts* that bear on the issue raised in patent owner's May 28 petition to suspend.

7. On August 18, 2008, the Office issued a decision dismissing the May 28 petition to suspend the proceeding.

8. On May 22, 2009, patent owner filed a petition under 37 CFR § 1.182 to suspend the '353 proceeding.

9. On June 5, 2009, requester filed a petition 37 CFR § 1.181 to expedite prosecution of the '353 proceeding.

10. On June 25, 2009, third party requester filed a petition under 37 CFR § 1.183 for suspension of 37 CFR § 1.939 to allow third party requester to file an opposition to patent owner's May 22, 2009 petition to suspend the '353 proceeding.

11. On August 4, 2009, the Office issued a non-final action in the '353 proceeding rejecting all claims under reexamination, i.e., claims 1-19.

12. On August 17, 2009, the Office issued a decision dismissing patent owner's May 22, 2009 petition, as the petition was found to lack the presence of three exhibits stated to be relied upon in the petition. Accordingly, the requester opposition was not considered.

13. On August 19, 2009, patent owner filed a renewed petition under 37 CFR § 1.182 to suspend the '353 proceeding, identical in substance with the original petition, and including the missing exhibits not included in the original petition.

14. On August 25, 2009, requester filed a petition 37 CFR § 1.181 to expedite prosecution of the '353 proceeding, supplanting its earlier June 5, 2009 petition.

15. Also on August 25, 2009, requester filed a renewed opposition to patent owner's August 19, 2009 petition to suspend the '353 proceeding.

16. On August 31, 2009, the Office issued a supplemental non-final Office action rejecting claims 1, 3-6, 9-14, and 17-19, all of the claims remaining under reexamination.

17. On September 30, 2009, the patent owner petition filed on August 19, 2009 was dismissed.

18. On October 13, 2009, patent owner filed a petition, entitled "Petition for Reconsideration of Decision Dismissing Petition Under 37 CFR 1.182 to Suspend Proceeding."

19. On November 4, 2009, third party requester filed an opposition to patent owner's October 13, 2009 petition for reconsideration.

20. On November 25, 2009, the patent owner filed a request for a one-month extension of time.

21. On November 27, 2009, the Office issued a decision dismissing patent owner's October 13, 2009 petition.

22. On December 1, 2009, the Office issued a decision granting the patent owner's request for a one-month extension of time.

23. On December 31, 2009, the patent owner filed a response to the August 31, 2009 supplemental non-final Office action.

24. On March 30, 2010, the patent owner filed the present petition under 37 CFR 1.182, entitled "Petition to Terminate *Inter Partes* Reexamination Proceeding Based on Statutory Estoppel" (the March 30, 2010 patent owner petition).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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 § 1.182 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 1.907(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.

MPEP 2686.04 provides, in pertinent part:

[W]hen 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 decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court 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 vacating the reexamination proceeding. . . .

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) . . .

DECISION

The patent owner argues that termination of the '353 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b). The first sentence of 35 U.S.C. 317(b) provides, in pertinent part (emphasis added):

> 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 . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The patent owner states that, pursuant to the statute, a final decision has been entered against a defendant in a civil action, that it has not sustained its burden of proving invalidity of any claim in suit, i.e., claims 1, 3-6, 9-14, and 17-19 of the '748 patent, which is the patent under reexamination. The patent owner has provided evidence that the defendant, Mobile 365, is apparently a privy of Sybase, Inc., the real party in interest in the '353 *inter partes* reexamination proceeding, because Mobile 365 is a wholly owned subsidiary of Sybase, Inc.[1] This evidence has not been contested by the requester.

On May 22, 2009, a statutory disclaimer under 37 CFR 1.321(a) of claims 2, 7, 8, 15, and 16 of the '748 patent was filed in the '748 patent file, which is application no. 10/720,343. Accordingly, the pending claims of the '353 reexamination proceeding, i.e., claims 1, 3-6, 9-14, and 17-19 of the '748 patent, are therefore identical to the patent claims in suit.

On March 31, 2009, a judgment was entered against Mobile 365 in the United States District Court for the Eastern District of Virginia (district court), holding that claims 1, 3-6, 9-14, and 17-19 of the '748 patent were not invalid.[2] On April 28, 2009, this judgment was appealed to the United States Court of Appeals for the Federal Circuit (Federal Circuit).[3] On December 23, 2009, the parties to the litigation filed a joint motion in the Federal Circuit to remand jurisdiction to the district court, which was ordered by the Federal Circuit "so that the parties may request the District Court to enter additional orders in aid of their settlement." [4] On July 21, 2009, the Federal Circuit dismissed the appeal, noting that "[t]he parties having so agreed."[5] On January 8, 2010, the district court entered a stipulated order of dismissal dismissing, with prejudice, "the parties' respective claims and counterclaims", and ordering each party to bear its own attorney fees and costs.[6] The Federal Circuit and the district court did not state, or otherwise indicate, that the March 31, 2009 holding of the district court was vacated. In view of the specific facts and circumstances of the present case, the March 31, 2009 district court judgment is deemed to be a

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[1] See Exhibit A, a November 8, 2006 press release entitled "Sybase Completes Acquisition of Mobile 365". Exhibit A is attached to the present petition.

[2] See Exhibit C, *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia, Civil Action No. 3:06CV485, final judgment, March 31, 2009. Exhibit C is attached to the present petition.

[3] See Exhibit D, attached to the present petition.

[4] See Exhibit J, attached to the present petition. Each party was ordered to bear its own costs.

[5] See *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, 2009 U.S. App. LEXIS 21015 (Fed. Cir. 2009).

[6] See Exhibit L, attached to the present petition.

final decision within the meaning of the statute.[7] Thus, a final decision has been entered against a defendant (Mobile 365) in a civil action, who is apparently in privy with the requester (Sybase, Inc.) of the present reexamination proceeding. The final decision held that the defendant/requester has not sustained its burden of proving the invalidity of claims 1, 3-6, 9-14, and 17-19 of the '748 patent.

The patent owner, however, has not presented sufficient evidence that the requester raised issues in the current *inter partes* proceeding that the requester "could have raised" [8] in the earlier litigation. In the present instance, the record shows that the '353 reexamination proceeding is being conducted before the Office based upon prior art that is different from the prior art asserted during the litigation (or otherwise of record therein).

The patent owner argues that all of the documents filed by the requester with the request are facially dated prior to the July 12, 2006 filing date of the '748 patent litigation, with the sole exception of the Bennett reference, U.S. Patent 7,209,950, which, as the requester admits, could have been placed in litigation.[9] This argument is not persuasive. With the exception of the Bennett reference,[10] the patent owner has not provided sufficient evidence that the issues of patentability based on the presently applied prior art in reexamination in the '353 proceeding could have been raised by the third-party requester at the time of the civil action. The patent owner has not provided evidence that the requester was aware of the presently applied prior art at a time when those references could have been raised as issues in the earlier litigation (with the exception of the Bennett reference).

The patent owner argues that the application of the estoppel provisions of the statute is not precluded by the last sentence of 35 U.S.C. 317(b), which permits "the assertion of invalidity based on newly discovered prior art unavailable to the third party requester . . . at the time of the inter partes proceedings". However, it is the "could have raised" provision of the first sentence of 35 U.S.C. 317(b) that is being relied upon. Because the patent owner has not provided sufficient evidence that the requester was aware of the prior art such that requester could have raised it in the earlier litigation, the Office need not address the last sentence of 35 U.S.C. 317(b).

Absent a sufficient evidentiary showing that the requester was aware of this prior art at a time when the art could have been raised by the requester in the earlier civil action, the estoppel provision of 35 U.S.C. 317(b), relied upon by the patent owner as mandating the termination of the '353 *inter partes* reexamination proceeding, is inapplicable. It is beneficial to the interest of the public to continue the present reexamination proceeding, in order to examine the patent based on prior art that was not before the court in the litigation, and such will be effected.

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[7] The Federal Circuit, in its remand to the district court and in its dismissal of the appeal, was silent regarding the March 31, 2009 holding of the district court that claims 1, 3-6, 9-14, and 17-19 of the '748 patent were not invalid. The district court, in its stipulated order of dismissal, stated only that the parties' respective claims and counterclaims were dismissed with prejudice.

[8] 35 U.S.C. 317(b), first sentence.

[9] See page 375 of the request for reexamination.

[10] And also with the exception of the admitted prior art which appears in the specification of the '748 patent.

In summary, the '353 *inter partes* proceeding will not be terminated because the patent owner has failed to show that the proceeding is solely based upon art issues that could have been raised by the third-party requester within the meaning of 35 U.S.C. 317(b). From a review of the record, it appears that the proceeding is based not only upon the Bennett reference, which was available and could have been introduced into the litigation, but also upon other references. The patent owner has not shown that the references other than Bennett were known to the requester at a time when those references could have been raised in the litigation.

This is not a case of first impression. This decision is consistent, for example, with the March 20, 2006 decision denying a petition to "dismiss" the *inter partes* reexamination proceeding, which decision was issued in the merged proceeding of *inter partes* reexamination control no. 95/000,020 and *ex parte* reexamination control no. 90/006,495. The March 20, 2006 decision is a final agency action by the Office, which found that the patent owner had not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the district court during the litigation of the patent under reexamination, or was available to the third party requester for entry into the litigation prior to the filing of the request for *inter partes* reexamination. For that reason, it was held that the requirement for termination of the 95/000,020 *inter partes* reexamination proceeding pursuant to 35 U.S.C. 317(b) had not been demonstrated.[11]

CONCLUSION

1. The March 30, 2010 patent owner petition under 37 CFR 1.182 is **dismissed**.

2. The '353 *inter partes* reexamination proceeding will not be terminated, and prosecution will continue in due course.

3. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action in the proceeding.

4. Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

7-15-10
Kenpet8

[11] See item no. 3 on page 12 of the March 20, 2006 final agency action denying a petition under 37 CFR 1.181 to "dismiss" the *inter partes* reexamination proceeding in the merged proceeding of *inter partes* reexamination control no. 95/000,020 and *ex parte* reexamination control no. 90/006,495.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,201	12/08/2006	6763345	1482-0001.04	7081

70653 7590 05/20/2008

EUGENE M. CUMMINGS, P.C.
ONE NORTH WACKER DRIVE
SUITE 4130
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2008

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

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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

TRACY DRUCE
NOVAK, DRUCE & QUIGG, LLP
1000 LOUISIANA AVE. WELLS FARGO PLAZA 53RD FLOOR
HOUSTON, TX 77002

Date:
MAILED

MAY 20 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000201
PATENT NO. : 6763345
ART UNIT : 3992

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

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,354	03/07/2008	6763345	1482-0001.16	4824

70653 7590 05/20/2008

EUGENE M. CUMMINGS, P.C.
ONE NORTH WACKER DRIVE
SUITE 4130
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2008

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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK, DRUCE & QUIGG, LLP
(NDQ) REEXAMINATION GROUP
1000 LOUISIANA STREET, 53 FLOOR
HOUSTON, TX 77002

Date:
MAILED

MAY 20 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000354
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MAILED

MAY 20 2008

CENTRAL REEXAMINATION UNIT

Eugene M. Cummings, P.C. (For Patent Owner)
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Novak, Druce & Quigg, LLP (For 95/000,201 Requester)
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(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, Texas 77002

In re James D. Hempleman et al.
Inter partes Reexamination Proceeding
Control No. 95/000,201
Filed: December 8, 2006
For: U.S. Patent No. 6,763,345

In re James D. Hempleman et al.
Inter partes Reexamination Proceeding
Control No. 95/000,354
Filed: March 7, 2008
For: U.S. Patent No. 6,763,345

: 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.

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REVIEW OF SALIENT FACTS

1. United States Patent Number 6,763,345 (the '345 patent) issued to James D. Hempleman et al. on July 13, 2004, with 96 claims.

2. A request for *inter partes* reexamination of claims 1-96 of the '345 patent, assigned Reexamination Control No. 95/000,201 ('201), was filed December 8, 2006, by third party requester APPLE Computer, Incorporated.

3. An order granting reexamination of claims 1-96 of the '345 patent was mailed for the '201 reexamination proceeding on March 1, 2007.

4. An Office action containing at least one rejection of each of claims 1-96 of the '345 patent was mailed for the '201 reexamination proceeding on October 3, 2007.

5. Patent owner filed a timely response on November 3, 2007, including an amendment [1] canceling claims 2, 3, 5, 6, 9, 10, 13-18, 20, 22-25, 29-30, 38-40, 49-56, 63-65, 74-81, and 83-96; amending claims 4, 7, 8, 11, 12, 19, 21, 26-28, 32-37, 41-48, 57-62, 66-73, and 82; adding new claims 97-107; and leaving original patent claims 1 and 31 unamended.

6. A request for *inter partes* reexamination of claims 1, 31, 32, 57, 90, 92, and 95 of the '345 patent, assigned Reexamination Control No. 95/000,354 ('354), was filed March 7, 2008, by third party requester YAHOO! Incorporated.

7. An order granting reexamination of claim 31of the '345 patent was mailed for the '354 reexamination proceeding on May 14, 2008.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

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[1] The November 3, 2007 amendment did not comply with the proper format for claim amendment in reexamination proceedings. A supplemental paper was filed November 5, 2007, to present the claims in proper format.

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As evidenced by the above review of facts, both the '201 and the '354 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 95/000,201 and 95/000,354 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,201 and 95/000,354 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

1. The patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. On November 3, 2007 patent owner filed an amendment in reexamination proceeding control number 95/000,201. The patent owner has not amended the claims in reexamination proceeding control number 95/000,354. As a result, the claims are not the same in the two proceedings that are being merged. Accordingly an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, *inter partes* reexamination Control Nos. 95/000,201 and 95/000,354. (This can be accomplished by amending the '354 proceeding to conform with the '201 proceeding.).

2. 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. 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, or expungement of the paper, if it is entered prior to discovery of the defect.

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. 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

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decision is not an Office action on the merits of patentability. [2] 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.

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

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[2] If the patent owner files a response to the next 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.

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By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany 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 two 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 a patent owner 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.

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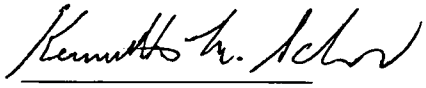
CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,201 and *inter partes* Reexamination Control No. 95/000,354 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Pursuant to Part II of this decision, **a housekeeping amendment is required within one month of this decision**, placing the same amendments in both cases of the present merged proceeding.

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 for the present merged proceeding, to be issued in due course. The examiner should not, however, issue an Office action until after the earlier of :(a) the submission of the required housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

4. 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

May 16, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,357	03/11/2008	7210744	PAS 07097	4783

7590 09/18/2008

EXAMINER	

James J. Prizzi
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P.O. BOX 231
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ART UNIT	PAPER NUMBER

DATE MAILED: 09/18/2008

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,357	03/11/08	7210744	PAS 07097

EXAMINER
ENGLISH, PETER C

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ART UNIT	PAPER
3993	

DATE MAILED:

09/18/08

INTER PARTES REEXAMINATION COMMUNICATION

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MAILED

SEP 18 2008

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

James Ray & Assocates
2640 Pitcairn Road
Monroeville, PA 15146

In re Montgomery, Jr.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,357	:	PETITION UNDER
Filed: March 11, 2008	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 7,210,744	:	

The paper filed by requester on June 10, 2008, entitled "Petition For Review of Denial of Request for *Inter Partes* Reexamination," is being treated as a petition Under 37 CFR 1.181 and 1.927 (hereinafter the Petition). The Petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed May 8, 2008.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,210,744 (hereinafter, the '744 patent) issued on May 1, 2007.

2. A request for *inter partes* reexamination was filed by a third party requestor, on March 11, 2008. The resulting reexamination proceeding was assigned Control No. 95/000,357 (hereinafter, the '357 proceeding).

3. Reexamination was requested for claims 1-4 of the '744 patent.

4. A Notice of Reexamination Request Filing Date was issued on April 2, 2008.

5. An order denying the request for reexamination for claims 1-4 was mailed on May 8, 2008.

6. On June 10, 2008, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the examiner incorrectly concluded that the teachings of U.S. Patent No. 6,585,326 to Sollami (hereinafter "Sollami '326") does not raise a substantial new question of patentability (SNQ). The examiner determined that Sollami '326 did not raise a SNQ because the teachings of Sollami '326 relied upon to raise the SNQ were also present in U.S. Patent No. 6,371,567 to Sollami (hereinafter "Sollami '567"), which was applied in a rejection in the previous examination of the application which issued as the '744 patent.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-4 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-4 of the '744 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

---

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

On September 4, 2008, the Court of Appeals for the Federal Circuit issued a decision that discussed the meaning of a substantial new question of patentability. See *In re Melvin J. Swanson and Patrick E. Guire* (CAFC 2007-1534). In this decision, the court found that the Office did not err in determining that Deutsch, which was applied in a rejection under 35 U.S.C. § 103 as a secondary teaching reference in the previous examination, raised a substantial new question of patentability based on anticipation. Specially, the court stated that "[i]n light of the extremely limited purpose for which the examiner considered Deutsch in the initial examination, the Board is correct that the issue of whether Deutsch anticipates the method disclosed in claims 22, 23, and 25 was a substantial new question of patentability, never before addressed by the PTO." The court also stated that:

> As the legislative history clarifies, to decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose. See H.R. Rep. No. 107-120, at 3 ("The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."); see also 147 Cong. Rec. H5359 (statement of Rep. Berman) ("Ideally, a reexamination could be requested based on prior art cited by an applicant that the examiner failed to adequately consider . . . .").
>
> Determining the scope of an examiner's previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions.

An analysis of the context in which Sollami '567 (which contained the same disclosure relied upon in Sollami '326) was previously considered and the scope of the prior consideration follows to determine whether Sollami '326 raises a substantial new question of patentability.

III. Summary of the Prior Prosecution with Respect to the Patent

The '744 patent contains claims 1-4.

The application (10/657,397), which issued as the '744 patent, was originally filed with 21 claims. In the first Office action, dated May 19, 2004, the examiner rejected claims 1-3 based on Sollami '567. The claims were also rejected based on a variety of other references (e.g., U.S. Patent Nos. 4,561,698; 4,844,550; 4,921,310; 5,303,984; 3,397,012; 4,084,556; etc.). See the Office action dated May 19, 2004. In reply, the applicant cancelled claims 1-21 and added new claims 21-25, which were narrower in scope than originally filed claims 1-3. See the reply filed August 23, 2004. The reply stated that Sollami '567 did not address the claimed feature that the split portion has "an

external surface that is uniformed," and argued that Sollami '567 is not applicable to new claims 21-25 for this reason. The examiner did not apply the rejection based on Sollami '567 to new claims 21-25, and made no comment as to why the rejection was not applied to claims 21-25.

The examiner eventually withdrew, or did not maintain, all of the prior art rejections, except for the anticipated rejection based on U.S. Patent No. 5,683,143 to Peterson. That rejection was appealed. On September 28, 2006, Board of Appeals and Interferences (BPAI) the reversed the examiner's rejection of claims 22-25 based on the Peterson patent. The February 12, 2007 Notice of Allowability did not provide reasons for allowance, but issued after the decision by the BPAI. As explained in the Petition on page 1, the BPAI found that Peterson did not teach that the split portion is flexible in a radial direction such that when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder. Claims 22-25 issued as claims 1-4 in the '744 patent.

IV. Analysis of the Request for Reexamination

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

(1) Claims 1-4 are unpatentable under 35 U.S.C. §102 over Sollami '326.

The Request was denied in the May 8, 2008 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the reference cited in the Request. The examiner determined that the teachings of Sollami '326 were cumulative to the teachings of Sollami '567 (the parent of Sollami '326), which was applied in a rejection against originally filed claims 1-3. Therefore, the examiner determined that Sollami '326 did not teach anything that was not taught in the prior art of record. Thus, Sollami '326 is stated, in the denial, to be cumulative and not to raise a substantial new question of patentability.

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the request, it states that Sollami '326 teaches a split portion is flexible in a radial direction such that when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder. The Director has reviewed the entire record, and has determined that there is a substantial new question of patentability presented by the teachings of Sollami '326 for reasons set forth below. Accordingly, the petition is granted, and reexamination is hereby ordered.

Sollami '326 was not cited in the earlier examination of the patent. It is true that the parent of Sollami '326, which is Sollami '567, was cited and applied against originally filed claims 1-3 (see the Office action dated May 19, 2004). It is also true that the disclosure of Sollami '567 and Sollami '326 both teach the subject matter for which the request for reexamination is relied upon (e.g., see column 4 line 52 to column 5 line 2 in both patents). Therefore, it is appropriate to treat Sollami '326 the same as Sollami '567, which is "old art" that was cited in a previous examination.

Review of the specification and prosecution history of the '744 patent clearly indicates that the invention of the '744 patent was allowed because of the claim limitations pertaining to the flexible split portion as mentioned above. Although it appears that Sollami '567 may also teach this claim limitation, the record does not show that the examiner in the previous examination fully appreciated this teaching of Sollami '567. While Sollami '567 was applied in a rejection against the originally filed claims 1-3 (that did not contain such limitations pertaining the flexible split portion) in the previous examination, there is no statement by the examiner regarding the teachings of Sollami '567 as to new claims 22-25, which issued as patent claims 1-4. Therefore, the record does not reflect that this issue of patentability was fully considered and decided by the examiner in the previous examination. In other words, the requester has drawn attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Accordingly, the requester has presented the teachings of Sollami '326 in "a new light" that was not considered by the examiner in the previous examination.

As pointed out above, the teachings of Sollami '326 are directly related to subject matter considered as the basis for allowability of the claims in the application that issued as the '744 patent. Accordingly, a reasonable examiner would consider evaluation of Sollami '326 as important in determining the patentability of claims 1-4. As such, it is agreed with petitioner that Sollami '326 raises a substantial new question of patentability with respect to claims 1-4 of the '744 patent.

Because it is agreed that Sollami '326 raises a SNQ with respect to claims 1-4 of the '744 patent, the Petition is GRANTED.

The issue of the newly proposed substantial new question based on obvious over Sollami '326 in view of Peterson, on page 5 of the Petition is not addressed because one substantial new question (based on Sollami '326 alone) has been raised by the request for reexamination, as to all the claims requested. It is further noted that the examiner is not required to address this new SNQ because it was not raised in the original request for reexamination.

CONCLUSION

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

2. Accordingly, the request for *inter partes* reexamination of claims 1-4 of the '744 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.

4. An Office action on the merits will follow in due course.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikow Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,357	03/11/2008	7210744	PAS 07097	4783

7590 06/23/2010

EXAMINER	

ART UNIT	PAPER NUMBER

James J. Prizzi
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P.O. BOX 231
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DATE MAILED: 06/23/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,357	03/11/2008	7210744	PAS 07097

JAMES RAY & ASSOCATES
2640 PITCAIRN ROAD
MONROEVILLE, PA 15146

EXAMINER	
DAWSON, GLENN	
ART UNIT	**PAPER**
3993	

DATE MAILED:

06/23/10

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,357	03/11/2008	7210744	PAS 07097

EXAMINER
DAWSON, GLENN

ART UNIT	PAPER
3993	

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DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

In re Montgomery
Inter Partes Reexamination Proceeding
Control No.: 95/000,357
Request Deposited: March 11, 2008
For: U.S. Patent No.: 7,210,744

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on the April 20, 2010 Third Party Requester, ("Petitioner" or "Sollami"), petition, entitled PETITION TO THE DIRECTOR filed under 37 C.F.R. § 1.183.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for consideration.

The petition to waive the timeliness requirement (of 37 C.F.R. § 41.66(a)) is denied for the reasons set forth below.

FEES

The requisite petition fee for a petition under 37 C.F.R. § 1.183 is $400.00 pursuant to 37 C.F.R. § 1.17(f), and the $400.00 fee has been charged to petitioner's credit card.

REVIEW OF FACTS

1. U.S. Patent No. 7,210,744 (the '744 patent) was granted to Robert H. Montgomery Jr. on May 1, 2007, based on an application for patent filed on December 3, 1998. The patent is assigned to Kennametal Inc.

2. On March 3, 2008, third party requester, The Sollami Company ("Sollami"), filed an original request for *inter partes* reexamination of the '744 patent, which request was assigned reexamination control no. 95/000,357 ("the '357 proceeding").

3. On May 8, 2008, the March 3, 2008 request for *inter partes* reexamination of the '744 patent was denied.

4. On June 10, 2008, Sollami filed a petition for review of the May 8, 2008 denial of the request for *inter partes* reexamination.

5. On September 18, 2008, the United States Patent and Trademark Office ("USPTO") granted the June 10, 2008 petition, and ordered *inter partes* reexamination of the '744 patent in the '357 proceeding.

6. On January 7, 2009, the USPTO issued an action closing prosecution, confirming all claims of the '744 patent.

7. On May 11, 2009, the USPTO issued a right of appeal notice.

8. On June 10, 2009, Sollami filed a notice of appeal.

9. On October 12, 2009, Sollami untimely filed an appellant's brief.

10. On February 23, 2010, the USPTO issued a notice of intent to issue *inter partes* reexamination certificate (NIRC) stating that Sollami's October 12, 2009 appellant's brief was late and was not considered.

11. On April 20, 2010, Sollami filed the present petition.

12. On May 4, 2010, the *inter partes* reexamination certificate for the '744 patent issued.

REELVANT STATUTES, REGULATIONS AND PROCEDURES

37 C.F.R. § 1.183 states, "[i]n an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f)."

37 C.F.R. § 41.66(a) states, "[a]n 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."

DECISION

Because the present petition was not timely submitted and failed to request waiver of any particular rule without any factual basis, the petition requesting the USPTO to "waive the timeliness requirement and accept the [fee] filed with the brief and [that] the brief be accepted," is denied. Additionally, because the USPTO lacks jurisdiction over a patent in a reexamination proceeding where the certificate of *inter partes* reexamination has issued, the petition is denied.

I. The Petition Requesting Waiver Fails to State a Basis for Which Relief Can be Granted

Patent owner filed the present petition requesting that the Director waive "the timeliness requirement" and accept their late filed brief. Even if the petition had been addressed prior to issuance of the certificate, the petition to accept the late filed appellant's brief would not be grantable.

In order for grant of any petition under 37 C.F.R. § 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case. Petitioners' failure to timely file an acceptable reply brief is not an extraordinary situation which, where justice requires, waiver of the rules. Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See In re *Tetrafluor, Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re *Bird & Son, Inc.* 195 USPQ 586, 588 (Comm'r Pats. 1977). In this instance, the following three considerations are to be noted:

First, an appellant's brief in an *inter partes* reexamination proceeding is required to be filed, "not later than two months from the latest filing date of the last-filed notice of appeal or cross appeal.... The time for filing an appellant's brief or an amended appellant's brief may not be extended." See 37 C.F.R. § 41.66(a). In the *inter partes* proceeding for the '744 patent, requester failed to timely file its appellant's brief. It appears that requester attempted to extend the period for filing the appellant's brief by submitting a petition fee under 37 C.F.R. § 1.17(g); the fee worksheet submitted October 12, 2009 refers to "Petition fee - 37 CFR 1.17(g) (Group II)" at page 2. [1] Such a submission is clearly inappropriate, since 37 C.F.R. § 41.66(a) specifically excludes any extension of time provisions for filing an appellant's brief during *inter partes* reexamination proceedings, and any petition for extension of time would have needed to be filed under 37 C.F.R. § 1.183 for waiver of 37 C.F.R. § 41.66(a). Additionally, even if the "petition" had been filed under 37 C.F.R. § 1.183 for waiver of 37 C.F.R. § 41.66(a), 37 C.F.R. § 1.956 requires, for an extension 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.

No detailed reason was given in the "petition" for extension for the delay in filing the brief (see MPEP 2665), and the "petition" was not filed "on or before the day on which action by the patent owner is due." It is to be noted that 35 U.S.C. § 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch" (37 C.F.R. § 1.937).

Thus, it appears from the record that that petitioners' counsel lacked the knowledge of, and failed to properly apply the patent rules of practice. As pointed out above, such does not constitute

[1] The USPTO has refunded the miscellaneous petition fee which was processed along with the appellant's brief submission on October 12, 2009.

extraordinary circumstances where the interests of justice require the granting of relief.

Second, upon learning in the February 23, 2010 communication that the appellant's brief was not timely submitted and that the '357 proceeding was to be concluded by a Notice regarding the USPTO's intent to issue an *inter partes* reexamination certificate for the '744 patent, requester waited nearly two months to submit the present petition, only two weeks before the reexamination certificate issued. This permitted the certificate to issue, divesting the USPTO of jurisdiction over the proceeding. Requester has not provided any compelling evidence for the delay in filing the 37 C.F.R. § 1.183 petition to waive the "timeliness requirement" to, after the certificate has issued, accept the untimely filed appellant's brief nearly 8 months after the appellant's brief was due. In the present circumstance, even if the USPTO had jurisdiction, the present petition is not grantable, as it appears from the record that that petitioners' counsel failed to exercise due care in prosecuting the proceeding. As pointed out above, such does not constitute extraordinary circumstances where the interests of justice require the granting of relief.

Third, 37 C.F.R. § 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts which justify considering timely an appellant's brief filed two months late, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 C.F.R. § 41.66(a).

For all of the reasons set forth above, patent owner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of the timeliness requirements for file an appellant's brief, and the April 20, 2010 petition under 37 C.F.R. § 1.183 is denied.

II. USPTO Lacks Jurisdiction to Grant Petition Under 37 C.F.R. § 1.183

The petition was filed with only two weeks remaining until the issuance of the reexamination certificate, which was insufficient time remaining to process and match the petition with the proceeding prior to issuance of the Certificate.[2] The present reexamination proceeding concluded with the issuance of *Inter Partes* Reexamination Certificate (0157th), US 7,210,744 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '744 patent. Therefore, the petition to accept the late filed appellant's brief is not authorized by statute. Accordingly, the petition is denied.

III. Alternative Relief Requested

In the last sentence of the petition, it is stated:

In the alternative, Petitioner requests that the Director issue an order *sua sponte* to reexamine the Montgomery '744 patent claims 1-4.

Pursuant to 37 C.F.R. § 1.4(c), "each distinct subject, inquiry or order must be contained in a

[2] No reason is given in the petition for the almost 2-months delay in filing this petition after receipt of the NIRC.

separate paper to avoid confusion and delay in answering papers dealing with different subjects." Requester would need to submit a 37 C.F.R. § 1.182 petition for a Director initiated reexamination separately form the present 37 C.F.R. § 1.183 petition. However, it is to be noted that, as pointed out in MPEP 2239, "[t]he Director of the USPTO will not normally consider requests to order reexamination at the Director's initiative received from members of the public."

CONCLUSION

1. The third party requester's petition filed April 20, 2010 for waiver of the timeliness requirement for filing an appellant's brief is **denied**.

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

3. Any further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

4. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at (571) 272-7755.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
United States Patent and Trademark Office

6-23-10
Kiva/jurisdiction

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

SEP 12 2008

CENTRAL REEXAMINATION UNIT

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

McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, D.C. 20005-3096 (For Patent Owner)

Richard L. Stroup
Finnegan, Henderson, Farabow, Garrett & Dunner LLP (For Requester)
901 New York Ave, N.W.
Washington, D.C. 20001

In re Benjamin N. Eldridge et al. :
Reexamination Proceeding : DECISION GRANTING
Control No.: 95/000,358 : PETITION
Filed: March 14, 2008 : UNDER 37 CFR 1.183
For: U.S. Patent No. 6,615,485 :

This is a decision on the petition under 37 CFR 1.183 filed by the patent owner on August 7, 2008, titled "PETITION TO SUSPEND RULE 37 C.F.R. 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. 1.183," requesting waiver of 37 CFR 1.943(b) that requires responses by the patent owner not to exceed fifty (50) pages in length. Specifically, the patent owner requests an additional fifty pages (100 total pages) to respond to the Office action mailed on June 12, 2008. The requisite fee of $400.00 mandated by the 37 CFR 1.17(f) is being charged to Deposit Account 50-0417 .

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition is granted to the extent that the page limit for the response to the June 12, 2008 first Office action is extended to not exceed 75 pages in length.

REVIEW OF FACTS

1. U.S. Patent No. 6,615,485 (the '485 patent) issued on September 9, 2003.

2. A request for reexamination of the '485 patent was filed on March 14, 2008. The request was assigned control No. 95/000,358 (the '358 proceeding).

3. Reexamination was ordered for the '358 proceeding on June 12, 2008. A first action on the merits accompanied the order. A shortened statutory period of two months was set for the filing of a response to the Office action. This shortened

statutory period was extended by one month by the petition decision of August 8, 2008.

4. On August 7, 2008, the patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, 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 patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds fifty (50) pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

The record reveals that the Office action mailed on June 12, 2008 exceeds fifty pages. The Office action adopts 27 grounds of rejection in 70 pages and does not appear to incorporate by reference a significant part of the request for reexamination. The order granting the request also takes 75 pages.

Based upon the above facts and the individual facts and circumstances of this proceeding, a response by the patent owner that does not exceed 75 pages in length (an additional 25 pages) to respond to the Office action mailed on June 12, 2008 is deemed equitable to address the Office action.

Accordingly, the petition is granted:

(A) For only the next immediate response filed by the patent owner, in response to the Office action mailed on June 12, 2008; and

(B) To permit patent owner to provide as much as seventy-five (75) pages for patent owner's response to the Office action mailed on June 12, 2008. The Office will enforce

compliance with this new page limit of 75 pages, and a strict review of the length of patent owner's response will be made upon its receipt.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to the extent that the page limit of the response by the patent owner to the Office action mailed on June 12, 2008, is extended, but is not to exceed seventy-five (75) pages in length.

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

3. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7729 or Pinchus M. Laufer, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7726.

Kenneth M. Schor

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

09-12-08
C:\kiva\kenpet6\IP\UV\95_358 waiver of page limit.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.
95/000,358	03/14/2008	6615485	074442-0016	4928

20277 7590 05/04/2009

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Richard L. Stroup
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901 New York Ave., NW
Washingto, DC 20001

MAILED

MAY 04 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,358*.

PATENT NUMBER *6,615,485*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	074442-0016

EXAMINER
FLANAGAN, BEVERLY

FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
LIVERMORE, CA 94551

ART UNIT	PAPER
3993	

DATE MAILED:

05/04/09

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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P.O. Box 1450
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FormFactor, Inc.
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7005 Southfront Road
Livermore, CA 94551

(For Patent Owner)

MAILED

MAY 04 2009

CENTRAL REEXAMINATION UNIT

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901 New York Ave, N.W.
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(For Requester)

Kenneth L. Cage
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600 13th Street, N.W.
Washington, D.C. 20005-3096

(Courtesy Copy)

In re Benjamin N. Eldridge et al.
Reexamination Proceeding
Control No.: 95/000,358
Filed: March 14, 2008
For: U.S. Patent No. 6,615,485

: DECISION DISMISSING
: PETITION
: UNDER 37 CFR 1.183

This is a decision on the petition under 37 CFR 1.183 filed by the patent owner on April 2, 2009, titled "PETITION TO SUSPEND RULE 37 C.F.R. 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. 1.183," requesting waiver of 37 CFR 1.943(b) that requires responses by the patent owner not to exceed fifty (50) pages in length. Specifically, the patent owner requests an additional fifty pages (100 total pages) to respond to the Office action mailed on March 18, 2009.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner representative's Deposit Account 500417 on April 3, 2009.

The petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,615,485 (the '485 patent) issued on September 9, 2003.

2. A request for reexamination of the '485 patent was filed on March 14, 2008. The request was assigned control No. 95/000,358 (the '358 proceeding).

3. Reexamination was ordered for the '358 proceeding on June 12, 2008. A first action on the merits accompanied the order. A shortened statutory period of two months was set for the filing of a response to the Office action.

4. A petition requesting an extension of time, filed August 6, 2008, was granted on August 8, 2009, extending the shortened statutory period by one month to September 12, 2008.

5. A petition requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length filed August 7, 2008 was granted on September 12, 2009 permitting a response not to exceed 75 pages in length.

6. A second petition requesting an extension of time, filed September 11, 2008, inadvertently in the application that matured into the patent subject to this reexamination proceeding, was denied March 4, 2009.

7. Patent owner filed a timely response on September 12, 2008, and the third party requester filed comments on October 10, 2008.

8. An action closing prosecution was mailed March 18, 2009, setting a one month period for response by the patent owner.

9. A petition requesting an extension of time, filed April 2, 2009, was granted on April 7, 2009, extending the period for response to May 18, 2009.

10. A petition to suspend rule 37 CFR 1.943(b) pursuant to the provisions of 37 CFR 1.183 was filed April 2, 2009, requesting an enlargement of the 50 page limit to 100 pages. This April 2nd petition to enlarge the page limit is the subject of this decision.

11. A "PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 CFR 1.81 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009" was filed April 21, 2009 and is awaiting decision.

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.

I. PATENT OWNER'S PETITION OF APRIL 2, 2009

Patent owner requests suspension of the 50 page limit rule because the examiner has issued a multiplicity of rejections that result in a seventy (70) page Office action that is based on a reexamination request of one hundred and forty two (142) pages. The patent owner asserts a responsibility to address thirty one (31) separate grounds of rejection in the Office action, including fourteen (14) anticipation rejections and seventeen (17) obviousness rejections, each on one or more of claims 1-12, 15, 18-25, 29-38, and 41-42.

The patent owner states that this case presents extraordinary circumstances because of the burden that each and every rejection must be addressed in a 50 page response and that such a response would not be practical. Further, patent owner avers that the outstanding Office action states that patent owner did not "specifically" address each adopted rejection under MPEP 2666 and that patent owner requires sufficient page length to specifically address each rejection. The petition further argues that the examiner has applied numerous cumulative grounds of rejection to the claims by essentially adopting the requester's multiplicity of rejections. According to patent owner, this presents a bias to the patent owner who bears the burden to fully respond in fifty (50) pages to a seventy (70) page Office action based on a one hundred and forty two (142) page reexamination request.

The record reveals that the original Office action, mailed on June 12, 2008, contained sixty seven (67) pages and was based on the reexamination request that contained one hundred and thirty four (134) pages. The June 12th Office action repeats the proposed rejections from the request in the first eight (8) pages and then in the next fifty eight (58) pages substantially adopts thirty (30) grounds of rejection essentially as proposed in the request

and declines to adopt seven (7) grounds of rejection. Patent owner responded to that Office action in forty four (44) pages, and the third party requester responded in twenty five (25) pages. The March 18, 2009 Office action reiterates the adopted and non-adopted grounds of rejection from the first Office action in the first sixty five (65) pages and then responds to patent owner's arguments and third party requester arguments in the next three (3) pages.

II. 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. In this instance, petitioner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to the outstanding Office action to 100 pages, exclusive of any fact-based declarations or other factual appendix evidence that may accompany patent owner's response. General requests, unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

In this instance, petitioner has requested that the page limit for patent owner's response to the outstanding Office action be increased to an amount that exceeds the number of pages of the outstanding Office action and exceeds the number of pages of the prior Office action, which was reiterated in the outstanding Office action. However, petitioner has not set forth with specificity the facts upon which petitioner based its determination that approximately 50 extra pages are needed for patent owner to adequately respond to the outstanding Office action. In fact, patent owner has submitted an April 21, 2009 petition under 37 CFR 1.181 requesting supervisory authority stating that the Office action offers nothing of substance. Page 3 of patent owner's April 21, 2009 petition states that "it is clear that the ACP offers nearly nothing of substance:

- Page 1: cover page
- Page 2: describes boilerplate procedure and history of submissions by Patent Owner and Requester.
- Pages 3-65 ("Previously Set Forth Rejections"): copies verbatim the discussion of maintained rejections presented on pages 3-65 of the Office Action mailed on June 12, 2008, with minor changes made solely with respect to Requester's Grounds 32-37, which were never adopted by the Examiner.
- Pages 65-67 ("Response to Arguments"): contains the only comments directed to Patent Owner's Response. Most of the section, spanning approximately 2 ¼ pages, simply cites various statements made by Patent Owner and Requester. A copy of these pages are provided as Attachment A for the Director's convenience.
- Pages 69-70: standard closing language, noting Office Action in an ACP".

As Patent owner believes the ACP to be a substantial reproduction of the prior Office action to which a response has already been filed, there appears to be no extraordinary

circumstance presented that would warrant waiver of the fifty (50) page limit imposed by 37 CFR 1.943 (b).

A showing which petitioner can make in support of a request for waiver of the fifty (50) page limit can be a response prepared in an attempt to comply with the 50-page limit, yet resulting in a response that is in excess of 50 pages. Such a response would be submitted concurrently with a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, as opposed to relying on general statements that patent owner needs fifty (50) extra pages to respond to an Office action that did not raise any new grounds of rejection, petitioner can rely on the proposed response (1) for justification that more pages are needed to complete the response and (2) to demonstrate an accurate determination of exactly how many additional pages are needed to complete the response.

Note that if the Office does not grant such a (renewed) petition to the full extent of the proposed response, patent owner would be given a period of 15 days within which to submit a compliant response in accordance with the page limit set forth in the decision on such a petition. *See* MPEP 2667(I)(A)(2). Further, it should also be noted that the presence, in the submission, of supporting expert declarations or other appendix evidence is not a basis for waiver of 37 CFR 1.943(b), as patent owner can fashion the content of such declarations or other appendix evidence to avoid having those pages count toward the 50-page limit. *See* MPEP 2667(I)(A)(2).[1]

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.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of FormFactor, Inc. The Office will not engage in double correspondence with more than one attorney or agent. The change in power of attorney filed in the reexamination proceeding does not control the correspondence address for the patent file. As a courtesy, this decision is being mailed to both addresses. The address of FormFactor, Inc. will be the sole address used in future correspondence, until a change in correspondence address is also made in the patent in accordance with 37 CFR 1.33(c). It is recommended that Form PTO/SB/123 be used for this purpose.

[1] That is, patent owner can limit the content of the expert declarations or other appendix evidence to factual observations and avoid including any legal conclusions about the factual observations.

CONCLUSION

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

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to address the petition filed April 21, 2009.

3. A response to the March 18, 2009 Action Closing Prosecution remains due by May 18, 2009.

4. The correspondence address in the patent needs to be changed to correspond with the power of attorney filed in this reexamination proceeding, as explained above.

5. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7729.

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

04-29-09

UNITED STATES PATENT AND TRADEMARK OFFICE

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Richard L. Stroup
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 New York Ave., NW
Washingto, DC 20001

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,358*.

PATENT NUMBER *6,615,485*.

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

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.
95/000,358	03/14/2008	6615485	074442-0016	4928

20277 7590 05/13/2009

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

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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United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	074442.0016

EXAMINER
FLANAGAN, BEVERLY

FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
LIVERMORE, CA 94551

ART UNIT	PAPER
3993	

DATE MAILED:

05/13/09

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
www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	074442.0016

EXAMINER
FLANAGAN, BEVERLY

FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
LIVERMORE, CA 94551

ART UNIT	PAPER
3993	

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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FormFactor, Inc.
Legal Department
7005 Southfront Road
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(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Richard L. Stroup
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(For Requester)

Kenneth L. Cage
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Washington, D.C. 20005-3096

(Courtesy Copy)

In re Benjamin N. Eldridge et al.
Reexamination Proceeding
Control No.: 95/000,358
Filed: March 14, 2008
For: U.S. Patent No. 6,615,485

: DECISION DISMISSING
: REQUEST FOR
: SUSPENSION OF THE
: RULES AND REFUSING
: ENTRY OF PAPER

This is a decision on the petition under 37 CFR 1.181 - 1.183 filed by the third party requestor on April 29, 2009, titled "REQUESTOR'S PETITION TO DENY AND TO STRIKE PATENT OWNER'S PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 C.F.R. 1.181 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009" which requests suspension of the rules to oppose the patent owner's request and which requests that the patent owner's petition be stricken.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) has been received.

The requestor's request that the rules be suspended to permit an opposition is dismissed. Further, the April 29, 2009, third party requestor paper is refused entry into the record, without consideration on the merits, for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,615,485 (the '485 patent) issued on September 9, 2003.

2. A request for reexamination of the '485 patent was filed on March 14, 2008. The request was assigned control No. 95/000,358 (the '358 proceeding).

3. Reexamination was ordered for the '358 proceeding on June 12, 2008. A first action on the merits accompanied the order. A shortened statutory period of two months was set for the filing of a response to the Office action.

4. After receiving an extension of time, patent owner filed a timely response on September 12, 2008, and the third party requester filed comments on October 10, 2008.

5. An action closing prosecution was mailed March 18, 2009, setting a one month period for response by the patent owner.

6. A petition requesting an extension of time, filed April 2, 2009, by patent owner, was granted on April 7, 2009, extending the period for response to May 18, 2009. No response by the patent owner has yet been filed.

7. A petition to suspend rule 37 CFR 1.943(b) pursuant to the provisions of 37 CFR 1.183 was filed April 2, 2009, by patent owner, requesting an enlargement of the 50 page limit to 100 pages, and was dismissed.

8. A "PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 CFR 1.81 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009" was filed April 21, 2009, by patent owner, and is awaiting decision.

9. A petition requesting that the April 21, 2009, patent owner petition be denied and stricken was filed by the third party requestor on April 29, 2009, and is the subject of this decision.

DECISION

I. 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 1.181 states in pertinent part:

(a) Petition may be taken to the Director:

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

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

37 CFR 1.181 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 1.945 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 1.939(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.

II. DECISION DISMISSING REQUEST FOR SUSPENSION OF THE RULES AND REFUSING ENTRY OF THE THIRD PARTY REQUESTER OPPOSITION

The third party requester has requested suspension of the rules so that the requestor can oppose and seek the denial of the April 21, 2009 patent owner request for reconsideration of the March 18, 2009, ACP or for supervisory intervention. The requestor argues that the patent owner's petition improperly seeks a review of the merits and the grant of extraordinary and improper relief that would unduly delay reexamination, conflict with Office policies, and unfairly prejudice the requestor.

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 within a period of 30 days from the of service of a patent owner's response to an Office action. This right is implemented by 37 CFR 1.947, which provides that a third party requester may once file written comments within 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 petition under 37 CFR 1.181, 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 petition under 37 CFR 1.181 requesting that an action not be designated as closing prosecution. This is an issue that goes to procedure, 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 comment on procedural matters, such as the propriety of an Office action closing prosecution, 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 April 21, 2009 petition is a paper that is not authorized by the statute governing *inter partes* reexamination proceedings, and thus 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 petition is not enterable into the record, because it is not provided for by the reexamination statute or regulations.

The third party asserts that the rules should be suspended to allow such an opposition. However, there is no statutory authority to provide for such an opposition and, moreover, the requestor has not shown that an extraordinary situation exists that would compel suspension of the rules. It is noted that whether the relief requested in patent owner's

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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 *ex parte* 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.

request for supervisory review is grantable in accordance with 37 CFR 1.181 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. § 2(b)(2)(A) provides that "[t]he Office may establish regulations, not inconsistent with the law, which shall govern the conduct of proceedings in the Office." Pursuant to the statute, 37 CFR.1.181(a) establishes the right, in reexamination proceedings, to petition to the Director with respect to any action, or inaction, which is "not subject to appeal" during the examination under the provisions of 35 U.S.C. 132. It follows that 37 CFR 1.181 permits a patent owner to secure supervisory review of an examiner's action in an *inter partes* reexamination proceeding consistent with the authority to conduct *inter partes* reexamination proceedings conferred upon the Office by 35 U.S.C. §§ 311 *et seq.* As the Office has the ability and authority to render a decision on the propriety and merits of patent owner's petition, the extraordinary relief requested to permit the requestor's opposition comments to be entered into the proceeding is not warranted.

In the area bearing on whether the Office has taken an *ultra vires* action, a requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office [2] or oppose the making public of the requester's protected material. However, the consideration under 37 CFR 1.181 of whether an action designated as an ACP is to be reopened is clearly a matter within the Office's jurisdiction, based on the incorporation of 35 U.S.C. § 132 into the *inter partes* reexamination statute via 35 U.S.C. § 314(a), as discussed above, and the requester cannot comment on the Office's authorized exercise of that jurisdiction. Accordingly, the requester's opposition to patent owner's petition of April 21, 2009, is not enterable into the record, and it is 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 April 29, 2009, paper filed in opposition to the patent owner's April 21, 2009, request for supervisory review 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 present petition paper has already been incorporated into the electronic Image File Wrapper (IFW), the original petition paper cannot be physically returned to the third party requester. Thus, the present petition paper will be expunged from the record by marking it as "closed" and "non-public" in the IFW. See MPEP 2667, first paragraph. A copy of the present decision will, however, be made of record in the reexamination file.

The request for suspension of the rules to permit an opposition is dismissed. Further, the April 29, 2009, requester comments filed in response to the patent owner's April 21, 2009, petition for supervisory review under 37 CFR 1.181 do not have an entry right in the instant proceeding, for the reasons set forth above.

---

[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.

CONCLUSION

1. The third party requestor's request under 37 CFR 1.183 for suspension of the rules is dismissed.
2. The third party requestor's April 29, 2009 paper in opposition to the patent owner's April 21, 2009, petition for supervisory review is refused entry as it is an improper paper. The opposition paper is not enterable into the record of the present reexamination proceeding, because such a submission is not provided for in the reexamination statute or the regulations promulgated under the statute.
3. Because the April 29, 2009 paper was previously incorporated into the IFW, the paper will be expunged from the record by marking it "closed" and "non-public" in the IFW record of the present reexamination proceeding. No copy of the opposition paper will be maintained of record in the Office.
4. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.
5. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7729.

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

cdd

5-12-09

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FormFactor, Inc.
Legal Department
7005 Southfront Road
Livermore, CA 94551

(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

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(Courtesy Copy)

In re Benjamin N. Eldridge et al.
Reexamination Proceeding
Control No.: 95/000,358
Filed: March 14, 2008
For: U.S. Patent No. 6,615,485

: DECISION DISMISSING
: REQUEST FOR
: SUSPENSION OF THE
: RULES AND REFUSING
: ENTRY OF PAPER

This is a decision on the petition under 37 CFR 1.181 - 1.183 filed by the third party requestor on April 29, 2009, titled "REQUESTOR'S PETITION TO DENY AND TO STRIKE PATENT OWNER'S PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 C.F.R. 1.181 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009" which requests suspension of the rules to oppose the patent owner's request and which requests that the patent owner's petition be stricken.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) has been received.

The requestor's request that the rules be suspended to permit an opposition is dismissed. Further, the April 29, 2009, third party requestor paper is refused entry into the record, without consideration on the merits, for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,615,485 (the '485 patent) issued on September 9, 2003.

2. A request for reexamination of the '485 patent was filed on March 14, 2008. The request was assigned control No. 95/000,358 (the '358 proceeding).

3. Reexamination was ordered for the '358 proceeding on June 12, 2008. A first action on the merits accompanied the order. A shortened statutory period of two months was set for the filing of a response to the Office action.

4. After receiving an extension of time, patent owner filed a timely response on September 12, 2008, and the third party requester filed comments on October 10, 2008.

5. An action closing prosecution was mailed March 18, 2009, setting a one month period for response by the patent owner.

6. A petition requesting an extension of time, filed April 2, 2009, by patent owner, was granted on April 7, 2009, extending the period for response to May 18, 2009. No response by the patent owner has yet been filed.

7. A petition to suspend rule 37 CFR 1.943(b) pursuant to the provisions of 37 CFR 1.183 was filed April 2, 2009, by patent owner, requesting an enlargement of the 50 page limit to 100 pages, and was dismissed.

8. A "PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 CFR 1.81 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009" was filed April 21, 2009, by patent owner, and is awaiting decision.

9. A petition requesting that the April 21, 2009, patent owner petition be denied and stricken was filed by the third party requestor on April 29, 2009, and is the subject of this decision.

DECISION

I. 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 1.181 states in pertinent part:

(a) Petition may be taken to the Director:

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

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

37 CFR 1.181 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 1.945 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 1.939(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.

II. DECISION DISMISSING REQUEST FOR SUSPENSION OF THE RULES AND REFUSING ENTRY OF THE THIRD PARTY REQUESTER OPPOSITION

The third party requester has requested suspension of the rules so that the requestor can oppose and seek the denial of the April 21, 2009 patent owner request for reconsideration of the March 18, 2009, ACP or for supervisory intervention. The requestor argues that the patent owner's petition improperly seeks a review of the merits and the grant of extraordinary and improper relief that would unduly delay reexamination, conflict with Office policies, and unfairly prejudice the requestor.

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 within a period of 30 days from the of service of a patent owner's response to an Office action. This right is implemented by 37 CFR 1.947, which provides that a third party requester may once file written comments within 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 petition under 37 CFR 1.181, 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 petition under 37 CFR 1.181 requesting that an action not be designated as closing prosecution. This is an issue that goes to procedure, 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 comment on procedural matters, such as the propriety of an Office action closing prosecution, 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 April 21, 2009 petition is a paper that is not authorized by the statute governing *inter partes* reexamination proceedings, and thus 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 petition is not enterable into the record, because it is not provided for by the reexamination statute or regulations.

The third party asserts that the rules should be suspended to allow such an opposition. However, there is no statutory authority to provide for such an opposition and, moreover, the requestor has not shown that an extraordinary situation exists that would compel suspension of the rules. It is noted that whether the relief requested in patent owner's

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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 *ex parte* 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.

request for supervisory review is grantable in accordance with 37 CFR 1.181 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. § 2(b)(2)(A) provides that "[t]he Office may establish regulations, not inconsistent with the law, which shall govern the conduct of proceedings in the Office." Pursuant to the statute, 37 CFR.1.181(a) establishes the right, in reexamination proceedings, to petition to the Director with respect to any action, or inaction, which is "not subject to appeal" during the examination under the provisions of 35 U.S.C. 132. It follows that 37 CFR 1.181 permits a patent owner to secure supervisory review of an examiner's action in an *inter partes* reexamination proceeding consistent with the authority to conduct *inter partes* reexamination proceedings conferred upon the Office by 35 U.S.C. §§ 311 *et seq.* As the Office has the ability and authority to render a decision on the propriety and merits of patent owner's petition, the extraordinary relief requested to permit the requestor's opposition comments to be entered into the proceeding is not warranted.

In the area bearing on whether the Office has taken an *ultra vires* action, a requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office [2] or oppose the making public of the requester's protected material. However, the consideration under 37 CFR 1.181 of whether an action designated as an ACP is to be reopened is clearly a matter within the Office's jurisdiction, based on the incorporation of 35 U.S.C. § 132 into the *inter partes* reexamination statute via 35 U.S.C. § 314(a), as discussed above, and the requester cannot comment on the Office's authorized exercise of that jurisdiction. Accordingly, the requester's opposition to patent owner's petition of April 21, 2009, is not enterable into the record, and it is 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 April 29, 2009, paper filed in opposition to the patent owner's April 21, 2009, request for supervisory review 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 present petition paper has already been incorporated into the electronic Image File Wrapper (IFW), the original petition paper cannot be physically returned to the third party requester. Thus, the present petition paper will be expunged from the record by marking it as "closed" and "non-public" in the IFW. See MPEP 2667, first paragraph. A copy of the present decision will, however, be made of record in the reexamination file.

The request for suspension of the rules to permit an opposition is dismissed. Further, the April 29, 2009, requester comments filed in response to the patent owner's April 21, 2009, petition for supervisory review under 37 CFR 1.181 do not have an entry right in the instant proceeding, for the reasons set forth above.

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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.

CONCLUSION

1. The third party requestor's request under 37 CFR 1.183 for suspension of the rules is dismissed.
2. The third party requestor's April 29, 2009 paper in opposition to the patent owner's April 21, 2009, petition for supervisory review is refused entry as it is an improper paper. The opposition paper is not enterable into the record of the present reexamination proceeding, because such a submission is not provided for in the reexamination statute or the regulations promulgated under the statute.
3. Because the April 29, 2009 paper was previously incorporated into the IFW, the paper will be expunged from the record by marking it "closed" and "non-public" in the IFW record of the present reexamination proceeding. No copy of the opposition paper will be maintained of record in the Office.
4. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.
5. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7729.

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

cdd

5-12-09

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,358	03/14/2008	6615485	074442-0016	4928

20277 7590 05/22/2009

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Richard L. Stroup
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 New York Ave., NW
Washingto, DC 20001

MAILED

MAY 22 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,358*.

PATENT NUMBER *6,615,485*.

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

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.
95/000,358	03/14/2008	6615485	074442-0016	4928

20277 7590 05/22/2009

EXAMINER	
ART UNIT	PAPER NUMBER

FormFactor, Inc
Legal Department
7005 Southfront Road
Livermore, CA 94551

DATE MAILED: 05/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

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MAILED

MAY 22 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

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Kenneth L. Cage
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600 13th Street, N.W.
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(Courtesy Copy)

In re Eldridge et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,358	:	FOR REOPENING
Filed: March 14, 2008	:	PROSECUTION
For: U.S. Patent No.: 6,615,485	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the Patent Owner on April 21, 2009. The petition is entitled "PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.181 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009," and is treated as 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 March 18, 2009. The petition is before the Director of the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated April 21, 2009 is denied with respect to reopening the prosecution of the *Inter Partes* reexamination proceeding 95/000,358.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,615,485 (hereinafter, the '485 patent) issued on September 9, 2003.

2. A request for *inter partes* reexamination, assigned control No. 95/000,358, was filed by a Third Party Requester on March 14, 2008.

3. Reexamination was ordered for the '358 proceeding on June 12, 2008. A first action on the merits accompanied the order. A shortened statutory period of two months was set for the filing of a response to the Office action.

4. After receiving an extension of time, Patent Owner filed a timely response on September 12, 2008, and the Third Party Requester filed comments on October 10, 2008.

5. An action closing prosecution was mailed March 18, 2009, setting a one month period for response by the Patent Owner.

6. A petition requesting an extension of time, filed April 2, 2009, by Patent Owner, was granted on April 7, 2009, extending the period for response to May 18, 2009. No response by the Patent Owner has yet been filed.

7. A petition to suspend rule 37 CFR 1.943(b) pursuant to the provisions of 37 CFR 1.183 was filed April 2, 2009, by Patent Owner, requesting an enlargement of the 50 page limit to 100 pages, and was dismissed.

8. A "PETITION FOR SUPERVISORY AUTHORITY PURSUANT TO THE PROVISIONS OF 37 CFR 1.81 AND IN THE ALTERNATIVE, PETITION FOR RECONSIDERATION OF THE ACTION CLOSING PROSECUTION OF MARCH 18, 2009" was filed April 21, 2009, by Patent Owner, and is the subject of this decision. A duplicate of this petition was filed again on May 14, 2009.

9. A petition requesting that the April 21, 2009, Patent Owner petition be denied and stricken was filed by the third party requestor on April 29, 2009, and this petition was refused entry and expunged from the record pursuant to a decision mailed May 13, 2009.

DECISION

Patent Owner Form Factor ("Patent Owner") petitions for supervisory authority under the provisions of 37 C.F.R.§ 1.181 because:

(1) the Action Closing Prosecution ("ACP") did not materially advance prosecution of the reexamination,

(2) the Examiner did not address whether U.S. Patent No. 5,828,226 (Higgins) is actually prior art,

(3) it is clear error for the Examiner not to provide express constructions for disputed claim limitations, and

(4) the ACP does not address the substance of Patent Owner's arguments rebutting Examiner's assertions of invalidity in view of the cited art."

See page 1 of the petition. Patent Owner states that the ACP "obfuscates the issues" and leaves "the record devoid of any reasoning or evidence relied upon by the Examiner," thus making it "impossible" for a Patent Owner to respond to the ACP or seek effective review. The Patent Owner further asserts that the examination "thus far has been unfair and unjust towards Patent Owner's good faith attempts at clarifying and addressing the issues." See pages 1-2 of the petition. Because of these grounds, petitioner requests that prosecution be reopened.

The Third Party Requester's comments, submitted on April 29, 2009, will not be addressed because of the May 13, 2009 decision to refuse entry and expunge the comments from the record.

In response to Patent Owner's arguments for reopening prosecution in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so for the reasons set forth below. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. 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 (ACP).

Turning to the facts in this proceeding, Patent Owner submitted a response to the first Office action of June 12, 2008. Specifically, the Patent Owner submitted a 43-page section containing remarks and arguments. On October 10, 2008, the Third Party Requester responded with comments and additional prior art to address the arguments made by the Patent Owner. The ACP essentially maintained all the rejections set forth in the first Office action mailed on June 12, 2008.

Regarding the Patent Owner's arguments as to claim construction, the Examiner specifically set forth in the ACP that the claim construction offered by the Patent Owner is too narrow under the broadest reasonable interpretation standard and that the Examiner agreed with the Third Party Requester. In essence, the Examiner adopted and incorporated by reference the Third Party Requester's comments. See pages 65 to 66 of the ACP. The requester specifically set forth the claim construction to which the Examiner adopted. See pages 21-24 in the request for reexamination. It is noted, however, that there is no requirement that the Examiner must explicitly set forth claim construction as part of an Office action as alleged by the Patent Owner. In this case, the Examiner did adopt the claim construction of the Third Party Requester, which is explicitly set forth in the request. Accordingly, the Patent Owner has clear notice of the claim construction being used by the Examiner via (1) the application of the prior art in the rejections and (2) the claim construction by the Third Party Requester.

In regards to the other arguments by the Patent Owner, the Examiner stated that it was difficult to align Patent Owner's arguments with the claim rejections because of the formatting or grouping of the arguments. See page 66 of the ACP. In addition, the Examiner explicitly stated agreement with the Third Party Requester's comments filed on October 10, 2008. See page 66 of the ACP. Therefore, the Examiner essentially adopted and incorporated by reference the Third Party Requester's comments.

To restate, the Examiner did not make any new grounds of rejection and maintained the rejections made in the first Office action of June 12, 2008. The ACP set forth all rejections and determinations not to make a proposed rejection. The Examiner addressed Patent Owner's arguments by stating agreement with the Third Party Requester's comments. Accordingly, the Examiner appropriately followed Office rules and procedures in deciding to issue the ACP, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. For the reasons set forth above, the Examiner followed Office rules and procedures and did not abuse her discretion in deciding to issue an ACP.

To the extent that Patent Owner's arguments pertain to the merits of the Examiner's rejections or determinations (e.g., whether Higgins is prior art and whether the Examiner applied the appropriate claim construction), these issues are appealable matters and are not appropriate to address via a petition. See MPEP 1201 and 1002. Therefore, the merits of the Examiner's decisions will not be addressed in this decision.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the Patent Owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated March 18, 2009 and reopening of prosecution of the '358 reexamination proceeding is denied.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or 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

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.
95/000,358	03/14/2008	6615485	P6C2-RX	4928

50905 7590 04/23/2010

N. KENNETH BURRASTON
KIRTON & MCCONKIE
P.O. BOX 45120
SALT LAKE CITY, UT 84145-0120

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RICHARD L. STROUP
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE NW
WASHINGTON DC 20001

Date: MAILED

APR 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000358
PATENT NO. : 6615485
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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	P6C2-RX

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
LIVERMORE, CA 94551

DATE MAILED:

04/23/10

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.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RICHARD L. STROUP
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE NW
WASHINGTON DC 20001

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000358
PATENT NO. : 6615485
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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	P6C2-RX

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

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LEGAL DEPARTMENT
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FormFactor, Inc.
Legal Department
7005 Southfront Road
Livermore, CA 94551

(For Patent Owner)

MAILED
APR 23 2010
CENTRAL REEXAMINATION UNIT

Richard L. Stroup
Finnegan, Henderson, Farabow, Garrett & Dunner LLP
901 New York Ave, N.W.
Washington, D.C. 20001

(For Requester)

N. Kenneth Burraston
Kirton & McConkie
P.O. Box 45120
Salt Lake City, UT 84145

(Courtesy Copy)

In re Benjamin N. Eldridge et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,358
Filed: March 14, 2008
For: U.S. Patent No. 6,615,485

: DECISION GRANTING
: PETITION TO WAIVE
: PAGE LIMITS FOR
: APPELLANT'S BRIEF

This is a decision on the petition under 37 CFR 1.183 filed by the patent owner on April 19, 2010, titled "Urgent Petition Under 37 CFR § 1.183 to Suspend Rule 37 CFR § 1.943(c)" which requests suspension of the rules to file an appellant brief that is 45 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 fee of $400.00 pursuant to 37 CFR 1.17(f) has been received.

The patent owner's request that the rules be suspended to permit a brief that is no more than 45 pages in length is granted. [1]

[1] This decision provides guidance on which portions of the brief are counted towards the page limit

REVIEW OF FACTS

1. U.S. Patent No. 6,615,485 (the '485 patent) issued on September 9, 2003.

2. A request for reexamination of the '485 patent was filed on March 14, 2008. The request was assigned control No. 95/000,358 (the '358 proceeding).

3. Reexamination was ordered for the '358 proceeding on June 12, 2008.

4. Prosecution in the '358 proceeding has progressed to appeal.

5. Patent owner filed an appeal brief on Dec. 16, 2009, which was not entered, as it was improper as indicated in the April 7, 2010 Notice.

6. Third party requester filed a respondent brief on January 15, 2010, which was not entered as it was improper as indicated in the April 7, 2010 Notice.

7. On April 19, 2010, patent owner filed the subject petition with a proposed appeal brief requesting a page limit waiver.

DECISION

I. RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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.

II. ANALYSIS

Petitioner requests that the provisions of 37 CFR 1.943(c) that the appeal brief shall not exceed 30 pages or 14,000 words in length be waived and expanded to 45 pages. Petitioner attaches a proffered appeal brief as a proposed replacement for the brief filed Dec. 16, 2009. The petition asserts that this situation is extraordinary and requires waiver of the rules because of the length and number of rejections in the record, especially as the Right of Appeal Notice (RAN) is 69 pages in length and includes 27 grounds of rejection.

The proffered appeal brief submitted as an exhibit to the petition includes 45 pages that address all of the grounds of rejection in the RAN while deleting all but one drawing and the sections summarizing the rejections from the RAN. The proffered brief is deemed to economize, exclude extraneous material, and it is found to be arranged so as not to repeat information already of record. Thus, the proffered brief appears to be a reasonable attempt at complying with a limited number of argument pages and therefore provides support for petitioner's request. The page limit of no more than 30 pages is waived and patent owner is granted permission to file an appeal brief that is no more than 45 pages in length, as defined below.

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) does not include 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)[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/information 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.

In reviewing the proffered appeal brief, the following pages would not be counted toward the expanded 45 page limit: one (1) transmittal page; six (6) pages of table of contents; four (4) pages of claims appendix; one (1) page of evidence appendix; one (1) page of related proceedings appendix. However, the forty-five (45) pages of argument would be counted toward the limit. Therefore, the appellant brief is effectively substantively 45 pages in length.

---

[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 identified in the rule as being excluded from the count of pages.

In view of the facts and circumstances of this proceeding, the additional fifteen (15) pages of argument are not deemed unreasonable, and granting an expansion of the page limit would be equitable. Therefore, the petition is granted to permit patent owner to file the proffered appeal brief that is no more than 45 pages in length as defined above.

PATENT OWNER'S ADDRESS

The correspondence address for the patent to be reexamined is the address of the patent owner in the patent file. See MPEP 2222 and 37 CFR 1.33(c). The patent owner address in the patent file does not match the new correspondence address filed in the '358 proceeding. It is required that the patent owner correspondence address be changed **in the patent file**. It is suggested that the power of attorney and a statement under 37 CFR 3.53(b) showing authority of the assignee to act in this proceeding be filed in the patent file.

CONCLUSION

1. The patent owner's request under 37 CFR 1.183 for suspension of the rules is granted to permit an appeal brief that is no longer than 45 pages in length as described herein.
2. Jurisdiction will be transferred to the Central Reexamination Unit to await filing of the appeal brief.
3. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7729.

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

cdd

4-23-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,358	03/14/2008	6615485	P6C2-RX	4928

50905 7590 05/20/2010

N. KENNETH BURRASTON
KIRTON & MCCONKIE
P.O. BOX 45120
SALT LAKE CITY, UT 84145-0120

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2010

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Richard L. Stroup
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 New York Ave., NW
Washingto, DC 20001

MAILED

MAY 2 0 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,358*.

PATENT NUMBER *6,615,485*.

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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	P6C2-RX

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
LIVERMORE, CA 94551

DATE MAILED:

05/20/10

INTER PARTES REEXAMINATION COMMUNICATION

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	P6C2-RX

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
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INTER PARTES REEXAMINATION COMMUNICATION

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,358	03/14/08	6615485	P6C2-RX

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

Richard L. Stroup
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DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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(For Patent Owner)

MAILED

MAY 20 2010

CENTRAL REEXAMINATION UNIT

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901 New York Ave, N.W.
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(For Requester)

N. Kenneth Burraston
Kirton & McConkie
P.O. Box 45120
Salt Lake City, UT 84145

(Courtesy Copy)

In re Benjamin N. Eldridge et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,358
Filed: March 14, 2008
For: U.S. Patent No. 6,615,485

: DECISION GRANTING
: PETITION TO WAIVE
: PAGE LIMITS FOR
: RESPONDENT'S BRIEF

This is a decision on the petition under 37 CFR 1.183 filed by the third party requester on April 30, 2010, titled "Urgent Petition Under 37 CFR § 1.183 to Suspend Rule 37 CFR § 1.943(c)" which requests suspension of the rules to file a respondent brief that exceeds the 15 page limit for respondent's brief.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) has been received.

The third party requester's request that the rules be suspended to permit a brief that is no more than 34 pages in length is granted based on the proffered brief, which includes 34 pages that count toward the limit. [1]

[1] This decision provides guidance on which portions of the brief are counted towards the page limit

REVIEW OF FACTS

1. U.S. Patent No. 6,615,485 (the '485 patent) issued on September 9, 2003.

2. A request for reexamination of the '485 patent was filed on March 14, 2008. The request was assigned control No. 95/000,358 (the '358 proceeding).

3. Reexamination was ordered for the '358 proceeding on June 12, 2008.

4. Prosecution in the '358 proceeding has progressed to appeal.

5. Patent owner filed an appellant brief on Dec. 16, 2009, which was not entered, as it was improper as indicated in the April 7, 2010 Notice.

6. Third party requester filed a respondent brief on January 15, 2010, which was not entered as it was improper as indicated in the April 7, 2010 Notice.

7. On April 19, 2010, patent owner filed a petition with a proposed appellant brief requesting a page limit waiver, which was granted on April 23, 2010.

8. Patent owner filed a brief that corresponded with the proposed appellant brief on April 28, 2010.

9. On April 30, 2010, third party requester filed a petition with a proposed respondent brief requesting a page limit waiver, which is the subject of this decision.

DECISION

I. RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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.

II. ANALYSIS

Petitioner requests that the provisions of 37 CFR 1.943(c) that the respondent brief shall not exceed 15 pages or 7,000 words in length be waived and expanded to no more than 35 pages. It is noted that the proffered brief includes 34 pages that count toward the page limit and therefore the request will be treated as requesting no more than 34 pages. Petitioner attaches a proffered respondent brief as a proposed replacement for the brief filed Jan. 15, 2010. The petition asserts that this situation is extraordinary and requires waiver of the rules because of the length and number of rejections in the record, especially as the 27 separate grounds of rejection that have been appealed and the fact that patent owner was granted a waiver of 37 CFR 1.943(c).

The proffered respondent brief submitted as an exhibit to the petition includes 34 pages that, according to petitioner, are required to address the appeal of the 27 rejections and avoid potential waiver and forfeiture of its rights. The brief is formatted in the same manner as the appellant brief, is edited to remove non-substantive portions of the brief. The proffered brief appears to be a reasonable attempt at complying with a limited number of argument pages and therefore provides support for petitioner's request. The page limit of no more than 15 pages is waived and third party requester is granted permission to file a respondent brief that is no more than 34 pages in length, as defined below.

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) does not include claim appendices and "reference materials such as prior art references." Furthermore, the sections of the respondent's briefs required under 37 CFR 41.68(b)(1)(i)-(iv) and (viii)-(ix)[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/information 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 41.68(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 or the Board as identified in the "Related appeals and interferences" section of the brief. Any documents that are not required to be

[2] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (viii) *Evidence Appendix*, (ix) *Related Proceedings Appendix*, and (x) *Certificate of Service*. The Claims Appendix is already explicitly identified in the rule as being excluded from the count of pages.

submitted (such as Office actions, requests for reexamination, etc.) are counted toward the page limit of the brief.

In view of the facts and circumstances of this proceeding, the additional nineteen (19) pages of argument are not deemed unreasonable, and granting an expansion of the page limit would be equitable. Therefore, the petition is granted to permit third party requester to file the proffered respondent brief that is no more than 34 pages in length as defined above.

PATENT OWNER'S ADDRESS

Patent owner filed a paper on April 29, 2010 regarding correspondence address with attachments showing that the address and power of attorney had been changed. However, these papers show that the change was made in the file of reexamination proceeding '358 only. The patent file is separate from the reexamination proceeding file. The change must also be made in the **patent file** as emphasized in the last Office communication. See MPEP 2222 and 37 CFR 1.33(c).

CONCLUSION

1. The third party requester's request under 37 CFR 1.183 for suspension of the rules is granted to permit a respondent brief that is no longer than 34 pages in length as described herein.
2. Jurisdiction will be transferred to the Central Reexamination Unit to await filing of the respondent brief.
3. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7729.

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

cdd

5-20-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,359	03/19/2008	7121419	FPP-4014-207	5996

22204 7590 11/28/2008

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/28/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FRANK P. PRESTA
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901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22201

Date:

NOV 28 2008

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000359
PATENT NO. : 7121419
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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Nixon & Vanderhye, PC
901 North Glebe Road
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Arlington, VA 22203

(For Requester)

In re Ferry et al
Inter Partes Reexamination Proceeding
Control No. 95/000,359
Filed: March 19, 2008
For: U.S. Patent No. 7,121,419

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

This is a decision on the October 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the October 9, 2008 patent owner petition to revive").

The October 9, 2008 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to deposit account no. 19-2380, as authorized by the patent owner on page 3 of the present petition.

SUMMARY

The October 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

35 U.S.C. 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.

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 provides, in pertinent part:

(b) 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.

(c) 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.

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

Abandonment for Failure To Reply to a Non-Final Action

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

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

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

MPEP 2668 provides, in pertinent part:

If the patent owner in an *inter partes* reexamination proceeding fails to file a timely and appropriate response to any Office action and no claims are allowable, then pursuant to 37 CFR 1.957(b), the prosecution of the reexamination proceeding is terminated, and a certificate under 37 CFR 1.997 is issued canceling all claims of the patent.

An *inter partes* reexamination prosecution terminated under 37 CFR 1.957(b) can be revived if the delay in response by the patent owner was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b).

*

*

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. PETITION REQUIREMENTS

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

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted a response to the April 17, 2008 nonfinal Office action and a petition fee under 37 CFR 1.17(m) with the present October 9, 2008 patent owner petition, which satisfy items (1) [1] and (2), respectively. The statement appearing on page 3 of the present petition that "any delay in reply by the patent owner was unintentional" is construed as a statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, which satisfies item (3). If this statement on page 3 of the present petition is not intended to be construed in this manner, the patent owner is required to so inform the Office.

---

[1] See MPEP 2668 IV and MPEP 711.03(c) II A 2 (a). Note that **the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.**

Accordingly, the October 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[2] is **granted**.

CONCLUSION

- The October 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.
- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the October 9, 2008 patent owner response to the April 17, 2008 nonfinal Office action.
- The third party requester is given **thirty (30) days** from the mail date of this decision to file comments on the October 9, 2008 patent owner response, which has become effective as of the mail date of this decision. This time period is statutory and cannot be waived or extended.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Joseph Kaufmann, of CRU Art Unit 3993, at (571) 272-4928.
- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

cn

[2] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.111, to the nonfinal Office action.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,359	03/19/2008	7121419	FPP-4014-207	5996

22204 7590 09/09/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/09/2009

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901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22201

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000359
PATENT NO. : 7121419
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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CENTRAL REEXAMINATION UNIT

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901 North Glebe Road
11th Floor
Arlington, VA 22203

(For Requester)

In re Ferry et al
Inter Partes Reexamination Proceeding
Control No. 95/000,359
Filed: March 19, 2008
For: U.S. Patent No. 7,121,419

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

This is a decision on the August 6, 2009 patent owner petition, entitled "Petition Under 37 CFR 1.182 Requesting Amendment to be Entered in *Inter Partes* Reexamination", which is taken as a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the August 6, 2009 patent owner petition").

The August 6, 2009 patent owner petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to deposit account no. 19-2380, as authorized by the patent owner on page 3 of the present petition.

SUMMARY

The August 6, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

35 U.S.C. 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.

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 provides, in pertinent part:

(b) 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.

(c) 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.

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

Abandonment for Failure To Reply to a Non-Final Action

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

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

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

MPEP 2668 provides, in pertinent part:

If the patent owner in an *inter partes* reexamination proceeding fails to file a timely and appropriate response to any Office action and no claims are allowable, then pursuant to 37 CFR 1.957(b), the prosecution of the reexamination proceeding is terminated, and a certificate under 37 CFR 1.997 is issued canceling all claims of the patent.

An *inter partes* reexamination prosecution terminated under 37 CFR 1.957(b) can be revived if the delay in response by the patent owner was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b).

*

*

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. 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

Analysis

The patent owner requests that the response, which accompanies the present petition, be entered and considered. The present proceeding, however, was terminated due to the failure of the patent owner to fully respond to the March 4, 2009 action closing prosecution. On page 3 of the action closing prosecution, the examiner informed the patent owner that "[t]he amendment provided by Patent Owner is defective as numeral (80) was deleted by strike out instead of bracketing in claims 4, 5, 11, and 12." In patent owner's amendment filed on April 1, 2009, which responded to the March 4, 2009 action closing prosecution, however, the deleted numerals (80) were not bracketed as required by 37 CFR 1.530(f), and as discussed by the examiner. Furthermore, the added numerals (180) were no longer underlined. Accordingly, the reexamination proceeding was terminated.

The patent owner argues that "[i]t was the Patent Owner's understanding that the waiver of 37 CFR 1.530(f)(1) requirements did not necessitate further correction as evidenced by the Examiner's examination and rejection of claims 4, 5, 11, and 12 and that the waiver would continue through the entire examination process." The patent owner further argues that "[t]his

misunderstanding was qualified by the Examiner not issuing a Notice of Defective Paper in *Inter Partes* Reexamination." Finally, the patent owner argues that "Patent Owner is unduly punished for the inadvertent failure to properly address an issue of formality."

The patent owner quotes the examiner's statement on page 3 of the action closing prosecution, which states:

> In order to prevent any further delay of the reexamination proceeding and to ensure that it is conducted with special dispatch, the Office has *sua sponte* waived the requirements of 37 CFR 1.530(f)(1) to the extent that the improper amendment of 9 October 2008 is *provisionally* accepted *for examination purposes.*

The patent owner, however, does not take into account the signed waiver on page 8 of the action closing prosecution, which states (bold in original):

> Based on the specific facts and circumstances of this proceeding, 37 CFR 1.530 is waived to the extent that the improper amendment of 9 October 2008 is *provisionally* accepted *for examination purposes*, in order to further statutorily requirement of 35 U.S.C. 305 that "All reexamination proceedings under this section . . . will be conducted with special dispatch within the Office" [sic].[1] Given that the amendment is informal and must be rectified, the Patent Owner is given **one month** from the date of this decision to re-submit the 9 October 2008 amendment in a form that complies with the requirements of 37 CFR 1.530. A shortened statutory period for response to this letter is set to expire **ONE MONTH** from the mailing date of this letter. **This period of time is separate from (and runs concurrently with) the time period set above for response to the Office action. If patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, prosecution of the present reexamination proceeding will be terminated, and a reexamination certificate will issue. 37 CFR 1.550(d)** [sic][2]**.**

The Office is required to conduct *inter partes* reexamination proceedings with special dispatch. See 35 U.S.C. 314(c). In the present case, the Office elected, in the interests of special dispatch, not to delay prosecution by sending out a Notice of Defective Paper. Instead, the Office elected to exercise its option to waive the provisions of 37 CFR 1.530 only to the extent that the improper amendment of October 9, 2008 was ***provisionally*** accepted for examination purposes. The patent owner was clearly notified of the informality, i.e., the deletion of the numeral (80) in claims 4, 5, 11 and 12 by strike out, rather than by bracketing as required by 37 CFR 1.530(f)(1), on page 3 of the action closing prosecution. Furthermore, the patent owner was clearly put on notice, in bold, that if the informality was not corrected within one month from the mail date of the action closing prosecution, that the amendment would not be held to be an appropriate response, that prosecution would be terminated, and that a reexamination certificate would issue. The informality was not corrected by the patent owner's April 1, 2009 response. The patent owner has provided no reason as to why the patent owner failed to comply with the clear

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[1] The relevant statute for *inter partes* reexamination proceedings is 35 U.S.C. 314(c).
[2] The relevant rule for *inter partes* reexamination proceedings is 37 CFR 1.915(d).

requirement to timely correct the informality within the one-month time period plainly set on page 8 of the action closing prosecution.

Relief

The patent owner further states that "[p]etitioner asserts that the failure to correct the improper amendment of claims 4, 5, 11, and 12 was inadvertent", that "[a]ny failure on Patent Owner's part to reamend claims 4, 5, 11, and 12 was inadvertent", and that "in the accompanying Response claims 4, 5, 11, and 12 have been amended in compliance with 37 CFR 1.530(f)(1)." In the interest of special dispatch, and in view of patent owner's statements that the failure to correct the amendment was inadvertent and of patent owner's present submission of a corrective response, the present petition is taken as a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted, with the present August 6, 2009 patent owner petition, a petition fee of $1620 pursuant to 37 CFR 1.17(m),[3] and a response to the March 4, 2009 action closing prosecution, which is a nonfinal Office action.[4] Because the August 6, 2009 response supplements and corrects patent owner's April 1, 2009 response to the March 4, 2009 action closing prosecution, the August 6, 2009 response is a corrective supplemental response. The August 6, 2009 corrective supplemental response and petition fee satisfy items (1)[5] and (2), respectively.

The statements appearing on page 2 of the present petition that "[p]etitioner asserts that the failure to correct the improper amendment of claims 4, 5, 11, and 12 was inadvertent", and that "[a]ny failure on Patent Owner's part to reamend claims 4, 5, 11, and 12 was inadvertent", taken together, are construed as a statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, which satisfies item (3). If these statements are not intended to be construed in this manner, the patent owner is required to so inform the Office.

Accordingly, the August 6, 2009 patent owner petition, which is taken as a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding, is **granted**.

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[3] The petition fee, as authorized by the patent owner on page 3 of the present petition, will be charged to patent owner's deposit account no. 19-2380.

[4] See MPEP 2671.02, which provides, in pertinent part: "Although an Action Closing Prosecution (ACP) has many attributes similar to a "final rejection" made in an *ex parte* reexamination proceeding or in a non-provisional application, it is not a final action . . .".

[5] See MPEP 2668 IV and MPEP 711.03(c) II A 2 (a). **Note that the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.**

CONCLUSION

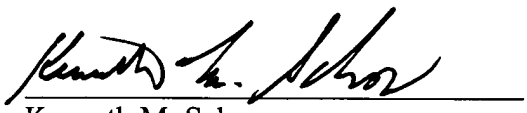
- The August 6, 2009 patent owner petition, which is taken as a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding, is **granted**.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the August 6, 2009 corrective supplemental patent owner response to the March 4, 2009 action closing prosecution.

- The third party requester is given **thirty (30) days** from the mail date of this decision to file comments under 37 CFR 1.947 after the August 6, 2009 corrective supplemental patent owner response, which has become effective as of the mail date of this decision. This time period is statutory and cannot be waived or extended.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Joseph Kaufmann, of CRU Art Unit 3993, at (571) 272-4928.

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or to the undersigned, at (571) 272-7710.



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CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding :
Control No. 95/000,366 : **DECISION DISMISSING**
Filed: May 5, 2008 : **PETITION**
For: U.S. Patent No. 7,158,861 :

This is a decision on the March 25, 2009 third party requester petition entitled "Petition To Merge Reexamination Proceedings And A Reissue Application Examination Under *37 C.F.R. § 1.182*" filed in *inter partes* reexamination control number 95/000,366, and requesting that the reissue application number 12/347,891 and *inter partes* reexamination proceeding control number 95/000,366 be merged.

Inter partes reexamination control number 95/000,366 is before the Office of Patent Legal Administration for consideration of the petition.

Summary:

The petition is dismissed for failure to submit the petition fee required under 37 CFR 1.17(f). The reissue application number 12/347,891 and *inter partes* reexamination proceeding control number 95/000,366 will not be merged.

BACKGROUND

1. U.S. Patent No. 7,158,861 (the '861 patent) issued to Wang et al. on January 2, 2007.

2. A request for *inter partes* reexamination of claims 1-4 of the '861 patent was filed on May 5, 2008, by the third party requester Head There, Inc., and the request was assigned control number 95/000,366 (the '366 *inter partes* proceeding).

3. On June 20, 2008, *inter partes* reexamination was ordered for claims 1-4 of the '861 patent based on the examiner's determination that the May 5, 2008 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a first Office action.

4. On August 19, 2008, patent owner filed an amendment in response to the Office action.

5. On September 11, 2008, the third party requester filed comments under 37 CFR 1.947 in response to the patent owner's amendment.

6. On December 31, 2008, the patent owner filed a "broadening" reissue application based on the '887 patent, which application was assigned application number 12/347,891 (the '891 reissue application).

7. On February 23, 2009, an action closing prosecution (ACP) was mailed for the '366 *inter partes* proceeding.

8. On March 25, 2009, the third party requester filed the instant petition requesting that the '891 reissue application and '366 *inter partes* proceeding be merged.

9. On March 26, 2009, patent owner filed an amendment under 37 CFR 1.951(a) for the '366 *inter partes* proceeding.

10. On April 2, 2009, patent owner filed a corrected amendment for the '366 *inter partes* proceeding.

11. On April 6, 2009, patent owner filed an opposition to the third party requester's petition to merge in which the patent owner requests that the Office not merge the '891 reissue application and the '366 *inter partes* proceeding.

12. On April 16, 2009, the third party requester filed, for the '366 *inter partes* proceeding, comments in response to the patent owner's April 2, 2009 amendment.

13. No action on the merits has been taken by the Office on the '891 reissue application.

DECISION

I. RELEVANT AUTHORITY

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 1.182 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 1.906(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 1.991 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. 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. The decision to merge, or not to merge, is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the proceedings. The status of the reissue application and the reexamination proceeding will be taken into account in the decision as to whether merger will be ordered, or one of the two proceedings stayed. Where there is "good cause" to stay the reexamination proceeding, the Director may do so pursuant to 35 U.S.C. 314(c).

* * * * *

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 requester. If such issues are raised, merger would ordinarily **not** be ordered, and one of the two proceedings stayed. In addition, consideration will also be given to the status of the reexamination proceeding.

II. DISCUSSION

The petition was not accompanied by the $400.00 petition fee required under 37 CFR 1.17(f) for a petition under 37 CFR 1.182. In addition, there is no authorization by third

party requester to charge any required fees to a deposit account. Accordingly, the petition is dismissed for failure to submit the required petition fee.

Even though the required petition fee has not been paid and the petition is being dismissed for that reason, a decision under 37 CFR 1.991 by the Office of Patent Legal Administration as to whether or not the two proceedings should be merged is timely, and is issued *sua sponte* as follows:

As evidenced by the above review of facts, the '891 reissue application and the '366 *inter partes* reexamination proceeding are currently pending. In this instance, a substantial amount of prosecution has taken place in the reexamination proceeding, and an action closing prosecution was mailed February 23, 2009. In contrast, the '891 reissue application was not filed until December 31, 2008, and no Office action on the merits has issued for the '891 reissue application.

The decision to merge, or not to merge, is made on a case-by-case basis. In this instance, the merger of the reexamination proceeding with the reissue application would delay the already substantially prosecuted reexamination proceeding contrary to the mandate of 35 U.S.C. § 314(c) for special dispatch in reexamination proceedings, and such will not be effected. It is also to be noted that the complexities of a merger would result in the proceedings not being expedited via such a merger. The rights of the *inter partes* reexamination requester to comment during a merged proceeding and to participate in the appeal process cannot be annulled, since they are required by statute, i.e., 35 U.S.C. 314(b) and 35 U.S.C. 315(b), respectively. Thus, a merger of the two proceedings would provide the third party requester with the right to support any Office rejections and to reply to any Office or patent owner reasons for patentability with regard to the newly added broadened claims. Yet, the effect and intent of the *inter partes* reexamination statute (35 U.S.C. 314(a)) is to preclude any third party requester comment and participation as to broadened claims or other reissue issues not proper for reexamination. In the present instance, and based on the present facts and circumstances, the merger of the proceedings would complicate the merged proceeding to the point where the proceeding progress would be delayed by permitting requester participation. The line between requester participation authorized by statute and requester participation not authorized by statute is a fine line. The returning or expunging of inadvertent unauthorized participation, and the objection to perceived unauthorized participation (which in fact may not be) would result in sufficient delay in this instance, to outweigh the benefit that might be gained by merger. Accordingly, the examination of the reissue and reexamination proceedings will not be merged at this time.

In this regard, it is to be noted that the grant or refusal of merger of reissue and *inter partes* reexamination proceedings under 37 CFR 1.991 **is discretionary**, and in this case, the facts and circumstances are such that the proceedings will not be merged. *However,*

the present decision not to merge is not an assurance that, in a future similar situation, merger would not be ordered.

A decision suspending action in the reissue application is being mailed in the reissue application concurrently with the instant petition decision.

CONCLUSION

1. The petition is **dismissed** for failure to submit the required petition fee under 37 CFR 1.17(f).

2. Reissue application number 12/347,891 and *inter partes* reexamination proceeding control number 95/000,366 will not be merged

3. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit.

4. Any questions concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at 571-272-7727.

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

6-8-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,372	07/23/2008	6,501,906		5533

7590 08/04/2008

MCNAIR LAW OFFICES P.A.
P.O. BOX 10827
GREENVILLE, SC 29603

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2008

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

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

James A. Finder
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(For Third Party Requestor)

In re	: Vieira
Reexamination Proceeding	
Control No.	: 95/000,372
Filed	: 7/23/2008
For U.S. Patent No.	: 6,501,906

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on a petition under 37 CFR 1.181 filed July 23, 2008 requesting withdrawal of the Notice of Failure to Comply with Inter Partes Reexamination Request Requirements.

A review of the record indicates that the corrected inter partes request of July 23, 2008 has been accepted.

In view of the above, the petition under 37 CFR 1.181 filed July 23, 2008 is dismissed as being moot.

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

Greg Morse,
Director,
Central Reexamination Unit

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NOV 28 2008

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Richard L. Stroup
Finnegan, Henderson, Farabow,
Garrett & Dunner
901 New York Avenue, N.W.
Washington, DC 20001

(For Requester)

In re Eldridge *et al*
Reexamination Proceeding
Control No.: 95/000,375
Filed: June 6, 2008
For: U.S. Patent No. 6,624,648 B2

: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR § 1.183**
: **AND, *SUA SPONTE*,**
: **EXTENDING TIME**
: **TO FILE RESPONSE**

This is a decision on the October 29, 2008 patent owner petition under 37 CFR 1.183 entitled "PETITION TO SUSPEND RULE 37 C.F.R § 1.943 PURSUANT TO THE PROVISIONS OF 37 CFR § 1.183." The petition requests waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner in an *inter partes* reexamination proceeding not exceed 50 pages in length.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for decision.

Summary: The petition is granted to the extent that the page limit for the response to the September 3, 2008 first Office action is extended to not exceed 62 pages in length. Further, the period for filing a patent owner response to the September 3, 2008 Office action is, *sua sponte*, extended for an additional two (2) weeks so as to expire on December 17, 2008.

11/28/2008 JHCDOUGA 00000001 500417 95000375

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FEES

A fee of $400.00 (37 CFR 1.17(f) is required for a petition under 37 CFR 1.183. No fee was remitted with, or authorized by, the petition papers. On November 26, 2008, patent owner's representative, Mr. Bernard P. Codd, (Registration No. 46,429), authorized a

charge of the $400.00 petition fee against Deposit Account No. 50-0417 in a telephone conversation with Senior Legal Advisor Stephen Marcus. The telephone conversation did not address the merits of the present petition or any other substantive issues, but was confined merely to the procedural question of fee authorization.

REVIEW OF FACTS

1. U.S. Patent No. 6,624,648 (the '648 patent) issued on September 23, 2003.

2. A request for *inter partes* reexamination of certain claims of the '648 patent was deposited in the Office on June 6, 2008, was assigned control No. 95/000,375 (the '375 proceeding), and was accorded a filing date of June 6, 2008.

3. On September 3, 2008, reexamination of the claims for which reexamination was requested was ordered in the '375 proceeding.

4. Also on September 3, 2008, a first Office action rejecting the patent claims for which reexamination was ordered was mailed. A shortened statutory period of two months was set for the filing of a response to the Office action.

5. On October 29, 2008, patent owner filed a request for a one-month extension of the time period for filing a response to the September 3, 2008 Office action.

6. Also on October 29, 2008, patent owner filed the present petition seeking waiver of the provisions of 37 CFR 1.943(b) that limit the number of pages permitted in a response to an Office action.

7. On October 31, 2008, the October 29, 2008 request for extension of time was granted, thereby extending the period for filing a response to the September 3, 2008 Office action to run through December 3, 2008.

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(b) 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).

DECISION

I. Waiver of the Provisions of 37 CFR 1.943(b).

37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds fifty (50) pages in length. In the instant petition, the patent owner requests a waiver of the provisions of 37 CFR 1.943(b) to provide patent owner with the ability to respond to properly respond to the outstanding September 3, 2008 Office action by filing a response of no more than sixty-two (62) pages.

The June 6, 2008 request for *inter partes* reexamination, filed by a third party requester, was one hundred twenty-eight (128) pages in length and proposed thirty-five (35) grounds of rejection for the thirty-two (32) claims of the '648 patent for which reexamination was requested and ordered. The September 3, 2008 Office action that accompanied the order for reexamination is sixty-two (62) pages in length. That Office action adopted thirty-one (31) separate grounds of rejection and declined to adopt four (4) grounds of rejection.

Given the numerous grounds of rejection set forth by the examiner, and petitioner's timely request, the Office will grant the present petition to the extent of waiving the 37 CFR 1.943(b) response limits of fifty (50) pages:

(A) For only the next immediate response to be supplied by the patent owner in response to the September 3, 2008 Office action, and

(B) To permit patent owner to provide as much as sixty-two (62) pages for patent owner's response to the September 3, 2008 Office action. The Office will enforce compliance with this new page limit of sixty-two (62) pages, and a strict review of the length of patent owner's response will be made upon its receipt.

This sixty-two (62) page limit is deemed equitable in light of the sixty-two (62) page length of the September 3, 2008 Office action.

II. *Sua Sponte* Grant of Additional Two Week Extension of Time

It is noted that the September 3, 2008 Office action set a shortened statutory period of TWO MONTHS from September 3, 2008 for the patent owner to file a response thereto. On October 31, 2008, the Office granted a request for a one-month extension of time for filing the patent owner's response. Therefore, the response to the September 3, 2008 Office action would be due not later than December 3, 2008. It is noted that no action was taken on the present patent owner 37 CFR 1.183 petition until the present decision. Given the circumstances of this case as a whole, the Office is, *sua sponte*, extending the time for filing a response to the September 3, 2008 Office action to extend an additional two weeks beyond the current due date, so as to run through December 17, 2008.

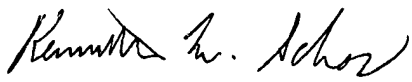
CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to the extent that the page limit for the response to the September 3, 2008 first Office action is extended to not exceed sixty-two (62) pages in length.

2. The time for filing a response to the September 3, 2008 first Office action is hereby extended to run through December 17, 2008.

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

4. Telephone inquiries with regard to this decision should be directed to 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

Ken/pet7/IP/length
November 26, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,376	06/03/2008	6805891	18005-08LL1	3118

7590 08/27/2008

EXAMINER	

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ART UNIT	PAPER NUMBER

DATE MAILED: 08/27/2008

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Banner & Witcoff, LTD. (For '376 Third Party Requester)
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Washington, DC 20005

Trojan Law Offices (Courtesy copy)
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Beverly Hills, CA 90212

In re Vijayen et al.	:	
Inter partes Reexamination Proceeding	:	
Control No. 95/000,337	:	
Filed: January 4, 2008	:	
For: U.S. Patent No. 6,805,891	:	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
In re Vijayen et al.	:	
Inter partes Reexamination Proceeding	:	
Control No. 95/000,376	:	
Filed: June 3, 2008	:	
For: U.S. Patent No. 6,805,891	:	

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 October 19, 2004 United States Patent Number 6,805,191(the '191 patent) issued.

2. On January 4, 2008 a first request for *inter partes* reexamination of the '191 patent, assigned Reexamination Control No. 95/000,337 (the '337 proceeding), was filed by first third party requester, Western Digital Technologies, Inc.

3. On February 29, 2008 the Office issued an order granting *inter partes* reexamination in the '337 proceeding.

4. On March 17, 2008 the Office issued an Office action in the '337 proceeding.

5. On May 12, 2008, patent owner petitioned for a one-month extension of time in which to respond to the outstanding Office action in the '337 proceeding.

6. On May 20, 2008, the Office issues a decision granting patent owner's request for a one-month extension of time to respond to the outstanding Office action.

7. On June 3, 2008, a second request for *inter partes* reexamination of the '191 patent, assigned Reexamination Control No. 95/000,376 (the '376 proceeding), was filed by a second third party requester, Seagate Technologies LLC.

8. On June 13, 2008 patent owner petitioned for a second one-month extension of time in which to respond to the outstanding Office action in the '337 proceeding.

9. On July 17, 2008 patent owner responded to the February 29, 2008 Office Action in the '337 proceeding, which response included an amendment to the claims.

10. On July 28, 2008 the Office issued a decision granting patent owner's request for a second one-month extension of time to respond to the outstanding Office action in the '337 proceeding.

11. On August 13, 2008, the Office issued an order granting *inter partes* reexamination in the '376 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. Both of the proceedings are *inter partes* reexamination proceeding. The first *inter partes* proceeding is still pending, and has not been terminated. Therefore, consideration of merger is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/000,337 and 95/000,376 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

1. Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. A review of the reexamination files for the '337 proceeding reflects that original patent claims 1-14 are present and unamended, but new claims 15-16 have been added. A review of the '376 proceeding reflects that only the original and unamended patent claims 1-14 are present. Therefore an appropriate "housekeeping amendment" is required within ONE (1) MONTH of this decision placing the same amendments in both cases.

2. The response to this requirement must be strictly limited to placing the same amendments in both cases; patent owner must not address any issues of patentability in the housekeeping

amendment. Any discussion of the merits or issues of the proceedings 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.

3. Submission by patent owner of a housekeeping amendment will not create a reply right for the *inter partes* third party requesters. Any comments paper filed by the requesters in response to any such housekeeping amendment would be improper, since the housekeeping amendment is not to address the merits of the proceeding. Any such comments paper would not be entered into the record, as it would be an improper submission under 37 CFR 1.939. Any amended/new claims of the housekeeping amendment may be addressed by the inter partes third party requesters at the next opportunity that requesters have to file a paper directed to the merits having an entry right.

4. In the event that the required housekeeping amendment (to place identical amendments in all (both) files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim,

and thus failing to particularly point out the invention - see Part II, item 4, above.

3. Each Office action issued by the examiner will take the form of a single action which jointly applies to both reexamination proceedings. Each action will contain identifying data for both of the cases, *i.e.* the '337 proceeding and the '376 proceeding and each action will be entered into both files (which will be maintained as separate files).

4. All parties are required to file papers (*e.g.*, Office actions, patent owner responses, requester comments, *etc.*) in duplicate, for placement of papers in both files. Any patent owner or requester papers must consist of a single response, with two copies being filed for entry in the two files, each of which must bear a signature. Any such paper must contain identifying data for both of the cases, *i.e.*, the '337 proceeding and the '376 proceeding. Any such paper must be served on all other parties. Copies of proof of service upon all other parties must accompany the filing of the paper in the Office.

All papers filed by the patent owner and the third party requesters are to be directed:

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

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

By hand 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 each other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such

paper was served on each other party, pursuant to 37 C.F.R. § 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 in the merged proceeding, which paper 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 appellant brief (patent owner or requesters) 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 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 clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '337 proceeding and (3) the '376 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 J. Nicholas Gross, United Module Corporation, 2030 Addison St., Suite 610, Berkeley, CA 94704.

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

(a) Designate one of the two correspondence addresses and parties prosecuting these proceedings as the correspondence address and party of record in both proceedings (to provide one address and party for the merged proceeding) and the patent file, and

(b) If there is a newly designated attorney, 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. Pending clarification, the address of J. Nicholas Gross, United Module Corporation, 2030 Addison St., Suite 610, Berkeley, CA 94704, will be used in future correspondence.

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,228 and 95/000,376 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Pursuant to Part II of this decision, patent owner is required to, within ONE MONTH of this decision, file a housekeeping amendment, placing the same amendments in all (both) cases of the present merged proceeding.

3. The patent owner is further required to, within ONE MONTH of this decision, unify the correspondence addresses and parties prosecuting these proceedings as set forth in the last section of this decision.

4. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action.

5. 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 (from the mailing of this decision) for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings, or

   (b) The receipt of both the required housekeeping amendment (i) and correspondence address and attorney papers (ii).

6. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

7. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

THE PROCTER & GAMBLE COMPANY
GLOBAL LEGAL DEPARTMENT - IP
SYCAMORE BUILDING - 4TH FLOOR
299 EAST SIXTH STREET
CINCINNATI OH 45202

MAILED

FEB 06 2009

OFFICE OF PETITIONS

(For Requester)

TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY UT 84110

In re Kvietok et al.	:	
Reexamination Proceeding	:	
Control No. 95/000,377	:	DECISION DISMISSING PETITION
Request Deposited: September 15, 2008	:	UNDER 37 CFR 1.78(a)(6)
For: U.S. Patent No. 7,223,361	:	

This is a decision on the petition, styled under 37 CFR 1.78(a)(3), filed on January 21, 2009, which is treated as a petition under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional application set forth in the concurrently-filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The application for patent which is the subject of the reexamination proceeding is a continuation of Application No. 10/417,462, filed on April 16, 2003, which is a continuation-in-part of Application No. 09/904,019, which was filed on July 12, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/251,067, which was filed on December 4, 2000, and for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

The petition is accompanied by an amendment to the first paragraph of the specification and to the claims.

At the outset, MPEP 2658 states that, in an *inter partes* reexamination, for a patent to be reexamined which matured from a utility or plant application filed before November 29, 2000, the patent owner can correct via reexamination the failure to adequately claim benefit under 35 U.S.C. 119(e) of an earlier filed provisional application. **Under no circumstances can a reexamination proceeding be employed to correct or add a benefit claim under 35 U.S.C. 119(e) for a patent matured from a utility or plant application filed on or after November 29, 2000**. (emphasis added)

Further, Section 4503 of the American Inventor's Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application.

35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of benefit claims under 35 U.S.C. 119(e) when the application is no longer pending, e.g., an issued patent. Therefore, a reexamination is not a valid mechanism for adding or correcting a benefit claim under 35 U.S.C. 119(e) after a patent has been granted (for a patent matured from a utility or plant application filed on or after November 29, 2000).[1]

Upon further review, it is noted that intermediate Application No. 10/417,462, filed on April 16, 2003, failed to claim benefit under 35 U.S.C. § 119(e) of prior-filed provisional Application No. 60/251,067, filed on December 4, 2000.

---

[1] See, e.g. MPEP 2258.

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP 201.06(d).

It is further noted that, 37 CFR 1.78(a)(6) requires that the claim under 35 U.S.C.§ 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application. Therefore, in order to request the delayed claim of benefit in Application No. 10/417,462 to provisional Application No. 60/251,067, filed on December 4, 2000, a petition under 37 CFR 1.137(a) or (b) would need to be filed to revive the application, accompanied by a proper reference to the prior-filed provisional application (*i.e.*, an ADS or an amendment to the first line of the specification).

Moreover, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 119(e) after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 119(e) is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

The proposed amendment to the specification, filed on January 21, 2009, is unacceptable as drafted, and therefore, is not considered a proper reference under 37 CFR 1.78(a)(5)(i). Specifically, the proposed amendment to the specification is not in compliance with 37 CFR 1.530(d)(1) in that the entire text of an added or rewritten paragraph must be submitted.

In this regard, 37 CFR 1.530(d) states, in pertinent part:

> A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted,

during the prosecution of the reexamination proceeding pursuant to § 1.550(a) or § 1.937.

(1) Specification other than the claims . **Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph including markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph.** The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.96 and 1.825).

(emphasis added)

Receipt of the petition fee is acknowledged. No additional petition fee is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Anthony Knight
Supervisor
Office of Petitions

PETITION FOR UNINENTIONALLY DELAYED BENEFIT OF CLAIM UNDER 37 CFR § 1.78(a)(3)	Docket Number **9213CE**

First Named Inventor:	Frank Andrej Kvietok *et al.*
Patent No.:	7,223,361
Art Unit:	3991
Issued:	May 29, 2007
Reexam Application/Control No.:	95/000,377
Reexam Filed:	September 15, 2008
Examiner:	Alan D. Diamond

COPY

Title: METHODS FOR EMITTING VOLATILE COMPOSITIONS

Attention: *Inter Partes* Reexams
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

Enclosed Are The Following Itmes:

(1) Petition & Pettition Fee Under 37 CFR §1.17(t)
(2) Statement that the entire delay was unintentional

1. Petition fee
Authorization is given to charge the required fee under 37 CFR 1.17(t) and any additional fees that may be required in connection with submission of this petition, or to credit any overpayment, to Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

PETITION FOR UNINENTIONALLY DELAYED BENEFIT OF CLAIM UNDER 37 CFR § 1.78(a)(3)

3. Statement. The entire delay in filing the required benefit claim until the grant of the petition under 37 CFR §1.78 (a)(3) was unintentional.

January 21, 2008
Date

Signature

Telephone
Number: (513) 983-7592

Amy I. Ahn-Roll
Typed or printed name

Registration Number: 44,498

CUSTOMER NUMBER: 27752

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Gregory W. Carr
CARR LLP
670 FOUNDERS SQUARE
900 JACKSON STREET
DALLAS, TX 75202

(For Patent Owner)

MAILED

JUN 25 2009

CENTRAL REEXAMINATION UNIT

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

(For Third Party Requester)

In re Billings	:	DECISION ON
Inter Partes Reexamination Proceeding	:	REQUEST FOR
Control No.: 95/000,378	:	WITHDRAWAL OF PETITION OF
Filed: October 9, 2008	:	EXTENSION OF TIME
For: U.S. Patent No. 7,344,450	:	

This is a decision on the May 22, 2009, petition entitled "Petition to Withdraw of Extension of Time" requesting a withdrawal of the petition of the extension of time filed on May 18, 2009.

The petition is before the Central Reexamination Unit for consideration.

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,344,450 (hereinafter, the '450 patent), issued to David P. Billings, on March 18, 2008.

2. On October 9, 2008, a third party deposited a Request for *Inter Partes* Reexamination of the '450 patent. The reexamination proceeding was assigned Control No. 95/000,378 (hereinafter, the '378 proceeding).

3. On March 25, 2009, the Patent Office mailed a non-final Office Action for the reexamination proceeding. The Patent Owner was given a two-month time period for response

4. On April 20, 2009, the Patent Owner filed a petition for a one-month extension of time for the response to the non-final Office Action mailed March 25, 2009.

5. On May 4, 2009, the Patent Office granted the request for the extension of time filed on April 20, 2009. The response deadline was extended to June 25, 2009.

6. On May 18, 2009, the Patent Owner filed a request for an extension of time for the response to the non-final Office Action mailed March 25, 2009.

7. On May 22, 2009, the Patent Owner filed present request to withdraw the petition for the extension of time filed on May 18, 2009.

DECISION

The Patent Office acknowledges the Patent Owner filed a petition for extension of time on May 18, 2009 unintentionally and in error. The Patent Office also acknowledges the request for the withdrawal of said petition filed on May 22, 2009.

Petitioner's request for a withdrawal of the petition for an extension of time is **granted**.

CONCLUSION

1. Petitioner's request is **granted**.

2. The period for response is unaffected by the petition of May 18, 2009.

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

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Gregory W. Cart
CARR LLP
670 FOUNDERS SQUARE
900 JACKSON STREET
DALLAS, TX 75202

(For Patent Owner)

MAILED

AUG 2 5 2009

CENTRAL REEXAMINATION UNIT

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

(For Requester)

In re Billings
Reexamination Proceeding
Control No. 95/000,378
Corrected Request Dated: October 9, 2008
For: U.S. Patent No. 7,344,450

: DECISION ON
: PETITION TO HAVE
: COMMENTS DEEMED
: TIMELY FILED

This is a decision on the August 11, 2009 "Petition Under 37 CFR § 1.10(e)" filed by the third party requester.

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

The petition is dismissed. For the reasons set forth below, the comments and other papers dated August 11, 2009 are not accepted as timely, and therefore, will not be considered by the examiner in this reexamination proceeding. See MPEP 2667.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,344,450 (hereinafter "the '450 patent') was issued to Billings on March 18, 2008.

2. On October 9, 2008, a third party requester deposited a corrected request for reexamination of claims 1-18 of the '450 patent.

3. On December 19, 2008, the Order granting reexamination was mailed.

4. On March 25, 2009, a Non-Final Office action was mailed.

5. On April 20, 2009, the patent owner filed a request for a one-month extension of time.

5. On May 4, 2009, a decision granting the one-month extension of time was mailed.

6. On June 16, 2009, the patent owner filed a request for an additional one-week extension of time.

7. On June 25, 2009, a decision granting the one-week extension of time was mailed.

8. On July 2, 2009, the patent owner's response was timely filed. The response included a certificate of service, which indicated the third party requester was served the response on July 2, 2009.

9. On August 11, 2009, the third party requester filed the "Petition Under 37 CFR § 1.10(e)" and papers in response to the Patent Owner's July 2, 2009 response and the March 25, 2009 Office action. The petition requests that the director consider the comments, declaration, information disclosure statement, and certificate of service, dated August 11, 2009, as timely filed on August 3, 2009.

DECISION

37 CFR § 1.10 Filing of correspondence by "Express Mail" states, in part:

(a)

(1) Any correspondence received by the US. 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).

...

(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 0f 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. (Emphasis added)

37 CFR § 1.1(a) states, in part:

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all **correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1)**, and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.*

(i) *In general.* All correspondence concerning patent matters processed by organizations reporting to the ***Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.*** (emphasis added)

Notice entitled "Termination of the Waiver of Provisions of 37 CFR 1.8 and 1.10 for Correspondence Intended for the United States Patent and Trademark Office but Addressed to Washington, DC 20231," dated March 1, 2005 published in the Official Gazette on March 29, 2005, states, in part:

> "Effective on April 4, 2005, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 ("Express Mail") will no longer be waived for correspondence addressed to the United States Patent and Trademark Office (USPTO), Washington, DC 20231. On May 1, 2003, the USPTO changed its address for certain correspondence to P.O. Box 1450, Alexandria, VA 22313-1450. See 37 CFR 1.1 and Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003), 1269 Off. Gaz. Pat. Office 159 (Apr. 22, 2003). To allow applicants time to become accustomed to the new address in Alexandria, VA, the USPTO waived the provisions of 37 CFR 1.8 and 1.10 such that correspondence addressed to Washington, DC 20231 would be treated as acceptable under 37 CFR 1.8 and 1.10 for otherwise compliant Certificates of Mailing and "Express Mail."
>
> The United States Postal Service (USPS) has ceased forwarding to the USPTO correspondence addressed to Washington, DC 20231. Additionally, the USPTO will no longer arrange for the delivery to Alexandria, VA of correspondence addressed to Washington, DC 20231 after April 3, 2005. Thus, after April 3, 2005, all correspondence addressed to the Washington, DC 20231 address will be returned to sender marked by the USPS as undeliverable. ***Such mail returned to the sender by the USPS will not be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1.***
>
> ***Pursuant to 37 CFR 1.1, correspondence intended for the USPTO must be mailed to P.O. Box 1450, Alexandria, VA 22313-1450, except as otherwise provided.*** (Emphasis added)

37 CFR 1.947 states, in part:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, ***a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.*** 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. (Emphasis added)

On August 11, 2009, the third party requester petitioned the director under 37 CFR § 1.10(e) to acknowledge and accept as timely the comments, declaration, information disclosure statement, and certificate of service filed on August 11, 2009 with the petition. The third party requester stated that the original documents were deposited with the United State Postal Service (USPS) "... in accordance with the 'Express Mail' mailing procedures set forth in 37 C.F.R. § 1.10" on August 3, 2009. See page 1 of the petition. The petition further explains that the mailing address used for the Office was:

> "Assistant Commissioner for Patents
> Box Reexam
> Washington, DC 20231."

See page 2 of the petition. The petition elaborates that the third party requester intended to file the comments and associated papers electronically, but the electronic filing system was not accessible at the time the filing was attempted. Thereafter, it was decided to use Express Mail to mail the comments and papers under 37 CFR 1.10. The petition explains that, due to inadvertent error, the mailing address was not corrected to reflect the current address for the Office. See page 2 of the petition. The petition also provides the "Express Mail" mailing label showing the date-in date, and an original copy of the documents. See pages 2-3 of the petition.

As pointed out above, 37 CFR 1.10(e) requires that the correspondence must be addressed in accordance with 37 CFR 1.1(a). 37 CFR 1.1(a) clearly states that the required correspondence address for patent correspondence is:

> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

Furthermore, the Official Gazette Notice dated March 29, 2005 (reproduced, in part, above) states that correspondence addressed to Washington, DC 20231 after April 3, 2005 will NOT be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1(a).

As stated above, the petition admits that the correspondence, including the comments, declaration, information disclosure statement, and the certificate of service, used the Washington, DC 20231 address. This correspondence was mailed on August 3, 2009, which is after the April 3, 2005 date given in the Official Gazette Notice. Therefore, the correspondence, which was not mailed in accordance with 37 CFR 1.10 and 1.1(a), cannot be used a proof of prior filing or mailing. For these reasons, the petition under 37 CFR 1.10(e) is dismissed.

Without the grant of the petition, the papers dated August 11, 2009 are untimely. 37 CFR 1.947 requires that any comments from the third party requester must be filed within 30 days from the certificate of service from the patent owner. As stated above in the relevant facts, the certification of service from the patent owner stated that the third party requester was served on

July 2, 2009. Therefore, the third party requester had until August 1, 2009 to timely submit comments. Because August 1, 2009 was a Saturday, the deadline was extended to Monday, August 3, 2009. See 35 U.S.C. 21(b). Therefore, the papers filed on August 11, 2009 are not timely because they were filed after August 3, 2009. See MPEP 2666.05.

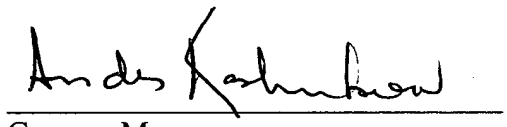
In accordance with MPEP 2667, the papers dated August 11, 2009 will be retained in the file but will not be considered by the examiner.

CONCLUSION

1. The petition to accept, as timely, the August 11, 2009 comments and associated papers is DISMISSED.

2. The papers dated August 11, 2009 will be retained in the file, but will NOT be considered by the examiner.

3. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361, or in his absence, to the undersigned at (571) 272-3838.



acting for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,378	10/09/2008	7344450	0EKM-136247	8212

21909 7590 10/07/2009

CARR LLP
670 FOUNDERS SQUARE
900 JACKSON STREET
DALLAS, TX 75202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/07/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

MAILED

OCT 07 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,378*.

PATENT NUMBER *7,344,450*.

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

Gregory W. Cart
CARR LLP
670 FOUNDERS SQUARE
900 JACKSON STREET
DALLAS, TX 75202

(For Patent Owner)

MAILED

OCT 07 2009

CENTRAL REEXAMINATION UNIT

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

(For Requester)

In re Billings
Reexamination Proceeding
Control No. 95/000,378
Corrected Request Dated: October 9, 2008
For: U.S. Patent No. 7,344,450

: DECISION ON
: RENEWED PETITION
: UNDER 37 CFR 1.10(e)

This is a decision on the September 1, 2009 "Request for Reconsideration of Petition Under 37 CFR § 1.10(e); Petitions under 37 CFR §§ 1.182 and 1.183" filed by the third party requester.

The request for reconsideration of the August 25, 2009 decision on the petition under 37 CFR 1.10(e) is before Director of Technology Center 1600, who oversees the Central Reexamination Unit. The alternative petitions under 37 CFR 1.182 and 1.183 will not be addressed for reasons explained below.

The request for reconsideration petition is denied. For the reasons set forth below, the comments and other papers dated September 1, 2009 are not accepted as timely, and therefore, will not be considered by the examiner in this reexamination proceeding. See MPEP 2667.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,344,450 (hereinafter "the '450 patent') was issued to Billings on March 18, 2008.

2. On October 9, 2008, a third party requester deposited a corrected request for reexamination of claims 1-18 of the '450 patent.

3. On December 19, 2008, the Order granting reexamination was mailed.

4. On March 25, 2009, a Non-Final Office action was mailed.

5. On April 20, 2009, the patent owner filed a request for a one-month extension of time.

6. On May 4, 2009, a decision granting the one-month extension of time was mailed.

7. On June 16, 2009, the patent owner filed a request for an additional one-week extension of time.

8. On June 25, 2009, a decision granting the one-week extension of time was mailed.

9. On July 2, 2009, the patent owner's response was timely filed. The response included a certificate of service, which indicated the third party requester was served the response on July 2, 2009.

10. On August 11, 2009, the third party requester filed the "Petition Under 37 CFR § 1.10(e)" and papers in response to the Patent Owner's July 2, 2009 response and the March 25, 2009 Office action. The petition requests that the director consider the comments, declaration, information disclosure statement, and certificate of service, dated August 11, 2009, as timely filed on August 3, 2009.

11. On August 25, 2009, a decision dismissing the petition under 37 CFR 1.10(e) was mailed.

12. On September 1, 2009, the third party requester filed a request for reconsideration of the petition under 37 CFR 1.10(e) and alternative petitions under 37 CFR 1.182 and 1.183 as a single paper.

DECISION

37 CFR § 1.10 Filing of correspondence by "Express Mail" states, in part:

(a)

(1) Any correspondence received by the US. 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).

...

(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 0f 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. (Emphasis added)

37 CFR § 1.1(a) states, in part:

> (a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all **correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1)**, and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.
>
> (1) *Patent correspondence.*
>
> (i) *In general.* All correspondence concerning patent matters processed by organizations reporting to the ***Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.*** (emphasis added)

Notice entitled "Termination of the Waiver of Provisions of 37 CFR 1.8 and 1.10 for Correspondence Intended for the United States Patent and Trademark Office but Addressed to Washington, DC 20231," dated March 1, 2005 published in the Official Gazette on March 29, 2005, states, in part:

> "Effective on April 4, 2005, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 ("Express Mail") will no longer be waived for correspondence addressed to the United States Patent and Trademark Office (USPTO), Washington, DC 20231. On May 1, 2003, the USPTO changed its address for certain correspondence to P.O. Box 1450, Alexandria, VA 22313-1450. See 37 CFR 1.1 and Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003), 1269 Off. Gaz. Pat. Office 159 (Apr. 22, 2003). To allow applicants time to become accustomed to the new address in Alexandria, VA, the USPTO waived the provisions of 37 CFR 1.8 and 1.10 such that correspondence addressed to Washington, DC 20231 would be treated as acceptable under 37 CFR 1.8 and 1.10 for otherwise compliant Certificates of Mailing and "Express Mail."
>
> The United States Postal Service (USPS) has ceased forwarding to the USPTO correspondence addressed to Washington, DC 20231. Additionally, the USPTO will no longer arrange for the delivery to Alexandria, VA of correspondence addressed to Washington, DC 20231 after April 3, 2005. Thus, after April 3, 2005, all correspondence addressed to the Washington, DC 20231 address will be returned to sender marked by the USPS as undeliverable. ***Such mail returned to the sender by the USPS will not be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1.***
>
> ***Pursuant to 37 CFR 1.1, correspondence intended for the USPTO must be mailed to P.O. Box 1450, Alexandria, VA 22313-1450, except as otherwise provided.*** (Emphasis added)

37 CFR 1.947 states, in part:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, ***a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response***. 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. (Emphasis added)

On August 11, 2009, the third party requester petitioned the director under 37 CFR § 1.10(e) to acknowledge and accept as timely the comments, declaration, information disclosure statement, and certificate of service filed on August 11, 2009 with the petition. This petition was dismissed in a decision mailed August 25, 2009. On September 1, 2009, the third party requester filed a request for consideration of the August 25, 2009 decision. As in the first petition, the third party requester stated that the original documents were deposited with the United State Postal Service (USPS) in accordance with the Express Mail mailing procedures set forth in 37 C.F.R. § 1.10 on August 3, 2009. See page 2 of the renewed petition. The renewed petition further explains that the mailing address used for the Office was:

> "Assistant Commissioner for Patents
> Box Reexam
> Washington, DC 20231."

See page 2 of the renewed petition. The renewed petition elaborates that the third party requester intended to file the comments and associated papers electronically, but the electronic filing system was not accessible at the time the filing was attempted. Thereafter, it was decided to use Express Mail to mail the comments and papers under 37 CFR 1.10. The renewed petition explains that, due to inadvertent error, the mailing address was not corrected to reflect the current address for the Office. See pages 2-3 of the renewed petition. The renewed petition also provides declarations by Bridgette Agness and Betty Rodriguez in support of the petition. See pages 2-3 of the renewed petition.

As pointed out above, 37 CFR 1.10(e) requires that the correspondence must be addressed in accordance with 37 CFR 1.1(a). 37 CFR 1.1(a) clearly states that the required correspondence address for patent correspondence is:

> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

Furthermore, the Official Gazette Notice dated March 29, 2005 (reproduced, in part, above) states that correspondence addressed to Washington, DC 20231 after April 3, 2005 will NOT be

considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1(a).

As stated above, the petition and supporting declarations admit that the correspondence, including the comments, declaration, information disclosure statement, and the certificate of service, was addressed to the Washington, DC 20231 address. This fact alone is controlling, and it is not relevant whether the use of the Washington, DC 20231 address was inadvertent. The correspondence was mailed on August 3, 2009, which is after the waiver regarding the requirements of 37 CFR 1.10 expired, as explained in the Official Gazette Notice. Therefore, the correspondence, which was not mailed in accordance with 37 CFR 1.10 and 1.1(a), cannot be used a proof of prior filing or mailing, as explicitly stated in the Official Gazette Notice and in the regulations. Without proof of prior mailing or filing, the petition under 37 CFR 1.10(e) cannot be granted.

In the renewed petition, the petitioner cites to MPEP 513, subsection VII, for the guideline that if the correspondence is **actually received** by the Office, it will not be denied a filing date because the correspondence was not addressed as set forth in 37 CFR 1.1(a). Petitioner then asserts that "... it is reasonable to infer that the Third Party Comments may have been delivered to the Office but not accepted by it." See page 4 of the renewed petition. The facts of the record simply do not support petitioner's inference that the correspondence was delivered to the Office, and more importantly, that the correspondence was **actually received** by the Office. The record clearly shows that petitioner received the correspondence as returned mail and the correspondence in question was never received by the Office until it was remailed on August 11, 2009. For evidence, see paragraph 6 of Bridgette Agness Declaration and the record of paper entries for the proceeding. If the Office actually received the correspondence, the correspondence would not have been returned to the sender, but instead would have had an Office Date stamp of receipt and entered into the record of the proceedings. See MPEP 505. In addition, the Official Gazette Notice clearly states that the USPS will be no longer forward mail addressed to the Washington, DC 20231 address to the Alexandria, VA address after April 3, 2005. Therefore, it is more plausible that a USPS employee or contractor wrote the "Alex, VA 22313" on the correspondence and returned it to sender to inform the sender of the correct address for the USPTO. More importantly, the Official Gazette Notice clearly states that "... ***mail returned to the sender by the USPS will not be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1."*** This is exactly what occurred to the correspondence in question in this proceeding. Accordingly, the record does not show that the correspondence in question was actually received by the Office nor does it establish the required proof of prior mailing under 37 CFR 1.10(e).

For all these reasons, the petition under 37 CFR 1.10(e) is denied.

Without the grant of the petition, the papers dated August 11, 2009 are untimely. 37 CFR 1.947 requires that any comments from the third party requester must be filed within 30 days from the certificate of service from the patent owner. As stated above in the relevant facts, the

certification of service from the patent owner stated that the third party requester was served on July 2, 2009. Therefore, the third party requester had until August 1, 2009 to timely submit comments. Because August 1, 2009 was a Saturday, the deadline was extended to Monday, August 3, 2009. See 35 U.S.C. 21(b). Therefore, the papers filed on August 11, 2009 are not timely because they were filed after August 3, 2009. See MPEP 2666.05.

In accordance with MPEP 2667, the papers dated August 11, 2009 will be retained in the file but will not be considered by the examiner.

Alternative Petitions under 37 CFR 1.182 and 1.183

Only the request for reconsideration petition filed under 37 CFR 1.10(e) is before the Central Reexamination Unit of the United States Patent and Trademark Office and is addressed in this decision. The alternative petitions under 37 CFR 1.182 and 1.183 must be filed as separate papers for proper consideration by the Office, and are 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 and 1.183 are decided by the Office of Patent Legal Administration while petitions filed under 37 CFR 1.10(e) are decided by the Central Reexamination Unit, the third party must submit the petitions under 37 CFR 1.182 and 1.183 as separate papers to avoid confusion and delay.

CONCLUSION

1. The renewed petition to accept, as timely, the August 11, 2009 comments and associated papers is DENIED.

2. The papers dated August 11, 2009 will be retained in the file, but will NOT be considered by the examiner.

3. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361, or in his absence, to Gregory Morse, Director of the CRU, at (571) 272-3838.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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SHEPPARD, MULLIN, RICHTER & HAMPTON LLP (For Requester)
333 SOUTH HOPE ST
48TH FLOOR
LOS ANGELES CA 90071-1448

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OFFICE OF PETITIONS

In re Billings	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No. 95/000,378	:	
Filed: 10/09/2008	:	
Attorney Docket Number: 0EKM-136247	:	

This is a decision on the third party requester petition filed under 37 CFR §§ 1.182 and 1.183, on September 1, 2009, requesting that papers filed in the Office on August 11, 2009 be considered to have been filed on August 9, 2009.

The petition is before the Office of Patent Legal Administration for a decision.

The petition is **dismissed**.

BACKGROUND

1. U.S. Patent No, 7,344,450 (hereinafter "the '450 patent") was issued to Billings on March 18, 2008.

2. On October 9, 2008, a third party requester filed a corrected request for reexamination of Claims 1-18 of the '450 patent.

3. On December 19, 2008, the Order granting reexamination was mailed.

4. On March 25, 2009, a non-final Office action was mailed.

5. On April 20, 2009, the patent owner filed a request for a one-month extension of time.

6. On May 4, 2009, a decision granting the one-month extension of time was mailed.

7. On June 16, 2009, the patent owner filed a request for an additional one-week extension of time.

8. On June 25, 2009, a decision granting the one-week extension of time was mailed.

9. On July 2, 2009, the patent owner's response was timely filed. The response included a certificate of service, which indicated the third party requester was served the response on July 2, 2009.

10. On August 11, 2009, the third-party requester filed a "Petition Under 37 CFR § 1.10(e)" and comments to the Patent Owner's July 2, 2009 response and the March 25, 2009 Office action. The petition requested that the Director consider the comments, declaration, and information disclosure statement, dated August 11, 2009, as timely filed on August 3, 2009.

11. On August 25, 2009, the petition was dismissed.

12. On September 1, 2009, the subject renewed petition was filed, requesting reconsideration of the petition under 37 CFR 1.10(e) and consideration under 37 CFR §§ 1.182 and 1.183.

13. On October 13, 2009, a duplicate copy of the above-referenced petition was filed, accompanied by the petition fee.[1]

14. Specifically, petitioners again aver that they attempted to timely file the papers in response to the Patent Owner's response on August 3, 2009. Petitioners state that they attempted to file the papers via the USPTO's Electronic Filing System (EFS), but that EFS was inaccessible. Petitioners then attempted to file the papers by USPS "Express Mail" Post Office to Addressee Service, but used an old address for the USPTO on the Express Mail label. The mailing was returned as undeliverable by the USPS on August 7, 2009. The papers were subsequently filed on August 11, 2009.

---

[1] Although the petition fee under 37 CFR 1.182 and 1.183 was not actually paid until the submission of the paper filed on October 13, 2009, the paper filed on September 1, 2009, authorized any required fee to be charged to counsel's deposit account.

DECISION ON PETITIONS UNDER 37 CFR §§ 1.10, 1.182, and 1.183

37 CFR 1.6 Receipt of correspondence, states, in part:

> (a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:
>
> ...
>
> (2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

37 CFR 1.10 Filing of correspondence by "Express Mail" states, in part:

> (a)
>
> (1) Any correspondence received by the US 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).
>
> ...
>
> (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 to 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, retumed postcard receipt, and official notation entered by the USPS. (Emphasis added)

35 USC 21 Filing date and day for taking action, states, in part:

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

37 CFR 1.182 Questions not specifically provided for, 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 1.183 Suspension of rules, states:

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

37 CFR 1.1(a) states, in part:

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all **correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs** (a)(1), and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) Patent correspondence.

(i) *In general.* All correspondence concerning patent matters processed by organizations reporting to the ***Commissioner for Patents***

should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

(emphasis added)

Notice entitled "Termination of the Waiver of Provisions of 37 CFR 1.8 and 1.10 for Correspondence Intended for the United States Patent and Trademark Office but Addressed to Washington, DC 20231," dated March 1, 2005 published in the *Official Gazette* on March 29, 2005, states, in part:

> "Effective on April 4, 2005, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 ("Express Mail") will no longer be waived for correspondence addressed to the United States Patent and Trademark Office (USPTO), Washington, DC 20231. On May 1, 2003, the USPTO changed its address for certain correspondence to P.O. Box 1450, Alexandria, VA 22313-1450. See 37 CFR 1.1 and Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003), 1269 Off. Gaz. Pat. Office 159 (Apr. 22, 2003). To allow applicants time to become accustomed to the new address in Alexandria, VA, the USPTO waived the provisions of 37 CFR 1.8 and 1.10 such that correspondence addressed to Washington, DC 20231 would be treated as acceptable under 37 CFR 1.8 and 1.10 for otherwise compliant Certificates of Mailing and "Express Mail."
>
> The United States Postal Service (USPS) has ceased forwarding to the USPTO correspondence addressed to Washington, DC 20231. Additionally, the USPTO will no longer arrange for the delivery to Alexandria, VA of correspondence addressed to Washington, DC 20231 after April 3, 2005. Thus, after April 3, 2005, all correspondence addressed to the Washington, DC 20231 address will be returned to sender marked by the USPS as undeliverable. ***Such mail returned to the sender by the USPS will not be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1.***
>
> ***Pursuant to 37 CFR 1.1, correspondence intended for the USPTO must be mailed to P.O. Box 1450, Alexandria, VA***

> ***22313-1450, except as otherwise provided.*** (Emphasis added)

37 CFR 1.947 states, in part:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, ***a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.*** 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. (Emphasis added)

OPINION

With regard to the renewed petition under 37 CFR 1.10, petitioner again asserts that "counsel for (Third Party Requester) Taylor Made made a good faith effort to submit the documents via Express Mail to the Office, but inadvertently included an old address on the 'Express Mail' label." Petitioner further asserts that, apparently in view of the incorrect Washington, DC address being lined out on the Express Mail label, and the address "Alex, VA 22313" being inserted, presumably by the U.S. Postal Service ("USPS") "it is reasonable to infer that the [documents] may have been delivered to the Office, but not accepted by it."

Petitioner's arguments have been considered, but are not persuasive. At the outset, petitioner concedes that the correspondence was mailed to an old address. As the correspondence was mailed to an address no longer in use after April 4, 2005, as stipulated by the *Official Gazette* notice of March 29, 2005, petitioner clearly did not comply with 37 CFR 1.10.

Moreover, petitioner's contention that the Express Mail envelope was delivered to the Office, but "not accepted," similarly lacks merit. In this regard, 37 CFR 1.6(a) states that correspondence received in the USPTO is stamped with the date of receipt except

for correspondence filed in accordance with 37 CFR 1.10. There is no provision in the rules for the Office to "not accept" correspondence delivered by the USPS. Further still, the Return to Sender label affixed to the Express Mail label states "insufficient address." The "refused" box on that label has **not** been checked. The showing of record suggests that the USPS, not the USPTO, annotated the Express Mail label with the correct city, state, and ZIP code, and subsequently returned the mailing to the sender. The burden is on petitioner to show that the Express Mail envelope was delivered to the Office, not on the Office to show that the envelope was not properly delivered. In summary, there is simply no evidence in support of a finding that the Express Mail envelope with the "date-in" of August 3, 2009, was ever delivered to the USPTO.

As such, the request for reconsideration under 37 CFR 1.10 is again **dismissed**.

With regard to the petitions under 37 CFR 1.182 and 1.183, the gravamen of petitioner's argument is that petitioner "made a good faith effort" to timely file the papers by Express Mail on August 3, 2009, but that the papers were not timely filed in the Office due to a clerical mistake in addressing the Express Mail envelope. Petitioner further states that this matter is "an extraordinary situation" because this reexamination proceeding is related to two other pending reexamination proceedings and because the matter relates to co-pending ligation. In this regard, petitioner states "Moreover, consideration of the Third Party Comments Documents in the two co-pending reexaminations but not in the present one may lead to inconsistent results."

With regard to the petition under 37 CFR 1.183, petitioner's arguments have been considered, but are not persuasive. The Office has prescribed a procedure for filing papers in the Office by Express Mail. Moreover, the *Official Gazette* notice referenced above sets forth the address to which papers must be sent. The filing of papers by "Express Mail" is a routine procedure, and petitioners have not demonstrated that the filing of the above-referenced papers was an extraordinary event. Moreover, the *Official Gazette* notice was published in March, 2005, over four (4) years prior to the filing the subject papers. It is unclear why counsel did not use the current Office mailing address. Petitioner has not explained why the failure to use the current correspondence address should be considered an extraordinary situation in which justice requires waiver of the rules. Rather than an extraordinary situation, the showing of record is that an avoidable mistake was made. Waiver of the

rules is not warranted when counsel makes an avoidable mistake.

With regard to petitioner's argument that a "good faith effort" was made to comply with the rules, while the showing of record is that petitioner intended to timely file a reply, the reply was not, in fact, timely filed. In this regard, the *Official Gazette* notice states that effective April 4, 2005, the provisions of 37 CFR 1.8 and 1.10 will **not** be waived for correspondence mailed to the Washington, DC 20231 address. The *O.G.* Notice further states that the provisions had been waived up to that point to allow applicants to become accustomed to the new address. In view thereof, petitioners have not shown why this should be considered an extraordinary circumstance where justice requires waiver of the rule.

Simply put, the mere fact that petitioner intended to properly file papers, but failed to do so, is not an extraordinary situation in which justice requires waiver of the rules.[2] Still further, the facts that litigation may be ongoing, and that this reexamination proceeding is related to other co-pending reexamination proceedings, do not constitute an extraordinary situation in which justice requires waiver of the rules. In this regard, petitioner is responsible for the proper filing of all papers. Neither the importances of the reexamination proceeding to petitioner, nor the circumstances surrounding the filing of the reexamination proceeding and related litigation, are relevant in determining the existence of an extraordinary situation where justice requires waiver of the rule. Rather, the showing required by 37 CFR 1.183 is that the failure to comply with 37 CFR 1.10 was due to an extraordinary circumstance in which justice requires waiver of the rules. The failure of petitioner to properly file papers in accordance with 37 CFR 1.10 constitutes an avoidable mistake in which waiver of the rules is not warranted.[3]

---

[2] See Krahn v. Commissioner, 15 USPQ2d 1823, 1825 (E.D. Va. 1990). A reasonably prudent person would file papers or fees in compliance with 37 CFR 1.8 and 1.10 to ensure their timely filing in the PTO, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 or 1.10 does not constitute "unavoidable" delay. Id.

[3] A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987); Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.C.C. 1981); Potter v. Dann; 201 USPQ 571 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

As petitioner has not shown the existence of an extraordinary circumstance in which justice requires waiver of the rules, the petition under 37 CFR 1.183 is dismissed.

With regards to the petition under 37 CFR 1.182, 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. The situation at hand, however, is specifically provided for in the regulations. In particular, 37 CFR 1.10 sets forth the procedure for filing papers using "Express Mail," including the address to which Express Mail shipments must be addressed. More importantly, 37 CFR 1.6 states that if papers are not properly filed in accordance with 37 CFR 1.10, or the other provisions governing the filing of papers in the Office, the papers will be stamped as received, and thereby considered filed, on the date of actual receipt. Here, the papers were clearly not filed in accordance with the provisions of 37 CFR 1.10, as an incorrect address was used due to petitioner's mistake. Rather, the papers were received on August 11, 2009, and were properly accorded a filing date of August 11, 2009.

Accordingly, the petition under 37 CFR 1.182 is **dismissed**.

In accordance with MPEP 2667, the papers dated August 11, 2009 will be retained in the file but will not be considered by the examiner.

CONCLUSION

1. The petition is **dismissed**.

2. Petitioner is given TWO (2) MONTHS to respond to this decision. **This time period is NOT extendable**.[4]

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
ATTN: Douglas I. Wood
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

[4] 37 CFR 1.181(f).

By FAX: (571) 273-8300
Attn: Office of Petitions

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

A reply may also be filed via the EFS-Web system.

4. Receipt of the petition fee of $400.00 is acknowledged. It is noted that the fee has been paid twice. As only one fee is required for consideration under 37 CFR 1.182 and 1.183, the duplicate petition fee will be credited to counsel's deposit account.

5. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

6. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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FEB 25 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester '136)

Mark G. Knedisen, Esq.
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Gates Ellis LLP
535 Smithfiled Street,
Henry Oliver Building
Pittsburgh, PA 15222-2312

(For Third Party Requester '382)

Inter partes Reexamination Proceeding
Control No. 95/000,136
Filed: March 14, 2006
For: U.S. Patent No. 6,299,793

Inter partes Reexamination Proceeding
Control No. 95/000,382
Filed: June 26, 2008
For: U.S. Patent No. 6,299,793

DECISION NOT TO MERGE
INTER PARTES REEXAMINATION
CONTROL NOS. 95/000,132 AND
95/000,382

Inter partes reexamination control Nos. 95/000,136 and 95/000,382 are before the Office of Patent Legal Administration for consideration of patent owner's petition against merging the two proceedings into a single merged proceeding.

REVIEW OF THE FACTS

1. On October 9, 2001, U.S. Patent 6,299,793 (the '793 patent) issued to Hartley *et al.*

2. On March 14, 2006, a request for *inter partes* reexamination of the '793 patent was filed by a third party requesters, Ice Ban America, Inc. and Earth Friendly Chemicals, Inc. The

resulting reexamination proceeding was assigned control number 95/000,136 ("the '136 reexamination proceeding").

3. On May 5, 2006, an order granting the '136 *inter partes* reexamination request was mailed. The examiner also mailed an Office action rejecting all 8 claims of the patent.

4. On July 5, 2006, the patent owner timely filed a response to the first Office action in the '136 reexamination proceeding.

5. On February 12, 2007 the examiner mailed an Action Closing Prosecution (ACP) in the '136 proceeding.

6. On April 9, 2007, patent owner filed a response to the ACP in the '136 reexamination proceeding.

7. On May 10, 2008, the examiner issued Right of Appeal Notice (RAN) to the parties in the '136 proceeding. In the RAN, the claims 1-3, and 7 remained rejected and claims 4-6 and 8 were confirmed.

8. On May 30, 2008, Patent Owner filed a notice of appeal in the '136 proceeding.

9. On June 26, 2008, a new third party requester filed a request for *inter partes* reexamination of claims 4-6,8 of the '793 patent. The request was filed by Glacial Technologies LLC and Archer Daniels Midland. The resulting reexamination proceeding was assigned control number 95/000,382.

10. On June 30, 2008, patent owner perfected the appeal by filing an appeal brief in the '136 reexamination proceeding. The patent owner appealed the rejection of claims 1-3, and 7. The third party requester '136 did not file either an appellant's brief or a respondent's brief.

11. On October 28, 2008, the patent owner filed a petition pursuant to 37 CFR 1.181 in both reexamination proceedings to request that the Office not merge the two control proceedings.

12. In the October 28, 2008 petition pursuant to 37 CFR 1.181, the patent owner argued that the proceedings should not be merged for numerous reasons including the following: a) length of pendency of the '136 IP reexamination proceeding; (b) the early stage of the '382 proceeding; (c) litigation in the '793 patent has been stayed pending outcome of the '136 reexamination proceeding; (4) merger of the '136 reexamination proceeding and the '382 reexamination proceeding will unduly delay completion of the '136 reexamination proceeding.

RELEVANT AUTHORITY

35 U.S.C. § 314(c) provides, in part:

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

37 CFR 1.103(e) provides:

Notice of suspension on initiative of the Office. The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

37 CFR 1.181 provides:

Petition to the Director. (3) To invoke the supervisory authority of the Director in appropriate circumstances.

37 CFR 1.989 provides, in part:

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 proceedings.

MPEP § 2686.01 provides, in part:

II. WHEN PROCEEDING IS SUSPENDED

It may also be desirable in certain situations to suspend one of the proceedings for a short and specified period of time. For example, a suspension of a first reexamination proceeding may be issued to allow time for the decision on the second request. Further, after the second proceeding has been ordered, it may be desirable to suspend the second proceeding prior to merging, where the first proceeding is presently on appeal before a Federal court to await the court's decision prior to merging. A suspension will only be granted in exceptional (extraordinary) instances because of the statutory requirements that examination proceed with "special dispatch", and the express written approval by the OPLA must be obtained. Suspension will not be granted when there is an outstanding
Office action.

IV. PROCEEDINGS NOT MERGED

Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section...shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination **>will unduly delay< the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its **>place in the process,< thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the

claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

DECISION

The present '136 reexamination proceeding and the present '382 reexamination proceeding are both currently pending for the '793 patent. A decision under 37 CFR 1.985(a) regarding merger of those proceedings, or suspension of one of them, is now required for the '136 reissue application and the '382 reexamination proceeding. As noted in MPEP § 2686.01, the Office policy is that if the second request for reexamination would unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. Moreover, if the Office were to merge the proceedings, the earlier filed reexamination proceeding would need to be withdrawn for its place in the process thus delaying, instead of advancing prosecution. However, as noted *supra* the Office always retains the authority to merge the proceedings.

It appears from a consideration of the record in each of the '136 reexamination application and the '382 reexamination proceeding that merger of the two proceedings is not an appropriate option. In addition, the Office after careful consideration will NOT suspend prosecution in the '382 reexamination proceeding.

This determination is based on the following considerations:

(1) With respect to the option of merging the '136 reexamination proceeding and the '382 reexamination proceeding, when a reexamination proceeding is on appeal to the Board of Patent Appeals and Interferences ("the BPAI"), that circumstance would itself weigh against merger of the reexamination proceeding with a later filed *inter partes* . For the present reexamination proceedings, a merger of the '136 reexamination proceeding and the '382 reexamination proceeding would impede treatment of the '136 reexamination proceeding with special dispatch. A merger would pull the '136 reexamination proceeding back from its briefed-on-appeal stage, and return the prosecution to a point in which no examination of the claims of record in the merged proceeding has taken place. It simply does not appear that prosecution on the '382 reexamination application, which has only received an order granting reexamination, will be concluded so quickly as to provide special dispatch for the '136 reexamination proceeding if the two proceedings are merged. There is a public interest in the outcome of the '136 reexamination proceeding, and the public has a right to have that proceeding conducted with special dispatch, particularly when it has reached a late stage of prosecution, rather than have prosecution delayed indefinitely in favor of prosecution in a reexamination proceeding that has not yet had an Office action.

In addition, the patent owner raised an additional valid argument in its assertion that the litigation involving the '793 patent has been suspended by the US District Court Northern

District of New York (Case No. 5:03-CV-1120 DEP) pending conclusion of the '136 reexamination proceeding. After five years of litigation , the trial court granted the stay pending resolution of the reexamination control proceeding. The motion for stay advised the court that the BPAI would expect to be finished within 6-12 months. To merge the proceedings, would not be beneficial to the court in seeking resolution by the USPTO prior to addressing the litigation suit.

(2) As to the option of suspending the '382 reexamination proceeding and continuing prosecution of the '136 reexamination application, it is again noted that the '136 reexamination proceeding is on appeal to the BPAI, while prosecution in the '382 reexamination proceeding has yet to proceed beyond the ordering of the reexamination request. To suspend the '382 reexamination proceeding so that prosecution could be conducted completed in the '136 reexamination would be contrary to the requirement of 35 U.S.C § 305 that reexamination proceedings in the Office (including appeals to the BPAI) be conducted with special dispatch under the specific facts of the two proceedings.

Persuasive consideration has also been given to the possibility of conducting the prosecution in the '136 reexamination proceeding and the '382 reexamination proceeding separately and concurrently. Under the facts of the two proceedings, it is deemed appropriate to do so. It is noted that the '793 application issued with 8 claims. In the '136 application, the Office has noted that claims 1-3,7 are rejected and have confirmed the patentability of claims 4-6 and 8. On appeal, the third party requester in the '136 reexamination proceeding did not appeal the confirmation of claims 4-6 and 8. In the '382 reexamination proceeding, the requester has only sought reexamination of claims 4-6 and 8 that were confirmed in the '136 proceeding. In light of this specific claims involved in each reexamination proceeding and in further light of the statutory requirement of special dispatch, the Office will allow the two proceedings to continue proceeding separately and concurrently.

CONCLUSION

1. Jurisdiction of the '136 *inter partes* reexamination proceeding is being returned to the Board of Patent Appeals and Interferences for action on the appeal in that proceeding.

2. Jurisdiction of the reexamination proceeding '382 is being returned to the Central Reexamination Unit to continue prosecution of the proceeding.

3. Telephone inquiries related to this decision should be directed to Sr. Legal Advisor Kery A. Fries at (571) 272-7757, or, in his absence, to Senior Legal Advisor Kenneth M. Schor at (571) 272-7710.

/Kenneth Schor/

Kenneth Schor
Sr. Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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Commissioner for Patents
United States Patent and Trademark Office
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DEC 12 2008

CENTRAL REEXAMINATION UNIT

Qun Liu
SQUIRE, SANDERS
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SAN FRANCISCO, CA 94111

(For Patent Owner)

Brian W. Oaks
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

(For Third Party Requester)

: DECISION
:GRANTING-IN-PART
: PETITION
: FOR EXTENSION OF TIME
: (37 CFR § 1.956)

In re: Deng *et alia*
Inter partes Reexamination Proceeding
Control No. 95/000,384
Deposited on: 9 July 2008
For: U.S. Patent No. 6,829672

This is a decision on the 5 December 2008, patent owner petition titled "Petition For Extension of Time Under 37 CFR § 1.956." The petition seeks an extension of time of two (2) months.

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

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

DISCUSSION

Patent Owner requests an extension of time of two (2) months time to respond to the outstanding Office action. The petition for a two (2) months extension of time is filed, together with authorization to debit a deposit account for the required petition fee of $200.00 as set forth in 37 CFR § 1.17 (g) and as required by 37 CFR § 1.956 for the extension of time. The Office action is a non-final action. The action set a shortened statutory period for response of two (2) months time for which the patent owner to respond. This is the first request for an extension of time.

CITATION OF RELEVENT CODE

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. (Emphasis added.)

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

> As noted above, a request for extension of time under 37 CFR§ 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefore. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. (Emphasis in the original.)

DECISION

The Patent Owner has set forth that based upon the number of rejections, the length of the outstanding Office action, and the need for translations and correspondence with China as "sufficient cause" to grant an extension of time. It is with these considerations that one must consider the patent owner have a fair opportunity to respond to the Office action.

On balance, there is always a question whether to grant an extension of time when balancing the need for special dispatch with the need for the patent owner to have a fair opportunity for which to properly respond to the outstanding Office action. In this situation it is considered that the

petition provides "sufficient cause" as to why an extension of time should be granted-in-part for a one (1) month extension of time.

The extension of time is hereby granted-in-part for a period of one-month additional time.

CONCLUSION

1. Patent owner's petition for a two (2) months extension of time in which to file a response to the Office action dated 3 November 2008 is hereby **granted-in-part**.

2. The extension of **one (1) month** extension of time is hereby granted.

3. The period for response is hereby extended to **3 February 2008**.

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

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

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

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

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

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

/Mark Reinhart/
for

_____

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,384	07/09/2008	6829672	075783.0113	4170

7590 04/06/2009

EXAMINER	

DR. GREGORY J. GONSALVES
13 EARTH STAR PLACE
GAITHERSBURG, MD 20878

ART UNIT	PAPER NUMBER

DATE MAILED: 04/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Brian W. Oaks
BAKER BOTTS L.L.P.
2001 Ross Ave., Suite 600
Dallas, TX 75201-2980

Date: MAILED

APR 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000384
PATENT NO. : 6829672
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
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Dr. Gregory J. Gonsalves
13 Earth Star Place
Gaithersburg, MD 20878

(For Patent Owner)

MAILED

APR 06 2009

Brian W. Oaks
Baker Botts LLP
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(For Requester) CENTRAL REEXAMINATION UNIT

In re Deng et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,384
Filed: July 9, 2008
For: U.S. Patent No. 6,829,672

: DECISION
: GRANTING-IN-PART
: PETITION

This is a decision on the petition filed by the patent owner on January 23, 2009, entitled "PETITION TO EXTEND PAGE LIMIT FOR RESPONSE TO OFFICE ACTION" requesting waiver of 37 CFR 1.943(b) that requires responses by the patent owner not to exceed fifty (50) pages in length. The petition is properly treated as a petition under 37 CFR 1.183. Specifically, the patent owner requests an additional seventy pages (120 total pages) to respond to the Office action mailed on November 3, 2008.

The petition and *inter partes* reexamination control number 95/000,384 are before the Office of Patent Legal Administration for consideration.

The petition was accompanied by the requisite fee of $400.00 mandated by 37 CFR 1.17(f).

The petition is granted to the extent that the page limit for the response to the November 3, 2008 first Office action is extended to not exceed 75 pages in length (i.e., an additional 25 pages).

RELEVANT BACKGROUND

1. U.S. Patent No. 6,829,672 (the '672 patent) issued on December 7, 2004.

2. A request for reexamination of the '672 patent was filed on July 9, 2008. The request was assigned control No. 95/000,384 (the '384 proceeding).

3. Reexamination was ordered for the '384 proceeding on September 30, 2008. A first action on the merits was mailed on November 3, 2008. A shortened statutory period of two months was set for the filing of a response to the Office action. This shortened statutory period was extended by one month by the petition decision of December 12, 2008.

4. On January 23, 2009, the patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.

5. On February 3, 2009, the patent owner filed a response to the Office action mailed November 3, 2008, which included a 116 page response, excluding the cover page, table of contents and claim appendix. The response also included declarations with exhibits. The patent owner also filed a petition to expunge information, requesting that information in the exhibits to the declarations be expunged. The petition to expunge information will be treated separately in due course.

6. On February 12, 2009, the third party requester filed a petition under 37 CFR 1.182 and 1.183 requesting that the Office strike a portion of the patent owner's response filed February 3, 2009, and alternatively, requested an extension of the page limit for requester's written comments. On February 17, 2009, the patent owner filed a response to the third party requester's petition. These papers will be addressed in a separate decision.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.939(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 1.943 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.

II. Findings and Analysis

Petitioner is requesting waiver of the requirements of 37 CFR 1.943(b) based on the fact that: (a) by petitioner's count, the Office action contains 52 separate rejections, (b) the examiner references claim chart appendices that consist of 120 pages, (c) the Office action itself consists of 31 pages, and (d) the request for *inter partes* reexamination consists of 99 pages. Petitioner requests an extension of the page limit for the response to the Office action from the 50-page limit to a limit of 120 pages. After the instant petition was filed, patent owner filed a response on February 3, 2009, that is 116 pages in length, excluding the cover page, table of contents, the claim appendix and the declarations (which are not part of the page count, for purposes of 37 CFR 1.943(b)).

Contrary to petitioner's assertion, the Office action is not 31 pages. Rather, the record reveals that: (a) the Office action mailed on November 3, 2008, is 18 pages in length, excluding the cover and transmittal sheets (4 pages), and (b) the rejections being made by the examiner are contained on 15 of the 18 pages. Also, the record reveals that the Office action adopts 52 grounds of rejection, based on 12 references, and makes reference in the rejections to - approximately 60 pages of the reexamination request and the claim chart appendices (120 pages) filed with request.

37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds fifty (50) pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references. 37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. 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.

A cursory review of the response filed February 3, 2009, reveals that it includes a significant amount of repetitive information. For example, patent owner makes repeated references to what was "explained above" and then repeats what was explained above. It is not, for example, necessary to repeat what is asserted to be missing in each prior art reference in multiple places throughout the response. Patent owner has not demonstrated that a response containing 116 pages is needed to adequately address the Office action.

Based upon the above facts and the individual facts and circumstances of this proceeding, a response by the patent owner that does not exceed 75 pages in length (an additional 25 pages) to respond to the Office action mailed on November 3, 2008 is deemed equitable to address the Office action.

Accordingly, the petition is granted to the following extent:

(A) For only the next immediate response filed by the patent owner, in response to the Office action mailed on November 3, 2008; and

(B) To permit patent owner to provide as much as seventy-five (75) pages for patent owner's response to the Office action mailed on November 3, 2008. The Office will enforce compliance with this new page limit of 75 pages, and a strict review of the length of patent owner's re-drafted response will be made upon its receipt.

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." Since the patent owner's February 3, 2009 response exceeds the page limit requirement set forth in 37 CFR 1.943(b), it 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, the original patent owner response paper cannot be physically returned to the patent owner. Rather, the patent owner's February 3, 2009 response will be expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP 2667. A copy of this decision will be made of record in the IFW.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.943(b) is granted to the extent that the page limit of the response by the patent owner to the Office action mailed on November 3, 2008, is extended, but is not to exceed seventy-five (75) pages in length. Patent owner is given **15 days** from the mailing date of this decision to submit a re-drafted response to the Office action that does not exceed 75 pages in length (excluding amendments, appendices of claims and reference materials). Patent owner does **not** need to resubmit the declarations with exhibits or the petition to expunge information filed February 3, 2009.

2. The patent owner's response filed February 3, 2009, excluding the declarations with exhibits and the petition to expunge information, is refused entry into the record. Because the patent owner's response was previously incorporated into the IFW for the present reexamination proceeding, the response is being expunged from the record by marking it "non-public" and "closed" in the IFW. The patent owner response filed February 3, 2009, will not constitute part of the record of the present reexamination proceeding.

3. If a proper patent owner response is timely received in response to this decision, then under 37 CFR 1.947, the third party requester may once file written comments, limited to the issues raised by the Office action or the patent owner's response, **within 30 days from the date of service of the patent owner's response**. The provisions of 37 CFR 1.943(b) are *sua sponte* waived to the extent that the written comments of the third party requester, filed in response to patent owner's response, shall not exceed 75 pages in length, excluding appendices of claims and reference materials such as prior art references.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any timely 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.

5. Telephone inquiries with regard to this decision should be directed to Eugenia Jones, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7727.

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.
95/000,384	07/09/2008	6829672	075783.0113	4170

7590 04/06/2009

DR. GREGORY J. GONSALVES
13 EARTH STAR PLACE
GAITHERSBURG, MD 20878

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/06/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Dallas, TX 75201-2980

Date:

MAILED

APR 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000384
PATENT NO. : 6829672
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
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Dr. Gregory J. Gonsalves
13 Earth Star Place
Gaithersburg, MD 20878

(For Patent Owner)

MAILED

APR 06 2009

Brian W. Oaks
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2001 Ross Avenue
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(For Requester) CENTRAL REEXAMINATION UNIT

In re Deng et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,384
Filed: July 9, 2008
For: U.S. Patent No. 6,829,672

: DECISION
: REFUSING ENTRY
: OF PAPERS

This is a decision on the third party requester paper entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.956" filed December 9, 2008.

This is also a decision on the patent owner paper entitled "SUPPLEMENTAL REQUEST FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.956" filed December 12, 2008 in response to the third party requester's opposition paper.

The December 9, 2008 third party requester paper and the December 12, 2008 patent owner paper are refused entry into the record, without consideration on the merits, for the reasons set forth below. Both papers are being expunged from the record.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,829,672 (the '672 patent) issued on December 7, 2004.

2. A request for reexamination of the '672 patent was filed on July 9, 2008. The request was assigned control No. 95/000,384 (the '384 proceeding).

3. Reexamination was ordered for the '384 proceeding on September 30, 2008. A first action on the merits was mailed on November 3, 2008. A shortened statutory period of two months was set for the filing of a response to the Office action.

4. The patent owner filed a petition for extension of time under 37 CFR 1.956 on December 5, 2008, requesting an extension of time to respond to the Office action. On December 9, 2008, the third party requester filed the instant opposition to the patent owner's petition for extension of time. The shortened statutory period was extended by one month by the petition decision of December 12, 2008. Also on December 12, 2008, the patent owner filed the instant supplemental request for extension of time under 37 CFR 1.956, which was filed in response to the third party requester's opposition paper filed December 9, 2008.

5. On January 23, 2009, the patent owner filed a petition under 37 CFR 1.183, requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length. This petition is being addressed in a separate decision.

6. On February 3, 2009, the patent owner filed a response to the Office action mailed November 3, 2008, which included a 116 page response, excluding the cover page, table of contents and claim appendix. The response also included a declaration under 37 CFR 1.132 by Mr. Guoshun Deng and a declaration by Mr. Feng Xiang. The patent owner also filed a petition to expunge information, requesting that information in the exhibits to the declarations be expunged. The petition to expunge information will be treated separately in due course.

7. On February 12, 2009, the third party requester filed a petition under 37 CFR 1.182 and 1.183 requesting that the Office strike a portion of the patent owner's response filed February 3, 2009, and alternatively, requested an extension of the page limit for requester's written comments. On February 17, 2009, the patent owner filed a response to the third party requester's petition. These papers are being treated in a separate decision.

DECISION

I. Applicable 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 1.939(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.

MPEP § 2667, I.B.4, states in pertinent part:

> Note that after an opposition to any patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not), any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned. There must be a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination...Further, any petition requesting an extension of time be denied will be returned since a requester does not have a statutory right to challenge this discretionary procedural process in the reexamination proceeding; whether or not the time is extended clearly does not go to the merits of the reexamination proceeding. The same would apply to oppositions as to petitions for revival of a terminated prosecution, petitions challenging the finality of an Office action, and the like.

II. Decision Refusing Entry of Third Party Requester Paper

The December 9, 2008 third party requester paper opposing patent owner's December 5, 2008 petition 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 1.956 requesting an extension of time 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 1.956. The petition under 37 CFR 1.956 is an issue that goes to formal requirements and equities, 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 a petition under 37 CFR 1.956 requesting an extension of time in an *inter partes* reexamination proceeding. 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 a patent owner's petition under 37 CFR 1.956 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 1.956 therefore is not enterable into the record.

It is noted that whether a patent owner's petition under 37 CFR 1.956 is grantable is a matter within the jurisdiction of the Office. Whether the Office should grant a petition for extension of time 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 a petition under 37 CFR 1.956 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 December 9, 2008 paper opposing patent owner's December 5, 2008 petition 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 opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the third party requester. Rather, the requester's paper opposing patent owner's petition 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.

III. Decision Refusing Entry of Patent Owner Paper

As indicated above, MPEP § 2667, I.B.4 states that "any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned."

Therefore, the December 12, 2008 patent owner response to the third party requester's December 9, 2008 opposition paper will not be considered. The paper is refused entry as an improper paper. Because the patent owner paper was incorporated into the IFW for the proceeding before discovery of the impropriety of the paper, the original paper cannot be physically returned to the patent owner. Rather, the patent owner'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.

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[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.

CONCLUSION

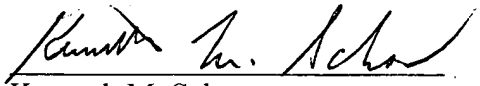
1. The third party requester's December 9, 2008 paper opposing patent owner's December 5, 2008 petition is refused entry into the record, as it is an improper paper. Because the third party requester's opposition paper was previously incorporated into the IFW for the present reexamination proceeding, the opposition paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The opposition paper will not constitute part of the record of the present reexamination proceeding.

2. The patent owner's December 12, 2008 response to the third party requester's December 9, 2008 opposition paper, is refused entry into the record, as it is an improper paper. Because the patent owner's response was previously incorporated into the IFW for the present reexamination proceeding, the response is being expunged from the record by marking it "non-public" and "closed" in the IFW. The patent owner response 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 proceeding is being returned to the Central Reexamination Unit to await the filing of any timely 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.

5. Telephone inquiries with regard to this decision should be directed to Eugenia Jones, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7727.



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.
95/000,384	07/09/2008	6829672	075783.0113	4170

7590 04/06/2009

EXAMINER	

DR. GREGORY J. GONSALVES
13 EARTH STAR PLACE
GAITHERSBURG, MD 20878

ART UNIT	PAPER NUMBER

DATE MAILED: 04/06/2009

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Date: MAILED

APR 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000384
PATENT NO. : 6829672
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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Dr. Gregory J. Gonsalves
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(For Patent Owner)

MAILED

APR 06 2009

CENTRAL REEXAMINATION UNIT

Brian W. Oaks
Baker Botts LLP
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980

(For Requester)

In re Deng et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,384
Filed: July 9, 2008
For: U.S. Patent No. 6,829,672

: DECISION
: REFUSING ENTRY
: OF PAPERS

This is a decision on the third party requester paper entitled "EXPEDITED PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183" filed February 12, 2009.

This is also a decision on the patent owner paper entitled "RESPONSE TO PETITION BY THE REEXAMINATION REQUESTER UNDER 37 C.F.R. §§ 1.182 and 1.183" filed February 17, 2009 in response to the third party requester's petition.

The February 12, 2009 third party requester paper and the February 17, 2009 patent owner paper are refused entry into the record, without consideration on the merits, for the reasons set forth below. Both papers are being expunged from the record.

RELEVANT BACKGROUND

1. U.S. Patent No. 6,829,672 (the '672 patent) issued on December 7, 2004.

2. A request for reexamination of the '672 patent was filed on July 9, 2008. The request was assigned control No. 95/000,384 (the '384 proceeding).

3. Reexamination was ordered for the '384 proceeding on September 30, 2008. A first action on the merits was mailed on November 3, 2008. A shortened statutory

period of two months was set for the filing of a response to the Office action. This shortened statutory period was extended by one month by the petition decision of December 12, 2008.

4. On January 23, 2009, the patent owner filed a petition under 37 CFR 1.183, requesting waiver of the requirement under 37 CFR 1.943(b) that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length. This petition is being addressed in a separate decision.

5. On February 3, 2009, the patent owner filed a response to the Office action mailed November 3, 2008, which included a 116 page response, excluding the cover page, table of contents and claim appendix. The response also included a declaration under 37 CFR 1.132 by Mr. Guoshun Deng and a declaration by Mr. Feng Xiang. The patent owner also filed a petition to expunge information, requesting that information in the exhibits to the declarations be expunged. The petition to expunge information will be treated separately in due course.

6. On February 12, 2009, the third party requester filed the instant petition under 37 CFR 1.182 and 1.183 requesting that the Office strike a portion of the patent owner's response filed February 3, 2009, and alternatively, requested an extension of the page limit for requester's written comments. On February 17, 2009, the patent owner filed the instant response to the third party requester's petition.

DECISION

I. Applicable 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 1.939(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.

MPEP § 2667, I.B.4, states in pertinent part:

> Note that after an opposition to any patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not), any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned. There must be a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination...Further, any petition requesting an extension of time be denied will be returned since a requester does not have a statutory right to challenge this discretionary procedural process in the reexamination proceeding; whether or not the time is extended clearly does not go to the merits of the reexamination proceeding. The same would apply to oppositions as to petitions for revival of a terminated prosecution, petitions challenging the finality of an Office action, and the like.

II. Decision Refusing Entry of Third Party Requester Paper

The February 12, 2009 third party requester paper opposing patent owner's January 23, 2009 petition 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 1.183 to waive the page limit requirement 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 1.183. The petition under 37 CFR 1.183 is an issue that goes to formal requirements and equities, 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 a petition under 37 CFR 1.183 to waive a requirement of the rules in an *inter partes* reexamination proceeding. 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 a patent owner's petition under 37 CFR 1.183 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 1.183 therefore is not enterable into the record.

It is noted that whether a patent owner's petition under 37 CFR 1.183 is grantable is a matter within the jurisdiction of the Office. Whether the Office should grant a petition to the USPTO Director to waive a requirement of the rules or to provide relief that is not expressly provided for in the rules 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 a petition under 37 CFR 1.183 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 February 12, 2009 paper opposing patent owner's January 23, 2009 petition 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 opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the third party requester. Rather, the requester's paper opposing patent owner's petition 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.

III. Decision Refusing Entry of Patent Owner Paper

As indicated above, MPEP § 2667, I.B.4 states that "any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned."

Therefore, the February 17, 2009 patent owner response to the third party requester's February 12, 2009 opposition paper will not be considered. The paper is refused entry as an improper paper. Because the patent owner paper was incorporated into the IFW for the proceeding before discovery of the impropriety of the paper, the original paper cannot be physically returned to the patent owner. Rather, the patent owner'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 third party requester's February 12, 2009 paper opposing patent owner's January 23, 2009 petition is refused entry into the record, as it is an improper paper. Because the third party requester's opposition paper was previously incorporated into the IFW for the present reexamination proceeding, the opposition paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The opposition paper will not constitute part of the record of the present reexamination proceeding.

2. The patent owner's February 17, 2009 response to the third party requester's February 12, 2009 opposition paper, is refused entry into the record, as it is an

[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.

improper paper. Because the patent owner's response was previously incorporated into the IFW for the present reexamination proceeding, the response is being expunged from the record by marking it "non-public" and "closed" in the IFW. The patent owner response 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 proceeding is being returned to the Central Reexamination Unit to await the filing of any timely 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.

5. Telephone inquiries with regard to this decision should be directed to Eugenia Jones, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7727.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	075783.0113	4170

7590 11/30/2009

DR. GREGORY J. GONSALVES
13 EARTH STAR PLACE
GAITHERSBURG, MD 20878

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/30/2009

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DR. GREGORY J. GONSALVES (For Patent Owner)
13 EARTH STAR PLACE
GAITHERSBURG MD 20878

BAKER BOTTS L.L.P. (For Requester)
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

In re Deng *et alia* : DECISION DISMISSING
Reexamination Proceeding : PETITION TO EXPUNGE AND
Control No. 95/000,384 : *SUA SPONTE* RETURNING
For: U.S. Patent No. 6,829,672 : INAPPROPRIATE PAPERS

The *inter partes* reexamination is before the Director of the Central Reexamination Unit for consideration of papers filed February 3, 2009, April 21, 2009, May 21, 2009, June 19, 2009, July 20, 2009, August 6, 2009, August 20, 2009, September 4, 2009, September 23, 2009, and October 21, 2009.

The petition to expunge filed February 3, 2009 is **dismissed** for the reasons set forth below.

The papers filed May 21, 2009, June 19, 2009, July 20, 2009, August 6, 2009, August 20, 2009, September 4, 2009, September 23, 2009, and October 21, 2009 are inappropriate for the reasons set forth below and are **expunged**.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,829,672 (hereinafter, the '672 patent), issued to Deng *et alia*, on December 7, 2004.

2. On July 9, 2008, a third party deposited a request for *inter partes* reexamination of the '672 patent. The reexamination proceeding was assigned Control No. 95/000,453 (hereinafter, the '384 proceeding).

3. On September 30, 2008, an order granting the request for reexamination was mailed in the '384 proceeding. On November 3, 2008, a non-final office was mailed.

4. On February 3, 2009, patent owner filed a response with a "PETITION TO EXPUNGE INFORMATION". The response exceeded the page limit.

5. On April 21, 2009, patent owner timely filed a response (after a petition for extension of time and a petition for an extension of the page limits were granted in part). The information submitted on February 3, 2009 did not need to be resubmitted with the April 21, 2009 response.

6. On May 21, 2009, third party requester filed a paper entitled "Petition under 37 C.F.R. §1.59(b) to Expunge Document" and submitted their response in an envelope labeled "PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE DO NOT SCAN".

7. On June 19, 2009, July 20, 2009, August 6, 2009, August 20, 2009, September 4, 2009, September 23, 2009, and October 21, 2009, either patent owner or requester filed what appears to be supplemental responses.

DECISION

MPEP 724.03 states:
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.

MPEP 724.05 states, in part:
Such petition must contain:
(A) a clear identification of the information to be expunged without disclosure of the details thereof;
(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
(E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

The February 3, 2009 material that formed part of the April 21, 2009 response is alleged proprietary material that was submitted by patent owner as information allegedly favorable to patentability. It is also noted that the petition lacks a clear statement that the information has not been otherwise made public, a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted, and a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information.

Accordingly the petition of February 3, 2009 is **dismissed** and the material will be made of record.

The third party requester papers of May 21, 2009 are improper for the following reasons.

37 CFR 1.947 states, in part:
Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. 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 states, in part:

(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.

Rules 1.947 and 1.948 limit the comments of the third party requester to those issues raised by the Office action or the patent owner's response. In the request for inter partes reexamination, the third party requester did not propose any rejections based upon the newly cited prior art submitted by requester on May 21, 2009 nor has the third party requester stated that these references for the first time are known or available to them as required by 37 CFR 1.948(a)(3). The patent owner has not amended the claims, and therefore, there is no basis for proposing a new rejection based on these references in response to patent owner's amendment. It is important to note that the examiner's finding of fact pertains to the cited prior art patents and printed publications, not to all existing prior art patents and printed publications. Therefore, in order to rebut a finding of fact of the examiner, the third party requester's comments must be restricted to the cited prior art patents and printed publications. However, instead of limiting the discussion to a rebuttal of the examiner's or patent owner's finding of fact as to the cited references, the requester has sought to introduce newly cited documents in newly proposed grounds of rejection. The proposals of new rejections based on the newly cited references are improper as such comments are not in compliance with 37 CFR 1.947 and 1.948, because they are not limited to issues raised by the Office action nor the patent owner's response. Accordingly, the newly proposed rejections are inappropriate.

MPEP 2667 states, in 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.

The third party requester paper of May 21, 2009 includes new references and new grounds of rejection and also exceeds the page limit.

The portions of the May 12, 2009 response that allege to be proprietary material and have not been scanned into the Image File Wrapper are hereby **returned**. The portions of the May 21, 2009 that have been entered into the file are hereby "closed" from public view.

The third party requester is given **fifteen days** to **rectify and refile comments**. Pursuant to MPEP § 2666.05 "[a]ny replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry."

The various papers filed June 19, 2009, July 20, 2009, August 6, 2009, August 20, 2009, September 4, 2009, September 23, 2009, and October 21, 2009 either address the returned papers or inappropriately supplement a previous response or both. All of these papers are being closed from the public record.

Since this proceeding is not a paper file, the papers are being "closed" from public view (while MPEP 2667 permits for the return of inappropriate or untimely submissions, this may not be possible in an Image File Wrapper (IFW) proceeding where a paper is inadvertently entered into the record. Instead, such a paper would be marked "closed" and "not public").

CONCLUSION

1. The petition to expunge filed February 3, 2009 is **dismissed**.

2. The papers filed May 21, 2009, June 19, 2009, July 20, 2009, August 6, 2009, August 20, 2009, September 4, 2009, September 23, 2009, and October 21, 2009 are inappropriate and are **expunged**.

3. The third party requester is given **fifteen days** to **rectify and refile comments**.

Eric Keasel
SPE, AU 3992

Encl. (to 3PR): submission of May 21, 2009 labeled ""PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE DO NOT SCAN"

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	075783.0113	4170

7590 02/04/2010

DR. GREGORY J. GONSALVES
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Brian W. Oaks
BAKER BOTTS L.L.P.
2001 Ross Ave., Suite 600
Dallas, TX 75201-2980

Date: .
MAILED

FEB 04 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000384
PATENT NO. : 6829672
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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DR. GREGORY J. GONSALVES
13 EARTH STAR PLACE
GAITHERSBURG MD 20878

(For Patent Owner)

MAILED

FEB 04 2010

CENTRAL REEXAMINATION UNIT

Brian Oaks
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

(For Third Party Requester)

In re: Deng *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/00,384
Deposited on: 09 July 2008
For: US Patent No. 6,829,672

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 29 January 2010, "Expedited Request for Extension of Time Under 37 CFR § 1.956" requesting the response period be extended by two (2) months for response to the Action Closing Prosecution mailed 13 January 2010. The petition timely submitted 29 January 2010 was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response be extended by two (2) months for Action Closing Prosecution mailed 13 January 2010, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 29 January 2010, together with 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 request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time

> periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

DECISION

The patent owner's representative petitions to extend the period for response by adding two (2) months to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Action Closing Prosecution was mailed 13 January 2010. The patent owner submitted a timely filed the petition on 29 January 2010 with the appropriate fee and certificate of service.

The petition dated 29 January 2010 notes that there are a large number of rejections and language issues. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petitioner is reminded that requests for more than one month, will be granted only in extraordinary situations.

The petition request to extend the response time is hereby granted-in-part.

A one (1) month extension of time is hereby granted.

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the Action Closing Prosecution dated 13 January 2010 is hereby **granted-in-part.**

2. The period for response is extended by one (1) month.

3. The response is extended to **13 April 2010.**

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

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

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

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

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

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

/Mark Reinhart/

_____

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	075783.0113	4170

7590 02/19/2010

EXAMINER	

DR. GREGORY J. GONSALVES
13 EARTH STAR PLACE
GAITHERSBURG, MD 20878

ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Brian W. Oaks
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2001 Ross Ave., Suite 600
Dallas, TX 75201-2980

Date:

MAILED

FEB 19 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000384
PATENT NO. : 6829672
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 Patent Owner)

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FEB 19 2010

CENTRAL REEXAMINATION UNIT

Brian Oaks
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

(For Third Party Requester)

In re: Deng *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/00,384
Deposited on: 09 July 2008
For: US Patent No. 6,829,672

CORRRECTED
DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 29 January 2010, "Expedited Request for Extension of Time Under 37 CFR § 1.956" requesting the response period be extended by two (2) months for response to the Action Closing Prosecution mailed 13 January 2010. The petition timely submitted 29 January 2010 was timely filed with certificate of service.

This decision corrects an error in the response date in the decision mailed on 04 February 2010.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response be extended by two (2) months for Action Closing Prosecution mailed 13 January 2010, which set one (1) month's time for filing a response thereto. The petition for extension of time was timely filed on 29 January 2010, together with 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 request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

DECISION

This is a corrected decision, correcting the response date from the decision mailed 04 February 2010.

The patent owner's representative petitions to extend the period for response by adding two (2) months to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Action Closing Prosecution was mailed 13 January 2010. The patent owner submitted a timely filed the petition on 29 January 2010 with the appropriate fee and certificate of service.

The petition dated 29 January 2010 notes that there are a large number of rejections and language issues. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petitioner is reminded that requests for more than one month, will be granted only in extraordinary situations.

The petition request to extend the response time is hereby granted-in-part.

A one (1) month extension of time is hereby granted.

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the Action Closing Prosecution dated 13 January 2010 is hereby **granted-in-part.**

2. The period for response is extended by one (1) month.

3. The response is extended to **13 March 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

60683 7590 01/16/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/16/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,053	11/09/2007	7,223,236	ALER-007REX	3387

60683 7590 01/16/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/16/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Nanda Alapati
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
8065 Leesburg Pike
Tysons Corner, VA 22182

Date:

MAILED

JAN 16 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000386
PATENT NO. : 7223236
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

Date: MAILED
JAN 16 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010053
PATENT NO. : 7223236
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(For Patent Owner)

MAILED

JAN 16 2009

CENTRAL REEXAMINATION UNIT

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

(For *Ex Parte* Requester)

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

(For *Inter Partes* Requester)

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

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

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,223,236 (the '236 patent) issued to Brown on May 29, 2007.

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

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

3. On January 18, 2008, *ex parte* reexamination was ordered for claims 1-26 of the '236 patent based on the examiner's determination that the November 9, 2007 request raised a substantial new question of patentability affecting these claims.

4. A request for *inter partes* reexamination of claims 1-26 of the '236 patent was filed on August 1, 2008, by third party requester Inverness Medical Innovations, Inc., which is the real party in interest, and the request was assigned control number 95/000,386 (the '0386 *inter partes* proceeding).

5. On September 29, 2008, a non-final Office action was mailed in the '10053 *ex parte* proceeding, rejecting claims 1-26 of the '236 patent.

6. On October 30, 2008, *inter partes* reexamination was ordered for claims 1-26 of the '236 patent based on the examiner's determination that the August 1, 2008 request raised a substantial new question of patentability affecting these claims.

7. On November 26, 2008, patent owner filed a response to the September 29, 2008 Office action, amending claims 1, 21, 22 and 25.

8. There has been no further Office action in the '0386 *inter partes* proceeding, and, since an Office action has been issued, clearly the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10053 *ex parte* proceeding expired after March 18, 2008. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '0386 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

[1] There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from the parties.

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

In accordance with 37 CFR 1.989(a), the 90/010,053 and 95/000,386 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since claims 1, 21, 22 and 25 have been amended in the '10053 *ex parte* proceeding, the claims are not currently the same in both files and an amendment is needed to place the same amendments in both proceedings.

2. Claims 1, 21, 22 and 25 are **rejected under 35 U.S.C. 112, paragraph 2,** as being indefinite as to the content of the claims, and thus failing to particularly point out the invention. Since the same claims read differently in the two proceedings, the intended scope of the claims in each proceeding is not clear.

3. Patent owner is required to submit an appropriate amendment within one month of this decision placing the same amendment in both files.

4. This merger decision provides **an Office action on the merits** pursuant to 35 U.S.C. 314(b)(2), and patent owner's amendment response goes to the merits of the proceeding, to address the above rejection under 35 U.S.C. 112. In order that the response be considered to be a complete response pursuant to 35 U.S.C. 314(b)(2), patent owner must include the remarks that set forth the basis for having proposed the amendment to claims 1, 21, 22 and 25 in the '10053 *ex parte* reexamination proceeding. Failure to include the basis for having made the amendment to claims 1, 21, 22 and 25 in the '10053 *ex parte* reexamination will result in a holding that the amendment is nonresponsive and nonenterable, leading to cancellation of claims 1, 21, 22 and 25 in each of the pending reexamination proceedings.

5. After patent owner files a response to this decision, the third party requester may once file written comments within a period of 30 days from the date of service of patent owner's response. Any such comments must be limited to patentability issues directed to patent owner's amendment of the claims made in the *inter partes* reexamination or claims newly presented in the *inter partes* reexamination. Such issues may include the issue of claim patentability based on prior patents and printed publications applicable to any amended claims and any newly presented claims in patent owner's response. The time for submitting comments by the third party requester may not be extended.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

All papers filed by patent owner and the third party requester(s) should be directed as follows:

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

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

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,386 and *ex parte* Reexamination Control No. 90/010,053 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Pursuant to Part II of this decision, the required amendment must be filed within ONE MONTH of the mail date of this decision, placing the same claims in both files of the present merged proceeding, together with an explanation of the basis for any amendment or new claims included in the response.

3. After patent owner files a response to this decision, the third party requester may once file written comments within a period of 30 DAYS from the date of service of patent owner's response. Any such comments must be limited to patentability issues directed to patent owner's amendment of the claims or newly presented claims. Such issues may include the issue of claim patentability based on prior patents/printed publications applicable to any amended claims and any newly presented claims in patent owner's response. The time for submitting comments by the third party requester is statutory and may not be extended.

4. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.

5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to place the same amendment in both proceedings and requester's comments on that response, or (b) the expiration of the time for filing the required response and any comments.

6. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.

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

January 12, 2009
C:\KIVA\KENPET3\ 95_0386 + 10053 amdt in EP reex, merits housekeeping amdt_req.doc

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.
95/000,387	08/06/2008	7314328	599928-015002	2321

61650 7590 04/29/2009

MYERS WOLIN, LLC
100 HEADQUARTERS PLAZA
North Tower, 6th Floor
MORRISTOWN, NJ 07960-6834

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DAVID M. MAIORANA, ESQ.
JONES DAY
901 LAKESIDE AVENUE, NORTH POINT
CLEVELAND, OH 44114

MAILED

APR 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,387*.

PATENT NUMBER *7,314,328*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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APR 29 2009
APR 2
CENTRAL REEXAMINATION UNIT
CENTRAL REEXAMINATION UNIT

MYERS WOLIN, LLC
100 HEADQUARTERS PLAZA
NORTH TOWER, 6TH FLOOR
MORRISTOWN, NJ 07960-6834

(For Third Party Requester)

DAVID M. MAIORANA, ESQ.
JONES DAY
901 LAKESIDE AVENUE, NORTH POINT
CLEVELAND, OH 44114

In re Liberatore	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,387	:	PETITION UNDER
Filed: August 6, 2008	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 7,314,328	:	

The paper filed by requester on November 14, 2008, entitled "Petition Under 37 C.F.R. § 1.927," is being treated as a petition Under 37 CFR 1.181 and 1.927 (hereinafter the Petition). The Petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed October 29, 2008.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,314,328 (hereinafter, the '328 patent) issued on January 1, 2008.

2. A request for *ex parte* reexamination was filed by the patent owner, on June 23, 2008. The resulting reexamination proceeding was assigned Control No. 90/010,207 (hereinafter, the '207 proceeding). Reexamination was requested for claims 1-20 of the '328 patent based upon a substantial new question of patentability by WO/01/96198 to Seaquist Closures Foreign, Inc. (hereinafter "the Seaquist application").

3. A request for *inter partes* reexamination was filed by a third party requestor, on August 6, 2008. The resulting reexamination proceeding was assigned Control No. 95/000,387 (hereinafter, the '387 proceeding). Reexamination was requested for claims 1-20 of the '328 patent based upon a substantial new question of patentability by the Seaquist application (a.k.a. "Degroot et al.").

4. A Notice of Reexamination Request Filing Date for the '387 proceeding was issued on August 13, 2008.

5. On August 18, 2008, an order granting reexamination was mailed in the '207 proceeding.

5. An order denying the request for reexamination for claims 1-20 in the '387 proceeding was mailed on October 29, 2008.

6. On November 14, 2008, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927 in the '387 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the examiner incorrectly concluded that the request in the '387 proceeding does not raise a substantial new question of patentability (SNQ) different from the SNQ raised in the '207 proceeding. The examiner determined that request in the '387 proceeding did not raise a SNQ different from the SNQ raised in the '207 proceeding because the teachings of the Seaquist application relied upon to raise the SNQ were cumulative to the teachings relied upon in the '207 proceeding. See pages 2-5 of the order denying reexamination mailed October 29, 2008.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-20 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-20 of the '328 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the

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

earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

On September 4, 2008, the Court of Appeals for the Federal Circuit issued a decision that discussed the meaning of a substantial new question of patentability. See *In re Melvin J. Swanson and Patrick E. Guir*e (CAFC 2007-1534). In this decision, the court found that the Office did not err in determining that Deutsch, which was applied in a rejection under 35 U.S.C. § 103 as a secondary teaching reference in the previous examination, raised a substantial new question of patentability based on anticipation. Specially, the court stated that "[i]n light of the extremely limited purpose for which the examiner considered Deutsch in the initial examination, the Board is correct that the issue of whether Deutsch anticipates the method disclosed in claims 22, 23, and 25 was a substantial new question of patentability, never before addressed by the PTO." The court also stated that:

> As the legislative history clarifies, to decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose. See H.R. Rep. No. 107-120, at 3 ("The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."); see also 147 Cong. Rec. H5359 (statement of Rep. Berman) ("Ideally, a reexamination could be requested based on prior art cited by an applicant that the examiner failed to adequately consider . . . .").
>
> Determining the scope of an examiner's previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions.

An analysis of the context in which the Seaquist application was previously considered and the scope of the prior consideration follows to determine whether the request in the '387 proceeding raises a substantial new question of patentability.

III. Analysis of the Request for Reexamination in the '387 proceeding

The Request in the '387 proceeding sets forth the following proposed rejection based upon a substantial new question (SNQ) of patentability:

(1) Claims 1-20 are unpatentable under 35 U.S.C. §102 over the Seaquist application.

The Request was denied in the October 29, 2008 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the Seaquist application that is different from the SNQ raised in the '207 *ex parte* request by the patent owner. The examiner determined that the teachings of the Seaquist application set forth in the Request were cumulative to the teachings of Seaquist application set forth in the request in the '207 proceeding. Therefore, the examiner determined that the Request did not present the Seaquist application in a new light. Thus, the teachings of Seaquist application presented in the Request in the '387 proceeding are stated, in the denial, to be cumulative and not to raise a substantial new question of patentability.

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the Request, it is first noted that the Seaquist application was not cited or considered in the prior examination of the '328 patent, except for in the '207 proceeding. The Request states that the Seaquist application teaches the following limitations:

> "a forwardly-projecting side wall tapering from the first end to the opening, the side wall having a peripheral outer surface defined by a concave surface that transitions into a convex surface that terminates at the opening;" and
> "each of the upper and lower walls comprising a portion of the peripheral outer surface such that each of the upper and lower wall comprises a concave surface that transitions into a convex surface terminating at the opening."

See, e.g., pages 26-29 of the Request and page 30 of the claim chart appendix. These limitations are present in each independent claim (see paragraphs c) and e) in claim 1; paragraphs c) and d) in claim 13; and paragraphs c) and d) in claim 17). The Request specifically points to portions of the reference that was not relied upon, or otherwise addressed, by the patent owner request in the '207 proceeding. In fact, the patent owner explicitly states that the above-mentioned limitations were "not shown" by the Seaquist application in the request in the '207 proceeding. See pages 3-7 in the request of the '207 proceeding.

Furthermore, review of the records for the prior examination of the '328 patent and the applications to which it claims the benefit, show that prior art was never applied to the

above-mentioned limitations. Therefore, the Request in the '387 proceeding has presented the Seaquist application in a new light by showing new technical teachings not considered in a prior examination. These new technical teachings would be important to a reasonable examiner in determining the patentability of the claims.

The Director has reviewed the entire record, and has determined that there is a substantial new question of patentability presented by the teachings of the Seaquist application for reasons set forth above. Accordingly, the petition is granted, and reexamination is hereby ordered.

CONCLUSION

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

2. Accordingly, the request for *inter partes* reexamination of claims 1-20 of the '328 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.

4. The proceeding is being forwarded to the Office of Patent Legal Administration for consideration of a merger with the '207 reexamination proceeding. An Office action on the merits will follow in due course.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,387	08/06/2008	7314328	599928-015002	2321

61650 7590 07/10/2009

MYERS WOLIN, LLC
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North Tower, 6th Floor
MORRISTOWN, NJ 07960-6834

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DAVID M. MAIORANA, ESQ.
JONES DAY
901 LAKESIDE AVENUE, NORTH POINT
CLEVELAND, OH 44114

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,387*.

PATENT NUMBER *7,314,328*.

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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(For Patent Owner)

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

DAVID M. MAIORANA, Esq.
JONES DAY
901 LAKESIDE AVENUE, NORTH POINT
CLEVELAND, OH 44114

(For Third Party Requester)

In re Liberatore
Inter partes Reexamination Proceeding
Control No. 95/000,387
Filed: August 6, 2008
For: U.S. Patent No. 7,314,328

Ex parte Reexamination Proceeding
Control No. 90/010,207
Filed: June 23, 2008
For: U.S. Patent No. 7,314,328

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 7,314,328 (the '328 patent) issued to Liberatore, on January 1, 2008.

2. A request for *ex parte* reexamination was filed by patent owner, on June 23, 2008. The resulting reexamination proceeding was assigned Control No. 90/010,207 (the '207 proceeding). Reexamination was requested for claims 1-20 of the '328 patent.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,387 (the '387 proceeding), was filed by third party requester on August 6, 2008. Reexamination was requested for claims 1-20 of the '328 patent.

4. An order granting reexamination of claims 1-20 in the '328 patent was mailed for the '207 reexamination proceeding on August 18, 2008.

5. An order denying the request for *inter partes* reexamination for claims 1-20 in the '387 reexamination proceeding was mailed on October 29, 2008.

6. On November 14, 2008, the third party requester filed a petition under 37 CFR §§ 1.181 and 1.927 for the '387 reexamination proceeding.

7. On April 29, 2009 the Office granted the third party's petition and granted *inter partes* reexamination of claims 1-20 of the '328 patent.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '387 and the '207 reexamination proceedings are currently pending. An order granting reexamination of claims 1-20 of the '328 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,387 and 90/010,207 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the

95/000,387 and 90/010,207 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

By EFS:

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

By U.S. Postal Service Mail:

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

By FAX to:

> (571) 273-9900
> Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,387 and *ex partes* Reexamination Control No. 90/010,207 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

4. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Maria Nuzzolillo, at (571) 272-8150, or in her absence, to Pinchus M. Laufer, at (571)272-7726.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,388	08/06/2008	7325994	599928-015002	2326

61650 7590 04/29/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2009

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APR 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,388*.

PATENT NUMBER *7,325,994*.

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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(For Third Party Requester)

DAVID M. MAIORANA, ESQ.
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CLEVELAND, OH 44114

In re Liberatore	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,388	:	PETITION UNDER
Filed: August 6, 2008	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 7,325,994	:	

The paper filed by requester on November 14, 2008, entitled "Petition Under 37 C.F.R. § 1.927," is being treated as a petition Under 37 CFR 1.181 and 1.927 (hereinafter the Petition). The Petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed October 29, 2008.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,325,994 (hereinafter, the '994 patent) issued on February 5, 2008.

2. A request for *ex parte* reexamination was filed by the patent owner, on June 23, 2008. The resulting reexamination proceeding was assigned Control No. 90/010,208 (hereinafter, the '208 proceeding). Reexamination was requested for claims 1-13 of the '994 patent based upon a substantial new question of patentability by WO/01/96198 to Seaquist Closures Foreign, Inc. (hereinafter "the Seaquist application").

3. A request for *inter partes* reexamination was filed by a third party requestor, on August 6, 2008. The resulting reexamination proceeding was assigned Control No. 95/000,388 (hereinafter, the '388 proceeding). Reexamination was requested for claims 1-13 of the '994 patent based upon a substantial new question of patentability by the Seaquist application (a.k.a. "Degroot et al.").

4. A Notice of Reexamination Request Filing Date for the '388 proceeding was issued on August 13, 2008.

5. On August 18, 2008, an order granting reexamination was mailed in the '208 proceeding.

5. An order denying the request for reexamination for claims 1-13 in the '388 proceeding was mailed on October 29, 2008.

6. On November 14, 2008, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927 in the '388 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the examiner incorrectly concluded that the request in the '388 proceeding does not raise a substantial new question of patentability (SNQ) different from the SNQ raised in the '208 proceeding. The examiner determined that request in the '388 proceeding did not raise a SNQ different from the SNQ raised in the '208 proceeding because the teachings of the Seaquist application relied upon to raise the SNQ were cumulative to the teachings relied upon in the '208 proceeding. See pages 2-5 of the order denying reexamination mailed October 29, 2008.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-13 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-13 of the '994 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the

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earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

On September 4, 2008, the Court of Appeals for the Federal Circuit issued a decision that discussed the meaning of a substantial new question of patentability. See *In re Melvin J. Swanson and Patrick E. Guir*e (CAFC 2007-1534). In this decision, the court found that the Office did not err in determining that Deutsch, which was applied in a rejection under 35 U.S.C. § 103 as a secondary teaching reference in the previous examination, raised a substantial new question of patentability based on anticipation. Specially, the court stated that "[i]n light of the extremely limited purpose for which the examiner considered Deutsch in the initial examination, the Board is correct that the issue of whether Deutsch anticipates the method disclosed in claims 22, 23, and 25 was a substantial new question of patentability, never before addressed by the PTO." The court also stated that:

> As the legislative history clarifies, to decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose. See H.R. Rep. No. 107-120, at 3 ("The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."); see also 147 Cong. Rec. H5359 (statement of Rep. Berman) ("Ideally, a reexamination could be requested based on prior art cited by an applicant that the examiner failed to adequately consider . . . .").
>
> Determining the scope of an examiner's previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions.

An analysis of the context in which the Seaquist application was previously considered and the scope of the prior consideration follows to determine whether the request in the '388 proceeding raises a substantial new question of patentability.

III. Analysis of the Request for Reexamination in the '388 proceeding

The Request in the '388 proceeding sets forth the following proposed rejection based upon a substantial new question (SNQ) of patentability:

(1) Claims 1-13 are unpatentable under 35 U.S.C. §102 over the Seaquist application.

The Request was denied in the October 29, 2008 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the Seaquist application that is different from the SNQ raised in the '208 *ex parte* request by the patent owner. The examiner determined that the teachings of the Seaquist application set forth in the Request were cumulative to the teachings of Seaquist application set forth in the request in the '208 proceeding. Therefore, the examiner determined that the Request did not present the Seaquist application in a new light. Thus, the teachings of Seaquist application presented in the Request in the '388 proceeding are stated, in the denial, to be cumulative and not to raise a substantial new question of patentability.

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the Request, it is first noted that the Seaquist application was not cited or considered in the prior examination of the '994 patent, except for in the '208 proceeding. The Request states that the Seaquist application teaches the following limitations:

> "a forwardly-projecting side wall tapering from the first end to the opening, the side wall having a peripheral outer surface defined by a concave surface that transitions into a convex surface that terminates at the opening;" and
> "each of the upper and lower walls comprising a portion of the peripheral outer surface such that each of the upper and lower wall comprises a concave surface that transitions into a convex surface terminating at the opening."

See, e.g., pages 24 and 26-28 of the Request and page 14 of the claim chart appendix. These limitations are present in the only independent claim (see paragraphs c) and d) in claim 1). The Request specifically points to portions of the reference that was not relied upon, or otherwise addressed, by the patent owner request in the '208 proceeding. In fact, the patent owner explicitly states that the above-mentioned limitations were "not shown" by the Seaquist application in the request in the '208 proceeding. See pages 3-4 in the request of the '208 proceeding.

Furthermore, review of the records for the prior examination of the '994 patent and the applications to which it claims the benefit, show that the prior art of record did not explicitly teach both of the above-mentioned limitations. See also the amendment of

March 23, 2007 to pending claim 67. Therefore, the Request in the '388 proceeding has presented the Seaquist application in a new light by showing new technical teachings not considered in a prior examination. These new technical teachings would be important to a reasonable examiner in determining the patentability of the claims.

The Director has reviewed the entire record, and has determined that there is a substantial new question of patentability presented by the teachings of the Seaquist application for reasons set forth above. Accordingly, the petition is granted, and reexamination is hereby ordered.

CONCLUSION

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

2. Accordingly, the request for *inter partes* reexamination of claims 1-13 of the '994 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.

4. The proceeding is being forwarded to the Office of Patent Legal Administration for consideration of a merger with the '208 reexamination proceeding. An Office action on the merits will follow in due course.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,391	08/14/2008	6,958,423	14795	4358

2071 7590 10/31/2008

McGLINCHEY STAFFORD, PLLC
4703 BLUEBONNET BLVD
BATON ROUGE, LA 70809

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/31/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PETER W. ROBERTS
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
7918 JONES BRANCH DRIVE, SUITE 500
MCLEAN, VA 22102

Date: OCT 31 2008

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000391
PATENT NO. : 6958423
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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McGlinchey Stafford, PLLC
4703 BlueBonnet Blvd.
Baton Rouge, LA 70809

(For Patent Owner)

OCT 31 2008

Roberts Mlotkowski Safran & Cole, P.C.
7918 Jones Branch Drive
Suite 500
McLean, Virginia 22102

(For Requester)

In re Parks et al
Inter Partes Reexamination Proceeding
Control No. 95/000,391
Filed: August 14, 2008
For: U.S. Patent No. 6,958,423

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

This is a decision on the September 2, 2008 requester petition under 37 CFR 1.182 to seal, entitled "Petition to Expunge/Seal Original *Inter Partes* Reexamination Request and Enter Substitute *Inter Partes* Reexamination Request Under 37 C.F.R. § 1.182," which is also taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.939 to permit consideration of the present petition ("the September 2, 2008 requester petition").

The September 2, 2008 requester petition and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee required by 37 CFR 1.183, 37 CFR 1.182, and 37 CFR 1.17(f) for the September 2, 2008 requester petition will be charged to deposit account no. 50-2478, as authorized by the requester in the last line of page 2 of the instant petition.

SUMMARY

37 CFR 1.939 is waived under 37 CFR 1.183 to the extent that the September 2, 2008 requester petition under 37 CFR 1.182 to seal has been considered.

The September 2, 2008 requester petition under 37 CFR 1.182 to seal is **granted** to the extent stated in this decision. The August 14, 2008 *inter partes* reexamination request is **provisionally sealed** by removing the request from public view in the Office's Image File Wrapper (IFW) database.

BACKGROUND

- On October 25, 2005, U.S. Patent No. 6,958,423 (hereinafter, "the '423 patent") issued to Parks et al.

- On August 14, 2008, a request for *inter partes* reexamination was filed by the third party requester[1], and the resulting reexamination proceeding was assigned control number 95/000,391 (hereinafter, "the '0391 proceeding").

- On September 2, 2008, the present petition, entitled "Petition to Expunge/Seal Original *Inter Partes* Reexamination Request and Enter Substitute *Inter Partes* Reexamination Request Under 37 C.F.R. § 1.182," was filed.

- No order has yet been mailed in the '0391 proceeding.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.59(b) provides:

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

37 CFR 1.939 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.

MPEP 724.04(c) provides, in pertinent part:

> (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

[1] This *inter partes* reexamination proceeding was filed by Chemtura Corporation, the real party in interest.

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 material to patentability.

(C) If any portion or all of the submitted information is found to be material to patentability, 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. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.

(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.

(E) If a petition to expunge is not 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 the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.

DECISION

Consideration of the September 2, 2008 Requester Petition Prior to First Office Action

The provisions of 37 CFR 1.939 prohibit the filing of any paper prior to the initial Office action on the merits in an *inter partes* reexamination, unless otherwise authorized. Unauthorized papers will not be considered and may be returned.

In the present case, the requester informs the Office that the patent owner believes that the footnotes appearing on pages 8 and 9 of the original *inter partes* reexamination request contain confidential information covered by a protective order issued by the court in *Albemarle Corporation v. Chemtura Corporation et al,* (M.D. La.) Civil Action No. 05-1239-JJB-SCR. The requester also informs the Office that a court ruling is pending on whether the subject matter of these footnotes is covered by the protective order.

To address the existing presence of this information at issue in the public record of the '0391 proceeding, an urgent situation has been created where justice requires temporary suspension of 37 CFR 1.939 so that the present requester petition may be considered. In view of the potential for violation of the court's protective order, should this information continue to be made available to the public, justice requires that 37 CFR 1.939 be suspended in this instance to permit the Office to consider the September 2, 2008 requester petition.

Accordingly, the provisions of 37 CFR 1.939 are waived under 37 CFR 1.183 to the extent that the present September 2, 2008 petition under 37 CFR 1.182 to seal is being considered.

Provisional Sealing of the August 14, 2008 Inter Partes Reexamination Request

The requester requests that the footnotes on pages 8 and 9 of the original *inter partes* reexamination request be sealed pending a court ruling on whether the subject matter of these footnotes is covered by a protective order issued by the federal district court in *Albemarle Corporation v. Chemtura Corporation et al,* (M.D. La.) Civil Action No. 05-1239-JJB-SCR.

To prevent any violation of a court protective order, the September 2, 2008 petition under 37 CFR 1.182 to seal is **temporarily granted** pending notification by the parties of the court's final determination as to whether the footnotes on pages 8 and 9 of the request are covered by the court's protective order. Accordingly, the August 14, 2008 *inter partes* reexamination request will be **provisionally sealed** by removing it from public view in the Office's Image File Wrapper (IFW) database.

The requester is given a period of **fifteen (15) days** to file, with a cover letter including the heading "Redacted Copy of Existing Request for Reexamination," an identical copy of the August 14, 2008 *inter partes* reexamination request, from which the footnotes appearing on pages 8 and 9 **have been redacted**. This redacted version of the request will replace the unredacted version of the provisionally sealed *inter partes* reexamination request in the public file. The cover letter is to be provided to avoid the inadvertent processing by the Office of the redacted request as a new filing of a reexamination request, and any charge by the Office of a duplicate filing fee.

The requester and the patent owner are required to inform the Office of the outcome of the court's final determination on whether the footnotes on pages 8 and 9 of the request are covered by the protective order within fifteen (15) days of the court's decision.

A final decision on whether the unredacted request will remain nonpublic is held in abeyance until the examiner issues a decision on the materiality of the footnotes. **The parties are cautioned that the provisional seal will be removed at the time the proceeding is being prepared for issuance of a certificate, unless a petition under 37 CFR 1.59(b) to expunge the unredacted request is filed by either party at least immediately after the mailing of the Notice of Intent to Issue a Reexamination Certificate (NIRC).** Pursuant to MPEP 724.04(c), the information at issue (the footnotes) will be reviewed by the examiner, or other appropriate Office official who is responsible for considering the information, at least by the mailing of the NIRC. The examiner or other appropriate Office official will make a determination as to whether or not any portion or all of the submitted information is material to patentability.

The Office will not expunge information found to be material to patentability, pursuant to MPEP 724.04(c). If any portion or all of the submitted information is found to be material to patentability, any petition to expunge this information will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. If all of the submitted information is found not to be material to patentability, an (otherwise grantable) petition to expunge this information will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to

be material to patentability, the petition to expunge will be dismissed, and the patent owner will be provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged.

CONCLUSION

- 37 CFR 1.939 is waived under 37 CFR 1.183 to the extent that the September 2, 2008 requester petition under 37 CFR 1.182 to seal has been considered.

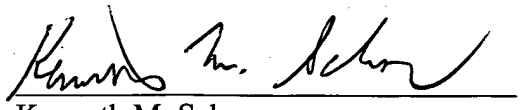
- The September 2, 2008 requester petition to seal under 37 CFR 1.182 is **granted**, and the August 14, 2008 *inter partes* reexamination request will be **provisionally sealed** by removing it from public view in the Office's Image File Wrapper (IFW) database, pending a final determination by the court regarding the applicability of the footnotes to the court's protective order.

- The requester is given a period of **fifteen (15) days** from the mail date of this decision to file, under the heading "Redacted Copy of Existing Request for Reexamination," an identical copy of the August 14, 2008 *inter partes* reexamination request, from which the footnotes appearing on pages 8 and 9 **have been redacted**. This redacted version of the request will replace the unredacted version of the provisionally sealed *inter partes* reexamination request in the public file.

- The requester and the patent owner are required to inform the Office of the outcome of the court's final determination on whether the footnotes on pages 8 and 9 of the request are covered by the protective order within **fifteen (15) days** of the court's final determination.

- A final decision on whether the unredacted request will remain nonpublic is held in abeyance until the examiner issues a decision on the materiality of the footnotes. **The parties are cautioned that the provisional seal will be removed at the time the proceeding is being prepared for issuance of a certificate, unless a petition under 37 CFR 1.59(b) to expunge the unredacted request is filed by either party.** 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 file 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, thus becoming open to the public.**

Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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

cn

kenpet7
10-30-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,393	11/11/2008	6213703	CEL.100C2XC1D1	9167

23557 7590 10/20/2009

SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE, FL 32614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2009

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SONNABENDLAW
600 PROSPECT AVE
BROOKLYN, NY 11215

Date:

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OCT 2 0 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000393
PATENT NO. : 6213703
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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James Parker
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P.O. Box 142950
Gainesville, FL 32614-2950

(For Patent Owner)

MAILED

OCT 20 2009

CENTRAL REEXAMINATION UNIT

Sonnabendlaw
600 Prospect Avenue
Brooklyn, NY 11215

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,393
Filed: November 11, 2008
For: U.S. Patent No. 6,213,703

: **DECISION**
: **DISMISSING**
: **PETITION UNDER**
: **37 C.F.R. §§ 1.183 AND 1.943**

This is a decision on the patent owner paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. 1.943(b)," filed on September 18, 2009.

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

Patent owner's account number 19-0065 was charged the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 filed on September 18, 2009.

REVIEW OF THE RELEVANT FACTS

1. On April 10, 2001, United States Patent Number 6,213,703 (the '703 patent) issued.

2. On November 11, 2008, an amended request for *inter partes* reexamination of the '703 patent, assigned Reexamination Control No. 95/000,393 (the '393 proceeding), was filed by third party requester Mr. Bob Holt. A November 11, 2008 filing date was assigned to the proceeding.

3. On January 13, 2009, the Office issued an order granting *inter partes* reexamination in the '393 proceeding, with an accompanying Office action on the merits.

4. Prosecution in the '393 proceeding progressed to the point where, on August 27, 2009, an Action Closing Prosecution (ACP) was mailed.

5. On September 14, 2009, patent owner filed a paper entitled, "PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.956." On September 22, the Office granted the petition for the extension of time. Patent owner's period for responding to the August 27, 2009 Action Closing Prosecution Office action has been extended one-month and will end on October 27, 2009.

6. On September 18, 2009, patent owner filed the instant petition in a paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b)."

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.

Patent Owner's Petition of September 18, 2009

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to thereby permit patent owner to file a response to the August 27, 2009 Action Closing Prosecution not to exceed 100 pages in length. Pet. at 1. In support of waiver of the rule, patent owner asserts that "[t]he 61-page ACP raised 29 distinct grounds for objection or rejection of the over 100 pending claims. An overwhelming majority of the claims are rejected under four or more grounds. Any attempt to respond to these rejections within the 50 page limit would not afford Patent Owner a meaningful opportunity to be heard...." Pet. at 2. Patent owner further asserts that "[b]y way of example, the 50 page limit would allow an average of less than two pages to develop a response to each of the rejections in the ACP." Pet. at 2. Patent owner also states that the "ACP incorporates no less than 150 pages of argument from the requestor." Pet. at 2. Further, it is asserted that the patent owner cannot adequately comment on all of this material within the prescribed page limit of 37 CFR 1.943(b). Pet. at 2.

Thus, patent owner states that "extraordinary circumstances exist" in this instance, which require suspension of 37 CFR 1.943(b) "in order to allow Patent Owner a full and fair opportunity to address each of the 29 grounds raised in the ACP," and that patent owner

believes it can adequately address the ACP within 100 pages (i.e., 50 additional pages). Pet. at 2 and 3.

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 response are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b). In this instance, petitioner has requested a waiver of the 50-page limit of 37 CFR 1.943(b) by discussing the number of distinct grounds or rejections and objections and the number of pages incorporated into the ACP from requester's arguments.

However, a response has not been submitted concurrently with present petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). 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 50-page limit of 37 CFR 1.943(b) would be an attempt to draft a response in compliance with the 50-page limit followed by submission of the resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Such a submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner could have relied on the proposed response for justification that more pages are needed to complete the response and to set forth an accurate determination of how many additional pages are needed to complete the response. Note that if the Office does not grant such a petition, accompanied by a proposed response, to the full extent of the proposed response, patent owner would be given a period of 15 days within which to submit a compliant response in accordance with the page limit set forth in the decision on the petition. *See* MPEP 2667(I)(A)(2).

Thus, in this instance, patent owner has provided arguments in support of why more pages are deemed necessary to complete the response, but patent owner has failed to provide a concrete basis for an accurate determination of how many additional pages are needed to complete the response. Rather, there is no indication in the petition under 37 CFR 1.183 how patent owner determined that 100 pages (*i.e.*, 50 additional pages) are needed to complete patent owner's response.

Thus, the specific facts set forth in the petition under 37 CFR 1.183 and the particular circumstances of the '393 proceeding are not found to present an extraordinary situation requiring waiver of the 50-page limit requirement of 37 CFR 1.943(b) for patent owner's response. Accordingly, patent owner's September 18, 2009 petition under 37 CFR 1.183 is **dismissed**. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

CONCLUSION

1. The September 18, 2009 patent owner petition under 37 CFR 1.183 is **dismissed**.

2. Patent owner's response to the August 27, 2009 Action Closing Prosecution is due no later than October 27, 2009 and is not to exceed 50 pages in accordance with 37 CFR 1.943(b).

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 Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole D. Dretar, Legal Advisor, at 571-272-7717.

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

Kenpet7
10-20-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,393	11/11/2008	6213703	CEL.100C2XC1D1	9167

23557 7590 01/27/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2010

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Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000393
PATENT NO. : 6213703
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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PO Box 142950
GAINESVILLE, FL 32614

(For Patent Owner)

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JAN 27 2010

CENTRAL REEXAMINATION UNIT

SONNABENDLAW
600 PROSPECT AVE
BROOKLYN, NY 11215

(For Third Party Requester)

In re Garrido
Reexamination Proceeding
Control No. : 95/000,393
Filed: November 11, 2008
Patent No. 6,213,703

DECISION
ON
PATENT OWNER'S
PETITION
UNDER 37 CFR 1.181

This is a decision addressing Patent Owner's petition, filed January 11, 2010, under 37 CFR 1.181 requesting that prosecution be reopened. Although the petition contains statements that the relief sought is a granting of a request for continued reexamination, the petition is being decided solely under 37 CFR 1.181. It is noted that Patent Owner filed a separate petition under 37 CFR 1.182, which will be addressed in another decision in due course, to request continued reexamination.

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

SUMMARY

Patent Owner's petition is DENIED.

BACKGROUND

1. Patent No. 6,213,703 (the '703 patent) issued on April 10, 2001.

2. A request for reexamination, assigned Control No. 95/000,393 (the '393 proceeding), was filed by a third party Requester on November 11, 2008.

3. Reexamination was ordered in the '393 reexamination proceeding on January 13, 2009.

4. An Office action on the merits was mailed on the same day, January 13, 2009.

5. On March 13, 2009, Patent Owner filed a reply to the Office action by the examiner.

6. On August 27, 2009, the Office mailed an Action Closing Prosecution (ACP). The ACP informed the Patent Owner that the amendment filed on March 13, 2009 was not compliant with 37 CFR 1.530(f), but that the regulations were provisionally waived to accept the amendment for examination purposes. The ACP also maintained the rejections in the first Office action on the merits (see, e.g., page 3 of the ACP). The ACP found that the declaration under 37 CFR 1.131 was ineffective to overcome the Wallace reference (see pages 25-26 of the ACP).

7. On October 27, 2009, Patent Owner filed a response to the ACP, which included claim amendments that were not compliant with 37 CFR 1.530(f). The Patent Owner was granted a one month extension of time to respond to the ACP. See the decision mailed September 22, 2009.

8. On November 25, 2009, the Requester filed comments on the Patent Owner's response.

9. On December 10, 2009, the Office mailed a Right of Appeal Notice (RAN). The RAN informed the Patent Owner that the amendment of October 27, 2009 was not entered because it failed to make the showing required by 37 CFR 1.116. The RAN maintained all the rejections, including the determination that the declarations under 37 CFR 1.131 was ineffective to overcome the Wallace reference (see pages 46-47 of the RAN).

10. On January 11, 2010, Patent Owner filed a petition under 37 CFR 1.181. The Patent Owner also filed a petition under 37 CFR 1.182 requesting continued reexamination, and a petition under 37 CFR 1.183 requesting waiver of the rule to grant an extension of time to file an appeal brief. These petitions will be addressed in separate decision(s) in due course. Patent Owner also filed an amendment to replace the informal amendment of March 13, 2009, accepted only for examination purposes, as required by the RAN (see page 2 of the RAN).

The patent owner (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 to have prosecution be reopened. Patent owner specifically requests that the director instruct the examiner to:

A. Change the designation of the Wallace reference from prior art under 35 U.S.C. 102(b) to 102(a); and

B. Withdraw the rejections based on the Wallace reference in light of the declarations filed under 37 CFR 1.131.

See pages 1-2 of the petition.

First, upon review of the record, it is noted that the ACP contained the same rejections based upon the Wallace reference and the determination that a declaration filed under 37 CFR 1.131 is ineffective to remove the Wallace reference. See the stated facts in the background section of this decision. Therefore, the action that the petitioner is requesting relief from is the ACP, dated August 27, 2009. Accordingly, a petition under 37 CFR 1.181 must have been filed within two months of August 27, 2009 (e.g., October 27, 2009) to be timely filed.

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.)

In other words, this petition is untimely to request relief from the examiner's actions in the ACP. Even if this petition is deemed timely filed as being a petition requesting relief from the RAN (dated December 10, 2009), the grounds of argument presented in the petition only address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of whether the Wallace reference is prior art under 35 U.S.C. 102(a) or (b) and whether the declarations filed under 37 CFR 1.131 are effective to remove the Wallace reference as prior art are appealable issues, and therefore, cannot be addressed by petitions. Therefore, the merits of the examiner's decisions will not be addressed in this decision.

In response to Patent Owner's general 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. 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 (RAN) and/or an action closing prosecution (ACP). The petition does not state that the examiner failed to follow Office policies and procedures, and does not allege that the ACP or RAN was premature. The record shows that the examiner

appropriately followed Office rules and procedures in the determination to issue an ACP and a RAN, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the ACP and RAN, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the Patent Owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed January 11, 2010, is **DENIED** for the reasons discussed above.

2. The present *inter partes* reexamination proceeding is being forwarded to the Office of Patent Legal Administration for consideration of petitions under 37 CFR 1.182 and 1.183.

4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,393	11/11/2008	6213703	CEL.100C2XC1D1	9167

23557 7590 03/01/2010

SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE, FL 32614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/01/2010

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000393
PATENT NO. : 6213703
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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(For Third Party Requester)

In re Garrido
Inter Partes Reexamination Proceeding
Control No. 95/000,393
Filed: November 11, 2008
For: U.S. Patent No. 6,213,703 B1

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the January 11, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.182 – REQUEST TO REOPEN PROSECUTION AFTER ACTION CLOSING PROSECUTION."

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

The petition is **dismissed**.

BACKGROUND

- On November 11, 2008, a request for *ex parte* reexamination meeting the filing date requirements was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,393 ("the '393 proceeding").

- Prosecution progressed, until, on December 10, 2009, a Right of Appeal Notice was mailed by the Office, refusing entry of an amendment after Action Closing prosecution filed on October 27, 2009, and setting a time period for filing of an appeal brief to run the longer of 1 month or thirty days from the date of the Right of Appeal Notice.

- On January 5, 2010, the third party requester filed a notice of appeal.

- On January 11, 2010 patent owner filed:

    - A Notice of appeal.

    - A request for extension of time to file an appeal brief.

- A petition under 37 C.F.R. § 1.183 requesting waiver of the prohibition of extensions of time to file an appeal brief, being dismissed in a decision mailed on an even date herewith.

- A petition entitled "PETITION UNDER 37 CFR 1.181," requesting reopening of prosecution.

- The instant petition entitled "PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination.

- A proposed amendment to correct the form of an earlier claim amendment.

- On January 15, 2010, the patent owner filed a notice of cross-appeal to the third party requester's notice of appeal.

- On January 27, 2010, the Office dismissed the petition filed under 37 C.F.R. § 1.181.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.181 provides, in pertinent part:

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

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

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

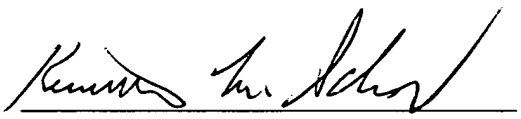
that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

The March 2005 Notice states that the § 1.182 petition procedure may be used to seek entry of an after-final submission. Patent owner's petition does not request entry of an after-final submission or a submission after an action closing prosecution; thus, relief is unavailable under § 1.182 according to the conditions set forth in the Notice based on which patent owner seeks relief. Allegations of procedural examiner error are addressable through a petition under § 1.181; such a petition was filed on January 11, 2010, and dismissed on January 27, 2010. Allegations of examiner error on the merits of the rejections are addressable through appeal; notices of appeal have been filed by both parties. Therefore, the situation is one that is specifically provided for in the regulations, and relief is unavailable under § 1.182.

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

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over this proceeding is returned to the Central Reexamination Unit.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



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

Kenpet7/RCR/IP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,393	11/11/2008	6213703	CEL.100C2XC1D1	9167

23557 7590 03/01/2010

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A PROFESSIONAL ASSOCIATION
PO Box 142950
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/01/2010

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000393
PATENT NO. : 6213703
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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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

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(For Third Party Requester)

In re Garrido
Inter Partes Reexamination Proceeding
Control No. 95/000,393
Filed: November 11, 2008
For: U.S. Patent No. 6,213,703 B1

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 1.183**

This is a decision on the January 11, 2010 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."

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

The petition is **dismissed**.

BACKGROUND

- On November 11, 2008, a request for *ex parte* reexamination meeting the filing date requirements was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,393 ("the '393 proceeding").

- Prosecution progressed, until, on December 10, 2009, a Right of Appeal Notice was mailed by the Office, refusing entry of an amendment after Action Closing Prosecution filed on October 27, 2009, and setting a time period for filing of an appeal brief to run the longer of 1 month or thirty days from the date of the Right of Appeal Notice.

- On January 5, 2010, the third party requester filed a notice of appeal.

- On January 11, 2010 patent owner filed:

    - A Notice of appeal.

- The instant request for extension of time to file an appeal brief.
- A petition under 37 C.F.R. § 1.183 requesting waiver of the prohibition of extensions of time to file an appeal brief, dismissed in a decision mailed on an even date herewith.
- A petition entitled "PETITION UNDER 37 CFR 1.181," requesting reopening of prosecution.
- A petition entitled "PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination, being dismissed in a decision mailed on an even date herewith.
- A proposed amendment to correct the form of an earlier claim amendment.

- On January 15, 2010, the patent owner filed a notice of cross-appeal to the third party requester's notice of appeal.
- On January 27, 2010, the Office dismissed the petition filed under 37 C.F.R. § 1.181.

PERTINENT REGULATIONS

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 41.66(a) provides:

> 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.

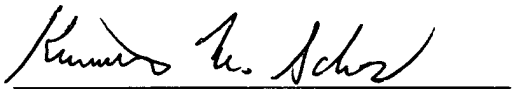
DECISION

Patent owner filed the instant petition to extend the time to file an appeal brief "until after a decision on the petitions filed concurrently under 37 C.F.R. §§ 1.181 and 1.182." On an even date herewith, the Office is issuing a decision dismissing patent owner's petition under § 1.182.

Patent owner's January 11 petition under § 1.181 was dismissed in a decision mailed on January 27, 2010. Therefore, both petitions have been decided prior to the date the appeal brief is due under 37 C.F.R. § 41.66(a) (quoted above). Therefore, patent owner's desired condition has been realized without the need for a waiver under § 1.183. Therefore, the instant petition is dismissed.

CONCLUSION

- The petition is **dismissed**.
- The time for filing an appeal brief continues to run pursuant to 37 C.F.R. § 41.66(a).
- 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.



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

March 1, 2010
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,394	08/29/2008	6763345	1482-0001.17	1998

70653 7590 12/28/2009

LAW OFFICES OF EUGENE M. CUMMINGS, P.C.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2009

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SUITE 800
WASHINGTON, DC 20037

Date:

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DEC 28 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000394
PATENT NO. : 6763345
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

(For Requester)

In re Hempleman *et alia*
Reexamination Proceeding
Control No. 95/000,394
For: U.S. Patent No. 6,763,345

: DECISION, DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.927

This is a decision on the December 29, 2008 paper entitled "PETITION TO GRANT INTER PARTES REEXAMINATION UNDER 37 C.F.R. §1.181 AND §1.927". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,763,345 (hereinafter, the '345 patent) issued on July 13, 2004 to Hempleman *et alia.*

2. On December 8, 2006, a request for *inter partes* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 95/000,201 (hereinafter, the '201 proceeding).

3. On March 8, 2008, a request for *inter partes* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 95/000,354 (hereinafter, the '354 proceeding).

4. On May 20, 2008, the '201 and '354 proceedings were merged.

5. On August 29, 2008, a request for *inter partes* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 95/000,394 (hereinafter, the '394 proceeding).

6. On November 28, 2008, the order denying reexamination in the '394 proceeding was mailed.

7. On December 2008, the present petition was filed.

8. On January 5, 2009, an Action Closing Prosecution was mailed in the merged '201/'354 proceedings rejecting all pending claims.

9. On April 14, 2009, a Right of Appeal Notice was mailed in the merged '201/'354 proceedings rejecting all pending claims.

10. No appeal was filed in the merged '201/'354 proceedings and, on May 29, 2009, a Notice of Intent to Issue *Inter Partes* Reexamination Certificate was mailed in the merged '201/'354 proceedings canceling all pending claims.

11. On September 8, 2009, the reexamination certificate issued for the '345 patent indicating that all claims were canceled.

DISCUSSION

The '394 request alleges that a Substantial New Question (SNQ) of patentability exists as to claim 31 due to the teachings in a Japanese unexamined patent application (H6-274167) of Shinji Murase.

The examiner found that the Murase did not contain a new, non-cumulative teaching as to claim 31 citing the teachings in the record of previous and ongoing examinations.

Third party requester ("Petitioner") in the '394 reexamination proceeding has petitioned seeking relief from the examiner's November 28, 2008 Order denying *inter partes* reexamination.

35 U.S.C. § 312(c) provides:

A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

37 CFR § 1.927 provides:

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if

the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2648 provides, in pertinent part:

If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be de novo. Each decision by the CRU Director will conclude with the following paragraph:

This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Requester argues that the Murase reference raises an SNQ as to claim 31 due to the new, non-cumulative teaching of the play list being "automatically generated".

A *de novo* review of the record indicates that the limitation "automatically generated" does not appear in the claim. Therefore, the Murase reference does not present any new, non-cumulative teaching that would raise an SNQ as to claim 31.

However, this argument (and the entire petition) appears moot in view of the fact that claim 31 of the '345 patent has been canceled in the reexamination certificate issued on September 8, 2009.

SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 6,763,345 has been presented in the '394 request by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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FEB 13 2009

CENTRAL REEXAMINATION UNIT

Wendy M. Gombert
BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE WA 98104

(For Patent Owner)

William J. Zychlewicz
PATRICK W. RASCHE
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Brown *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,396
Deposited on: 23 September 2008
For: US Patent No. 6,516,236

This is a decision on the 3 February 2009, patent owner "Petition and Request for Extension of under 37 CFR § 1.956 and Payment of Fee Under 37 CFR § 1.17(g)," requesting that the time for responding to the Office action mailed 23 January 2009 to be extended by two (2) months.

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

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

Statement of Relevant Facts

1. On 4 February 2003 US patent No. 6,516,236 was granted.

2. On 23 September 2008 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 20 November 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 23 January 2009 a non-final Office action was mailed setting a time for response of two (2) months.

5. On 3 February 2009 a petition for a two (2) months extension of time was received.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 23 January 2009. The non-final Office action provides two (2) month period for response. The petition requesting a two (2) months extension of time was timely filed on 3 February 2009. On 10 February 2009 a letter was received authorizing payment by a deposit account for the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted-in-part.

> **37 CFR § 1.956. 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

The petition requests an extension of two (2) months time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy and the applied references length is extensive. Further the patent owner is assessing the need for experts to determine the need for declarations under 37 CFR § 1.132.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

The petition request is hereby granted-in-part.

A **one-month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 23 January 2009 is **granted-in-part**.

2. A **one-month** extension of time is hereby granted.

3. The office action mailed set a two-months response time for which to respond, with the granting of this extension of time, the period will end on **23 April 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, Supervisory Patent Examiner, in the absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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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701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

MAILED
MAY 06 2010
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,396
Filed: September 23, 2008
For: U.S. Patent No. 6,516,236

DECISION DISMISSING PETITION

This is a decision addressing patent owner's February 19, 2010 petition paper entitled "PATENT OWNER'S CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT UNDER 37 C.F.R. § 1.943(b)."

The petition is before the Office of Patent Legal Administration for consideration.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was recorded on February 22, 2010.

The petition is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,516,236 ("the '236 patent") issued on February 4, 2003.

2. On September 23, 2008, a request for *inter partes* reexamination of the '236 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,396 ("the '396 proceeding").

3. On November 20, 2008, the Office issued an order granting *inter partes* reexamination in the '396 proceeding.

4. On January 23, 2009, the Office issued a non-final Office action on the merits in the '396 proceeding.

5. On February 3, 2009, patent owner filed a "PETITION AND REQUEST FOR EXTENSION OF TIME UNDER 37 CFR § 1.956 AND PAYMENT OF FEE UNDER 37 CFR § 1.17(g)" ("request for extension of time").

6. On February 13, 2009, the Office mailed a decision granting, in-part, patent owner's February 3, 2009 request for extension of time and extending the time period for response to the January 23, 2009 Office action by one month.

7. On April 23, 2009, patent owner filed a response to the January 23, 2009 Office action, including ten declarations.

8. On May 22, 2009, third party requester filed comments after patent owner's April 23, 2009 response.

9. On February 4, 2010, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" ("notice of defective paper"), stating that patent owner's April 23, 2009 response exceeded the page limit of 37 CFR 1.943(b) and giving patent owner 15 days to file a re-drafted response or a supplemental response with pages redacted.

10. On February 19, 2010, patent owner filed the instant petition paper entitled, "PATENT OWNER'S CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT UNDER 37 C.F.R. § 1.943(b)" ("the petition under 37 CFR 1.183").

11. Concurrently, on February 19, 2010, patent owner filed a re-drafted response, including redacted versions of six of the ten declarations that were filed as part of the April 23, 2009 response.

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.

MPEP 2667(I), 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.

Patent Owner's Petition under 37 CFR 1.183

On February 4, 2010, the Central Reexamination Unit (CRU) mailed a notice of defective paper, stating that patent owner's April 23, 2009 response exceeds 50 pages and giving patent owner 15 days to file a re-drafted response that does not exceed the page limit or a supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. On February 19, 2010, in response to the notice of defective paper, patent owner filed the instant petition under 37 CFR 1.183, concurrently with a re-drafted response and redacted versions of six of ten declarations that accompanied the April 23, 2009 response.[1]

In the petition under 37 CFR 1.183, patent owner asserts that it "believes its first Response was compliant, and that its substantially shortened and redacted new Response should certainly not be considered over-length."[2] Nonetheless, in the petition under 37 CFR 1.183, patent owner requests that "[t]o whatever extent if any the USPTO determines that its shortened and redacted Response submitted on February 19, 2010 is still over-length for any reason, the Patent Owner hereby petitions the Commissioner of Patents and Trademarks to waive the page limitations imposed by 37 C.F.R. § 1.943(b) and grant the Patent Owner leave to submit an over length brief to that same extent; that is, of up to and including all redacted declarations and shortened briefing filed in its February 19, 2010 Response."[3]

In this instance, patent owner's February 19, 2009 re-drafted response, including the redacted versions of the six declarations, is page-length compliant as a total of 50 pages count toward the page limit of 37 CFR 1.943(b). In particular, the remarks portion of the re-drafted response includes 45 pages of arguments[4], and the redacted versions of the six declarations include approximately 5 pages of arguments.[5] Thus, the portions of patent owner's February 19, 2010 redrafted response, including the portions of the six redacted declarations, which count toward

[1] The April 23, 2009 response included ten declarations: "the Mathias declaration," "the Omoigui declaration," "the Malina declaration," "the Levy declaration," "the Chouinard declaration," "the Stone declaration," "the Richter declaration," "the McConnell declaration," "the Petzold declaration," and the "Ard declaration." On February 19, 2010, patent owner submitted the redacted versions of six of the declarations: "the redacted Mathias declaration," "the redacted Omoigui declaration," "the redacted Malina declaration," "the redacted Levy declaration," "the redacted Chouinard declaration," and "the redacted Stone declaration."

[2] See Petition under 37 CFR 1.183 at page 2.

[3] Id. at page 1.

[4] The cover page and table of contents page of the re-drafted response are excluded from the page count.

[5] See, e.g., pages 21-22, paragraphs 72 and 73, of the redacted Omoigui declaration, pages 6-7 of the redacted Chouinard declaration, and page 9, paragraph 30, of the redacted Stone declaration.

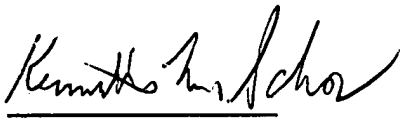
the page limit, do not exceed 50 pages, and no waiver of 37 CFR 1.943(b) is required for entry of the February 19, 2010 re-drafted response and the six redacted declarations into the record of the '396 proceeding. Accordingly, patent owner's conditional request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. Patent owner's February 19, 2010 petition to waive the page limit requirement of 37 CFR 1.943(b) under 37 CFR 1.183 is **dismissed**.

2. Jurisdiction over the '396 proceeding is returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries with regard to this decision 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,397	09/23/2008	6941543	14983-132	3058

25315 7590 02/12/2009

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER	

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,397	09/23/2008	6941543	14983-132	3058

25315 7590 02/12/2009

EXAMINER

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

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Wendy M. Gombert
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701 FIFTH AVENUE
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SEATTLE WA 98104

(For Patent Owner)

MAILED

FEB 12 2009

CENTRAL REEXAMINATION UNIT

William J. Zychlewicz
PATRICK W. RASCHE
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Brown *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,397
Deposited on: 23 September 2008
For: US Patent No. 6,941,543

This is a decision on the 6 February 2009, patent owner "Petition and Request for Extension of under 37 CFR § 1.956 and Payment of Fee Under 37 CFR § 1.17(g)," requesting that the time for responding to the Office action mailed 29 January 2009 to be extended by two (2) months.

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

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

Statement of Relevant Facts

1. On 6 September 2005 US patent No. 6,941,543 was granted.

2. On 23 September 2008 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 25 November 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 29 January 2009 a non-final Office action was mailed setting a time for response of two (2) months.

5. On 6 February 2009 a petition for a two (2) months extension of time was received.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 29 January 2009. The non-final Office action provides two (2) month period for response. The petition requesting a two (2) months extension of time was timely filed on 6 February 2009. On 10 February 2009 a letter was received authorizing payment by a deposit account for the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted-in-part.

> **37 CFR § 1.956. 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

The petition requests an extension of two (2) months time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy and the applied references length is extensive. Further the patent owner is assessing the need for experts to determine the need for declarations under 37 CFR § 1.132.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

The petition request is hereby granted-in-part.

A **one-month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 29 January 2009 is **granted-in-part**.

2. A **one-month** extension of time is hereby granted.

3. The office action mailed set a two-months response time for which to respond, with the granting of this extension of time, the period will end on **29 April 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, Supervisory Patent Examiner, in the absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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.
95/000,397	09/23/2008	6941543	14983-132	3058

25315 7590 05/26/2010

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,397	09/23/08	6941543	14983.132

EXAMINER
KISS, ERIC

PATRICK W. RASCHE
ARMSTRONG TEASDALE, LLP
ONE METROPOLITAN SQUARE
SUITE 2600
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ART UNIT	PAPER
3992	

DATE MAILED:

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,397	09/23/08	6941543	14983.132

EXAMINER
KISS, ERIC

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SUITE 2600
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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.

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ST. LOUIS, MO 63102-2740

(For *Inter Partes* Requester)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,397
Filed: September 23, 2008
For: U.S. Patent No. 6,941,543

DECISION DISMISSING PETITION

This is a decision addressing patent owner's February 19, 2010 petition paper entitled "PATENT OWNER'S CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT UNDER 37 C.F.R. § 1.943(b)."

The petition is before the Office of Patent Legal Administration for consideration.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on February 24, 2010.

The petition is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,941,543 ("the '543 patent") issued on September 6, 2005.

2. On September 23, 2008, a request for *inter partes* reexamination of the '543 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,397 ("the '397 proceeding").

3. On November 25, 2008, the Office issued an order granting *inter partes* reexamination in the '397 proceeding.

4. On January 29, 2009, the Office issued a non-final Office action on the merits in the '397 proceeding.

5. On February 6, 2009, patent owner filed a "PETITION AND REQUEST FOR EXTENSION OF TIME UNDER 37 CFR § 1.956 AND PAYMENT OF FEE UNDER 37 CFR § 1.17(g)" ("request for extension of time").

6. On February 12, 2009, the Office mailed a decision granting, in-part, patent owner's February 6, 2009 request for extension of time and extending the time period for response to the January 29, 2009 Office action by one month.

7. On April 29, 2009, patent owner filed a response to the January 29, 2009 Office action, including ten declarations.

8. On May 29, 2009, third party requester filed comments after patent owner's April 29, 2009 response.

9. On February 4, 2010, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" ("notice of defective paper"), stating that patent owner's April 29, 2009 response exceeded the page limit of 37 CFR 1.943(b) and giving patent owner 15 days to file a re-drafted response or a supplemental response with pages redacted.

10. On February 19, 2010, patent owner filed the instant petition paper entitled, "PATENT OWNER'S CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT UNDER 37 C.F.R. § 1.943(b)" ("the petition under 37 CFR 1.183").

11. Concurrently, on February 19, 2010, patent owner filed a re-drafted response, including redacted versions of five of the ten declarations that were filed as part of the April 29, 2009 response.[1]

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.

[1] While patent owner submitted redacted versions of six declarations, as noted in footnote 2 of this decision, two copies of the same redacted declaration were submitted.

MPEP 2667(I), 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.

Patent Owner's Petition under 37 CFR 1.183

On February 4, 2010, the Central Reexamination Unit (CRU) mailed a notice of defective paper, stating that patent owner's April 29, 2009 response exceeds 50 pages and giving patent owner 15 days to file a re-drafted response that does not exceed the page limit or a supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. On February 19, 2010, in response to the notice of defective paper, patent owner filed the instant petition under 37 CFR 1.183, concurrently with a re-drafted response and redacted versions of five of the ten declarations that accompanied the April 29, 2009 response.[2]

In the petition under 37 CFR 1.183, patent owner asserts that it "believes its first Response was compliant, and that its substantially shortened and redacted new Response should certainly not be considered over-length."[3] Nonetheless, in the petition under 37 CFR 1.183, patent owner requests that "[t]o whatever extent if any the USPTO determines that its shortened and redacted Response submitted on February 19, 2010 is still over-length for any reason, the Patent Owner hereby petitions the Commissioner of Patents and Trademarks to waive the page limitations imposed by 37 C.F.R. § 1.943(b) and grant the Patent Owner leave to submit an over length brief to that same extent; that is, of up to and including all redacted declarations and shortened briefing filed in its February 19, 2010 Response."[4]

In this instance, patent owner's February 19, 2009 re-drafted response, including the redacted versions of the five declarations, is page-length compliant as a total of 50 pages count toward the page limit of 37 CFR 1.943(b). In particular, the remarks portion of the re-drafted response

---

[2] The April 29, 2009 response included ten declarations: "the Mathias declaration," "the Omoigui declaration," "the Malina declaration," "the Levy declaration," "the Chouinard declaration," "the Stone declaration," "the Richter declaration," "the McConnell declaration," "the Petzold declaration," and the "Ard declaration." On February 19, 2010, patent owner submitted the redacted versions of five of the declarations: "the redacted Mathias declaration," "the redacted Omoigui declaration," "the redacted Malina declaration," "the redacted Levy declaration," and "the redacted Stone declaration." As indicated in footnote 1 of this decision, two copies of "the redacted Levy declaration" were submitted.

[3] See Petition under 37 CFR 1.183 at page 2.

[4] Id. at page 1.

includes 47 pages of arguments[5], and the redacted versions of the five declarations include approximately 3 pages of arguments.[6] Thus, the portions of patent owner's February 19, 2010 redrafted response, including the portions of the five redacted declarations, which count toward the page limit, do not exceed 50 pages, and no waiver of 37 CFR 1.943(b) is required for entry of the February 19, 2010 re-drafted response and the five redacted declarations into the record of the '397 proceeding. Accordingly, patent owner's conditional request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. Patent owner's February 19, 2010 petition to waive the page limit requirement of 37 CFR 1.943(b) under 37 CFR 1.183 is **dismissed**.

2. Jurisdiction over the '397 proceeding is returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries with regard to this decision 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

[5] The cover page and table of contents page of the re-drafted response are excluded from the page count.
[6] See, e.g., pages 21-22, paragraphs 72 and 73, of the redacted Omoigui declaration, and page 9, paragraph 30, of the redacted Stone declaration.

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.
95/000,398	09/23/2008	6513058	14983-130	3059

25315 7590 02/12/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Patrick W. Rasche, Esq.
Armstrong Teasdale LLP
One Metropolitan Square
St. Louis, MO 63102-2740

DATE MAILED: 02/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,398	09/23/2008	6513058	14983-130	3059

25315 7590 02/12/2009

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2009

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www.uspto.gov

Wendy M. Gombert
BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE WA 98104

(For Patent Owner)

MAILED

FEB 12 2009

CENTRAL REEXAMINATION UNIT

William J. Zychlewicz
PATRICK W. RASCHE
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Brown *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,398
Deposited on: 23 September 2008
For: US Patent No. 6,513,058

This is a decision on the 6 February 2009, patent owner "Petition and Request for Extension of under 37 CFR § 1.956 and Payment of Fee Under 37 CFR § 1.17(g)," requesting that the time for responding to the Office action mailed 29 January 2009 to be extended by two (2) months.

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

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

Statement of Relevant Facts

1. On 28 January 2003 US patent No. 6,513,058 was granted.

2. On 23 September 2008 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 25 November 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 29 January 2009 a non-final Office action was mailed setting a time for response of two (2) months.

5. On 6 February 2009 a petition for a two (2) months extension of time was received.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 29 January 2009. The non-final Office action provides two (2) month period for response. The petition requesting a two (2) months extension of time was timely filed on 6 February 2009. On 10 February 2009 a letter was received authorizing payment by a deposit account for the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted-in-part.

> **37 CFR § 1.956. 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

The petition requests an extension of two (2) months time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy and the applied references length is extensive. Further the patent owner is assessing the need for experts to determine the need for declarations under 37 CFR § 1.132.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

The petition request is hereby granted-in-part.

A **one-month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 29 January 2009 is **granted-in-part**.

2. A **one-month** extension of time is hereby granted.

3. The office action mailed set a two-months response time for which to respond, with the granting of this extension of time, the period will end on **29 April 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, Supervisory Patent Examiner, in the absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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.
95/000,398	09/23/2008	6513058	14983-130	3059

25315 7590 05/05/2010

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2010

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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.
95/000,398	09/23/08	6513058	14983.130

EXAMINER
KISS, ERIC

PATRICK W. RASCHE
ARMSTRONG TEASDALE, LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

ART UNIT	PAPER
3992	

DATE MAILED:
MAILED

MAY 05 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,398	09/23/08	6513058	14983.130

EXAMINER
KISS, ERIC

PATRICK W. RASCHE
ARMSTRONG TEASDALE, LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

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.

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BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

(For Patent Owner)

PATRICK W. RASCHE
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
ST LOUIS, MO 63102-2740

(For *Inter Partes* Requester)

MAILED

MAY 05 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,398
Filed: September 23, 2008
For: U.S. Patent No. 6,513,058

DECISION DISMISSING PETITION

This is a decision addressing patent owner's February 19, 2010 petition paper entitled "PATENT OWNER'S CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT UNDER 37 C.F.R. § 1.943(b)."

The petition is before the Office of Patent Legal Administration for consideration.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was recorded on February 24, 2010.

The petition is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,513,058 ("the '058 patent") issued on January 28, 2003.

2. On September 23, 2008, a request for *inter partes* reexamination of the '058 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,398 ("the '398 proceeding").

3. On November 25, 2008, the Office issued an order granting *inter partes* reexamination in the '398 proceeding.

4. On January 29, 2009, the Office issued a non-final Office action on the merits in the '398 proceeding.

5. On February 6, 2009, patent owner filed a "PETITION AND REQUEST FOR EXTENSION OF TIME UNDER 37 CFR § 1.956 AND PAYMENT OF FEE UNDER 37 CFR § 1.17(g)" ("request for extension of time").

6. On February 12, 2009, the Office mailed a decision granting, in-part, patent owner's February 6, 2009 request for extension of time and extending the time period for response to the January 29, 2009 Office action by one month.

7. On April 28, 2009, patent owner filed a response to the January 29, 2009 Office action, including ten declarations.

8. On May 28, 2009, third party requester filed comments after patent owner's April 28, 2009 response.

9. On February 4, 2010, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" ("notice of defective paper"), stating that patent owner's April 28, 2009 response exceeded the page limit of 37 CFR 1.943(b) and giving patent owner 15 days to file a re-drafted response or a supplemental response with pages redacted

10. On February 19, 2010, patent owner filed the instant petition paper entitled, "PATENT OWNER'S CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT UNDER 37 C.F.R. § 1.943(b)" ("the petition under 37 CFR 1.183").

11. Concurrently, on February 19, 2010, patent owner filed a re-drafted response, including redacted versions of six of the declarations that were filed as part of the April 28, 2009 response.

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.

MPEP 2667(I), 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.

Patent Owner's Petition under 37 CFR 1.183

On February 4, 2010, the Central Reexamination Unit (CRU) mailed a notice of defective paper, stating that patent owner's April 28, 2009 response exceeds 50 pages and giving patent owner 15 days to file a re-drafted response that does not exceed the page limit or a supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. On February 19, 2010, in response to the notice of defective paper, patent owner filed the instant petition under 37 CFR 1.183, concurrently with a re-drafted response and redacted versions of six of ten declarations that accompanied the April 28, 2009 response.[1]

In the petition under 37 CFR 1.183, patent owner asserts that it "believes its first Response was compliant, and that its substantially shortened and redacted new Response should certainly not be considered over-length."[2] Nonetheless, in the petition under 37 CFR 1.183, patent owner requests that "[t]o whatever extent if any the USPTO determines that its shortened and redacted Response submitted on February 19, 2010 is still over-length for any reason, the Patent Owner hereby petitions the Commissioner of Patents and Trademarks to waive the page limitations imposed by 37 C.F.R. § 1.943(b) and grant the Patent Owner leave to submit an over length brief to that same extent; that is, of up to and including all redacted declarations and shortened briefing filed in its February 19, 2010 Response."[3]

In this instance, patent owner's February 19, 2009 re-drafted response, including the redacted versions of the six declarations, is page-length compliant as a total of 47 pages count toward the page limit of 37 CFR 1.943(b). In particular, the remarks portion of the re-drafted response includes 42 pages of arguments[4], and the redacted versions of the six declarations include approximately 5 pages of arguments.[5] Thus, the portions of patent owner's February 19, 2010 redrafted response, including the portions of the six redacted declarations, which count toward

[1] The April 28, 2009 response included ten declarations: "the Mathias declaration," "the Omoigui declaration," "the Malina declaration," "the Levy declaration," "the Chouinard declaration," "the Stone declaration," "the Richter declaration," "the McConnell declaration," "the Petzold declaration," and the "Ard declaration." On February 19, 2010, patent owner submitted the redacted versions of six of the declarations: "the redacted Mathias declaration," "the redacted Omoigui declaration," "the redacted Malina declaration," "the redacted Levy declaration," "the redacted Chouinard declaration," and "the redacted Stone declaration."

[2] Petition under 37 CFR 1.183 at page 2.

[3] Id. at page 1.

[4] The cover page and table of contents page of the re-drafted response are excluded from the page count.

[5] See, e.g., pages 21-22, paragraphs 72 and 73, of the redacted Omoigui declaration, pages 6-7 of the redacted Chouinard declaration, and page 9, paragraph 30, of the redacted Stone declaration.

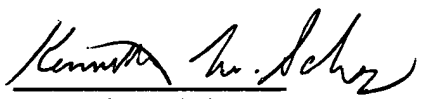
the page limit, do not exceed 50 pages, and no waiver of 37 CFR 1.943(b) is required for entry of the February 19, 2010 re-drafted response and the six redacted declarations into the record of the '398 proceeding. Accordingly, patent owner's conditional request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. Patent owner's February 19, 2010 petition to waive the page limit requirement of 37 CFR 1.943(b) under 37 CFR 1.183 is **dismissed**.

2. Jurisdiction over the '398 proceeding is returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries with regard to this decision 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,399	11/17/2008	6447190	S001-6099	1540

21884 7590 05/29/2009

WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA, VA 22314

EXAMINER
CLARK, JEANNE MARIE

ART UNIT	PAPER NUMBER
3993	

MAIL DATE	DELIVERY MODE
05/29/2009	PAPER

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

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

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BRUCE L. ADAMS
ADAMS & WILKINS
17 BATTERY PLACE, SUITE 1231
NEW YORK, NY 10004

Date:

MAILED

MAY 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000399
PATENT NO. : 6447190
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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.

John L. Welsh
2000 Duke Street
Suite 100
Alexandria, VA 22314

In re Application of:
Benjamin J. Kwitek
Application No. 95/000,399
Filed: November 17, 2008
For: VISCOELASTIC GRIP FOR A WRITING IMPLEMENT

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed April 14, 2009.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. ∋ 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. ∋ 402.06. 37 C.F.R. ∋ 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed April 14, 2009 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthews
Patent Reexamination Specialist
Central Reexamination Unit
(571) 272-4233

cc: Benjamin J. Kwitek
1061 Valley View Drive
Canon City, CO 81212

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.
95/000,399	11/17/2008	6447190		1540

37833 7590 03/12/2010

LITMAN LAW OFFICES, LTD.
POST OFFICE BOX 41200
SOUTH STATION
ARLINGTON, VA 22204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L. ADAMS
ADAMS & WILKINS
17 BATTERY PLACE, SUITE 1231
NEW YORK, NY 10004

Date: MAILED

MAR 12 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000399
PATENT NO. : 6447190
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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Benjamin J. Kwitek
1061 Valley View Drive
Canon City CO 81212

(For Patent Owner)

MAILED

MAR 12 2010

CENTRAL REEXAMINATION UNIT

Bruce L. Adams, Esq.
Adams & Wilks
18 Battery Place, Suite 1231
New York, NY 10004

(For Requester)

Richard J. Apley
Litman Law Offices, Ltd.
P. O. Box 15035
Arlington, VA 22215

(Courtesy Copy)

In re Kwitek
Inter Partes Reexamination Proceeding
Control No. 95/000,399
Filed: November 17, 2008
For: U.S. Patent No. 6,447,190

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

This is a decision on the February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the February 4, 2010 patent owner petition to revive").

This decision also addresses the power of attorney and change of correspondence address filed on September 16, 2009.

The February 4, 2010 patent owner petition to revive, the September 16, 2009 power of attorney, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

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

SUMMARY

The February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The power of attorney and change of correspondence address filed on September 16, 2009 in this reexamination proceeding is **ineffective**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.33(c) provides, in pertinent part:

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.

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 provides, in pertinent part:

(b) 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.

(c) 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.

Best Available Copy

37 CFR 1.958 provides, in pertinent part:

(b) 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).

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

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

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be . . . an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee . . .

MPEP 2622 provides, in pertinent part (emphasis added):

Address of Patent Owner: The correspondence address **for the patent to be reexamined**, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings. See 37 CFR 1.33(c).

MPEP 2668 provides, in pertinent part:

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

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted an appeal brief and the appropriate fee for filing the appeal brief on February 4, 2010, which satisfies item (1).[1] A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the February 4, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The power of attorney and change of correspondence address filed on September 16, 2009 in this reexamination proceeding is **ineffective**. The official correspondence address of record for the patent owner in this reexamination proceeding is the correspondence address as recorded in the patent file, application no. 09/704,566.[2] In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, is Benjamin J. Kwitek, 1061 Valley View Drive, Canon City, CO 81212. The attorneys of record for the patent owner, as recorded in the patent file, are Nicholas Aquilino, John Welsh, and Howard Flaxman. A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Richard J. Apley. **In the absence of a filing of a change of power of attorney and correspondence address in the patent file, i.e., in application no. 09/704,566, however, any future correspondence in this reexamination proceeding will be mailed to the patent owner only at the official correspondence address of record in the patent file, application no. 09/704,566.**

Furthermore, the Office notes that the power of attorney and change of correspondence address filed on September 16, 2009 in this reexamination proceeding requests that all correspondence be mailed to the address associated with customer number 37833. The address associated with customer number 37833, however, is Litman Law Offices, Ltd., Post Office Box 41200, South Station, Arlington, VA 22204, which differs from the address given in the signature block on page 2 of the present petition. **Therefore, if the patent owner files a power of attorney and change of correspondence address in the patent file, application no. 09/704,566, that is identical to that submitted in this reexamination proceeding on September 16, 2009, the official correspondence address will differ from that provided in the signature block on page 2 of the present petition.** The patent owner may wish to change the correspondence address associated with customer number 37833 by filing a customer number data change, PTO/SB/124A.

---

[1] See MPEP 2668 IV and 711.03(c) II A 2(c).
[2] See 37 CFR 1.33(c) and MPEP 2622.

CONCLUSION

- The February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- The September 16, 2009 power of attorney and change of correspondence address is **ineffective**. A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Richard J. Apley. In the absence of a filing of a change of power of attorney and correspondence address in the patent file, application no. 09/704,566, any future correspondence in this reexamination proceeding will be mailed to the patent owner **only** at the official correspondence address of record in the patent file, application no. 09/704,566.

- The address associated with customer number 37833, as designated in the power of attorney and change of correspondence address submitted on September 16, 2009 in this reexamination proceeding, differs from the address given in the signature block on page 2 of the present petition. If the patent owner properly files a power of attorney and change of correspondence address in the patent file, application no. 09/704,566, that is identical to that submitted in this reexamination proceeding, the official correspondence address will differ from that provided in the signature block on page 2 of the present petition. The patent owner may wish to change the correspondence address associated with customer number 37833 by filing a customer number data change, PTO/SB/124A.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Art Unit 3993 for processing of the February 4, 2010 appeal brief.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jeanne Clark, of Art Unit 3993, at (571) 272-7714.

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,399	11/17/2008	6447190		1540

37833 7590 03/26/2010

LITMAN LAW OFFICES, LTD.
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ARLINGTON, VA 22204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/26/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BRUCE L. ADAMS
ADAMS & WILKINS
17 BATTERY PLACE, SUITE 1231
NEW YORK, NY 10004

Date:

MAILED

MAR 2 6 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000399
PATENT NO. : 6447190
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RICHARD J. APLEY
LITMAN LAW OFFICES, LTD
P.O. BOX 15035
ARLINGTON, VA 22215

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000399
PATENT NO. : 6447190
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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Benjamin J. Kwitek
1061 Valley View Drive
Canon City CO 81212

(For Patent Owner)

MAILED

MAR 26 2010

Bruce L. Adams, Esq.
Adams & Wilks
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(For Requester)

CENTRAL REEXAMINATION UNIT

Richard J. Apley
Litman Law Offices, Ltd.
P. O. Box 15035
Arlington, VA 22215

(Courtesy Copy)

In re Kwitek
Inter Partes Reexamination Proceeding
Control No. 95/000,399
Filed: November 17, 2008
For: U.S. Patent No. 6,447,190

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

This decision **supplements** the March 12, 2010 decision on the February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding.

This decision also addresses the power of attorney and change of correspondence address filed on September 16, 2009.

The March 12, 2010 decision, the February 4, 2010 patent owner petition to revive, the September 16, 2009 power of attorney, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee set forth in 37 CFR 1.17(m) for the February 4, 2010 petition under 37 CFR 1.137(b) has been received.

SUMMARY

The third party requester is given **30 days from the mail date of this supplemental decision** to submit a respondent brief in response to patent owner's February 4, 2010 appeal brief.

The February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The power of attorney and change of correspondence address filed on September 16, 2009 in this reexamination proceeding is **ineffective**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.33(c) provides, in pertinent part:

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.

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 provides, in pertinent part:

(b) 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.

(c) 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 provides, in pertinent part:

(b) 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).

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

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

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be . . . an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee . . .

MPEP 2622 provides, in pertinent part (emphasis added):

Address of Patent Owner: The correspondence address **for the patent to be reexamined**, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings. See 37 CFR 1.33(c).

MPEP 2668 provides, in pertinent part:

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

This supplemental decision clarifies that the third party requester is given 30 days from the mail date of this supplemental decision to file any respondent brief in response to patent owner's February 4, 2010 appeal brief. The due date for any respondent brief is tolled from the mail date of the decision granting a petition to revive, because patent owner's February 4, 2010 appeal brief is not ripe for comment until the proceeding is revived. This supplemental decision is otherwise identical to the March 12, 2010 decision.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted an appeal brief and the appropriate fee for filing the appeal brief on February 4, 2010, which satisfies item (1).[1] A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the February 4, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The power of attorney and change of correspondence address filed on September 16, 2009 in this reexamination proceeding is **ineffective**. The official correspondence address of record for the patent owner in this reexamination proceeding is the correspondence address as recorded in the patent file, application no. 09/704,556.[2] In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, is Benjamin J. Kwitek, 1061 Valley View Drive, Canon City, CO 81212. The attorneys of record for the patent owner, as recorded in the patent file, are Nicholas Aquilino, John Welsh, and Howard Flaxman. A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Richard J. Apley. **In the absence of a filing of a change of power of attorney and correspondence address in the patent file, i.e., in application no. 09/704,556, however, any future correspondence in this reexamination proceeding will be mailed to the patent owner only at the official correspondence address of record in the patent file, application no. 09/704,556.**

Furthermore, the Office notes that the power of attorney and change of correspondence address filed on September 16, 2009 in this reexamination proceeding requests that all correspondence be mailed to the address associated with customer number 37833. The address associated with customer number 37833, however, is Litman Law Offices, Ltd., Post Office Box 41200, South Station, Arlington, VA 22204, which differs from the address given in the signature block on page 2 of the present petition. **Therefore, if the patent owner files a power of attorney and change of correspondence address in the patent file, application no. 09/704,556, that is identical to that submitted in this reexamination proceeding on September 16, 2009, the official correspondence address will differ from that provided in the signature block on page 2 of the present petition.** The patent owner may wish to change the correspondence

[1] See MPEP 2668 IV and 711.03(c) II A 2(c).
[2] See 37 CFR 1.33(c) and MPEP 2622.

address associated with customer number 37833 by filing a customer number data change, PTO/SB/124A.

CONCLUSION

- The February 4, 2010 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- The third party requester is given **30 days from the mail date of this supplemental decision** to submit a respondent brief in response to patent owner's February 4, 2010 appeal brief.

- The September 16, 2009 power of attorney and change of correspondence address is **ineffective**. A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Richard J. Apley. In the absence of a filing of a change of power of attorney and correspondence address in the patent file, application no. 09/704,556, any future correspondence in this reexamination proceeding will be mailed to the patent owner **only** at the official correspondence address of record in the patent file, application no. 09/704,556.

- The address associated with customer number 37833, as designated in the power of attorney and change of correspondence address submitted on September 16, 2009 in this reexamination proceeding, differs from the address given in the signature block on page 2 of the present petition. If the patent owner properly files a power of attorney and change of correspondence address in the patent file, application no. 09/704,566, that is identical to that submitted in this reexamination proceeding, the official correspondence address will differ from that provided in the signature block on page 2 of the present petition. The patent owner may wish to change the correspondence address associated with customer number 37833 by filing a customer number data change, PTO/SB/124A.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Art Unit 3993 for processing of the February 4, 2010 appeal brief.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jeanne Clark, of Art Unit 3993, at (571) 272-7714.

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Cynthia L. Nessler
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.
95/000,402	01/26/2009	6,442,573 B1	F0657.70000US00	1370

22804 7590 07/16/2010

THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES, CA 90067

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/16/2010

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600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:

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JUL 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000402
PATENT NO. : 6442573
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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JUL 16 2010

CENTRAL REEXAMINATION UNIT

THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES CA 90067

(For Patent Owner)

HUNTER D. KEETON
WOLF, GREENFIELD & SACKS
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

(For Third Party Requester)

In re Schiller et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,402
Filed: January 26, 2009
For: U.S. Patent No. 6,442,573

: **DECISION**
: **GRANTING-IN-PART AND**
: **DISMISSING-IN-PART**
: **PETITION UNDER § 1.183**
:

This is a decision on the June 4, 2010 patent owner petition pursuant to 37 C.F.R. § 1.183 requesting waiver of the rules for entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief.

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

The petition under 37 C.F.R. § 1.183 is **granted** as to the request for rule waiver and an extension of time the extent specified below, but **dismissed** as to the request for entry of a corrected claim amendment and entry of a correctly scanned affidavit.

BACKGROUND

- On January 26, 2009, a corrected request for *inter partes* reexamination of U.S. Patent Number 6,442,573 B1, originally submitted on October 15, 2008, by third party requester Frame Media Inc. was accorded a filing date, and the resulting reexamination proceeding was assigned control number 95/000,402 ("the '402 proceeding").

- Prosecution progressed until, on May 4, 2010, a Right of Appeal Notice was issued by the Office. The Notice refused entry of a December 31, 2009 amendment and affidavit as noncompliant with § 1.116, and refused entry of patent owner comments submitted on December 31, 2009 as not addressing issues raised in a December 4, 2009 ACP.

- On June 4, 2010, patent owner filed the following petitions:

    - A petition entitled "PETITION PURSUANT TO 37 CFR 1.181 REQUESTING RECONSIDERATION OF THE EXAMINER'S EXPUNGEMENT OF THE PATENT OWNER'S RESPONSE UNDER 37 CFR 1.951 TO THE ACTION CLOSING PROSECUTION."

    - The instant petition filed under 37 C.F.R. § 1.183, requesting entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief.

- Also on June 4, 2010, Notices of Appeal were filed by both the patent owner and the third party requester.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 41.37 states, in pertinent part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
>
> (e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (Emphasis added)

37 C.F.R. § 41.61(b) states:

> (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.

37 C.F.R. § 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.

37 C.F.R. § 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.

DECISION

The present patent owner petition requests three separate types of relief under 37 C.F.R. § 1.183: entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief. 37 C.F.R. § 1.4(c) states that 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. As the present petition requests multiple distinct inquiries, the petition violates § 1.4(c). In the interest of providing special dispatch for the present proceeding, the request for extension of time will be taken up in this decision. The requests for entry of a corrected claim amendment and entry of a correctly scanned affidavit, however, are dismissed pursuant to § 1.4(c). Any future submission should be limited to a single subject or inquiry. It is further noted that relief under § 1.183 is an extraordinary remedy, and would not be available where another remedy exists; therefore, petitioner should not file any petition under that section while a petition for the same relief under another section (e.g., § 1.181) is outstanding.

The present patent owner petition for an extension of time was filed on June 4, 2010, simultaneously with filing of Notices of Appeal by patent owner and third party requester. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for "waiver the deadline for filing an appeal brief." Petition at 1-2. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

Pursuant to 37 C.F.R. § 41.66(a), the time for filing an appellant's brief is two months from the expiration of the time for filing (by the last party entitled to do so) a Notice of appeal or cross appeal. Once a party has filed a Notice of appeal, the other party has a 14 day period in which to file a Notice of cross-appeal, pursuant to § 41.61(b). In the present proceeding, Notices of appeal were filed by both parties on June 4, 2010. Therefore, the time for patent owner petitioner to file an Appeal Brief is due to expire on July 18, 2010. The outstanding petition under 37 C.F.R. § 1.181 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petition under § 1.181. A decision on the § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an Appeal Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appeal Brief is extended to run 30 days from the due date; i.e., August 17, 2010. In the interests of equity and uniformity, third party requester's time period to submit an appeal Brief is *sua sponte* extended to run 30 days from the due date; i.e., August 17, 2010.

If the petition under § 1.181 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed June 4, 2010 for filing an Appeal Brief is **granted to the extent stated above.**

2. The time for to file both the patent owner and third party requester Appeal Briefs is extended to run **30 days** from the § 41.61(b) due date; i.e., through August 17, 2010.

3. The separate inquiries addressed in the present petition; i.e., entry of a corrected claim amendment and entry of a correctly scanned affidavit, are in violation of § 1.4(c), and therefore relief based upon those inquiries is not granted, and those separate inquires are **dismissed**.

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth M. Schor

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

July 16, 2010
Ken reexam/EOT

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,402	01/26/2009	6,442,573 B1	F0657.70000US00	1370

22804 7590 07/27/2010

THE HECKER LAW GROUP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2010

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Date:

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JUL 27 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000402
PATENT NO. : 6442573
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 Patent Owner)

MAILED

JUL 27 2010

HUNTER D. KEETON
WOLF, GREENFIELD & SACKS
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

In re Schiller et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,402
Filed: January 26, 2009
For: U.S. Patent No. 6,442,573

: **DECISION**
: **GRANTING-IN-PART AND**
: **DISMISSING-IN-PART**
: **PETITION UNDER § 1.183**
:

This is a corrected decision on the June 4, 2010 patent owner petition pursuant to 37 C.F.R. § 1.183 requesting waiver of the rules for entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief. This decision replaces the decision on these petitions mailed on July 16, 2010, which is hereby **vacated**.

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

The petition under 37 C.F.R. § 1.183 is **granted** as to the request for rule waiver and an extension of time the extent specified below, but **dismissed** as to the request for entry of a corrected claim amendment and entry of a correctly scanned affidavit.

BACKGROUND

- On January 26, 2009, a corrected request for *inter partes* reexamination of U.S. Patent Number 6,442,573 B1, originally submitted on October 15, 2008, by third party requester Frame Media Inc. was accorded a filing date, and the resulting reexamination proceeding was assigned control number 95/000,402 ("the '402 proceeding").

- Prosecution progressed until, on May 4, 2010, a Right of Appeal Notice was issued by the Office. The Notice refused entry of a December 31, 2009 amendment and affidavit as noncompliant with § 1.116, and refused entry of patent owner comments submitted on December 31, 2009 as not addressing issues raised in a December 4, 2009 ACP.

- On June 4, 2010, patent owner filed the following petitions:

    - A petition entitled "PETITION PURSUANT TO 37 CFR 1.181 REQUESTING RECONSIDERATION OF THE EXAMINER'S EXPUNGEMENT OF THE PATENT OWNER'S RESPONSE UNDER 37 CFR 1.951 TO THE ACTION CLOSING PROSECUTION."

    - The instant petition filed under 37 C.F.R. § 1.183, requesting entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief.

- Also on June 4, 2010, Notices of Appeal were filed by both the patent owner and the third party requester.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 41.37 states, in pertinent part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
>
> (e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (Emphasis added)

37 C.F.R. § 41.61(b) states:

> (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.

37 C.F.R. § 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.

37 C.F.R. § 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.

DECISION

The present patent owner petition requests three separate types of relief under 37 C.F.R. § 1.183: entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief. 37 C.F.R. § 1.4(c) states that 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. As the present petition requests multiple distinct inquiries, the petition violates § 1.4(c). In the interest of providing special dispatch for the present proceeding, the request for extension of time will be taken up in this decision. The requests for entry of a corrected claim amendment and entry of a correctly scanned affidavit, however, are dismissed pursuant to § 1.4(c). Any future submission should be limited to a single subject or inquiry. It is further noted that relief under § 1.183 is an extraordinary remedy, and would not be available where another remedy exists; therefore, petitioner should not file any petition under that section while a petition for the same relief under another section (e.g., § 1.181) is outstanding.

The present patent owner petition for an extension of time was filed on June 4, 2010, simultaneously with filing of Notices of Appeal by patent owner and third party requester. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for "waiver the deadline for filing an appeal brief." Petition at 1-2. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

Pursuant to 37 C.F.R. § 41.66(a), the time for filing an appellant's brief is two months from the expiration of the time for filing (by the last party entitled to do so) a Notice of appeal or cross appeal. Once a party has filed a Notice of appeal, the other party has a 14 day period in which to file a Notice of cross-appeal, pursuant to § 41.61(b). In the present proceeding, Notices of appeal were filed by both parties on June 4, 2010. Therefore, the time for patent owner petitioner to file an Appeal Brief is due to expire on August 18, 2010. The outstanding petition under 37 C.F.R. § 1.181 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petition under § 1.181. A decision on the § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an Appeal Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appeal Brief is extended to run 30 days from the due date; i.e., September 17, 2010. In the interests of equity and uniformity, third party requester's time period to submit an appeal Brief is *sua sponte* extended to run 30 days from the due date; i.e., September 17, 2010.

If the petition under § 1.181 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed June 4, 2010 for filing an Appeal Brief is **granted to the extent stated above.**

2. The time for to file both the patent owner and third party requester Appeal Briefs is extended to run **30 days** from the § 41.61(b) due date; i.e., through September 17, 2010.

3. The separate inquiries addressed in the present petition; i.e., entry of a corrected claim amendment and entry of a correctly scanned affidavit, are in violation of § 1.4(c), and therefore relief based upon those inquiries is not granted, and those separate inquires are **dismissed**.

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

July 26, 2010
Ken reexam/EOT

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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.
95/000,403	09/26/2008	7411129	125448-41	3849

32914 7590 05/27/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/27/2010

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c/o DLA PIPER US LLP
203 N. LASALLE STREET, SUITE 1900
CHICAGO, IL 60601

Date: **MAILED**

MAY 27 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000403
PATENT NO. : 7411129
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 Patent Owner)

MAILED

MAY 27 2010

CENTRAL REEXAMINATION UNIT

PATENT GROUP
DLA PIPER LLP
203 N. LASALLES ST., SUITE 1900
CHICAGO, IL 60601

(For Third Party Requester)

In re Kummer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,403
Filed: September 26, 2008
For: U.S. Patent No. 7,411,129 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.183**

This is a decision on the April 29, 2010 patent owner petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."

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

The petition under 37 C.F.R. § 1.183 to request for rule waiver and an extension of time is **dismissed**.

FEES

The requisite petition fee for a petition under 37 C.F.R. § 1.183 is $400.00 pursuant to 37 C.F.R. § 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 07-0153 as authorized on page 1 of the petition.

BACKGROUND

- On September 26, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,403 ("the '403 proceeding").

- Prosecution progressed until, on March 30, 2010, a Right of Appeal Notice was issued by the Office.

- On April 29, 2009, patent owner filed the following petitions:

  - A petition entitled "PETITIONS REQUESTING ENTRY OF AMENDMENT AND CONTINUED REEXAMINATION UNDER 37 C.F.R. §§ 1.181 & 1.182."

  - The instant petition entitled ""PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On April 30, 2010, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.

- On May 14, 2010, third party requester filed a Notice of cross-appeal to the Board of Patent Appeals and Interferences.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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 § 41.37 states, in pertinent part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
>
> (e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (emphasis added)

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.

DECISION

The present patent owner petition for an extension of time was filed on April 29, 2010, prior to the patent owner filing of a Notice of Appeal on April 30, 2010. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for "waiver of the prohibition of an extension of time for filing an appeal brief." Petition at 1. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed Notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a Notice of cross-appeal was filed on May 14, 2010. Therefore, the time for patent owner petitioner to file an Appeal Brief is due to expire on July 14, 2010. The outstanding petition under 37 C.F.R. § 1.181 and § 1.182 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petition under § 1.181 and § 1.182. A decision on the § 1.181 and § 1.182 petition has not yet been rendered. However, more than a month and a half remains before the due date for filing of the appeal brief; more than 2 months remained when the petition was filed. Furthermore, granting patent owner's request for an indefinite extension of time, tied only to the date of the petition decision, is not in accord with the statutory mandate of special dispatch. Therefore, no sufficient cause exists, at this point in the proceeding, to extend the time for response.

If the petition under 37 C.F.R. § 1.181 and § 1.182 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than one month prior to the deadline as extended, then petitioner may file a petition for an additional extension of time for a specific amount of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed April 29, 2010 for filing an Appeal Brief is **dismissed**.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit.

3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

May 26, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,403	09/26/2008	7411129	125448-41	3849

32914 7590 07/07/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PATENT GROUP
c/o DLA PIPER US LLP
203 N. LASALLE STREET, SUITE 1900
CHICAGO, IL 60601

Date:
MAILED

JUL 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000403
PATENT NO. : 7411129
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
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DALLAS TX 75201-4761

(For Patent Owner)

PATENT GROUP
DLA PIPER LLP
203 N. LASALLES ST., SUITE 1900
CHICAGO, IL 60601

(For Third Party Requester)

In re Kummer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,403
Filed: September 26, 2008
For: U.S. Patent No. 7,411,129 B2

: **DECISION**
: **GRANTING PETITION**
: **UNDER § 1.183**

This is a decision on the June 30, 2010 patent owner petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR § 1.183."

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

The petition under 37 C.F.R. § 1.183 to request for rule waiver and an extension of time is **granted** to the extent specified below.

BACKGROUND

- On September 26, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,403 ("the '403 proceeding").

- Prosecution progressed until, on March 30, 2010, a Right of Appeal Notice was issued by the Office.

- On April 29, 2010, patent owner filed the following petitions:

- A petition entitled "PETITIONS REQUESTING ENTRY OF AMENDMENT AND CONTINUED REEXAMINATION UNDER 37 C.F.R. §§ 1.181 & 1.182."

- A petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On April 30, 2010, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.

- On May 14, 2010, third party requester filed a Notice of cross-appeal to the Board of Patent Appeals and Interferences.

- On May 27, 2010, the Office issued a decision dismissing the April 29, 2009 patent owner petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," as being premature.

- On June 30, 2010, patent owner filed the instant petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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 § 41.37 states, in pertinent part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
>
> (e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (Emphasis added)

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.

DECISION

The present patent owner petition for an extension of time was filed on June 30, 2010, subsequent to the patent owner filing of a Notice of Appeal on April 30, 2010. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for "waiver of the prohibition of an extension of time for filing an appeal brief." Petition at 1. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed Notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a Notice of cross-appeal was filed on May 14, 2010. Therefore, the time for patent owner petitioner to file an Appeal Brief is due to expire on July 14, 2010. The outstanding petition under 37 C.F.R. § 1.181 and § 1.182 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petition under § 1.181 and § 1.182. A decision on the § 1.181 and § 1.182 petition has not yet been rendered. In the event patent owner were to have filed an Appeal Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 and § 1.182 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appeal Brief is extended to run 30 days from the due date; i.e., August 13, 2010.

If the petitions under § 1.181 and § 1.182 have not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed June 30, 2010 for filing an Appeal Brief is **granted to the extent stated above.**

2. The time for to file an Appeal Brief is extended to run **30 days** from the previously extended due date; i.e., through August 13, 2010.

3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Kenneth M. Schor/

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

July 7, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,404	10/14/2008	6658035	23814-0003RX1	9276

25764 7590 01/22/2009

FAEGRE & BENSON LLP
PATENT DOCKETING
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402-3901

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/22/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,404	10/14/2008	6658035	23814-0003RX1	9276

25764 7590 01/22/2009

EXAMINER

Bing Ai
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

ART UNIT	PAPER NUMBER

DATE MAILED: 01/22/2009

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Paul G Koziol
FAEGRE & BENSON LLP
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MINNEAPOLIS MN 55402-3901

(For Patent Owner)

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JAN 22 2009

CENTRAL REEXAMINATION UNIT

Bing Ai
FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Mason *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,404
Deposited on: 14 October 2008
For: US Patent No. 6,658,035

This is a decision on the 14 January 2009, patent owner "Request for Extension of Time to Respond to an Inter Partes Reexamination Office Action (37 CFR § 1.956)," requesting that the time for responding to the Office action mailed 19 December 2008 to be extended by forty-five (45) days.

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 2 December 2003 US patent No. 6,658,035 was granted.

2. On 14 October 2008 a request for reexamination was filed by a third party requester for *Inter Parte* Reexamination with the Office.

3. On 19 December 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed with a non-final Office action.

4. On 14 January 2009 a petition for a forty-five (45) day extension of time was received.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 19 December 2008. The non-final Office action provides two (2) month period for response. The petition request for a forty-five (45) day extension of time was timely filed on 14 January 2009. The petition request authorizes electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

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.

Decision

The petition requests an extension of forty-five (45) additional days time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy many patents resulting in extensive numbers of rejections. The petitioner further notes related reexamination in which the response dates coincide.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one-month extension of time is hereby granted.

The petition request is hereby **granted-in-part**.

A **one-month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 19 December 2008 is **granted-in-part**.

2. A **one-month** extension of time is hereby granted.

3. The office action mailed set a two-months response time for which to respond, with the granting of this extension of time, the response period will end on **19 March 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.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,404	10/14/2008	6658035	23814-0003RX1	9276

25764 7590 02/23/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,404	10/14/08	6658035	

Bing Ai
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12390 EL CAMINO REAL
SAN DIEGO, CA 92130

EXAMINER	
NGUYEN, TUAN	
ART UNIT	**PAPER**
3992	

DATE MAILED:

02/23/09

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.

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(For Patent Owner)

BING AI
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

MAILED

FEB 23 2009

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,404
Filed: October 14, 2008
For: U.S. Patent No. 6,658,035

: DECISION
: DISMISSING
: PETITION

This is a decision on the patent owner paper entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)," filed on January 14, 2009.

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

Patent owner paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 by credit card on January 14, 2009.

REVIEW OF THE RELEVANT FACTS

1. On December 2, 2003, United States Patent Number 6,658,035 (the '035 patent) issued.

2. On October 14, 2008, a request for *inter partes* reexamination of the '035 patent, assigned Reexamination Control No. 95/000,404 (the '404 proceeding), was filed by third party requester Syntune AB.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '404 proceeding, with an accompanying Office action on the merits.

4. On January 14, 2009, patent owner filed the instant petition paper entitled, "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)" concurrently with a petition paper entitled,

"REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (petition for extension of time).

5. On January 22, 2009, the Office mailed a decision granting, in-part, patent owner's January 14, 2009 petition for extension of time. Patent owner's period for responding to the December 19, 2008 Office action has been extended one-month and will end on March 19, 2009.

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.

Patent Owner's Petition of January 14, 2009

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to permit patent owner to file a response to the December 19, 2008 Office action not to exceed 150 pages in length. Pet. at 1. In support of waiver of the rule, patent owner indicates that the December 19, 2008 Office action is 58 pages in length and that, in rejecting claims 1-82 of the '035 patent, "the Office Action incorporates by reference many of the detailed explanations from the 146 page Request for Reexamination submitted by the Requester." Pet. at 2. Patent owner further indicates that the Office action applies 28 different patents and printed publications and groups 6 different primary references with others "to provide at least 33 different combinations of references used in the rejection of one or more claims." Pet. at 2. On page 3 of the petition, patent owner asserts:

> The number of references applied against the claims is substantial. The number of specific bases for rejection set out in the Office Action is even greater. Well over 150 pages were effectively required in the Office Action just to set out the grounds for rejection. The Patent Owner simply cannot satisfactorily address all the references, respond to all of the different grounds of rejection and provide proper support for the arguments in a response of 50 pages or less.

Further in support of waiver of the rule, patent owner indicates that, due to the complexity of the technology at issue, patent owner expects to submit in support of its response one or more expert declarations, pages of which patent owner indicated will count toward the 50-page limit,

thereby reducing the number of pages available for patent owner "to properly argue over the many prior art references and grounds of rejection." Pet. at 3. Finally, patent owner indicates that the '035 patent is the subject of pending proceedings both in district court and at the International Trade Commission. Pet. at 3. Patent owner asserts that "[s]ignificant economic interests of the parties to these actions are at stake" so the results of the '404 reexamination proceeding "are vitally important." Pet. at 3. Accordingly, patent owner further asserts that "[r]estricting the Patent Owner's ability to respond to such an extensive and complex array of rejections under these circumstances would be unjust." Pet. at 3.

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. In this instance, petitioner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to the outstanding Office action to 150 pages. General requests unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

In this instance, petitioner has requested that the page limit for patent owner's response to the outstanding Office action be increased by 100 pages; however, petitioner has not set forth with specificity the facts upon which petitioner based its determination that 100 extra pages are needed for patent owner to adequately respond to the outstanding Office action. General statements regarding the extent of the examiner's use of incorporation by reference of requester's detailed explanations from the request and the extent to which the examiner did or did not adopt proposed rejections are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b). Rather, petitioner must make a thorough review of the Office action to more accurately determine the extent of the examiner's use of incorporation by reference and reasonably approximate the number of pages of the request that are incorporated into the Office action if this is to serve as the justification for increasing the page limit beyond the 50-page limit. For instance, one basis for petitioner's request for waiver of the page limit is that "[w]ell over 150 pages were effectively required in the Office Action just to set out the grounds for rejection." Pet. at 3. Petitioner did not specify, however, exactly how it arrived at its determination that the "effective length" of the December 19, 2008 Office action exceeds 150 pages. Presumably, petitioner arrived at the "effective length" by combining the length of the Office action (58 pages) and the length of the request (145 pages) in some unspecified fashion.

A cursory review of the record in the '404 proceeding indicates that the examiner's use of incorporation by reference is not as extensive as petitioner suggests. Notably, the examiner appears to have fully explained the rejections of the two independent claims and appears to have limited the use of incorporation by reference of requester's detailed explanations from the request to only the rejections of the dependent claims. Moreover, it appears that the number of proposed rejections not adopted by the examiner is not as few as petitioner suggests as several pages of the December 19, 2008 Office action include discussion of reasons why the examiner

did not adopt certain proposed rejections (*e.g.*, pages 36-37, 38-39, 43-44, 45-46, and 48). Accordingly, petitioner must substantiate its conclusion that the "effective length" of the Office action exceeds 150 pages with specific facts from the record in order to serve as justification for waiver of 37 CFR 1.943(b).

Additionally, the submission of supporting expert declarations or affidavits, alone, is not a basis for waiver of 37 CFR 1.943(b) as patent owner can fashion the content of such declarations or affidavits to avoid having the pages count toward the 50-page limit. That is, patent owner can limit the content of the expert declarations or affidavits to factual observations and avoid including any legal conclusions about the factual observations. *See* MPEP 2667(I)(A)(2).

Perhaps the best showing petitioner can make to support a request for waiver of the 50-page limit of 37 CFR 1.943(b) is to attempt to draft a patent owner's response in compliance with the 50-page limit, and submit a proposed response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) 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, patent owner 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 patent owner petition under 37 CFR 1.183 is **dismissed**.

2. Patent owner's response to the December 19, 2008 Office action is due no later than March 19, 2009 and is not to exceed 50 pages in accordance with 37 CFR 1.943(b).

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 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,404	10/14/2008	6658035	23814-0003RX1	9276

25764 7590 03/18/2009

EXAMINER

FAEGRE & BENSON LLP
PATENT DOCKETING - INTELLECTUAL PROPERTY
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402-3901

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2009

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SAN DIEGO, CA 92130

Date:
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MAR 18 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000404
PATENT NO. : 6658035
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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MAR 18 2009

CENTRAL REEXAMINATION UNIT

Paul G Koziol
FAEGRE & BENSON LLP
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MINNEAPOLIS MN 55402-3901

(For Patent Owner)

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P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Mason *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,404
Deposited on: 14 October 2008
For: US Patent No. 6,658,035

This is a decision on the 11 March 2009, patent owner second "Request for Extension of Time to Respond to an *Inter Partes* Reexamination Office Action (37 CFR § 1.956)," requesting that the time for responding to the Office action mailed 19 December 2008 to be extended by an additional seven (7) days

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

The petition is dismissed for the reasons set forth below.

Statement of Relevant Facts

1. On 2 December 2003 US patent No. 6,658,035 was granted.

2. On 14 October 2008 a request for reexamination was filed by a third party requester for *Inter Parte* Reexamination with the Office.

3. On 19 December 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed with a non-final Office action.

4. On 14 January 2009 a petition for a forty-five (45) day extension of time was received.

5. On 23 January 2009 a decision granting-in-part the request for extension of time was mailed. The time granted-in-part was for one (1) month.

6. On 11 March 2009 a second petition for extension of time was submitted for consideration requesting additional seven (7) days extension of time.

Discussion

The Patent Owner requests a second extension of time in which to file a response to the non-final Office action was mailed 19 December 2008. The non-final Office action provides two (2) month period for response. The first petition for extension of time which was granted-in-part further extended the response time by one (1) month. The second petition request for a seven (7) day extension of time was timely filed on 11 March 2009. The petition request authorizes electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

The request is dismissed.

> **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)

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. **Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.** [emphasis added]

Decision

The petition requests a second extension of seven (7) additional days time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner again notes that the Office action is lengthy many patents resulting in extensive numbers of rejections. The petitioner further notes related reexamination in which the response dates coincide.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is not "sufficient cause" to grant the petition for an additional extension of time. Second requests for extension of time, or requests greater than one (1) month, will be granted only in extraordinary situations, pursuant to MPEP § 2665.

The petition request is hereby **dismissed**.

Conclusion

1. The patent owner's second petition for further extension of time in which to file a response to the Office action dated 19 December 2008 is **dismissed**.

2. The response period will end on **19 March 2009**.

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,404	10/14/2008	6658035	23814-0003RX1	9276

25764 7590 05/14/2009

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ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000404
PATENT NO. : 6658035
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 Patent Owner)

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P.O. Box 1022
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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,404
Filed: October 14, 2008
For: U.S. Patent No. 6,658,035

DECISION GRANTING PETITION

This is a decision on the patent owner paper entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)," filed on March 19, 2009.

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

The petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card, as authorized on page 5 of the petition.

REVIEW OF THE RELEVANT FACTS

1. On December 2, 2003, United States Patent Number 6,658,035 (the '035 patent) issued.

2. On October 14, 2008, a request for *inter partes* reexamination of the '035 patent, assigned Reexamination Control No. 95/000,404 (the '404 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '404 proceeding, with an accompanying Office action on the merits.

4. On January 14, 2009, patent owner filed a petition paper entitled, "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)" (petition under 37 CFR 1.183) concurrently with a petition paper entitled, "REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (petition for extension of time).

5. On January 22, 2009, the Office mailed a decision granting in-part patent owner's January 14, 2009 petition for extension of time.

6. On February 23, 2009, the Office mailed a decision dismissing patent owner's January 14, 2009 petition under 37 CFR 1.183.

7. On March 19, 2009, patent owner filed the instant renewed petition entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)" (renewed petition under 37 CFR 1.183).

8. Concurrently on March 19, 2009, patent owner filed an "AMENDMENT AND RESPONSE BY PATENT OWNER TO FIRST OFFICE ACTION (37 C.F.R. §§ 1.943 & 1.945)," with accompanying declarations, in response to the December 19, 2008 Office action.

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.

On March 19, 2009, concurrently with the renewed petition under 37 CFR 1.183, patent owner filed a response with accompanying declarations to the December 19, 2008 Office action. Patent owner asserts that the March 19, 2009 response and accompanying declarations include 137 pages of arguments: 70 pages from the remarks section of the response, 59 pages from the declaration of Luke F. Lester and 8 pages from the declaration of Thomas Hankin and Mark

Thomas.[1] Thus, based on patent owner's assertions, the arguments portions of patent owner's response and accompanying declarations exceed the 50-page limit set forth in 37 CFR 1.943(b) by 87 pages.[2] In the renewed petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the March 19, 2009 response and accompanying declarations.

On February 23, 2009, the Office mailed a decision dismissing patent owner's January 14, 2009 petition under 37 CFR 1.183, stating that "[g]eneral requests unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b)."[3] The February 23, 2009 decision also stated that "[p]erhaps the best showing petitioner can make to support a request for waiver of the 50-page limit of 37 CFR 1.943(b) is to attempt to draft a patent owner's response in compliance with the 50-page limit" so that "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."[4]

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the present March 19, 2009 renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Further, in the renewed petition under 1.183, patent owner has substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts justifying an increase in the number of pages available for patent owner to respond to the December 19, 2008 Office action.[5] Additionally, patent owner has provided detailed explanations of how the submitted response and accompanying declarations economize, exclude extraneous material, and are arranged so as not to repeat information already of record.[6]

Based on the specific facts and explanations set forth in the renewed petition under 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response, which is in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the arguments portions of patent owner's March 19, 2009 response and accompanying declarations exceed the 50-page limit by 87 pages.

---

[1] The total number of pages of the response and accompanying declarations asserted by patent owner to contain arguments adds up to 137 pages (70 pages from the remarks section of the response, 59 pages from the declaration of Luke F. Lester and 8 pages from the declaration of Thomas Hankin and Mark Thomas). It is noted that in the first full paragraph on page 4 of the renewed petition under 1.183, patent owner asserts that 139 pages are required, but in the conclusion paragraph on the same page patent owner asserts that 137 pages are required.

[2] Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2).

[3] *See* February 23, 2009 decision at page 3.

[4] *See* February 23, 2009 decision at page 4.

[5] *See* renewed petition under 1.183 at pages 2-4

[6] *See* renewed petition under 1.183 at pages 3-4.

Accordingly, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 87 pages of the arguments portions of patent owner's March 19, 2009 response and accompanying declarations that exceed the 50-page limit.

CONCLUSION

1. Patent owner's renewed petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) is waived as to 87 pages of the arguments portions of patent owner's March 19, 2009 response and accompanying declarations that exceed the 50-page limit.

2. Jurisdiction for the '404 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

Kenpet7\IP\length
5-12-09

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25764 7590 09/11/2009

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ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000404
PATENT NO. : 6658035
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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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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SAN DIEGO, CA 92130

(For Third Party Requester)

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SEP 11 2009

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,404
Filed: October 14, 2008
For: U.S. Patent No. 6,658,035

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

This is a decision on patent owner's petition paper entitled "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)," filed on July 7, 2009.

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

The petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

FEES

The petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card, as authorized on page 4 of the petition.

REVIEW OF THE RELEVANT FACTS

1. On December 2, 2003, United States Patent Number 6,658,035 (the '035 patent) issued.

2. On October 14, 2008, a request for *inter partes* reexamination of the '035 patent, assigned Reexamination Control No. 95/000,404 (the '404 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '404 proceeding, with an accompanying Office action on the merits.

4. On March 19, 2009, patent owner timely filed a response entitled "AMENDMENT AND RESPONSE BY PATENT OWNER TO FIRST OFFICE ACTION (37 C.F.R. §§ 1.943 & 1.945)" in the '404 proceeding.

5. On March 20, 2009, third party requester filed a paper entitled "REQUESTER'S NOTICE TO THE PATENT OFFICE," notifying the Office of third party requester's withdrawal from participation in the '404 proceeding.

6. On July 7, 2009, patent owner filed the instant "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R. §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)" (petition under 37 CFR 1.183).

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

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

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

In the July 7, 2009 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.903, requiring patent owner to serve papers on third party requester, and waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, in view of third party requester's March 20, 2009 withdrawal from participation in the '404 proceeding.[1] 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.

Request to Waive the Service of Papers Requirements of 37 CFR 1.903

In support of its request for waiver of 37 CFR 1.903, patent owner asserts that because third party requester has withdrawn from participating in the '404 proceeding, "service of papers on the Requester is no longer necessary, and only creates administrative inconvenience for both the Patent Owner and the Requester."[2]

Patent owner is advised that the requirement of serving the third party requester with any document filed by patent owner in the *inter partes* proceeding still applies despite third party requester's withdrawal from participation in the '404 proceeding, as such service of papers is not a third party requester participation in the proceeding. Further, administrative inconvenience does not give rise to an extraordinary situation in which justice requires suspension of the service requirements of 37 CFR 1.903.

But, most important, 35 U.S.C. 314(b)(1) provides: "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." 37 CFR 1.183 is clear that it does not apply to a "requirement of the regulations in this part which is not a requirement of the statutes," and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of 37 CFR 1.903 is dismissed.

Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In patent owner's petition under 37 CFR 1.183, patent owner requests for "a waiver of the requirements of 37 C.F.R § 1.955."[3] In support of its request for waiver of 37 CFR 1.955, patent owner states that because third party requester has withdrawn from participating in the '404 proceeding, "only a single party (patent owner) will now participate in the present *inter partes* reexamination proceeding."[4] Patent owner asserts that "[t]he issues in the present *inter partes* reexamination proceeding are complex, and an interview between representatives of the Patent Office and the Patent Owner may assist the Office in expeditiously resolving the present

[1] Petition under 37 CFR 1.183 at pages 1-2.
[2] Id. at page 3.
[3] Id. at page 2.
[4] Id.

proceeding" and that "by granting a waiver of 37 C.F.R § 1.955, special dispatch will be promoted in accordance with the statutory requirements of 35 U.S.C. § 314(c)."[5] Further, patent owner asserts that, with third party requester no longer participating in the '404 proceeding, "no harm would come to any party if the requested waiver is granted."[6]

In the instant petition under 37 CFR 1.183, patent owner has requested waiver of the prohibition against interviews under 37 CFR 1.955, generally, as opposed to waiver of the regulation for a particular interview request. In this instance, patent owner has not set forth with specificity facts that give rise to an extraordinary situation in which justice requires suspension of 37 CFR 1.955. Patent owner is advised that patent owner may petition under 37 CFR 1.183 for waiver of the prohibition of interviews on the merits on an interview-by-interview basis. Patent owner is reminded that, in each such instance, the petition must establish an extraordinary situation in which justice requires waiver of the regulation.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of 37 CFR 1.955 is dismissed. In the event patent owner files a renewed petition under 37 CFR 1:183 for waiver of 37 CFR 1.955 as to this particular interview request, no additional fee need be submitted; however, a separate petition paper and petition fee would need to be submitted for each interview request subsequent to the renewed request.

CONCLUSION

1. Patent owner's July 7, 2009 petition paper entitled "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)" is dismissed.

2. Jurisdiction for the '404 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

Kenpet7/IP
9-10-09

[5] Id.
[6] Id. at page 3.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,404	10/14/2008	6658035	23814-0003RX1	9276

25764 7590 11/19/2008

FAEGRE & BENSON LLP
PATENT DOCKETING - INTELLECTUAL PROPERTY
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90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402-3901

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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P.O. BOX 1022
MINNEAPOLIS, MN 55402-1022

Date:
MAILED

NOV 19 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000404
PATENT NO. : 6658035
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 Patent Owner)

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CENTRAL REEXAMINATION UNIT

BING AI
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,404
Filed: October 14, 2008
For: U.S. Patent No. 6,658,035

DECISION GRANTING PETITION

This is a decision on patent owner's petition paper entitled "RENEWED PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R § 1.955 (37 C.F.R. § 1.183)," filed on September 18, 2009.

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

No fee is required for the renewed petition under 37 CFR 1.183.[1]

The petition under 37 CFR 1.183 is granted to the extent set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On December 2, 2003, United States Patent Number 6,658,035 (the '035 patent) issued.

2. On October 14, 2008, a request for *inter partes* reexamination of the '035 patent, assigned Reexamination Control No. 95/000,404 (the '404 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '404 proceeding, with an accompanying Office action on the merits.

[1] *See* September 11, 2009 decision dismissing patent owner's July 7, 2009 petition under 37 CFR 1.183.

4. On March 19, 2009, patent owner timely filed a response entitled "AMENDMENT AND RESPONSE BY PATENT OWNER TO FIRST OFFICE ACTION (37 C.F.R. §§ 1.943 & 1.945)" in the '404 proceeding.

5. On March 20, 2009, third party requester filed a paper entitled "REQUESTER'S NOTICE TO THE PATENT OFFICE," notifying the Office of third party requester's withdrawal from participation in the '404 proceeding.

6. On July 7, 2009, patent owner filed a petition paper entitled "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R. §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)" (petition under 37 CFR 1.183).

7. On September 11, 2009, the Office mailed a decision dismissing patent owner's July 7, 2009 petition under 37 CFR 1.183.

8. On September 18, 2009, patent owner filed the instant petition paper entitled "RENEWED PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.955 (37 C.F.R. § 1.183)" (renewed petition under 37 CFR 1.183).

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Renewed Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In the September 18, 2009 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, to conduct a single interview with the Office prior to issuance of the next Office action.[2] The instant petition has been fully considered. 37 CFR 1.183 provides for suspension or

[2] Renewed petition under 37 CFR 1.183 at pages 3-4.

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.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form.[3] The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it."[4] Thus, the basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the '404 *inter partes* reexamination proceeding.[5] Thus, only a single party (patent owner) will now participate in the '404 *inter partes* reexamination proceeding, and any interview that might be permitted in the proceeding. Based on the present facts and circumstances, it is found that permitting an interview to be conducted at this point in the '404 *inter partes* proceeding would not be anticipated to potentially hinder the ability of the Office to conduct the '404 *inter partes* proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office prior to issuance of the next Office action, patent owner asserts that, given the complexity of the subject technology (integrated photonic circuits), an interview would "enhance the understanding of the technology and the relevant patentability issues."[6] Patent owner also asserts that, given the number of outstanding rejections ("a total of over 500 individual rejections applied to the 82 claims"), an interview "may assist the Office in reducing the number of issues associated with these rejections."[7] Further, patent owner asserts that, given the amount of information under consideration, such as patent owner's 139-page March 19, 2009 response, an interview "would

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[3] 65 FR at 76768.

[4] 65 FR at 76769.

[5] *Requester's Notice to the Patent Office*, filed March 20, 2009 (stating "Requester Syntune AB hereby notifies the Patent Office that it has reached a Settlement Agreement with the patent owner JDS Uniphase Corporation ("JDSU") and that a settlement and compromise has been reached such that the issues of validity, enforceability, and infringement are no longer in dispute between Syntune and JDSU. ... Accordingly, as part of the Settlement Agreement, Syntune will no longer participate in the Inter Partes Reexamination of U.S. Patent No. 6,658,035, assigned PTO Control No. 95/000,404 and initiated by a request filed on October 14, 2008.")

[6] Renewed petition under 37 CFR 1.183 at page 3.

[7] Renewed petition under 37 CFR 1.183 at page 3.

provide an opportunity to discuss the substance of the Patent Owner's response in view of the outstanding rejections to clarify and focus the issues...."[8]

In view of the particular facts and circumstances set forth herein, in this instance, the record in the '404 *inter partes* reexamination proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceedings, and the Office. Thus, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that a single interview will be permitted. It is noted, however, that there are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted to the extent that patent owner satisfies the following preliminary requirements.[9]

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.

2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interviews will not be permitted at any other time or place, without the authority of the Director.

---

[8] Renewed petition under 37 CFR 1.183 at page 3.

[9] The requirements and guidelines are analogous to those set forth in MPEP 2281 for interviews in *ex parte* reexamination proceedings.

2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by the conferees who signed the December 19, 2008 Office action, or their substitutes (if the conferees are not reasonably available).

4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto. A copy of the interview summary should be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original will be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed either as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview, whichever is later.

2. All papers filed by patent owner in the '404 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's September 18, 2009 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is granted to the extent that a single interview will be permitted, upon compliance with the Preliminary Requirements set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the December 19, 2008 Office action.

3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.

4. Jurisdiction over the '404 inter partes reexamination proceeding is returned to Art Unit 3993 of the Central Reexamination Unit for action not inconsistent with this Decision.

5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

kenInterview/
11-18-09

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(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Mason *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,405
Deposited on: 16 October 2008
For: US Patent No. 6,687,278

This is a decision on the 14 January 2009, patent owner "Request for Extension of Time to Respond to an Inter Partes Reexamination Office Action (37 CFR § 1.956)," requesting that the time for responding to the Office action mailed 19 December 2008 to be extended by forty-five (45) days

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 3 February 2004 US patent No. 6,687,278 was granted.

2. On 16 October 2008 a request for reexamination was filed by a third party requester for *Inter Parte* Reexamination with the Office.

3. On 19 December 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed with a non-final Office action.

4. On 14 January 2009 a petition for a forty-five (45) day extension of time was received.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 19 December 2008. The non-final Office action provides two (2) month period for response. The petition requestion a forty-five (45) day extension of time was timely filed on 4 January 2009. The petition request authorizes electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

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.

Decision

The petition requests an extension of forty-five (45) additional days time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy many patents resulting in extensive numbers of rejections. The petitioner further notes related reexamination in which the response dates coincide.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A fourteen (14) day extension of time is hereby granted.

The petition request is hereby **granted-in-part**.

A **one-month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 19 December 2008 is **granted-in-part**.

2. A **one-month** extension of time is hereby granted.

3. The office action mailed set a two-months response time for which to respond with the granting of this extension of time will end on **19 March 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.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,405
Filed: October 16, 2008
For: U.S. Patent No. 6,687,278

: DECISION
: DISMISSING
: PETITION

This is a decision on the patent owner paper entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)," filed on January 14, 2009.

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

Patent owner paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 by credit card on January 14, 2009.

REVIEW OF THE RELEVANT FACTS

1. On February 3, 2004, United States Patent Number 6,687,278 (the '278 patent) issued.

2. On October 16, 2008, a request for *inter partes* reexamination of the '278 patent, assigned Reexamination Control No. 95/000,405 (the '405 proceeding), was filed by third party requester Syntune AB.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '405 proceeding, with an accompanying Office action on the merits.

4. On January 14, 2009, patent owner filed the instant petition paper entitled, "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)" concurrently with a petition paper entitled, "REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (petition for extension of time).

5. On January 16, 2009, the Office mailed a decision granting, in-part, patent owner's January 14, 2009 petition for extension of time. Patent owner's period for responding to the December 19, 2008 Office action has been extended one-month and will end on March 19, 2009.

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.

Patent Owner's Petition of January 14, 2009

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to permit patent owner to file a response to the December 19, 2008 Office action not to exceed 150 pages in length. Pet. at 1. In support of waiver of the rule, patent owner indicates that the December 19, 2008 Office action "is 54 pages in length, yet it includes only summaries of the rejections of all claims 1-26 in the ['278] patent," and that "[i]nstead of explaining the bases of the rejections, the Office Action incorporates by reference many of the detailed explanations from the 136 page Request for Reexamination by the Requester." Pet. at 2. Patent owner further indicates that the Office action applies 29 different patents and printed publications and groups 4 different primary references with others "to provide at least 37 different combinations of references used in the rejection of one or more claims," and that "[w]ith only very few exceptions, all the grounds for rejection set out in the request for reexamination were adopted and incorporated into the Office Action." On page 3 of the petition, patent owner asserts:

> The number of references applied against the claims is substantial. The number of specific bases for rejection set out in the Office Action is even greater. Well over 150 pages were effectively required in the Office Action just to set out the grounds for rejection. The Patent Owner simply cannot satisfactorily address all the references, respond to all of the different grounds of rejection and provide proper support for the arguments in a response of 50 pages or less.

Further in support of waiver of the rule, patent owner further indicates that, due to the complexity of the technology at issue, patent owner expects to submit in support of its response

one or more expert declarations, pages of which patent owner indicated will count toward the 50-page limit, thereby reducing the number of pages available for patent owner "to properly argue over the many prior art references and grounds of rejection." Pet. at 3. Finally, patent owner indicates that the '278 patent is the subject of pending proceedings both in district court and at the International Trade Commission. Pet. at 3. Patent owner asserts that "[s]ignificant economic interests of the parties to these are at stake" so the results of the '405 reexamination proceeding "are vitally important." Pet. at 3. Accordingly, patent owner further asserts that "[r]estricting the Patent Owner's ability to respond to such an extensive and complex array of rejections under these circumstances would be unjust." Pet. at 3.

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. In this instance, petitioner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to the outstanding Office action to 150 pages. General requests unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

In this instance, petitioner has requested that the page limit for patent owner's response to the outstanding Office action be increased by 100 pages; however, petitioner has not set forth with specificity the facts upon which petitioner based its determination that 100 extra pages are needed for patent owner to adequately respond to the outstanding Office action. General statements regarding the extent of the examiner's use of incorporation by reference of requester's detailed explanations from the request and the extent to which the examiner did or did not adopt proposed rejections are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b). Rather, petitioner must make a thorough review of the Office action to more accurately determine the extent of the examiner's use of incorporation by reference and reasonably approximate the number of pages of the request that are incorporated into the Office action if this is to serve as the justification for increasing the page limit beyond the 50-page limit. For instance, one basis for petitioner's request for waiver of the page limit is that "[w]ell over 150 pages were effectively required in the Office Action just to set out the grounds for rejection." Pet. at 3. Petitioner did not specify, however, exactly how it arrived at its determination that the "effective length" of the December 19, 2008 Office action exceeds 150 pages. Presumably, petitioner arrived at the "effective length" by combining the length of the Office action (54 pages) and the length of the request (120 pages) in some unspecified fashion.

A cursory review of the record in the '405 proceeding indicates that the examiner's use of incorporation by reference is not as extensive as petitioner suggests. Notably, the examiner appears to have fully explained the rejections of the two independent claims and appears to have limited the use of incorporation by reference of requester's detailed explanations from the request to only the rejections of the dependent claims. Moreover, it appears that the number of proposed rejections not adopted by the examiner is not as few as petitioner suggests as several pages of the December 19, 2008 Office action include discussion of reasons why the examiner

did not adopt certain proposed rejections (*e.g.*, pages 38-39, 40-41, 45-46, and 47-48). Accordingly, petitioner must substantiate its conclusion that the "effective length" of the Office action exceeds 150 pages with specific facts from the record in order to serve as justification for waiver of 37 CFR 1.943(b).

Additionally, the submission of supporting expert declarations or affidavits, alone, is not a basis for waiver of 37 CFR 1.943(b) as patent owner can fashion the content of such declarations or affidavits to avoid having the pages count toward the 50-page limit. That is, patent owner can limit the content of the expert declarations or affidavits to factual observations and avoid including any legal conclusions about the factual observations. *See* MPEP 2667(I)(A)(2).

Perhaps the best showing petitioner can make to support a request for waiver of the 50-page limit of 37 CFR 1.943(b) is to attempt to draft a patent owner's response in compliance with the 50-page limit, and submit a proposed response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) 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, patent owner 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 patent owner petition under 37 CFR 1.183 is **dismissed**.

2. Patent owner's response to the December 19, 2008 Office action is due no later than March 19, 2009 and is not to exceed 50 pages in accordance with 37 CFR 1.943(b).

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 Nicole D. Dretar, Legal Advisor, at 571-272-7717.

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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MAR 18 2009

CENTRAL REEXAMINATION UNIT

Paul G Koziol
FAEGRE & BENSON LLP
PATENT DOCKETING
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS MN 55402-3901

(For Patent Owner)

Bing Ai
FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

DECISION GRANTING IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]

In re: Mason *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,405
Deposited on: 16 October 2008
For: US Patent No. 6,687,278

This is a decision on the 11 March 2009, patent owner second "Request for Extension of Time to Respond to an *Inter Partes* Reexamination Office Action (37 CFR § 1.956)," requesting that the time for responding to the Office action mailed 19 December 2008 to be extended by seven (7) days

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

The petition is dismissed for the reasons set forth below.

Statement of Relevant Facts

1. On 3 February 2004 US patent No. 6,687,278 was granted.

2. On 16 October 2008 a request for reexamination was filed by a third party requester for *Inter Parte* Reexamination with the Office.

3. On 19 December 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed with a non-final Office action.

4. On 14 January 2009 a petition for a forty-five (45) day extension of time was received.

5. On 23 January 2009 a decision granting-in-part the request for extension of time was mailed. The time granted was for one (1) month.

6. On 11 March 2009 a second petition for extension of time was submitted for consideration requesting additional seven (7) days extension of time.

Discussion

The Patent Owner requests a second extension of time in which to file a response to the non-final Office action was mailed 19 December 2008. The non-final Office action provides two (2) month period for response. The first petition for extension of time which was granted-in-part further extended the response time by one (1) month. The second petition request for a seven (7) day extension of time was timely filed on 11 March 2009. The petition request authorizes electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

The request is dismissed.

> **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)

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. **Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.** [emphasis added]

Decision

The petition requests a second extension of seven (7) additional days time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner again notes that the Office action is lengthy many patents resulting in extensive numbers of rejections. The petitioner further notes related reexamination in which the response dates coincide.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is not "sufficient cause" to grant the petition for an additional extension of time. Second requests for extension of time, or requests greater than one (1) month, will be granted only in extraordinary situations, pursuant to MPEP § 2665.

The petition request is hereby **dismissed**.

Conclusion

1. The patent owner's second petition for further extension of time in which to file a response to the Office action dated 19 December 2008 is **dismissed**.

2. The response period will end on **19 March 2009**.

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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.
95/000,405	10/16/08	6687278	

EXAMINER
NGUYEN, TUAN

BING AI
FISH & RICHARDSON PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

ART UNIT	PAPER
3992	

DATE MAILED:

05/13/09

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

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.
95/000,405	10/16/2008	6687278	G&C 235.3-US-RX	9285

25764 7590 05/13/2009

FAEGRE & BENSON LLP
PATENT DOCKETING - INTELLECTUAL PROPERTY
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402-3901

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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(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

BING AI
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,405
Filed: October 16, 2008
For: U.S. Patent No. 6,687,278

DECISION GRANTING PETITION

This is a decision on patent owner's renewed petition entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)," filed on March 19, 2009.

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

The petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card, as authorized on page 5 of the petition.

The petition under 37 CFR 1.183 is granted.

REVIEW OF THE RELEVANT FACTS

1. On February 3, 2004, United States Patent Number 6,687,278 (the '278 patent) issued.

2. On October 16, 2008, a request for *inter partes* reexamination of the '278 patent, assigned Reexamination Control No. 95/000,405 (the '405 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '405 proceeding, with an accompanying Office action on the merits.

4. On January 14, 2009, patent owner filed a petition paper entitled, "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)" (petition under 37 CFR 1.183) concurrently with a petition paper entitled, "REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (petition for extension of time).

5. On January 16, 2009, the Office mailed a decision granting in-part patent owner's January 14, 2009 petition for extension of time.

6. On February 23, 2009, the Office mailed a decision dismissing patent owner's January 14, 2009 petition under 37 CFR 1.183.

7. On March 19, 2009, patent owner filed the instant renewed petition entitled "PETITION TO SUSPEND PAGE LIMIT FOR RESPONSE TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. §§ 1.183 AND 1.943)" (renewed petition under 37 CFR 1.183).

8. Concurrently on March 19, 2009, patent owner filed an "AMENDMENT AND RESPONSE BY PATENT OWNER TO FIRST OFFICE ACTION (37 C.F.R. §§ 1.943 & 1.945)," with accompanying declarations, in response to the December 19, 2008 Office action.

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.

On March 19, 2009, concurrently with the renewed petition under 37 CFR 1.183, patent owner filed a response with accompanying declarations to the December 19, 2008 Office action. Patent owner asserts that the March 19, 2009 response and accompanying declarations include 131 pages of arguments: 70 pages from the remarks section of the response, 53 pages from the declaration of Luke F. Lester and 8 pages from the declaration of Peter Hankin and Mark

Thomas.[1] Thus, based on patent owner's assertions, the arguments portions of patent owner's response and accompanying declarations exceed the 50-page limit set forth in 37 CFR 1.943(b) by 81 pages.[2] In the renewed petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the March 19, 2009 response and accompanying declarations.

On February 23, 2009, the Office mailed a decision dismissing patent owner's January 14, 2009 petition under 37 CFR 1.183, stating that "[g]eneral requests unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b)."[3] The February 23, 2009 decision also stated that "[p]erhaps the best showing petitioner can make to support a request for waiver of the 50-page limit of 37 CFR 1.943(b) is to attempt to draft a patent owner's response in compliance with the 50-page limit" so that "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."[4]

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the present March 19, 2009 renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Further, in the renewed petition under 1.183, patent owner has substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts justifying an increase in the number of pages available for patent owner to respond to the December 19, 2008 Office action.[5] Additionally, patent owner has provided detailed explanations of how the submitted response and accompanying declarations economize, exclude extraneous material, and are arranged so as not to repeat information already of record.[6]

Based on the specific facts and explanations set forth in the renewed petition under 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response, which is in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the arguments portions of patent owner's March 19, 2009 response and accompanying declarations exceed the 50-page limit by 81 pages.

---

[1] The total number of pages of the response and accompanying declarations asserted by patent owner to contain arguments adds up to 131 pages (70 pages from the remarks section of the response, 53 pages from the declaration of Luke F. Lester and 8 pages from the declaration of Peter Hankin and Mark Thomas). It is noted that in the first full paragraph on page 4 of the renewed petition under 1.183, patent owner asserts that 139 pages are required, but in the conclusion paragraph on the same page patent owner asserts that 131 pages are required.

[2] Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2).

[3] *See* February 23, 2009 decision at page 3.

[4] *See* February 23, 2009 decision at page 4.

[5] *See* renewed petition under 1.183 at pages 2-4

[6] *See* renewed petition under 1.183 at pages 3-4.

Accordingly, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 81 pages of the arguments portions of patent owner's March 19, 2009 response and accompanying declarations that exceed the 50-page limit.

CONCLUSION

1. Patent owner's renewed petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) is waived as to 81 pages of the arguments portions of patent owner's March 19, 2009 response and accompanying declarations that exceed the 50-page limit.

2. Jurisdiction for the '405 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

Kenpet7\IP\length
5-12-09

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.
95/000,405	10/16/2008	6687278	G&C 235.3-US-RX	9285

25764 7590 09/11/2009

FAEGRE & BENSON LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON, PC
P.O. BOX 1022
Minneapolis, MN 55440-1022

Date: MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000405
PATENT NO. : 6687278
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
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

BING AI
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,405
Filed: October 16, 2008
For: U.S. Patent No. 6,687,278

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

This is a decision on patent owner's petition paper entitled "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)," filed on July 7, 2009.

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

The petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

FEES

The petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card, as authorized on page 4 of the petition.

REVIEW OF THE RELEVANT FACTS

1. On February 3, 2004, United States Patent Number 6,687,278 (the '278 patent) issued.

2. On October 16, 2008, a request for *inter partes* reexamination of the '278 patent, assigned Reexamination Control No. 95/000,405 (the '405 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '405 proceeding, with an accompanying Office action on the merits.

4. On March 19, 2009, patent owner timely filed a response entitled "AMENDMENT AND RESPONSE BY PATENT OWNER TO FIRST OFFICE ACTION (37 C.F.R. §§ 1.943 & 1.945)" in the '405 proceeding.

5. On March 20, 2009, third party requester filed a paper entitled "REQUESTER'S NOTICE TO THE PATENT OFFICE," notifying the Office of third party requester's withdrawal from participation in the '405 proceeding.

6. On July 7, 2009, patent owner filed the instant "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R. §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)" (petition under 37 CFR 1.183).

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

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

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

In the July 7, 2009 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.903, requiring patent owner to serve papers on third party requester, and waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, in view of third party requester's March 20, 2009 withdrawal from participation in the '405 proceeding.[1] 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.

Request to Waive the Service of Papers Requirements of 37 CFR 1.903

In support of its request for waiver of 37 CFR 1.903, patent owner asserts that because third party requester has withdrawn from participating in the '405 proceeding, "service of papers on the Requester is no longer necessary, and only creates administrative inconvenience for both the Patent Owner and the Requester."[2]

Patent owner is advised that the requirement of serving the third party requester with any document filed by patent owner in the *inter partes* proceeding still applies despite third party requester's withdrawal from participation in the '405 proceeding, as such service of papers is not a third party requester participation in the proceeding. Further, administrative inconvenience does not give rise to an extraordinary situation in which justice requires suspension of the service requirements of 37 CFR 1.903.

But, most important, 35 U.S.C. 314(b)(1) provides: "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." 37 CFR 1.183 is clear that it does not apply to a "requirement of the regulations in this part which is not a requirement of the statutes," and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of 37 CFR 1.903 is dismissed.

Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In patent owner's petition under 37 CFR 1.183, patent owner requests for "a waiver of the requirements of 37 C.F.R § 1.955."[3] In support of its request for waiver of 37 CFR 1.955, patent owner states that because third party requester has withdrawn from participating in the '405 proceeding, "only a single party (patent owner) will now participate in the present *inter partes* reexamination proceeding."[4] Patent owner asserts that "[t]he issues in the present *inter partes* reexamination proceeding are complex, and an interview between representatives of the Patent Office and the Patent Owner may assist the Office in expeditiously resolving the present

[1] Petition under 37 CFR 1.183 at pages 1-2.
[2] Id. at page 3.
[3] Id. at page 2.
[4] Id.

proceeding" and that "by granting a waiver of 37 C.F.R § 1.955, special dispatch will be promoted in accordance with the statutory requirements of 35 U.S.C. § 314(c)."[5] Further, patent owner asserts that, with third party requester no longer participating in the '405 proceeding, "no harm would come to any party if the requested waiver is granted."[6]

In the instant petition under 37 CFR 1.183, patent owner has requested waiver of the prohibition against interviews under 37 CFR 1.955, generally, as opposed to waiver of the regulation for a particular interview request. In this instance, patent owner has not set forth with specificity facts that give rise to an extraordinary situation in which justice requires suspension of 37 CFR 1.955. Patent owner is advised that patent owner may petition under 37 CFR 1.183 for waiver of the prohibition of interviews on the merits on an interview-by-interview basis. Patent owner is reminded that, in each such instance, the petition must establish an extraordinary situation in which justice requires waiver of the regulation.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of 37 CFR 1.955 is dismissed. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.955 as to this particular interview request, no additional fee need be submitted; however, a separate petition paper and petition fee would need to be submitted for each interview request subsequent to the renewed request.

CONCLUSION

1. Patent owner's July 7, 2009 petition paper entitled "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)" is dismissed.

2. Jurisdiction for the '405 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

Kenpet7/IP
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[5] Id.
[6] Id. at page 3.

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(For Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,405
Filed: October 16, 2008
For: U.S. Patent No. 6,687,278

DECISION GRANTING PETITION

This is a decision on patent owner's petition paper entitled "RENEWED PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R § 1.955 (37 C.F.R. § 1.183)," filed on September 18, 2009.

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

No fee is required for the renewed petition under 37 CFR 1.183.[1]

The petition under 37 CFR 1.183 is granted to the extent set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On February 3, 2004, United States Patent Number 6,687,278 (the '278 patent) issued.

2. On October 16, 2008, a request for *inter partes* reexamination of the '278 patent, assigned Reexamination Control No. 95/000,405 (the '405 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '405 proceeding, with an accompanying Office action on the merits.

[1] *See* September 11, 2009 decision dismissing patent owner's July 7, 2009 petition under 37 CFR 1.183.

4. On March 19, 2009, patent owner timely filed a response entitled "AMENDMENT AND RESPONSE BY PATENT OWNER TO FIRST OFFICE ACTION (37 C.F.R. §§ 1.943 & 1.945)" in the '405 proceeding.

5. On March 20, 2009, third party requester filed a paper entitled "REQUESTER'S NOTICE TO THE PATENT OFFICE," notifying the Office of third party requester's withdrawal from participation in the '405 proceeding.

6. On July 7, 2009, patent owner filed a petition paper entitled "PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R. §§ 1.903 AND 1.955 (37 C.F.R. § 1.183)" (petition under 37 CFR 1.183).

7. On September 11, 2009, the Office mailed a decision dismissing patent owner's July 7, 2009 petition under 37 CFR 1.183.

8. On September 18, 2009, patent owner filed the instant petition paper entitled "RENEWED PETITION TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.955 (37 C.F.R. § 1.183)" (renewed petition under 37 CFR 1.183).

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Renewed Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In the September 18, 2009 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, to conduct a single interview with the Office prior to issuance of the next Office action.[2] The instant petition has been fully considered. 37 CFR 1.183 provides for suspension or

[2] Renewed petition under 37 CFR 1.183 at page 4.

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.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form.[3] The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it."[4] Thus, the basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the '405 *inter partes* reexamination proceeding.[5] Thus, only a single party (patent owner) will now participate in the '405 *inter partes* reexamination proceeding, and any interview that might be permitted in the proceeding. Based on the present facts and circumstances, it is found that permitting an interview to be conducted at this point in the '405 *inter partes* proceeding would not be anticipated to potentially hinder the ability of the Office to conduct the '405 *inter partes* proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office prior to issuance of the next Office action, patent owner asserts that, given the complexity of the subject technology (integrated photonic circuits), an interview would "enhance the understanding of the technology and the relevant patentability issues."[6] Patent owner also asserts that, given the number of outstanding rejections ("a total of over two hundred (200) individual rejections applied to the 26 claims"), an interview "may assist the Office in reducing the number of issues associated with these rejections."[7] Further, patent owner asserts that, given the amount of information under consideration, such as patent owner's 131-page March 19, 2009 response, an

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[3] 65 FR at 76768.

[4] 65 FR at 76769.

[5] *Requester's Notice to the Patent Office*, filed March 20, 2009 (stating "Requester Syntune AB hereby notifies the Patent Office that it has reached a Settlement Agreement with the patent owner JDS Uniphase Corporation ("JDSU") and that a settlement and compromise has been reached such that the issues of validity, enforceability, and infringement are no longer in dispute between Syntune and JDSU. ... Accordingly, as part of the Settlement Agreement, Syntune will no longer participate in the Inter Partes Reexamination of U.S. Patent No. 6,687,278, assigned PTO Control No. 95/000,405 and initiated by a request filed on October 16, 2008.")

[6] Renewed petition under 37 CFR 1.183 at page 3.

[7] Renewed petition under 37 CFR 1.183 at page 3.

interview "would provide an opportunity to discuss the substance of the Patent Owner's response in view of the outstanding rejections to clarify and focus the issues...."[8]

In view of the particular facts and circumstances set forth herein, in this instance, the record in the '405 *inter partes* reexamination proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceedings, and the Office. Thus, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that a single interview will be permitted. It is noted, however, that there are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted to the extent that patent owner satisfies the following preliminary requirements.[9]

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.

2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interviews will not be permitted at any other time or place, without the authority of the Director.

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[8] Renewed petition under 37 CFR 1.183 at page 3.

[9] The requirements and guidelines are analogous to those set forth in MPEP 2281 for interviews in *ex parte* reexamination proceedings.

2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by the conferees who signed the December 19, 2008 Office action, or their substitutes (if the conferees are not reasonably available).

4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto. A copy of the interview summary should be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original will be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed either as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview, whichever is later.

2. All papers filed by patent owner in the '405 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's September 18, 2009 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is granted to the extent that a single interview will be permitted, upon compliance with the Preliminary Requirements set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the December 19, 2008 Office action.

3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.

4. Jurisdiction over the '405 inter partes reexamination proceeding is returned to Art Unit 3993 of the Central Reexamination Unit for action not inconsistent with this Decision.

5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

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11-18-09